

This Opinion is Not a
Precedent of the TTAB

Hearing: November 20, 2019

Mailed: December 17, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Southcorp Brands Pty Limited

Serial No. 88310184

Gary D. Krugman of Sughrue Mion, PLLC,
for Southcorp Brands Pty Limited.

Tracy Fletcher, Trademark Examining Attorney, Law Office 115,
Daniel Brody, Managing Attorney.

Before Cataldo, Mermelstein and Hudis,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Southcorp Brands Pty Limited, seeks registration on the Principal Register of the mark 19 CRIMES (in standard characters) for the following goods and services, as amended:¹

¹ Application Serial No. 88310184 was filed on February 21, 2019, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), as to both classes of goods and services, based upon Applicant's allegation of a bona fide intention to use the mark in commerce.

Upon the Examining Attorney's requirement, Applicant amended the identification of Class 9 goods and Class 41 services in its May 22, 2019 response to the Examining Attorney's May 6, 2019 first Office Action.

motion picture films featuring comedy, drama, action, adventure and animation; prerecorded audio tapes, audio video cassettes, audio video discs, and digital versatile discs featuring music, and motion picture films featuring comedy, drama, action, adventure and animation

in International Class 9; and

production, distribution and rental of motion pictures films; production, distribution, and rental of television and radio programs; production, distribution, and rental of sound and visual recordings in the nature of videos in the field of comedy, drama, action, adventure and animation; production of live-action and animated entertainment television shows; production of entertainment television and radio news programs; provision of entertainment information via communication and computer networks; providing entertainment information services via a global communications network in the nature of websites featuring a wide variety of general interest entertainment information relating to motion picture films, television show programs, musical videos, related film clips, photographs, and multimedia entertainment content; presentation of live stage shows; presentation of live show performances; theater productions; entertainer services, namely, live appearances by a professional entertainer; entertainment services, namely, displaying a series of motion picture films featuring comedy, drama, action, adventure and animation via television broadcast

in International Class 41.

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 19 CRIMES merely describes the subject matter of the recited goods and services. Applicant and the Examining Attorney filed briefs, and also presented arguments at an oral hearing before this panel of the Board.

I. Mere Descriptiveness

In the absence of acquired distinctiveness,² Section 2(e)(1) of the Trademark Act prohibits registration on the Principal Register of “a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive . . . of them.” 15 U.S.C. § 1052(e)(1). A term is “merely descriptive” within the meaning of Section 2(e)(1) if it “immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). “On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive.” *In re Tennis in the Round, Inc.*, 199 USPQ 496, 498 (TTAB 1978); *see also In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987).

A term need only describe a single feature or attribute of the identified goods or services to be descriptive. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001). Whether a mark is merely descriptive cannot

² Applicant has not made a claim of acquired distinctiveness. As noted, the filing basis for this Application is intent-to-use pursuant to Trademark Act Section 1(b). A claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), is normally not filed in a Section 1(b) application before the applicant files an allegation of use, because a claim of acquired distinctiveness, by definition, requires prior use of the mark. TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1212.09(a). Accordingly, the question of whether Applicant’s 19 CRIMES mark has acquired distinctiveness under Trademark Act Section 2(f) is not before us.

be determined in the abstract or on the basis of guesswork. Descriptiveness must be evaluated “in relation to the particular goods [or services] for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use.” *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219 (quoting *In re Bayer AG*, 82 USPQ2d at 1831). The question is not whether a purchaser could guess the nature of the goods from the mark alone. Rather, we evaluate whether someone who knows what the goods or services are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002).

A. Arguments, Evidentiary Objections and Evidence of Record

In her May 6, 2019 first Office Action,³ the Examining Attorney argues

In this case, both the individual components and the composite result are descriptive of applicant’s goods and services and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods and services. Specifically, the wording “19 CRIMES” immediately informs consumers that the identified goods and services feature nineteen crimes that were the basis for “punishment by transportation” from England to Australia.

³ At .pdf 3.

Page references herein to the application record refer to the .pdf version of the USPTO’s Trademark Status & Document Retrieval (TSDR) system. References to the briefs refer to the Board’s TTABVue docket system.

In support of this contention, the Examining Attorney introduced into the record the following dictionary definitions of the terms comprising the mark:⁴

19 – the cardinal number equal to $18 + 1$; and

crime – an act committed in violation of law where the consequence of conviction by a court is punishment, especially where the punishment is a serious one such as imprisonment.

The Examining Attorney further introduced screenshots from Applicant's webpage, excerpted below.⁵



⁴ At .pdf 11-14. Definitions retrieved from ahdictionary.com, from the source The American Heritage Dictionary of the English Language, Fifth Edition 2019.

⁵ At .pdf 6-10.



James Wilson


"Remember this is a voice from the tomb. For is this not a living tomb?" - James Wilson

Though his early life is shrouded in mystery, James Wilson's time in Australia is immortalized in his letter "A Voice from the Tomb" which describes the penal colony experience in vivid detail. It was this letter that proved instrumental in setting in motion the great "Catalpa Rescue."


James Wilson was a convict who played a part in the "Catalpa Rescue" from Australia. In 1876, Harrington, along with six others, braved a massive typhoon in nothing more than a tiny rowboat to board an American whaling ship in what is now remembered as the "Catalpa Rescue."



Cornelius Dwyer Kane



Cornelius Dwyer Kane (aka Keane) (1839-1891) had been a law clerk and cener from Skibbereen, County Cork, Ireland. Transported aboard the Hougoumont, Kane was conditionally pardoned in 1871, but was forbidden from returning to Ireland, so he never reunited with his wife and children there. He did, however, settle in Queensland and became a civil servant.



James Kieley

James also played a part in the "Catalpa Rescue", which obviously didn't go to plan. He was convicted, sent to Western Australia "for life" imprisonment, however he was granted a pardon by the King in 1905. There's a great article on Trove about this [here](#).

19 Crimes.

Join The Banished Newsletter My Account Swag Bag (0)

The Gang The Wines The 19 Crimes The Corks Living Labels Store Locator

The Crimes.

Nineteen crimes turned criminals into colonists. Upon conviction British rogues guilty of a least one of the 19 crimes were sentenced to live in Australia, rather than death. This punishment by "transportation" began in 1783 and many of the lawless died at sea. For the rough-hewn prisoners who made it to shore, a new world awaited. As pioneers in a frontier penal colony, they forged a new country and new lives, brick by brick. This wine celebrates the rules they broke and the culture they built.

1. Grand Larceny, theft above the value of one shilling
2. Petty Larceny, theft under one shilling.
3. Buying or receiving stolen goods, jewels, and plate...
4. Stealing lead, iron, or copper, or buying or receiving.
5. Impersonating an Egyptian.
6. Stealing from furnished lodgings.
7. Setting fire to underwood.
8. Stealing letters, advancing the postage, and secreting the money.
9. Assault with an intent to rob.
10. Stealing fish from a pond or river.
11. Stealing roots, trees, or plants, or destroying them.
12. Bigamy.
13. Assaulting, cutting, or burning clothes.
14. Counterfeiting the copper coin...
15. Clandestine marriage.
16. Stealing a shroud out of a grave.
17. Watermen carrying too many passengers on the Thames, if any drowned.
18. Incurable rogues who broke out of Prison and persons reprieved from capital punishment.
19. Embezzling Naval Stores, in certain cases.

DENOMINATED SINGLE FELONIES PUNISHABLE BY TRANSPORTATION
Whipping, Imprisonment, the Pillory, and Hard Labour in Houses of Correction, according to the Nature of the offence.

the PRINCIPAL of which are the FOLLOWING:

- 1- Grand Larceny, Theft above the value of One Shilling.
- 2- Petty Larceny, Theft under One Shilling.
- 3- Buying or receiving Stolen Goods, Jewels, and Plate...
- 4- Stealing Lead, Iron, or Copper, or buying or receiving.
- 5- Impersonating an Egyptian.
- 6- Stealing from Furnished Lodgings.
- 7- Setting fire to Underwood.
- 8- Stealing Letters, advancing the Postage, and secreting the money.
- 9- Assault with an intent to Rob.
- 10- Stealing Fish from a Pond or River.
- 11- Stealing Roots, Trees, or Plants, or destroying them.
- 12- Bigamy.
- 13- Assaulting, Cutting, or Burning clothes.
- 14- Counterfeiting the Copper Coin...
- 15- Clandestine Marriage.
- 16- Stealing a Shroud out of a Grave.
- 17- Watermen carrying too many passengers on the Thames, if any drowned.
- 18- Incurable rogues who broke out of Prison and persons reprieved from Capital Punishment.
- 19- Embezzling Naval Stores, in certain cases.

In her May 24, 2019 final Office Action,⁶ the Examining Attorney argues

The wording “19 CRIMES” describes the subject matter of the identified entertainment goods and services. In this case, the wording “19 CRIMES” immediately informs consumers that the identified goods and services concern nineteen crimes that were the basis for “punishment by transportation” from England to Australia. The wording refers to the British prisoners who were sent to Australia (instead of the gallows) in

⁶ At .pdf 3.

the 18th century, each of whom was supposed to have violated one of the infamous ‘19 crimes’ of the time. Notably, applicant’s website includes the tab “The 19 Crimes” at the top of the page detailing the nineteen crimes that “turned criminals into colonists” which are the subject of applicant’s goods and services. The examining attorney relies on the above-referenced dictionary definitions and the web pages from applicant’s website previously made of record together with the web pages attached thereto.⁷

In support of this contention, the Examining Attorney relied upon screenshots from a third-party website⁸ discussing wines produced by Applicant under its 19 CRIMES mark featuring interactive labels on their bottles, accessed by means of a cellular phone. Applicant objected to this evidence in its brief⁹ on the basis that:

While the Examining Attorney indicates in the May 24, 2019 Office Action that these website excerpts are from Applicant’s website, they are not. The web pages on their face, have the website address as www.themanual.com with a 2019 copyright notice indicating ownership by Designtecnica Corporation. Applicant does not know the origin of this website and the Examining Attorney does not specifically discuss it, except to generally indicate that she relies on these excerpts. This “evidence” should be excluded as improperly made of record and for misleading the Board by falsely asserting that these excerpts are from Applicant’s website.

Applicant does not further elaborate on its contention that it “does not know the origin of this website”¹⁰ despite the Examining Attorney’s inclusion with the screenshots of the website address as well as the date upon which the website was accessed, *see, e.g., In re I-Coat Co.*, 126 USPQ2d 1730, 1733 (TTAB 2018); *see also* Trademark Board Manual of Procedure (TBMP) § 1208.03 (June 2019), thus

⁷ These are web pages from the third-party website discussed below.

⁸ At .pdf 5-9.

⁹ 6 TTABVUE 7 n.3.

¹⁰ 6 TTABVUE 7 n.3.

complying with the requirements for introducing such evidence into the record. *See In re Mueller Sports Medicine, Inc.*, 126 USPQ2d 1584, 1587 (TTAB 2018); *see also* TMEP § 710.01(b) (October 2018) and authorities cited therein. In addition, the Examining Attorney specifically refers to Applicant's webpages "previously made of record"¹¹ with her May 6, 2019 Office Action and neither claims or implies that the third-party website evidence introduced with her May 24, 2019 Office Action consists of pages from Applicant's own website. Accordingly, we disagree with Applicant's contention that the Examining Attorney misled the Board by falsely making such an assertion. With regard to Applicant's statement that "the Examining Attorney does not specifically discuss [the evidence], except to generally indicate that she relies upon these excerpts",¹² we find it reasonable to infer that the Examining Attorney relied upon the third-party website evidence in support of the sole issue presented in her May 24, 2018 final Office Action and presently on appeal, namely, the refusal of registration on the ground of mere descriptiveness under Trademark Act Section 2(e)(1). In view thereof, we find the third-party website evidence to be admissible as indicative of the perceptions of the author and the content received by the viewer and properly of record. *See, e.g., In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1087 n.4 (TTAB 2016). Nonetheless, inasmuch as this evidence does not directly discuss the goods and services at issue herein, it is entitled to little probative weight in our determination.

¹¹ Examining Attorney's May 24, 2019 final Office Action at .pdf 3.

¹² 6 TTABVue 7 n.3.

The Federal Circuit, our primary reviewing court, has sanctioned the use of internet evidence in ex parte registration proceedings. *See, e.g., In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) (“[i]nternet evidence is generally admissible and may be considered for purposes of evaluating a trademark”) (citations omitted). The Federal Circuit has also noted that, in ex parte proceedings, “administrative agencies like the PTO are not bound by the rules of evidence that govern judicial proceedings.” *In re Epstein*, 32 F.3d 1559, 1565 (Fed. Cir. 1994). In addition, USPTO examining attorneys have a limited ability to collect evidence. *In re Budge Mfg., Inc.*, 857 F.2d 773, 8 USPQ2d 1259, 1260-1261 (Fed. Cir. 1988); *see also In re Pacer Technology*, 338 F.3d 1348, 67 USPQ2d 1629, 1632 (Fed. Cir. 2003) (Federal Circuit was “mindful of the reality that the PTO is agency of limited resources”); *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 868 (Fed. Cir. 1985) (the examining attorney “does not have means” to undertake the research, such as a marketing survey, necessary to prove that the public would actually make the goods/place association asserted).

We reiterate the Board’s well-established practice of taking a more permissive approach to the admissibility and probative value of evidence in an ex parte proceeding than we would in an inter partes proceeding. *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1597 (TTAB 2018); *In re Sela Products LLC*, 107 USPQ2d 1580, 1584 (TTAB 2013) (“...the Board does not, in ex parte appeals, strictly apply the Federal Rules of Evidence, as it does in inter partes proceedings.”). In ex parte proceedings, the Board observes the spirit of the rules of evidence rather than

exalting their technical requirements. *See In re Hudson News Co.*, 39 USPQ2d 1915, 1920 n.10, 1924 n.18 (TTAB 1996), *aff'd without opinion* (Fed. Cir. 1997) (Board allowed NEXIS evidence to show psychological effect of color blue, despite hearsay nature, recognizing the difficulty for examining attorney to establish such fact without relying on NEXIS evidence; Board also accepted sufficiency of evidence showing features of applicant's trade dress were common, recognizing that USPTO's limited resources constrain an examining attorney's ability to acquire photographs of interiors of retail establishments); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565 (TTAB 1996); *In re Murphy Door Bed Co.*, 223 USPQ 1030, 1032 n.9 (TTAB 1984). *See also In re Berman Brothers Harlem Furniture Inc.*, 26 USPQ2d 1514, 1515 (TTAB 1993); TBMP § 1208.

In her brief,¹³ the Examining Attorney argues:

The evidence of record makes clear that nineteen particular crimes are the subject of applicant's goods and services. In particular, the wording 19 CRIMES immediately informs consumers that the identified entertainment film and television goods and services concern nineteen historical crimes that were the basis for "punishment by transportation" from England to Australia. The wording refers to British prisoners who supposedly violated one of the infamous nineteen crimes of the time and were sent to Australia instead of the gallows.¹⁴

¹³ Examining Attorney's brief, 8 TTABVUE 5 (internal citations omitted).

¹⁴ The dissent argues that the Examining Attorney "abandoned" her position that the 19 CRIMES mark merely describes the nineteen crimes forming the basis for a sentence of transportation to Australia, and that Applicant did not have a full and fair opportunity to respond to this argument in its brief. However, as noted above the Examining Attorney raised and maintained this argument in her first and final Office Actions and appeal brief, and added in her final Office Action and brief the argument that the mark also merely describes the prisoners themselves who were convicted of these crimes. We thus disagree with the dissent's position that Applicant was not on notice of the Examining Attorney's basis for maintaining the refusal of registration or afforded an opportunity to respond thereto. We further note that Applicant neither advanced this argument nor requested remand to address

In its brief,¹⁵ Applicant argues:

In the present case, Applicant submits that the mark “19 CRIMES” clearly falls on the suggestive side of the descriptive/suggestive line, as applied to the goods/services identified in the application, inasmuch as it does not immediately or directly describe any feature, characteristic or quality of any of Applicant’s goods or services. As is shown in Applicant’s website, the term “19 CRIMES” refers to a time in late 18th and 19th century England where if an individual was convicted of one or more of 19 enumerated crimes, that individual would be sentenced to live in exile in Australia, rather than put to death. These convicted individuals became pioneers in what was then a frontier penal colony, developing the new country of Australia. The mark “19 CRIMES” references those crimes as part of that late 18th and 19th century practice of banishing those convicted individuals to live in Australia. The mark is a classic example of a mark which clearly requires thought, imagination and a multi-stage reasoning process in order to arrive at a conclusion with respect to the characteristics or features of any of the goods/services set forth in the application. That the subject matter of one or more of Applicant’s intended television programs, films, etc. may be related to this time of history in England and Australia does not make the mark “merely descriptive” of any of the goods or services. In point of fact the subject matter of the intended products and services is not the 19 crimes that would result in someone shipped from England to Australia. Rather, the subject matter of the intended products and services are the individuals who were exiled to Australia, which individuals had their own unique stories and which individuals became colonists and pioneers in the development of the new country of Australia. Applicant’s website excerpts of record herein support this argument as these excerpts refer to certain of these individuals exiled to Australia, each of whom had a unique story to tell.

Applicant thus argues that the subject matter of its identified goods and services under the 19 CRIMES mark is not the 19 enumerated crimes themselves, but the

any substantive or procedural issue in this proceeding. *See, e.g., In re Adlon Brand GmbH & Co.*, 120 USPQ2d 1717, 1725 (TTAB 2016); *See also* TBMP § 1209.04.

¹⁵ Applicant’s brief, 6 TTABVUE 8-9.

stories of those “incorrigible rogues” who were sentenced to colonize Australia upon being convicted of those crimes. Applicant states in its reply brief:¹⁶

As is clear from Applicant’s web pages which are of record herein, the subject matter of the intended products and services covered by Applicant’s application is not the 19 crimes that would result in someone convicted of one or more of those crimes being deported from England to Australia. Rather, it is a number of the individuals who were exiled to Australia which is the focus of and the subject matter of the intended products and services. Reviewing the website evidence of record shows that Applicant focuses on various individuals exiled to Australia, specifically, John Boyle O’Reilly, Michael Harrington, James Wilson, Cornelius Dwyer-Kane and James Kieley. Each of these individuals, and others like them, became pioneers in what was then a frontier penal colony – Australia, and helped forge a new country and new lives. Each of these individuals had their own story, leading to their conviction, their exile to Australia, and their lives in Australia afterwards.

B. Discussion

Based upon the evidence of record, we make the following findings of fact:

- as defined, 19 CRIMES directly describes nineteen acts committed in violation of law resulting upon conviction in a serious penalty such as imprisonment;
- in 18th and 19th Century Britain, criminal jurisprudence enumerated nineteen crimes that carried a punishment of “transportation” by ship for forced colonization of a penal colony located in present-day Australia;
- Applicant produces wines, including Australian wines inspired by the enumerated nineteen crimes and the convicts turned colonists who were sentenced to colonize Australia upon conviction;

¹⁶ Applicant’s reply brief, 9 TTABVUE 3-4.

- Applicant's 19crimes.com website features several tabs. "The 19 Crimes" tab enumerates the 19 antique crimes that "turned criminals into colonists"¹⁷ and notes that Applicant's "wine celebrates the rules they broke and the culture they built."¹⁸ "The Gang" tab discusses the lives and feats of several individual convicts transported as colonists to Australia.

Applicant offers motion pictures, audio and video tapes, cassettes and discs as well as production, distribution and rental thereof and related entertainment services under its 19 CRIMES mark. Because Applicant's goods and services are broadly identified as to subject matter in the field of entertainment, we find that the relevant purchasing public for these goods and services includes anyone interested in entertainment in the fields of comedy, drama, action, adventure or animation. In other words, Applicant's goods and services appear to be intended for the general public. We therefore consider the impression the 19 CRIMES mark will have upon the general public encountering the mark in connection with the identified goods and services. The question is not whether someone presented only with the mark could guess what the goods are, but "whether someone who knows what the goods and services are will understand the mark to convey information about them." *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 103 USPQ2d at 1757 (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002).

¹⁷ May 6, 2019 Office Action at .pdf 9-10.

¹⁸ *Id.*

Applicant's goods include motion picture films, prerecorded audio and video tapes, cassettes and discs featuring comedy, drama, action, adventure and animation. These goods are broadly identified as to their subject matter and encompass motion picture films, tapes, cassettes and discs on the subject of the nineteen crimes in 18th and 19th Century Britain forming the basis for a sentence of transportation to Australia. These crimes and the imposition of sentencing thereunder are encompassed within the subjects of dramas, action/adventure stories, and possibly dark comedies. 19 CRIMES thus merely describes the subject matter of Applicant's goods in Class 9.

Applicant's services include production, distribution and rental of motion picture films, television and radio programs, videos, websites and live performances in the fields of comedy, drama, action, adventure and animation. These services are also broadly identified as to their subject matter and, similar to Applicant's goods, encompass various production, distribution and rental of programs and providing entertainment services on the subject of the nineteen crimes resulting in a sentence of transportation to Australia. 19 CRIMES thus is merely descriptive of the subject matter of Applicant's dramas, action/adventure stories and potentially comedies in Class 41.

Applicant argues that the subject matter of its goods and services is not the nineteen crimes themselves, but rather the convicts who were exiled to Australia thereunder and their stories of adversity. We note, however, that Applicant's goods and services are not so limited, and Applicant's own website includes a tab labeled "the 19 Crimes" enumerating the crimes that predicated the sentence of

transportation to Australia upon the convicts who would become unwilling colonists there. While Applicant may intend for its goods and services to focus on the convicts and their stories as opposed to the crimes, as discussed above, Applicant's broadly identified goods and services may include the subject of the nineteen crimes and the ramification of conviction thereof. As has often been stated, our mere descriptiveness determination must be based on the significance of the term in connection with Applicant's goods and services, not in the abstract. *See, e.g., Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *cf. Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014) ("Parties that choose to recite services in their trademark application that exceed their actual services will be held to the broader scope of the application.").

Applicant further argues that when the 19 CRIMES mark is considered not in relation to the crimes themselves but to the individuals transported to Australia upon conviction thereof, the mark is suggestive "inasmuch as it does not immediately or directly describe any feature, characteristic or quality of any of Applicant's goods or services."¹⁹ We disagree that consumers encountering the 19 CRIMES mark must use imagination, thought or perception to perceive the nature of Applicant's identified entertainment products and services on the subject of individuals convicted of the nineteen crimes resulting in a sentence of transportation to Australia. However, as discussed above, because we find Applicant's mark to merely describe the nineteen

¹⁹ 6 TTABVue 8.

crimes themselves under the broadly stated subject matter of Applicant's goods and services, we need not make such a finding.²⁰

Further, it is settled that a term is merely descriptive if it describes a single feature or characteristic of the identified goods or services. *Dial-A-Mattress*, 57 USPQ2d at 1812. In this case, 19 CRIMES is merely descriptive of the subject matter of Applicant's broadly worded audio and video products and services, which is a sufficient basis to find Applicant's proposed mark merely descriptive. *See, e.g., In re Putman Publ'g Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE merely descriptive of news and information services in the food processing industry). Applicant acknowledges that "The mark '19 CRIMES' references those crimes as part of that late 18th and 19th century practice of banishing those convicted individuals to live in Australia."²¹ It is "settled that so long as any one of the meanings of a term is descriptive, the term may be considered to be merely descriptive." *In re Chopper Ind.*, 222 USPQ 258, 259 (TTAB 1984); *see also, In re IP Carrier Consulting Group*, 84 USPQ2d 1028, 1034 (TTAB 2007); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Here, the proposed mark is 19 CRIMES, conviction of which resulted in involuntary transportation to a penal colony in Australia.

²⁰ The dissent posits that our determination that Applicant's 19 CRIMES mark merely describes its broadly worded goods and services is "grounded upon subjective abstractions and guesswork". We disagree, and note our finding is based upon evidence of record from Applicant's own website and recitation of goods and services. We note in addition that the dissent relies in support of its arguments upon third-party registrations that are not in the record.

²¹ Applicant's brief, 6 TTABVUE 8.

II. Conclusion

The evidence submitted by the Examining Attorney establishes that the proposed mark 19 CRIMES is a merely descriptive term related to the subject matter of Applicant's identified goods and services. When 19 CRIMES is used in connection with Applicant's identified informational and entertainment products and services, it immediately tells consumers about a feature of those goods and services, namely, that the information and entertainment provided relates to the 19 crimes of 18th and 19th Century Britain that led to involuntary colonization of Australia.

Decision: The refusal to register Applicant's mark 19 CRIMES is affirmed.

Hudis, Administrative Trademark Judge, dissenting:

Because I believe the majority misapplies the law of mere descriptiveness to the facts of this appeal, considered evidence that should have been found inadmissible, and supported its decision on a theory not advanced by the Examining Attorney during briefing, I respectfully dissent.

I. Legal Principles of Mere Descriptiveness

Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), prohibits registration on the Principal Register of a mark which, when used on or in connection with the goods of the applicant is merely descriptive of them. *See also* Trademark Act Section 3, 15 U.S.C. § 1053, applying the same rules for registration of service marks (for services) as they are applied to trademarks (for goods). "A term is merely descriptive if it **immediately** conveys knowledge of a quality, feature, function, or characteristic of

the goods or services with which it is used.” *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir.1987)) (emphasis added). “On the other hand, ‘if a mark requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods [or services], then the mark is suggestive.” *In re MBNA Am. Bank, N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) (quoting *In re Nett Designs*, 236 F.3d 1339, 57 U.S.P.Q.2d 1564, 1566 (Fed. Cir. 2001).

“The categories are in actuality ‘central tones in a spectrum ... and are frequently difficult to apply.” *In re Gyulay*, 3 USPQ2d at 1010 (quoting *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 207 USPQ 278, 282 (5th Cir.1980), *cert. denied*, 450 U.S. 981 (1981)). “As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment.” *Anheuser-Busch, Inc. v. Holt*, 92 USPQ2d 1101, 1105 (TTAB 2009).

Our “determination that a mark is merely descriptive is a factual finding” which must be supported “by substantial evidence.”²² *In re Stereotaxis, Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005). Whether a mark is merely descriptive or not

²² The “substantial evidence standard” asks “whether a reasonable person might find that the evidentiary record supports the agency’s conclusion[.]” and “involves examination of the record as a whole, taking into account evidence that both justifies and detracts from an agency’s decision.” *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000).

is “determined from the viewpoint of the relevant purchasing public,” *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986), and “[t]he Board resolves doubts as to the mere descriptiveness of a proposed mark in favor of the applicant.” *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016).

Whether a mark is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the mark is used, not in the abstract or on the basis of guesswork. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, we evaluate whether someone who knows what the goods or services are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). A mark need not immediately convey an idea of each and every specific feature of the goods in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the goods. *See In re Gyulay*, 3 USPQ2d at 1010; *In re H.U.D.D.L.E.*, 216 USPQ 358, 359 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338, 339 (TTAB 1973).

II. Review of the Factual Record, and the Majority’s Findings of Fact

As noted by the majority, the Examining Attorney’s mere descriptiveness refusal to register Applicant’s mark was supported by a very thin evidentiary record, consisting of the following:

- Dictionary definitions of the terms comprising the mark:²³
 - 18 + 1 = “19”; and
 - “Crime” – an act committed in violation of law where the consequence of conviction by a court is punishment, especially where the punishment is a serious one such as imprisonment.
- Screenshots from Applicant’s website at 19crimes.com, shown above in the majority’s opinion.²⁴
- Screenshots from a third-party website at themanual.com, not shown above in the majority’s opinion, posting an article entitled “Food & Drink: Learn about the 19 Crimes that Inspired a Wine Label (and a new AR App).”²⁵

Beginning with the third-party website at themanual.com, as the majority notes, Applicant objected to the inclusion of this evidence in the record on appeal.²⁶ While the Examining Attorney included the required URL and capture date for this website evidence, *see In re I-Coat Co.*, 126 USPQ2d 1730, 1733 (TTAB 2018), the general purpose for this requirement is so that “an applicant can verify the information presented in the case.” *Id.*

In fact, Applicant could not verify this information, and stated in its brief that it did not know the origin of the site. Moreover, the themanual.com evidence should have been afforded no probative value, and to the extent the majority found the evidence admissible it should have been “only to show what [was posted on the site] ..., not the truth of what [was posted]” *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1040 (TTAB 2010). Finally, as noted by the majority, the discussion on the themanual.com site has nothing to do with the goods and services identified in the 19

²³ May 6, 2019 Office Action at .pdf 11-14.

²⁴ *Id.* at .pdf 6-10.

²⁵ May 24, 2019 Office Action at .pdf 5-9.

²⁶ Applicant’s Brief, 6 TTABVUE 7 n.3.

CRIMES application at issue, and therefore is irrelevant. Fed. R. Evid. 401, 402.

In my view, the themanual.com hearsay evidence should not have been considered for a factual history of the so-called “19 Crimes” associated with 19th century England and Australia, and should have been given no weight nor relied upon by the majority for factual findings. Fed. R. Evid. 801, 802. In this connection, the majority’s reliance on *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1087 n.4 (TTAB 2016) for the admissibility of the themanual.com site is inappropriate. The third-party evidence at issue in *In re Mr. Recipe* was the ENCYCLOPEDIA BRITANNICA, a reference having much greater guarantees of trustworthiness than a relatively unknown opinion blog.

In large part, moreover, the majority justifies ignoring the rules of evidence by citing a line of cases tracing their origins to before and shortly after the advent of the Internet, when Trademark Examining Attorneys had much less access to publicly available information. Taking a more permissive approach to the admissibility and probative value of evidence in an ex parte proceeding should not justify ignoring the rules of evidence altogether.

This leaves us with the few pages from Applicant’s 19crimes.com website that were made of record by the Examining Attorney. What those pages show are (1) a list of the 19 crimes that could result in someone being shipped from England to Australia, and (2) brief descriptions of certain individuals who were exiled to Australia, and who became colonists and pioneers in the development of Australia as new country.²⁷

²⁷ See Applicant’s brief, 6 TTABVUE 8-9.

Turning now to the findings of fact stated by the majority:

- “As defined, 19 CRIMES directly describes nineteen acts committed in violation of law resulting upon conviction in a serious penalty such as imprisonment.”

This finding is not supported by the admissible record.

- “In 18th and 19th Century Britain, criminal jurisprudence enumerated nineteen crimes that carried a punishment of “transportation” by ship for forced colonization of a penal colony located in present-day Australia.”

This finding is not supported by the admissible record.

- “Applicant produces wines, including Australian wines inspired by the enumerated nineteen crimes and the convicts turned colonists who were sentenced to colonize Australia upon conviction thereof.”

This finding, taken from a statement in Applicant’s brief, is irrelevant to the goods and services identified in the 19 CRIMES application at issue.

- “Applicant’s 19crimes.com website features several tabs. “The 19 Crimes” tab enumerates the 19 antique crimes that “turned criminals into colonists” and notes that Applicant’s “wine celebrates the rules they broke and the culture they built. “The Gang” tab discusses the lives and feats of several individual convicts transported as colonists to Australia.”

Besides the contents of the 19 CRIMES application and the definitions of “19” and “Crimes,” this is the only other admissible evidence of record.

III. Consideration of Applicant’s 19 CRIMES Mark in the Context of the Goods and Services Identified in the Application

For ease of discussion, a shortened description of “Applicant’s Class 9 Goods” may be stated as video and/or audio works recorded on various types of media featuring comedy, drama, action, adventure, animation and music; and a shortened description of “Applicant’s Class 41 Services” may be stated as production, distribution and rental

of live and recorded entertainment featuring comedy, drama, action, adventure and animation.

At its core, the underpinnings of the majority's conclusion that Applicant's 19 CRIMES mark is merely descriptive of Applicant's identified goods and services are the following:

- Applicant's Class 9 Goods "are broadly identified as to their subject matter and **encompass** motion picture films, tapes, cassettes and discs on the subject of the nineteen crimes in 18th and 19th Century Britain forming the basis for a sentence of transportation to Australia. These crimes and the imposition of sentencing thereunder **are encompassed within** dramas, action/adventure stories, and possibly dark comedies. 19 CRIMES thus merely describes the subject matter of Applicant's goods in Class 9. (Emphasis added).
- Applicant's Class 41 Services "include production, distribution and rental of motion picture films, television and radio programs, videos, websites and live performances in the fields of comedy, drama, action, adventure and animation. These services are also broadly identified as to their subject matter and, similar to Applicant's goods, **encompass** various production, distribution and rental of programs and providing entertainment services on the subject of the nineteen crimes resulting in a sentence of transportation to Australia. 19 CRIMES thus is merely descriptive of the subject matter of Applicant's dramas, action/adventure stories and potentially comedies in Class 41. (Emphasis added).

As the emphasis added above illustrates, the majority's opinion that Applicant's 19 CRIMES mark is merely descriptive of the identified goods and services in Classes 9 and 41 is grounded upon subjective abstractions and guesswork (that is, what Applicant's goods and services could "encompass"), contrary to the proscriptions of *In re Abcor Dev. Corp.*, 200 USPQ at 218 and *In re Remacle*, 66 USPQ2d at 1224.

By the logic of the majority, any application for a mark on the subject of recorded media, and related entertainment services, in the fields of comedy, drama, action, adventure and animation, if their topics conceivably could cover the subject of the

mark, would be unregistrable absent a showing of acquired distinctiveness. This cannot be Office registration policy as shown by the following marks registered on the Principal Register without a showing of secondary meaning: CSI: CRIME SCENE INVESTIGATION (Reg. No. 2775596), LAW & ORDER (Reg. No. 2588624), MIAMI VICE (Reg. No. 1409888), NYPD BLUE (Reg. No. 1836383), and CRIMINAL MINDS (Reg. No. 3162620).

Moreover, the majority opinion concedes that Applicant's identified goods and services are intended for the general public. The viewpoint of the relevant purchasing public is a mandatory consideration as required by the Federal Circuit Court of Appeals in *In re Bed & Breakfast Registry*, 229 USPQ at 819. Whether a term is entitled to trademark status turns on how the mark is understood by the relevant purchasing public. *Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1553 (Fed. Cir. 1991). That is, whether people who know what the goods and services are (recorded and live entertainment) will understand the mark to convey information about them. *DuoProSS Meditech*, 103 USPQ2d at 1757.

Taking all of the admissible evidence at face value, only a very small sliver of the relevant purchasing public "might" have some idea (if any) of the content of Applicant's Class 9 and 41 Goods and Services based on the 19 CRIMES mark – university educated individuals with a major or concentration in 19th Century British history. The vast majority of the relevant purchasing public, which the majority concedes are general consumers of recorded and live entertainment, will have no

notion that 19 CRIMES immediately and directly describes the content of Applicant's Class 9 and 41 Goods and Services.

As argued by Applicant and the Examining Attorney in their briefs, based only in part upon the content of Applicant's 19crimes.com website, the intended content of Applicant's Class 9 Goods and Class 41 Services concerns the individuals who were exiled to Australia, each of whom had their own unique stories in becoming colonists and pioneers in the development of the new country of Australia. The intended content of Applicant's Class 9 Goods and Class 41 Services is not about the so-called 19 crimes per se. However, the majority posits (speculates) that Applicant's Class 9 Goods and Class 41 Services are so broadly worded in the Application that this **could be** about the 19 crimes themselves based solely upon a bureaucratic reading of Applicant's identified goods and services.

The majority opinion's reliance on *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014) for the proposition that "parties that choose to recite services in their trademark application that exceed their actual services will be held to the broader scope of the application" is inapposite. The Federal Circuit made that statement in the context of its analysis of the sophistication of the parties' potential customers in an opposition proceeding (based on likelihood of confusion), not as part of an analysis regarding whether either party's mark was, or was not, merely descriptive.

So what is the average consumer of Applicant's Class 9 Goods and Class 41 Services, members of the general public, likely to believe upon encountering

Applicant's 19 CRIMES mark? Will Applicant's recorded and live programming be about modern day or historical criminal behavior or laws? Will Applicant's programming be about modern-day or historical figures convicted of a certain list of 19 CRIMES? According to the admissible evidentiary record, the 19 CRIMES mark simply does not immediately and directly tell us. Rather, the average consumer will have to engage in an exercise of imagination, thought, and perception to arrive at a notion as to the content of Applicant's applied-for Class 9 Goods or Class 41 Services. In my view, this vaults the 19 CRIMES mark over the merely descriptive bar and onto the suggestive platform of registrability. I thus believe that the majority's opinion affirming the Examining Attorney's denial of registration based on mere descriptiveness is not supported by substantial evidence.

IV. The Majority's Opinion that Applicant's 19 CRIMES Mark is Merely Descriptive is based upon a Theory Not Maintained by the Examining Attorney.

Finally, as noted above by the majority, in the May 6, 2019 first Office Action²⁸ the Examining Attorney argues:

In this case, both the individual components and the composite result are descriptive of applicant's goods and services and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods and services [identified in the Application].

²⁸ At .pdf 3.

Page references herein to the application record refer to the .pdf version of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs refer to the Board's TTABVUE docket system.

Continuing, in the May 24, 2019 final Office Action,²⁹ the Examining Attorney argues:

The wording “19 CRIMES” describes the subject matter of the identified entertainment goods and services. In this case, the wording “19 CRIMES” immediately informs consumers that the identified goods and services concern nineteen crimes that were the basis for “punishment by transportation” from England to Australia. The wording refers to the British prisoners who were sent to Australia (instead of the gallows) in the 18th century, each of whom was supposed to have violated one of the infamous ‘19 crimes’ of the time. Notably, applicant’s website includes the tab “The 19 Crimes” at the top of the page detailing the nineteen crimes that “turned criminals into colonists” which are the subject of applicant’s goods and services.

Then, the Examining Attorney in her brief³⁰ argues that:

The evidence of record makes clear that nineteen particular crimes are the subject of applicant’s goods and services. In particular, the wording 19 CRIMES immediately informs consumers that the identified entertainment film and television goods and services concern nineteen historical crimes that were the basis for “punishment by transportation” from England to Australia. (See webpages from applicant’s website, www.19crimes.com, attached to the Office Action dated May 6, 2019.)

Thus, after issuing the First Office Action, it appears the Examining Attorney abandoned the theory (now relied upon by the majority) that Applicant’s 19 CRIMES mark is merely descriptive, generally, of Applicant’s Class 9 Goods and Class 41 Services as recited in the Application. Rather, the theory relied upon by the Examining Attorney in the Final Office Action and her brief on appeal is that Applicant’s 19 CRIMES mark is merely descriptive of Applicant’s goods and services as amplified by Applicant in its 19crimes.com website. I thus believe it unfair for the

²⁹ At .pdf 3.

³⁰ Examining Attorney’s brief, 8 TTABVUE 5.

majority to affirm the Examining Attorney's mere descriptiveness refusal based upon a theory to which Applicant did not have a full and fair opportunity to respond in its reply brief.

The majority's reliance on *In re Adlon Brand GmbH & Co.*, 120 USPQ2d 1717, 1725 (TTAB 2016) and TBMP § 1209.04 is misplaced. *In re Adlon Brand* involved the applicant's grievance that the examining attorney, in her office action in response to the applicant's request for reconsideration, presented a new issue based on significantly different evidence. The Board said that if the applicant believed the office action was procedurally erroneous, or if the applicant desired more time to address the examining attorney's new evidence, the applicant's recourse was to file with the Board, after the filing of the appeal but before briefing, a request for remand with a showing of good cause. Similarly TBMP § 1209.04 discusses generally an Applicant's request for remand under circumstances not present on this appeal. Here, by contrast, the majority affirms the refusal to register based upon a theory not maintained in the Examining Attorney's brief on appeal and to which Applicant did not have an opportunity to respond. This is manifestly unfair.

V. Conclusion

At best, based upon the admissible evidence of record, it is a close case as to whether Applicant's 19 CRIMES mark is merely descriptive or suggestive of Applicant's Class 9 Goods and Class 41 Services. In such close cases, the proper outcome is to find the mark suggestive and publish the Application for potential opposition. *In re Entenmann's Inc.*, 15 USPQ2d 1750, 1751 n.2 (TTAB 1990) ("[I]n ex parte cases involving a refusal to register on the basis of mere descriptiveness, it is

the practice of this Board to resolve doubts in favor of the applicant and pass the mark to publication.”). I therefore dissent.