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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86418459
Applicant	AXEL LTD, CO.
Applied for Mark	THRIFTER
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of AXEL LTD, CO.

Serial No. 86418459

Trademark: THRIFTER

Filing Date: October 8, 2014

BRIEF OF THE APPLICANT

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I. INTRODUCTION

COMES NOW the Applicant AXEL LTD, CO. (hereinafter "Applicant") and through counsel The Trademark Company, PLLC, and provides this Brief of the Applicant in support of its appeal of the examining attorney's refusal to register the instant mark.

II. STATEMENT OF THE CASE

On or about October 8, 2014 Applicant filed the instant trademark with the U.S. Patent and Trademark Office seeking to register the same on in connection with the following services: "on-line retail store services featuring a wide variety of consumer goods of others" in Class 35 and "on-line social networking services" in Class 45.

On or about January 30, 2015 the Examining Attorney refused registration of the Applicant's trademark on the grounds that it is merely descriptive under Section 2(e)(1) of the Trademark Act of 1946 when used on or in connection with Applicant's services.

On or about June 4, 2015 Applicant filed a response to the Office Action dated January 30, 2015 arguing in support of registration. However, ultimately Applicant's argument was not deemed persuasive by the Examining Attorney and, accordingly, on or about June 19, 2015 the Examining Attorney made the refusal final.

The instant appeal now timely follows.

III. ARGUMENT

The Examining Attorney refused registration based upon a finding that the mark is merely descriptive of the Applicant's services. Insofar as Applicant's proposed mark is not merely descriptive of the services identified in the application, Applicant respectfully submits that there is no basis to maintain the instant refusal and that registration of the Applicant's trademark is appropriate.

Matter that "merely describes" the goods or services on or in connection with which it is used is not registrable on the Principal Register. TMEP § 1209. As noted in *In re Abcor Development Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (CCPA 1978):

The major reasons for not protecting such marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.

To be refused registration on the Principal Register under §2(e)(1) of the Trademark Act (hereinafter "the Act"), 15 U.S.C. §1052(e)(1), a mark must be merely descriptive or deceptively misdescriptive of the goods or services to which it relates. TMEP § 1209.01(b). A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. *See In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (APPLE PIE held merely descriptive of potpourri); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY held merely descriptive of lodging reservations services); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984) (MALE-P.A.P. TEST held merely descriptive of clinical pathological immunoassay testing services for detecting and monitoring prostatic cancer); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979) (COASTER-CARDS held merely descriptive of a coaster suitable for direct mailing).

The determination of whether or not a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. TMEP § 1209.01(b)(*emphasis added*). This requires consideration of the context in which the mark is used or intended to be used in connection with those goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services in the

marketplace. *Id.* See also *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

It is not necessary that a term describe all of the purposes, functions, characteristics or features of a product to be considered merely descriptive; it is enough if the term describes one significant function, attribute or property. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d1370, 1371 (Fed. Cir. 2004) ("A mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services," citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); *In re Gyulay*, 820 F.2d at 1218, 3 USPQ2d at 1010.

However, use of a descriptive term in conjunction with other distinguishing elements does not render the entire mark "merely descriptive". Instead, to be characterized as "descriptive," a mark must immediately convey knowledge of the ingredients, qualities or characteristics of the goods or services. *In re Quik-Print Copy Shops Inc.*, 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980) (emphasis added). In the context of the Act, "merely" descriptive means "only" descriptive. *Id.* at n. 7. Moreover, the mark must give some reasonably accurate or tolerably distinct knowledge of the essence of the service. If the information conveyed by the mark is indirect or vague, the mark is being used in a suggestive rather than a descriptive manner. See J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §11:19 (Ed. 2000); *The Money Store v. Harris Corp. Finance, Inc.* 216 USPQ 11, 18 (Cir. 1982) ("THE MONEY STORE' conveys the idea of a commercial establishment whose service involves supplying money. The term does not, however, necessarily convey 'the essence of the business, money lending.... Some imagination and perception are therefore required to identify the precise

nature of the services“); *In re Ralston Purina Company*, 191 USPQ 237, 238 (TTAB 1976) (The term SUPER is not used to describe any real or specific item or characteristic or quality, but merely to connote a vague desirable characteristic or quality and therefore it need not be disclaimed from RALSTON SUPER SLUSH).

In determining whether a particular mark is merely descriptive of a product, a reviewing court is tasked with considering the mark in its entirety, with a view toward “what the purchasing public would think when confronted with the mark as a whole.” *In re Hutchinson Technology Inc.* 852 F.2d 552, 552-54 (Fed. Cir. 1988). To the extent that there may be doubt as to whether applicant’s mark is merely descriptive or suggestive of its goods, it is commonly accepted practice to resolve any doubt in the applicant’s favor and publish the mark for opposition. *In re Morton-Norwich Products, Inc.* 209 USPQ 791 (TTAB 1981); *In re Gourmet Bakers Inc.*, 173 USPQ 565 (TTAB 1972).

Applicant respectfully submits that the instant mark is suggestive of the Applicant’s services and not merely descriptive as contended by the Examining Attorney.

If a consumer has to exercise “mature thought or follow a multi-stage reasoning process” to determine the characteristics of a product or service, then the mark is suggestive, not descriptive. *In re Tennis in the Round, Inc.* 199 USPQ 496, 498 (TTAB 1978) (“This association of applicant’s mark with the phrase ‘theater-in-the-round’ creates an incongruity...,” thus TENNIS IN THE ROUND is not merely descriptive of tennis facilities.). *See also, Blisscraft of Hollywood v. United Plastics Co.* 294 F.2d. 694, 131 USPQ 55 (2d. Cir. 1961) (POLY PITCHER not merely descriptive of polyethylene pitchers; suggestive of Molly Pitcher of Revolutionary time); *In re Colonial Stores, Inc.* 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE not merely descriptive of bakery products; suggestive of nursery rhyme);

Douglas Laboratories Corp. v. Copper Tan, Inc. 210 F.2d 453, 100 USPQ 237 (2d Cir. 1954), cert. denied 347 U.S. 968, 101 USPQ 505 (1954) (finding COPPERTONE for sun tan oil suggestive, not descriptive); *In re Realistic Co.* 440 F.2d 1393, 169 USPQ 610 (CCPA 1971) (finding CURV for permanent wave solution suggestive, not descriptive); and, *Colgate-Palmolive Co. v. House for Men, Inc.* 143 USPQ 159 (TTAB 1964) (finding RAPID-SHAVE for shaving cream suggestive, not descriptive).

In *Equine Technologies Inc. v. Equitechnology Inc.* 68 F.3d 542 (1st Cir. 1995), the court was required to determine whether the mark EQUINE TECHNOLOGIES was descriptive or suggestive when used in connection with high-tech hoof pads for horses. The court cited authorities indicating that the hallmark of the descriptive term is a specific identification of the marked good. *Id.* at 544. In holding the mark EQUINE TECHNOLOGIES to be correctly characterized as suggestive rather than descriptive, the court noted that while there is no dispute that the term “equine” is descriptive of horses, the question is whether the mark, in its entirety, is merely descriptive of the plaintiff’s product — hoof pads for horses. *Id.* at 545. In this case, the court found that the mark itself does not convey information about the plaintiff’s products or its intended consumers. Rather, it requires imagination to connect the term “Equine Technologies” to hoof care products in general, and to the plaintiff’s product in particular.

In *Ex Parte Club Aluminum Products Co.* 105 USPQ 44 (Commissioner 1955), the mark COOK-N-LOOK was held registrable for transparent glass covers for cooking utensils. The mark was somewhat suggestive of a property the goods might have, but like Applicant’s mark, did not describe the goods *per se*:

The mark is a compound word mark which describes what one who uses the covers can do, *i.e.* look into the utensil to see the cooking process, but this does not make the mark descriptive of the covers. The necessity for analysis removes it from the category of mere descriptiveness.

Id

In *Independent Nail & Packing Co. v. Stronghold Screw Products, Inc.* 205 F.2d 921, 925 (Cir. 1953), cert. denied 346 U.S. 491 (1953), the court held that STRONGHOLD as applied to ribbed nails was not descriptive, stating that:

Although the word ‘stronghold’ is suggestive of one of the attributes of plaintiff’s nail with the annular thread, it is not descriptive of a nail, let alone that type of nail. A person unaware of the particular product of the manufacturer, upon seeing or hearing the name ‘stronghold’ would find it virtually impossible to identify the product to which it might have been applied.

Id.

In *Worthington Foods, Inc. v. Kellogg Co.* 732 F. Supp. 1417, 1435 (S.D. Ohio 1990), the court found that a multi-stage reasoning process was necessary before a consumer could understand the message conveyed by the mark HEARTWISE, that is, food which is healthful for the heart. The court also noted that assuming HEARTWISE meant “wise for one’s heart,” it might refer to a large number of goods or services such as running shoes, a treadmill, a calorie counter, or an Ann Landers newspaper column. The court held that HEARTWISE was a suggestive rather than descriptive mark as the consumer could not directly cull a message concerning the healthful characteristics of the goods simply from looking at the mark.

A brief review of other suggestive marks helps clarify this dichotomy:

(1) SUGAR & SPICE for use on bakery products held to be suggestive not descriptive.

In re Colonial Stores, Inc. 394 F.2d 549, 157 USPQ 382 (CCPA 1968).

(2) 100 YEAR NITE-LITE for light with life expectancy of 500 years held to be suggestive not descriptive. *Donsky v. Bandwagon, Inc.* 193 USPQ 336 (D. Mass. 1976).

(3) TENNIS IN THE ROUND held not descriptive of tennis facilities. *In re Tennis in the Round, Inc.* 199 USPQ 496 (TTAB 1978).

(4) RAILROAD SALVAGE for sale of goods from bankruptcy liquidations and discontinued goods held to be suggestive. *Railroad Salvage of Conn., Inc. v. Railroad Salvage, Inc.* 561 F.Supp. 1014 (D.R.I. 1983).

(5) UNDERNEATH IT ALL for undergarment products held to be suggestive in *Maidenform, Inc. v. Munsingwear, Inc.* 195 USPQ 297 (SDNY 1977).

(6) CITIBANK for urban banking services held to be suggestive in *Citibank, N.A. v. Citibanc Group, Inc.* 724 F.2d 1540 (11th Cir. 1984).

(7) CHARRED KEG for bourbon whiskey held to be suggestive, even though bourbon is an American-type whiskey that is made in part by aging carried out in new charred oaken containers. *In re Majestic Distilling Co., Inc.* 164 USPQ 386 (CCPA 1970).

(8) LONGTONG for barbecue tongs held to be suggestive in *Ex parte Nixdorff Krein Mfg Co.*, 115 USPQ 362 (Comm. Pat. 1957).

(9) BRAKLEEN for a brake parts cleaner held to be suggestive and not descriptive in *C.J. Webb, Inc.* 182 USPQ 63 (TTAB 1974).

(10) DRI-FOOT held to be suggestive of foot deodorant in *In re Pennwalt Corp.* 173 USPQ 317 (TTAB 1972).

(11) CHEW 'N CLEAN was held not to be descriptive of tooth powder in *In re Colgate-Palmolive Company* 160 USPQ 733 (CCPA 1969).

(12) COPPERTONE was found not to be descriptive of a suntan preparation in *Douglas Lab Corp. v. Copper Tan, Inc.* 210 F.2d 453, 100 USPQ 237 (2d Cir. 1954), cert denied 347 U.S. 968 (1954).

In the present case, the “mental link” between the trademark THRIFTER and the Applicant’s services as identified in the application is neither immediate nor instantaneous.

A. Assumption of Descriptiveness Not Permitted

In the instant case, the examining attorney assumed that the term THRIFTER has some relationship with the Applicant’s services. Merely because Applicant has chosen to utilize an existing word in the English language does not satisfy the test of being merely descriptive. It is equally as likely that the Applicant’s use of the term in these services is arbitrary or suggestive and not merely descriptive.

Evidence of this fact can be found insofar as the Examining Attorney requested additional information about the proposed use of the mark. Applicant represented that there was none as it is an intent-to-use application. It seems somewhat impossible to therefore maintain a refusal on merely an assumption of descriptiveness in the absence of any evidence thereof.

As such, it is respectfully submitted that in the absence of evidence on the record of the mark being related to the services of the Applicant, there is no such evidence and, accordingly, one cannot assume descriptiveness to maintain the instant refusal. Accordingly, for this reason it is requested that instant refusal based not on facts or evidence of record but an assumption be reversed.

B. Applicant's Trademark is Suggestive Under the TTAB's Three-Part Test

The Trademark Trial and Appeal Board has adopted a three-part test to help determine whether a mark is descriptive or suggestive:

- (1) The degree of imagination necessary to understand the product;
- (2) A competitor's need to use the same terms; and
- (3) Competitors' current use of the same or similar terms.

See No Nonsense Fashions, Inc. v. Consolidated Food Corp., 226 USPQ 502 (TTAB 1985).

(1) Degree of Imagination

Under the degree of imagination test, the greater the number of "imaginative steps" required for a consumer to arrive at a tolerably accurate or direct description of the product or service from the mark itself, the more likely the term is accurately characterized as "suggestive" and not "merely descriptive". *See Railroad Salvage of Connecticut, Inc. v. Railroad Salvage, Inc.*, 561 Fed. 1014 (DCRI 1983). Since there is no instantaneous connection as to the nature of the services provided by the Applicant, it is far more likely that the trademark is correctly deemed suggestive rather than descriptive. *See Stix Products, Inc. v. United Merchants and Manufacturers, Inc.*, 295 Fed. Supp. 479 (SDNY 1968).

In the instant case, a consumer viewing Applicant's mark would need to undertake the following imaginative steps to arrive at a tolerably accurate or direct description of the product or service from the mark itself:

Step 1: Read the mark THRIFTER;

Step 2: With knowledge of the Applicant's services, contemplate whether the mark THRIFTER has any relevance to "on-line retail store services featuring a wide variety of consumer goods of others" in Class 35 and "on-line social networking services" in Class 45 insofar as neither class of services deals with "thrift store services" per se or as recited in the recitation of services.

Step 3: Arrive at the conclusion that there is no readily discernable nexus as between the service mark and the services on that which is known from the recitation of services.

Accordingly, it is respectfully submitted that the refusal at hand cannot pass the first prong of the required test.

(2) Competitor's Need to Use Applicant's Trademark

Next, we consider Applicant's competitor's need to use Applicant's Trademark. Provided that alternative wording exists this part of the test favors registration of the Applicant's trademark. In the instant case, it is clear that Applicant's competitors have numerous choices in regard to alternative language that can be used to identify their own respective services.

Specifically, Applicant's competitors could use the following: PENNYPENCHER or FRUGALER. Accordingly, in consideration of this second factor, it is again far more likely that the trademark is accurately categorized as suggestive rather than descriptive.

(3) Competitor's Current Use of Applicant's Trademark

Finally, we consider Applicant's actual competitor's current use of the trademark at issue. There is little evidence of such use. Moreover, the use, if any, that has been provided, should not

be deemed persuasive as those competitors are, in the Applicant's view, making unauthorized use and potentially infringing upon Applicant's trademark and may soon have to answer to Applicant for these transgressions.

That being said, it is requested that the evidence provided, limited in nature, and most likely simply of infringing activity, should also not be considered to support a finding of descriptiveness.

IV. CONCLUSION

In sum, applying the Trademark Trial and Appeal Board's tests and relevant standards to the refusal at hand, the relevant consuming public would not form an immediate impression of the features, functions, qualities or characteristics of the goods claimed by Applicant by mere sight of the trademark at issue. In view of the above arguments, Applicant believes that the proposed mark is entitled to registration on the Principal Register.

WHEREFORE the Applicant AXEL LTD, CO., by Counsel respectfully requests the Trademark Trial and Appeal Board to reverse the refusal under Section 2(e)(1) of the Trademark Act of 1946 and allow the publication of THRIFTER on the Principal Register.

Respectfully submitted this 5th day of February, 2016

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