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Date of Deposit: November 12, 2003

By: Linda Clark
Linda Clark

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

APPLICANT:
Waste Management, Inc.

SERIAL NO.:
76/326,374

FILED: October 16, 2001

MARK: E-CYCLING

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APPLICANT'S APPEAL BRIEF

I. Introduction

Applicant has appealed to the Trademark Trial and Appeal Board from the final decision of the United States Patent and Trademark Office Trademark Attorney refusing registration of the above-referenced mark.

Applicant filed its application to register the mark E-CYCLING on October 16, 2001. The Trademark Attorney mailed his Final Refusal on March 10, 2003. The Applicant noticed its appeal from that final refusal on September 9, 2003.

The Trademark Attorney has refused registration, contending that "the subject matter for which registration is sought is merely descriptive of the identified services." In addition, the Trademark Attorney contends that "the fact that an applicant may be the first and only user of a merely descriptive or generic designation does not justify registration if the term is merely descriptive."

As set forth in the following sections of this Appeal Brief, Applicant submits that the Trademark Attorney's contentions are in error and respectfully requests that this Board reverse his refusal and pass this mark to publication.

II. Relevant Facts

Applicant filed its application to register E-CYCLING as a service mark for recycling services in International Class 40 on October 16, 2001. Applicant's application was based upon Section 1(b) of the Trademark Act.

A representative advertising brochure for Applicant's services is attached hereto as Exhibit A; however, the attached brochure is not of record in the present application, but is available if the Board wants to review it.

In the first Office Action, dated December 31, 2001, from a different Trademark Attorney than the present Trademark Attorney, certain documents were made of record upon which the first Trademark Attorney relied. The same documents were again relied upon in the second Office Action of March 10, 2003, as set forth in the second sentence of the third paragraph under the "Refusal of Registration" section. These documents included: a printout from Applicant's own web page; a press release dated October 22, 2001, after Applicant's filing date; another press release entitled EIA "Electronics Recycling Fact Sheet" which appears to be dated Monday, October 15, 2001, printed out on December 28, 2001, but references on its second page, fourth

paragraph, the launching of an initiative on October 20, 2001; an article entitled "Model Aims to Help Recyclers Curb High-Tech Trash" dated January 12, 2001, wherein on the second page the phrase "esv\Stuart.e-cycling" appears; a definition of "e-"reading "(Electronic-) The 'e-dash' prefix may be attached to anything that is moved from paper to its electronic alternative, such as e-mail, e-cash, etc." from the Computer Glossary; and a definition from the Official Internet Dictionary stating that "e-adj." is: "an abbreviation of 'electronic' that generally indicates information or functions involving the Internet."

In addition to those materials, the Trademark Attorney in the second Office Action attached a number of articles from a Lexis search, each one of which has a publication date sometime in 2002, after Applicant's application filing date.

III. Argument

A. The Law

As set forth in § 2.03 of Gilson's "Trademark Protection & Practice" (Matthew Bender) "whether or not a term is descriptive depends on its meaning to the public in relation to a particular product or service. It is descriptive if it informs the purchasing public of the characteristics, quality, functions, uses, ingredients, components, or other properties of a product, or conveys comparable information about a service. One court has said that the test is whether the term is descriptive to one who has never seen the product and does not know what it is." (pps. 2-60 – 2-61). The Seventh Circuit has developed what it calls the "degree of imagination" test in distinguishing between descriptive marks and suggestive marks. "[I]f a mark imparts information directly it is descriptive. If it stands for an idea which requires some operation of the imagination to connect it with the goods, it is suggestive." Platinum Home Mortgage Corp. v. Platinum Financial Group, Inc., 149 F.3d 722, 47 U.S.P.Q. 2d 1587 (7th Cir. 1998). As set

forth in a case relied upon by the Trademark Attorney, In Re: National Shooting Sports Foundation, Inc., 219 U.S.P.Q. 1018 (T.T.A.B. 1983), "combinations of merely descriptive components have been found registrable if the juxtaposition of the words is inventive or evokes a unique commercial impression... In those cases and others the descriptiveness of the components was either lost in the combination or the composite was so incongruous or unusual that it possessed only suggestive significance."

B. The Law Applied To The Present Mark

The evidence of record does not support a refusal to register based upon descriptiveness. Applicant submits that its mark for recycling services is at a minimum only suggestive of its services, and is in fact arbitrary when applied to its services. If anything, consumers encountering this mark, without knowing what the services are, would think it had something to do with bicycling, rather than recycling services, or perhaps an internet based cycling game.

What does the record contain?

Applicant's web site uses Applicant's E-CYCLING mark, but Applicant submits that the use of its own mark on its own web site does not support the first Trademark Attorney's contention that the term cycling "is an abbreviated form of the term recycling." Applicant used its mark for its services. There is no support in the present record for the contention that the term "cycling" is an abbreviated form of the term recycling.

The only document which precedes Applicant's filing date which utilizes Applicant's mark E-CYCLING is the Purdue University article entitled "Model Aims To Help Recyclers Curb High-Tech Trash" wherein the end of the article contains a reference to "esv\Stuart.e-cycling." Applicant is unaware of who or what that is, other than perhaps some reference to the

author's name "Julie Ann Stuart." Throughout the article, all that appears are references to recycling and electronic hardware.

The definitions of record do not relate to recycling services. Applicant's recycling services are not something "that is moved from paper to its electronic alternative, such as e-mail, e-cash, etc." such as the E-TICKET case, Continental Airlines, Inc. v. United Airlines, Inc., 53 U.S.P.Q.2d 1385 (T.T.A.B. 1999). Applicant's recycling services are not "information or functions involving the Internet," as set forth in the second relied upon definition of "e-". Applicant acknowledges that its recycling services, as set forth in its advertising brochure, Exhibit A, are for the recycling of such items as PC computers, main frames, servers, broadcast equipment, etc., which may typically be referred to as "electronic equipment"; however, the definitions of record do not relate to these types of products.

Applicant submits that when the individual terms of its mark are considered separately, the individual components "e-" and "cycling" are not within the definitions relied upon by the Trademark Attorney. In this regard, Applicant would submit that, as always, the mark must be considered in its entirety, rather than being subdivided; however, even when subdivided its mark is not merely descriptive.

When considering Applicant's mark in its entirety, it becomes apparent that its mark is suggestive, in that its mark stands for an idea which requires some operation of the imagination to connect it with the services. Applicant's mark involves an element of incongruity, in that cycling is bicycling, not recycling in the sense of recycling products. Applicant's mark demands a mental exercise which renders its mark suggestive, and not merely descriptive.

Lastly, as to the contention that Applicant was merely the first entity to use a "highly descriptive or generic designation" which does not justify registration, as set forth by the

Trademark Attorney with reference to the National Shooting Sports Foundation case, Applicant submits that for such case law to be applicable, there must be the showing that the mark is in fact "merely descriptive or is a generic designation," which is not the case with respect to the mark of the present application. In this regard, although each case needs to be decided upon its own facts, Applicant's counsel would agree that the term "SHOOTING, HUNTING, OUTDOOR TRADESHOW, AND CONFERENCE" is certainly a "highly descriptive or generic designation" of the services of "conducting and arranging tradeshow in the hunting, shooting, and outdoor sports products field," which was the mark at issue in the National Shooting Sports Foundation case. Applicant's mark is not ELECTRONICS RECYCLING, which would be a mark analogous to the mark at issue in the National Shooting Sports Foundation case, and the public should certainly be permitted to use those terms "electronics recycling" or "recycling of electronics".

The public, or Applicant's competitors, will not be deprived of the opportunity to describe their services in marketing them to the public as electronic component recycling services or whatever. However, Applicant's competitors should not be permitted to use Applicant's mark E-CYCLING, contrary to the rights of Applicant. In this regard, all of the articles relied upon by the Trademark Attorney appearing in 2002 are dated after the December 28, 2001 date of Applicant's web page advertising its services under its mark, as attached to the first Office Action. Applicant is one of the largest companies in the United States involved in the handling of trash, and it should not be penalized because others have chosen to infringe upon its rights after Applicant has adopted and introduced its mark into the American consciousness. Additionally, it is very possible, and likely, that many of the 2002 references to E-CYCLING are related to Applicant's own activities. For example, please note the reference in Exhibit A, in the

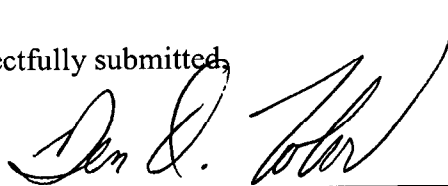
dark green section under the heading "How does... organization" wherein reference is made to the fact that "We even have the experience to help local and state governments develop pilot projects... "

IV. Conclusion

In view of the foregoing discussed case law and facts, Applicant submits that its mark is at best only suggestive of its services, and is not merely descriptive of its services, and is thus entitled to registration. Accordingly, Applicant respectfully requests that the refusal to register be reversed, and that Applicant's mark be published for opposition purposes and such action is respectfully requested.

Date: 11/12, 2003

Respectfully submitted,



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