

# Exhibits

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TRADEMARK  
ATTY. DOCKET NO. BBU/62

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

TRADEMARK TRIAL AND  
APPEAL BOARD  
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Applicant : BBI Marketing Services, Inc.  
Serial No. : 76/013,877  
Filed : March 30, 2000  
Mark : BASES PRODUCT ADVISOR  
Attorney : Sally Shih  
Law Office : 106

Cincinnati, Ohio

June 11, 2002

Assistant Commissioner for Trademarks  
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06-14-2002

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**APPLICANT'S APPEAL BRIEF**

**I. INTRODUCTION**

Pursuant to a Notice of Ex Parte Appeal filed April 10, 2002, Applicant has appealed the Trademark Examining Attorney's final refusal to register Applicant's mark BASES PRODUCT ADVISOR for "Market research services," in International Class 35 under Section 6 of the Trademark Act. The Examiner's final refusal is based solely on Applicant's refusal to

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Kathryn E. Smith

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comply with the Examiner's requirement to insert a disclaimer of the terms "PRODUCT ADVISOR" into the application.

## **II. RELEVANT FACTS**

The facts which set the groundwork for this appeal show that Applicant's mark is entitled to registration.

Applicant, BBI Marketing Services, Inc., is the owner of a family of "BASES" marks. Because of Applicant's success and its widespread marketing efforts, Applicant's BASES marks have become well-known within the market research industry. As a result of the recognition of the quality of services rendered and promoted by Applicant in connection with its BASES family of marks, Applicant's marks have become valuable corporate assets which customers have come to associate with Applicant's business.

Specifically, Applicant's family of "BASES" containing marks include the following:

- (1) BASES  
Registration No. 1,206,443  
Status: Registered  
Goods/Services: Marketing research services  
Int.'l Class: 35
  
- (2) BASES LAUNCH CONTROL  
Status: Cancelled Under Section 8  
Registration No. 1,693,496  
Goods/Services: Market research services  
Int.'l Class: 35

- (3) BASES PRICE ADVISOR  
Serial No. 76/033,606  
Status: Pending; Applicant must file an Amendment to Allege Use before case can proceed to issue on the Supplemental Register  
Goods/Services: Market research services  
Int.'l Class: 35
- (4) BASES BRAND ADVISOR  
Serial No. 76/002,958  
Status: Pending  
Goods/Services: Market research services  
Int.'l Class: 35
- (5) BASES XRX  
Registration No. 1,831,531  
Status: Registered  
Goods/Services: Market research services  
Int.'l Class: 35
- (6) BASES-BY-MAIL  
Registration No. 1,823,126  
Status: Registered  
Goods/Services: Market research services  
Int.'l Class: 35
- (7) PRE-BASES  
Registration No. 1,737,005  
Status: Registered  
Goods/Services: Market research services  
Int.'l Class: 35
- (8) BASES ATTVISOR  
Serial No. 76/161,762  
Goods/Services: Market research services  
Int.'l Class: 35

Copies of each of the foregoing applications and registrations are enclosed  
herewith for purposes of establishing a record herein.

A copy of Applicant's website, [www.bases.com](http://www.bases.com), is attached as **Exhibit A** for the Board's reference, to illustrate the context in which Applicant's marks correlate to one another, and the services provided by Applicant in connection with its various BASES marks.

### **III. APPLICANT'S ARGUMENTS IN RESPONSE TO THE REFUSAL UNDER §6**

Through Applicant's development of the foregoing family of BASES marks, and the identity of the BASES brand, Applicant has established a favorable reputation among the relevant consuming public. Were Applicant to disclaim its rights to the terms "PRODUCT ADVISOR" in their entirety, any of Applicant's competitors could develop a competitive "PRODUCT ADVISOR" service, e.g., "Jones Product Advisor" which would effectively dilute the established value of Applicant's BASES brand of services.

Section 6 of the Trademark Act requires "unregistrable matter" or "an unregistrable component" of the mark to be disclaimed. Typically an unregistrable component of a registrable mark is matter which does not indicate source, or matter which is merely descriptive or deceptively misdescriptive of the goods or services, or primarily geographically descriptive of them. While the terms "PRODUCT ADVISOR" in Applicant's BASES PRODUCT ADVISOR mark may be somewhat suggestive of the nature of Applicant's services, Applicant contends that those terms are not so descriptive, or merely descriptive of market research services, such that they *immediately* convey the notion of Applicant's services.

In terms of the disclaimer requirement for terms which are *merely descriptive*, one would typically understand the term 'merely' in its ordinary meaning of 'only' or 'solely' - that is, when considered with the particular goods or services, the mark because of its meaning does

nothing but describe them. It is submitted that when the terms "PRODUCT ADVISOR" are considered in the context of the mark in its entirety, those terms are not solely or merely descriptive. To be merely descriptive, the mark must immediately describe a particular characteristic or feature of the goods or services themselves, or must directly convey the purpose or use of the goods. The terms "PRODUCT ADVISOR" in Applicant's BASES PRODUCT ADVISOR mark do not serve a merely descriptive function. Because of the terms' unique connotation, and their use in combination with Applicant's well-known BASES brand, the terms "PRODUCT ADVISOR" in Applicant's mark can and do serve a source indicator function within the context of Applicant's mark as a whole, i.e., BASES PRODUCT ADVISOR. Simply because the terms may impart information about the services or hint as to the usage thereof, it does not render the mark incapable of functioning as a trademark, nor does it make the mark merely descriptive of the goods.

In deciding the descriptiveness question, if the terms only "vaguely suggest" a characteristic, they are not merely descriptive. In re George Weston Limited, 228 USPQ 57 (TTAB 1985). Stated as a positive rule, the term must describe an "important", "significant", or "key" characteristic or function. In re Underwater Connections, Inc., 221 USPQ 95 (TTAB 1983); In re Eiseman, 220 USPQ 89 (TTAB 1983); In re Conductive Systems, Inc., 220 USPQ 84 (TTAB 1983).

On the other hand, a mark is suggestive and not descriptive if:

it requires imagination, thought and perception to reach a conclusion as to the nature of the goods or services in connection with which it is used; a mark is deemed descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or

characteristics of the goods or services. West & Co. v. Arica Inst., Inc. 195 USPQ 466 (2d Cir. 1977); McGregor-Doniger, Inc. v. Drizzle, Inc., 199 USPQ 466 (S.D.N.Y. 1978), aff'd 202 USPQ 81 (2d Cir. 1979).

Here, it takes some amount of imagination or thought to arrive at a conclusion as to the nature of Applicant's services. A consumer's mind would not jump instinctively from contemplation of the mark to knowledge of Applicant's services. "If the mental leap between the word and the product's attribute is not almost instantaneous, this strongly indicates suggestiveness not descriptiveness." Investacorp, Inc. v. Arabian Investment Banking Corp., 19 USPQ2d 1056 (11<sup>th</sup> Cir. 1991). If some exercise of imagination, thought, or perception is required to reach a conclusion as to the nature of the goods or services, the mark is suggestive, not merely descriptive, In re IA Corp., Serial No. 75/419,109 (TTAB 2000).

**B. Third Party Trademark Usage**

While it is recognized that the allowance of third-party registrations is not controlling, they do lend credence to Applicant's arguments. It is noted that the Board has held that the following marks, when applied to the identified goods and services, were not merely descriptive. Notably, in several of the following cases, the Board did not require a disclaimer of terms within the mark.

| <u>MARK</u>       | <u>GOODS</u>   | <u>CASE CITATION</u> |
|-------------------|--|----------------------|
| MINI-STORAGE      | Storage and warehouse services                                     | 180 USPQ 274         |
| FILL-R-UP         | Combined automobile filling station services and car wash services | 182 USPQ 443         |
| THE MONEY SERVICE | Financial services wherein funds are transferred                   | 200 USPQ 57          |

|                        |   |                |
|------------------------|---|----------------|
| COLLEGE CREDIT<br>CARD | Surveying and canvassing<br>college affiliated personnel<br>on behalf of commercial<br>establishments for credit<br>information | 174 USPQ 340   |
| ROACH MOTEL            | Waterbug and roach trap   | 200 USPQ 417   |
| ACTION SLACKS          | Pants   | 28 USPQ2d 1464 |
| WET/DRY BROOM          | Electric vacuum cleaners  | 226 F. 815     |
| HEATUBE                | Electrical heating units  | 109 USPQ 423   |

**IV. CONCLUSION**

For the foregoing reasons, Applicant submits that the refusal by the Trademark Examining Attorney to register Applicant's mark should be reversed.

In the event that the Board affirms the Examiner's decision in favor of enforcing the disclaimer requirement, it is respectfully requested that the application be remanded to the Examiner for continued prosecution consistent with the Board's determination.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication or credit any overpayment to Deposit Account No. 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

Date: June 11, 2002

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