

**This Opinion is Not a
Precedent of the TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re gaugewear, Inc.
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Serial No. 86569473
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Robert G. Crouch of Marsh Fischmann & Beyfogle LLP,
for gaugewear, Inc.

Anne M. Farrell, Trademark Examining Attorney, Law Office 118,
Michael W. Baird, Managing Attorney.

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Before Cataldo, Gorowitz and Coggins,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

gaugewear, Inc. (“Applicant”) seeks registration on the Principal Register of the
mark GAUGEWEAR (in standard characters) for:

Biometric data measurement and transmitter device for athletic and
fitness measurements in the nature of multifunctional electronic devices
for measuring and transmitting the core body temperature in
International Class 9; and

Clothing, namely, active wear tops and bottoms, underwear, socks,
belts, hats, scarves, and gloves in International Class 25.¹

¹ Application Serial No. 86569473 was filed on March 19, 2015, based upon Applicant’s
allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the
Trademark Act in connection with both classes of goods.

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant's mark is merely descriptive of both classes of the identified goods. In addition, the Examining Attorney required Applicant to submit information regarding the identified goods pursuant to Trademark Rule 2.61(b). After the Examining Attorney made the refusal and requirement final, Applicant appealed to this Board. We affirm the requirement and moot the refusal.

Preliminary Matter – Section 2(e)(1) Refusal as to Class 25

In its brief, Applicant presents general arguments against the refusal of registration on the ground of mere descriptiveness, and presents specific arguments in relation to its goods identified in Class 9, but not Class 25.² In her brief, the Examining Attorney argues that:

Applicant has limited its appeal to International Class 9. Since applicant has neither responded to nor appealed the examining attorney's Final refusal as to International Class 25 in a timely manner, that International Class and the goods identified therein are deemed abandoned. 37 C.F.R. §2.63(b)(1)-(2); TMEP §714.04.³

Trademark Rule 2.63(b) provides for an examining attorney's issuance of a final refusal or requirement and an applicant's response thereto. Similarly, Trademark Manual of Examining Procedure (TMEP) § 714.04 discusses the form of an examining attorney's final action. Neither supports the Examining Attorney's position that Applicant has "abandoned" its application as to the goods identified in Class 25 as a

² 4 TTABVUE 8-15. Applicant also addresses in its brief the requirement for information under Trademark Rule 2.61(b).

³ 6 TTABVUE 4.

result of its failure to specifically discuss them in its appeal brief in response to the refusal to register under Section 2(e)(1). Simply put, the authorities relied upon by the Examining Attorney do not support her position that Applicant's omission of a specific discussion of the refusal of registration with regard to one of its recited classes of goods constitutes an abandonment of the application on appeal as to those goods.

The filing of a notice of appeal has the effect of appealing all refusals or requirements made final. *In re Citibank, N.A.*, 225 USPQ 612, 613 (TTAB 1985). An applicant's failure to address the refusals or requirements is a basis for affirming an examining attorney's refusal of registration on those grounds. *See In re Heather Harley and Carolyn Jones*, 119 USPQ2d 1775, 1777 (TTAB 2016) (refusing registration based on failure to address or argue any of the examining attorney's refusals or requirements); *In re DTI P'ship, LLP*, 67 USPQ2d 1699, 1701-02 (TTAB 2003) (refusing registration based on failure to address request for information requirement, finding Section 2(e)(1) refusal moot); *In re The Ridge Tahoe*, 221 USPQ 839, 840 (TTAB 1983) (failure to argue correctness of requirement may result in refusal on that ground alone); *In re Big Daddy's Lounges Inc.*, 200 USPQ 371, 372 (TTAB 1978) (failure to respond or argue correctness of requirements on appeal could result in a decision refusing registration by default); *cf. Hyatt v. Dudas*, 551 F.3d 1307, 89 USPQ2d 1465, 1469 (Fed. Cir. 2008) (an appellant who fails to provide any argument in the appeal brief directed to rejected claims has waived a challenge to that ground of rejection, and the Board of Patent Appeals has the discretion to simply affirm any rejections against such claims).

In this case, Applicant has argued against the Section 2(e)(1) refusal, making specific reference to its goods in Class 9. In addition, Applicant discussed in its brief potential meanings of its mark in relation to various types of apparel. We do not construe Applicant's failure to specifically reference its Class 25 goods in its arguments against the mere descriptiveness refusal as an abandonment of its application as to those goods. Therefore, we will consider the issues that are the subject of the instant appeal as they apply to the goods identified in Class 9 and Class 25.

Requirement for Information

In her first office action, the Examining Attorney required Applicant to submit the following information about the identified goods:⁴

To permit proper examination of the application, applicant must submit additional product information about the goods. *See* 37 C.F.R. §2.61(b); *In re AOP LLC*, 107 USPQ2d 1644, 1650-51 (TTAB 2013); *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTI P'ship LLP*, 67 USPQ2d 1699, 1701-02 (TTAB 2003); TMEP §814. The requested product information should include fact sheets, instruction manuals, and/or advertisements. If these materials are unavailable, applicant should submit similar documentation for goods of the same type, explaining how its own product will differ. If the goods feature new technology and no competing goods are available, applicant must provide a detailed description of the goods.

The submitted factual information must make clear how the goods operate, their salient features, and their prospective customers and channels of trade. Conclusory statements regarding the goods will not satisfy this requirement.

⁴ June 25, 2015 office action at 3.

All references to the prosecution history of the involved application are to the .pdf version of the file in the Trademark Search and Document Retrieval (TSDR) database.

Failure to comply with a request for information can be grounds for refusing registration. *In re AOP LLC*, 107 USPQ2d at 1651; *In re DTI P'ship LLP*, 67 USPQ2d at 1701-02; TMEP §814. Merely stating that information about the goods is available on applicant's website is an inappropriate response to a request for additional information and is insufficient to make the relevant information of record. *See In re Planalytics, Inc.*, 70 USPQ2d 1453, 1457-58 (TTAB 2004).

In response, Applicant submitted the following statements:⁵

Further information on the goods can be found at the Applicant's website (www.gaugewear.com). As the product is still under development, further detail is not readily available. In addition, information about a similar product can be found in U.S. Patent No. 8,303,172 (a copy of which is attached). It is currently anticipated that the product will not differ substantially from the patent description.

Applicant's response, indicating that information can be found on its website, ignored the Examining Attorney's statement, supported by decisional law, that such a response is insufficient. Furthermore, no copy of U.S. Patent No. 8,303,172 was attached to Applicant's communication, and none has been subsequently introduced into the record.

The Examining Attorney's December 31, 2015 Office action, raising for the first time the Section 2(e)(1) refusal also at issue herein, noted without elaboration that "The requirement for information about the goods is maintained and continued."⁶ Applicant's July 6, 2016 petition to revive addressed only the mere descriptiveness refusal.

⁵ Applicant's December 7, 2015 communication at 6.

⁶ December 31, 2015 office action at 2.

In her final office action, the Examining Attorney again required further information about the goods identified in the involved application.⁷ The language of this request for additional information is essentially identical to the Examining Attorney's original request for information raised in her June 25, 2015 Office action. The Examining Attorney did not indicate that a copy of U.S. Patent No. 8,303,172 was not made of record; however she did repeat the admonition that merely stating information about the goods is available on Applicant's website fails to satisfy the requirement.

Applicant did not file a request for reconsideration. In its brief, Applicant argues as follows:⁸

In the December 31, 2015 Office Action, the Examining Attorney submitted evidence comprising the information taken from Applicant's website. Therefore, Applicant had no reason to supply such information in Applicant's Response because the Examining Attorney had already entered the information into the record. As the Board pointed out in *Planalytics*, there are several reasons it is necessary to enter information from a website into the record rather than simply referencing the website. Among these reasons cited by the Board are: 1) evidence should be in the record to facilitate further review by the USPTO, 2) Congress requires the Director to send the record to the CAFC if an appeal were taken and therefore the record should be complete with the website information itself, 3) an Examining Attorney should not be required to scavenge a website in search of relevant information, and 4) website content is transitory and may change over time. Importantly, each of these reasons for the Applicant to supply screenshots of the website were satisfied when the Examining Attorney submitted screenshots of the website containing the required information. Requiring Applicant to submit the same information would be redundant and clearly unnecessary because the Examining Attorney previously entered the information into the record. The *Planalytics* opinion indicates that what is important is that the website itself be

⁷ August 9, 2016 office action at 5.

⁸ 4 TTABVUE 16-7.

submitted into the record, not that the Applicant must be the party who submits it.

Moreover, Applicant did not only refer the Examining Attorney to a website, but also referenced a specific U.S. Patent. Given the nature of patents, much of the reasoning behind the Board's requirements for submission of screenshots from a website in *Planalytics* is inapplicable to information contained in a patent. Specifically, a granted patent is not transitory. That is to say, there is no risk that a trademark applicant will revise a patent in order to remove information which may be detrimental to acquiring a trademark. Additionally, patents are technical documents which thoroughly describe a given product or products and the entire copy of a patent may be beneficial to an Examining Attorney in reviewing the product. Therefore, there is no need for an applicant to specifically submit only a portion of a patent because a "scavenger hunt" would not be required. Therefore, the Examining Attorney has provided no precedent to support an assertion that providing a reference to a patent is unacceptable to satisfy a request for information.

"The Office may require the applicant to furnish such information ... as may be reasonably necessary to the proper examination of the application." Trademark Rule 2.61(b). As the Board has noted:

Failure to comply with a request for information is grounds for refusal of registration. *In re Cheezwhse.com Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTI P'ship LLP*, 67 USPQ2d 1699, 1701(TTAB 2003); TMEP § 814. In view of applicant's equivocal responses (not to mention its complete silence on this point in its brief), we find that applicant has not complied with the requirement for more specific information.

In re AOP LLC, 107 USPQ2d 1644, 1651 (TTAB 2013).

A request for information must be clear, and the information requested must be "reasonably necessary" for examination. *See In re SPX Corp.*, 63 USPQ2d 1592, 1597 (TTAB 2002) (affirming requirement under Trademark Rule 2.61(b) "because ... the request for information was reasonable"). An examining attorney generally has considerable discretion in deciding whether and what information should be

requested pursuant to Trademark Rule 2.61(b). An examining attorney's ability to determine the registrability of a trademark is impaired without a clear understanding of the identified goods and services or of the meaning of the mark, and the applicant is often in the best position to supply that information. This is particularly the case where, as here, the application at issue is based upon an assertion of a *bona fide* intent to use the mark in commerce, and there are no specimens of record or other evidence of use of the applied-for mark. Finally, it is settled that the failure to comply with a Trademark Rule 2.61(b) requirement is itself a proper ground for refusal of registration, even if it is the only outstanding refusal or requirement. *In re DTI P'ship LLP*, 67 USPQ2d at 1701-02 (affirming refusal to register under Trademark Rule 2.61 without reaching refusal under Trademark Act § 2(e)(1)).

In this case, the Examining Attorney raised the requirement for information concerning the identified goods in her first office action, continued the requirement in her second office action and, *inter alia*, made the requirement final in her third office action. Applicant's December 7, 2015 response to the first office action impermissibly referred the Examining Attorney to Applicant's website in spite of the Examining Attorney's express indication in the first office action that such a response would be inappropriate and insufficient, and also referred to a patent that it did not make of record. Applicant did not address the information requirement in its July 6, 2016 petition to revive and did not file a request for reconsideration or request for remand by which it could have introduced the required information. Applicant thus

was afforded three opportunities in which to comply with the Examining Attorney's requirement for information and failed to do so.

The submission by the Examining Attorney of information from Applicant's website does not, contrary to Applicant's arguments, relieve Applicant of the obligation to submit such information as required. We have made clear that providing hyperlinks to internet materials is insufficient to make such materials of record. *See In re HSB Solomon Assocs., LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012) (stating that "a reference to a website's internet address is not sufficient to make the content of that website or any pages from that website of record"). Further, there is no indication on this record of the extent of information available on Applicant's website or what portions of it were introduced by the Examining Attorney. It would have been a simple matter for Applicant to submit such information or simply to supplement the information introduced by the Examining Attorney and indicate that such supplementation included the entirety of relevant website information. Similarly, Applicant suggests in its brief that the Examining Attorney or this tribunal should search USPTO records for referenced U.S. Patent No. 8,303,172 and thus obtain the information therefrom. Applicant cites to no authority for its apparent position that either the Examining Attorney or the Board should search USPTO records for a referenced patent or take judicial notice thereof when Applicant easily could have introduced the patent, or its relevant portions, into the record as required. The Board does not take judicial notice of records residing in the Patent and Trademark Office; they must be proved by competent evidence. *See, e.g., In re Jonathan Drew Inc.*, 97

USPQ2d 1640, 1644 n.11 (TTAB 2011) (stating that “the Board's well-established practice is not to take judicial notice of registrations that reside in the USPTO”); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1293 (TTAB 1986) (“[W]e do not take judicial notice of application and registration files that reside in the Patent and Trademark Office on the basis of their mere identification in briefs, pleadings and evidentiary submissions.”).

The information required by the Examining Attorney was “reasonably necessary to the proper examination of the application.” Trademark Rule 2.61(b). Product information from Applicant’s website and patent documentation relating to the goods clearly assist the Examining Attorney in determining, *e.g.*, whether GAUGEWEAR or the terms GAUGE and WEAR comprising the mark are merely descriptive of some or all of the recited goods.

Applicant did not directly answer the outstanding request for information during prosecution, but rather impermissibly directed the Examining Attorney to its website and a referenced patent. It would have been a simple matter to directly provide during prosecution the information required by the Examining Attorney. It was within the Examining Attorney’s discretion to ask for such materials and to refuse registration when the requirement went unsatisfied.

As a result, we find that Applicant failed to comply with the Examining Attorney’s information request as posed in her first and final office actions.

Section 2(e)(1) Refusal

In view of our decision with respect to the Trademark Rule 2.61(b) requirement, we deem the substantive Section 2(e)(1) mere descriptiveness refusal to be moot. Applicant's failure to comply with the Trademark Rule 2.61(b) requirement is a sufficient basis, in itself, for affirming the refusal to register Applicant's mark. *In re DTIP'ship LLP*, 67 USPQ2d at 1701-02. Moreover, our ability to fully and accurately assess the substantive merits of the mere descriptiveness issue has been hindered by Applicant's failure to submit the information and materials, particularly the referenced but not produced patent, which were properly requested by the Trademark Examining Attorney under Trademark Rule 2.61(b). *Id.* See also discussion *supra*. In these circumstances, we decline to reach the merits of that refusal.

Conclusion

We have carefully considered all arguments and evidence of record, including any not specifically discussed herein.

The refusal to register based on Applicant's failure to comply with the Trademark Examining Attorney's final requirement for information under Trademark Rule 2.61(b) is affirmed. The Section 2(e)(1) mere descriptiveness refusal is moot.