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

Proceeding	85078518
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board**

Applicant: MVP Group International, Inc.)
)
Serial No: 85078518)
)
Trademark: ECO WICK (word mark))
)
Filing Date: July 6, 2010)
)
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APPLICANT'S APPEAL BRIEF

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir:

This is a timely Appeal to the Trademark Trial and Appeal Board from the Examiner's Final Rejection dated January 4, 2012 (hereinafter "Final Rejection"), of the registration of the proposed mark. The instant Appellant's Appeal Brief is timely filed because a Notice of Appeal and the required fees are being filed concurrently herewith.

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I. INDEX OF CASES CITED

In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (C.C.P.A. 1978).

In re George Weston Ltd., 228 USPQ 57 (TTAB 1985).

In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987).

In re Pennwalt Corp., 173 USPQ 317 (TTAB 1972).

In re The Noble Co., 225 USPQ 749 (TTAB 1985).

In re Venture Lending Associates, 226 USPQ 285 (TTAB 1985).

Kendall-Jackson Winery, Ltd. V. E. & J. Gallo Winery, 150 F.3d 1042, 1047, 47 USPQ2d 1332 (9th Cir. 1998).

Lahoti v. VeriCheck, Inc., 586 F.3d 1190, 1198, 92 USPQ2d 1641 (9th Cir. 2009).

No Nonsense Fashions, Inc. v. Consolidated Foods Corp., 226 USPQ 502 (TTAB 1985).

Rodeo Collection, Ltd. v. West Seventh, 812 F.2d 1215, 1218, 2 USPQ2d 1204, 1206 (9th Cir. 1987).

The Firestone Tire & Rubber Company v. the Goodyear Tire & Rubber Company, 186 USPQ 557, 1975 WL 20835 (TTAB 1975), affirmed, 189 USPQ 348, 1976 WL 21295 (CCPA 1976).

U.S. Search, LLC v. U.S. Search.com Inc., 300 F.3d 517, 63 USPQ2d 2013 (4th Cir. 2002).

Zatarains, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786, 791, 217 USPQ 988 (5th Cir. 1983).

II. DESCRIPTION OF THE RECORD

On July 6, 2010, the Applicant and Appellant herein, MVP Group International, Inc. filed the present application for the word mark "ECO WICK" in International Class 004 for "Candles; Scented Candles".

On October 19, 2010, the Examiner issued an Office Action, in which registration of the proposed mark was refused under Section 2(e)(1) as being merely descriptive of a feature of the goods. In this Office Action, the Examiner provided evidence of (i) dictionary definitions of the term "eco" and the term "wick"; (ii) "Internet evidence showing 'eco' candles which contain ecologically friendly wicks as part of the candle components"; and (iii) "advertisements from third party candle manufacturers who market 'eco' candles with eco friendly wicks."

On April 13, 2011, the Appellant filed a Response to Office Action arguing that the refusal of registration of the proposed mark under Section 2(e)(1) was improper. In this Response to Office Action, the Appellant provided evidence in the nature of an MP3 recording of the crackling sounds made from the burning of a candle including a wooden wick. Additionally, in this Response to Office Action, the Appellant disclaimed the exclusive right to use "WICK" apart from the mark as shown.

On May 18, 2011, the Examiner issued another Office Action, in which registration of the proposed mark was again refused under Section 2(e)(1) as being merely descriptive of a feature of the goods. In this Office Action, it was

noted that the MP3 evidence was not made of record as it was not provided in the proper format.

On November 18, 2011, the Appellant filed a Response to Office Action again arguing that the refusal of registration of the proposed mark under Section 2(e)(1) was improper. In this Response to Office Action, the Appellant again provided evidence in the nature of an MP3 recording of the crackling sounds made from the burning of a candle including a wooden wick.

On January 4, 2012, the Examiner issued a Final Office Action, in which registration of the proposed mark was again refused under Section 2(e)(1) as being merely descriptive of a feature of the goods. In this Final Office Action, the Examiner provided additional Internet evidence purporting to show “wooden wicked candles that ‘feature an eco-wick that burns cleanly and for twenty-five to eighty hours with minimal soot.’”

On April 12, 2012, the Appellant filed a Request for Reconsideration again arguing that the refusal of registration of the proposed mark under Section 2(e)(1) was improper.

On May 1, 2012, the Examiner issued a Request for Reconsideration Denied, in which the Examiner maintained his refusal of registration of the proposed mark under Section 2(e)(1) as being merely descriptive of a feature of the goods.

III. STATEMENT OF THE ISSUES

1. *Whether the registration of the proposed mark of ECO WICK is properly refused under Section 2(e)(1) because the applied-for mark merely describes a feature of the goods?*

IV. ARGUMENT

1. Whether the registration of the proposed mark of ECO WICK is properly refused under Section 2(e)(1) because the applied-for mark merely describes a feature of the goods?

Section 2(e)(1) Refusal

Registration of the proposed mark was refused because “the subject matter for which registration is sought is merely descriptive of the identified goods.” The Appellant respectfully submits that this refusal is not properly supported, and should be withdrawn for the reasons set forth below.

In support of its Section 2(e)(1) refusal, the Examiner has provided in the present Final Office Action as well as in previous Office Actions certain evidence which attempts to show the ecologically-friendly nature of certain types of candles and/or how to make certain types of candles that are purported to be ecologically and/or environmentally friendly.

Additionally, the Examiner has provided definitions for the component portions of the proposed mark, i.e. “ECO” and “WICK”. In particular, the Examiner states that the term “ECO” is defined as “‘ecological,’ meaning a balanced relationship between man’s products and the environment”, as well as “ECO” being used as a “short hand for the longer term ‘eco-friendly.’” Additionally, the Examiner provides that the term “WICK” is defined as “a bundle of fibers or a loosely twisted, braided, or woven cord, tape or tube usually of soft spun cotton threads that by capillary attraction draws up to be burned a steady supply of the oil in lamps or the melted tallow or wax in candles.”

Based on such evidence, the Examiner has concluded that the term “ECO’ merely describes a feature of the goods, candles and scented candles which contain ‘eco’ or ecologically friendly properties, which cause little or no adverse environmental or health impact.” Further, the Examiner contends that “(i)n light of the common use of the term by third parties in identifying favorable features of candle and eco-friendly products, it would be perceived by the industry and by consumers, as identifying or describing the same or similar features of the applicant’s candle product – possessing eco or ecologically friendly wicks.”

In contrast to the evaluation of the Examiner, the Appellant respectfully submits that the applied-for mark should be found, at most, to be merely suggestive of the goods to which the mark is to be applied. As provided in McCarthy on Trademarks, “The distinctiveness of a mark cannot be determined in the abstract, but only by reference to the goods or services upon which the mark is used.” McCarthy on Trademarks and Unfair Competition by J. Thomas McCarthy, 4th Edition, §11.64 (2011), citing *U.S. Search, LLC v. U.S. Search.com Inc.*, 300 F.3d 517, 63 USPQ2d 2013 (4th Cir. 2002). Similarly, TMEP §1209.01(b) provides that “The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. This requires consideration of the context in which the mark is used or intended to be used in connection with those goods/services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. See *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 determining the distinction between descriptive marks and suggestive marks, the most commonly applied tests by both courts and the Trademark Board are (1) the imagination test, (2) the competitors’ need test, and (3) the competitors’ use test. See e.g., *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 791, 217 USPQ 988 (5th Cir. 1983); *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502 (TTAB 1985).

The Applied-for Mark is Suggestive Under the Imagination Test

“The more imagination that is required on the potential customer’s part to get some direct description of the product from the designation, the more likely the designation is suggestive, not descriptive.” McCarthy on Trademarks, §11.67, citing, e.g., *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 791, 217 USPQ 988 (5th Cir. 1983) (“A suggestive term suggests, rather than describes, some particular characteristic of the goods or services to which it applies and requires the consumer to exercise the imagination in order to draw a conclusion as to the nature of the goods and services.”); *Kendall-Jackson Winery, Ltd. V. E. & J. Gallo Winery*, 150 F.3d 1042, 1047, 47 USPQ2d 1332 (9th Cir. 1998) (“If a consumer must use imagination or any type of multistage reasoning to understand the mark’s significance, then the mark does not describe the mark’s features, but suggests them. Such a mark is therefore

classified as ‘suggestive’ rather than ‘descriptive.’.”); *Lahoti v. VeriCheck, Inc.*, 586 F.3d 1190, 1198, 92 USPQ2d 1641 (9th Cir. 2009) (“A mark is suggestive if ‘imagination’ or a ‘mental leap’ is required in order to reach a conclusion as to the nature of the product being referenced. ... By contrast, a mark is descriptive if it ‘define[s] a particular characteristic of the product in a way that does not require any exercise of the imagination.’”).

Further, TMEP §1209.01(a) provides that “Suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services.” See e.g., *In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985); *In re The Noble Co.*, 225 USPQ 749 (TTAB 1985); and *In re Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972).

The Appellant respectfully submits that an average consumer of candles and/or scented candles, seeing the proposed mark of “ECO WICK” would not automatically and instinctively reach a conclusion as to the specific nature of the identified goods. Conversely, the Appellant respectfully asserts that any such conclusion clearly requires the type of imagination and multistage reasoning that has been envisioned by the courts and the Trademark Board on many occasions.

In the present Final Rejection, the Examiner contends that the Appellant has improperly argued that the proposed mark is suggestive while simply focusing on the mark itself, irrespective of the goods. The Appellant strenuously disputes this assessment, as the Appellant believes that it has clearly focused on

the proposed mark in relation to the specifically identified goods. Moreover, the Appellant respectfully believes that it is actually the Examiner that has not complied with the acknowledged standard of review. For example, in its analysis, the Examiner has focused on the proposed mark in relation to “candles with ecologically friendly wicks”, or “candles and scented candles which contain ‘eco’ or ecologically friendly properties, which cause little or no adverse environmental or health impact.” However, the identified goods, as noted above, are “Candles; Scented candles”, and not “candles with ecologically friendly wicks”, or “candles and scented candles which contain ‘eco’ or ecologically friendly properties, which cause little or no adverse environmental or health impact.”

In applying the appropriate standard of review, the Appellant respectfully submits that if someone were to mention the term “ECO WICK” to a consumer looking for candles and/or scented candles, the consumer would not immediately conclude that of course these products necessarily include wicks that are considered ecologically friendly because they must “burn cleanly with minimal soot” or “which cause little or no adverse environmental or health impact.” In contrast, the Appellant respectfully believes that the consumer would have to stop and think a bit if the consumer were to reach any such conclusions. As such, the Appellant respectfully asserts that this line of thought is exactly the type of imagination, mental leap, and/or multistage reasoning that the courts and the Trademark Board had in mind when deciding all of these previous cases. Further, the Appellant respectfully submits that any conclusion that such a

natural and automatic descriptive link exists between the proposed mark and the identified goods is merely a function of improper hindsight based on the specifics of the present application.

Moreover, the Appellant respectfully submits that whether or not a given product is viewed as “eco-friendly” is typically only applied in a relativistic sense in comparison to other goods. While certain materials can be utilized in making candles that can tend to result in candles that make a lesser or more ecologically-friendly impact on the environment, the identified goods are not necessarily limited to such products. As such, the candles to which the proposed mark is intended to be applied are not specifically designed to be necessarily ecologically-friendly, although they are also not specifically designed to be ecologically-unfriendly either. Even as applied to candles which do include wooden wicks, which some of the identified goods likely would, such candles may be more ecologically friendly than the candles that utilize more traditional types of wicks, but they may be less ecologically friendly than candles using other alternative types of wicks. Thus, the relativistic nature of the labeling of any given product as ecologically friendly should preclude the average consumer from automatically and necessarily, without thought, imagination or multistage reasoning, labeling any candle product as “eco-friendly”. Thus, the Appellant respectfully submits that the term “Eco” as utilized herein should be found at most to be merely suggestive of the goods and/or services to which the applied-for mark is to be applied.

Still further, the Appellant respectfully cites to Application Serial No.

77501939, where the applied-for mark of “Ecowix” has been allowed for the identified goods of “Wicking textile fabrics composed in part of bamboo charcoal for the manufacture of baby wraps, blankets, clothing and diapers”, with the only hold-up for registration being the filing of an appropriate specimen in conjunction with the Statement of Use. The analysis utilized in evaluating the applied-for mark of “Ecowix” would seem to be also appropriate in the present case, and in that previous case the Trademark Office found the applied-for mark of “Ecowix” to not be descriptive of the identified goods. The Appellant herein believes that the allowance of such a mark is persuasive that the presently proposed mark should not be found to be merely descriptive of the identified goods. The Examiner responded to this in the Final Rejection by stating that the “mark in Application Serial Number 77501939 is for a combination of descriptive terms and creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the identified textile goods in that application and was therefore found registrable.” The Examiner continues that “the applied for mark consists of *two separate words*, ECO and WICK. The applied-for mark in this case is not a composite in any way, shape or form.” The Appellant does not believe that the simple use of a single composite term as opposed to two separate words, which could have been easily combined into a single composite term, warrants completely disparate treatment and analysis as suggested by the Examiner.

Accordingly, based on the arguments provided above, the Appellant respectfully submits that the proposed mark of “ECO WICK” should be found to

be merely suggestive under the imagination test.

The Applied-for Mark is Suggestive Under the Competitors' Need Test

“If the message conveyed by the mark about the goods or services is so direct and clear that competing sellers would be likely to need to use the term in describing their goods in advertising and promotion, then this indicates that the mark is descriptive.” McCarthy on Trademarks, §11.68, citing *Rodeo Collection, Ltd. v. West Seventh*, 812 F.2d 1215, 1218, 2 USPQ2d 1204, 1206 (9th Cir. 1987).

The Appellant respectfully submits that many other terms are available for competing sellers to use in order to describe candles and scented candles, even ones which are likely viewed as eco-friendly, other than the proposed mark of “ECO WICK”. In fact, competitors can easily use such alternative terms as “ecological candles” and/or “eco-friendly candles” in conjunction with their candles to give a much better sense for the product than the term “ECO WICK”.

Accordingly, the Appellant respectfully submits that the proposed mark of “ECO WICK” should be found to be suggestive under the competitors' need test.

The Applied-for Mark is Suggestive Under the Competitors' Use Test

“A useful way to test whether a designation is descriptive or suggestive is to determine the extent to which other sellers have used the designation on similar goods and services. If others are in fact using the term to describe their goods or services, an inference of descriptiveness can be drawn.” McCarthy on

Trademarks, §11.69, citing e.g., *The Firestone Tire & Rubber Company v. the Goodyear Tire & Rubber Company*, 186 USPQ 557, 1975 WL 20835 (TTAB 1975), affirmed, 189 USPQ 348, 1976 WL 21295 (CCPA 1976) (where others in the industry do not use the term as a descriptive reference, this is evidence that the term is neither a natural nor obvious way to describe the goods).

The Appellant respectfully submits that any such use by competitors of the term “eco wick” to describe their candles is minimal at best, and that there clearly is no broad-based usage of such term in the relevant industry. The Examiner has cited to certain such uses by others in the industry, but such uses appear to be quite minimal. The Appellant respectfully asserts that any such minimal usage should not be grounds to deny an otherwise appropriate trademark registration. Accordingly, the Appellant respectfully submits that the proposed mark of “ECO WICK” should be found to be suggestive under the competitors’ use test.

Accordingly, based on the arguments and evidence as provided and/or cited to above, while examining the appropriate tests for determining whether a given mark should be found descriptive or suggestive, the Appellant respectfully submits that the refusal under Section 2(e)(1) for being merely descriptive is improper and should be withdrawn.

VI. SUMMARY

In summary, based on the arguments as provided above, the Appellant respectfully submits that the applied-for mark should be found, at most, to be merely suggestive of the goods to which the mark is to be applied, and the Appellant respectfully requests that the refusal based on Section 2(e)(1) be withdrawn.

Dated this 27th day of May, 2012.

Respectfully submitted,

/James P. Broder/

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