

NOV - 7 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Laser Karaoke, Inc.,)
d.b.a. Karaoke Warehouse)
Trademark : TOP TUNES (stylized)) BEFORE THE
TRADEMARK TRIAL
Serial No. : 76/335835) AND
Attorney : Courtney J. Miller) APPEAL BOARD
Address : Calfee, Halter &) ON APPEAL
Griswold, LLP)
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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Examining Attorney's refusal to register the mark TOP TUNES on the ground that it is merely descriptive within the meaning of § 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

FACTS

Applicant seeks registration of the mark TOP TUNES in stylized form¹ for "[r]etail stores and retail store services available through computer communications for audio components specifically for use in karaoke, namely, (i) compact discs containing songs that have been re-recorded by musicians other

¹ The applicant's original mark was "TOP TUNES COMPACT DISC + GRAPHICS KARAOKE CDG" in stylized form, but the applicant deleted the generic/informational terms from the mark.

than the original artists, and in which some or all of the vocal lines may have been removed, and in which graphics such as song lyrics or other images have been added; (ii) compact disc players, (iii) audio amplifiers, (iv) microphones, (v) audio speakers, and (vi) cables" in Class 35.² The examining attorney³ refused registration under Section 2(e)(1) of the Trademark Act because the applicant's mark was merely descriptive of the identified goods.

ARGUMENT

THE MARK IS MERELY DESCRIPTIVE BECAUSE IT DESCRIBES A FEATURE OF THE SERVICES.

Section 2(e)(1) of the Trademark Act directs the Commissioner of Patents and Trademarks to refuse registration on the Principal Register of any mark which "when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them." A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the

² The applicant originally identified the goods in the application as "Retail stores and retail store services available through computer communications for audio components for use in karaoke, namely, compact discs, compact disc players, audio amplifiers, microphones, audio speakers, and cables." The applicant subsequently amended its identification as stated above.

³ The original examining attorney issued the first and final refusals; this matter was subsequently assigned to the current examining attorney.

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relevant goods. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b).

In this case, the mark describes the type of goods that the applicant sells, i.e., highly regarded or hit songs.

The applicant argues that, because it sells music performed by artists other than the original artists, and because the music omits lyrics and vocals, its mark is not merely descriptive. The applicant claims that the examining attorney's evidence does not show use of the mark in connection with karaoke music (i.e., music without lyrics or vocals, or music performed by artists other than the originals). The applicant's argument and its attempt to discredit the evidence in the record are unpersuasive.

The examining attorney's evidence, attached to the first and final office actions, consists of excerpted articles from the Lexis/Nexis electronic database, various websites on the Internet and The American Heritage Dictionary of the English Language. The evidence includes references to "top tunes" in connection with music recorded or performed by both original and non-original artists. Most of the evidence does not specifically address whether the music performed includes lyrics

and vocals, although in one article the music referred to does not have lyrics. Article 57 of 489, which appeared in "The San Francisco Chronicle" on September 7, 2001, describes the San Francisco Starlight Orchestra playing dance music from the 1920's and 30's.

Ultimately, whether the applicant's music includes lyrics or vocals or has been otherwise altered is irrelevant. The applicant does not dispute that one of the definitions of tune is "a song," or that "top" is a laudatory term that means "the highest position or rank."⁴ The applicant's recitation of services is:

Retail stores and retail store services available through computer communications for audio components specifically for use in karaoke, namely, (i) compact discs containing songs that have been re-recorded by musicians other than the original artists, and in which some of all of the vocal lines may have been removed, and in which graphics such as song lyrics or other images have been added

Thus, the applicant is a retailer of "songs," which is the definition of "tunes." The definition of "tunes" does not stipulate that the songs include lyrics or exclude visual effects; tunes are merely songs. "Top" is simply a laudatory modifier of "tunes." Accordingly, the mark as a whole is merely descriptive.


⁴ The American Heritage Dictionary of the English Language. These definitions were attached to the examining attorney's final action.

Finally, in response to the applicant's claim that consumers would not know the nature of its services based on the mark, the examining attorney must consider whether a mark is merely descriptive in relation to the identified goods/services, not in the abstract. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985); *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985). TMEP §1209.01(b). When viewing the mark in the context of the services, there is no doubt that the mark merely describes the services.

CONCLUSION

For the foregoing reasons, the refusal to register on the basis of § 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), should be affirmed.

Respectfully submitted,



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