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

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Applicant	Peter Teshar
Applied for Mark	COLLEGE BIDS
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Peter Teshler

Serial No. 85405171

Filed: August 23, 2011

Mark: COLLEGE BIDS

TRADEMARK LAW OFFICE: 117

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BRIEF FOR APPELLANT

I. INTRODUCTION

Applicant appeals from the Examining Attorney's final refusal UNDER Section 2(e)(1) to register Applicant's COLLEGE BIDS trademark ("Mark") on the grounds that the Mark is merely descriptive. Applicant respectfully requests the Trademark Trial and Appeal Board ("TTAB") reverse the Examining Attorney's decision and pass the application to publication. Applicant has filed a timely Notice of Appeal. Applicant seeks oral argument in this appeal.

II. SECTION 2(e)(1) PARTIAL REFUSAL

The Examining Attorney partially refuses registration of the applied-for mark on the Principal Register under the assertion that Applicant's applied-for mark, COLLEGE BIDS, "merely describes a feature of Applicant's goods and/or services." See Office

Action, page 2. Specifically, the Examining Attorney refuses registration of the applied-for mark on the Principal Register with respect to “on-line trading services in which a seller posts items to be sold at a set price; online trading services in which a seller posts items to be sold in an auction-style format where bidding is done electronically.”

In support of the refusal, the Examining Attorney argues that Applicant’s goods and services are “broadly identified” (see Office Action, page 2). As such, the Examining Attorney reasons that it can be “presumed that the services “are offered to all persons and entities including colleges and that the items offered for sale include those for or on the subject of colleges. The Examining Attorney thus concludes that the term “COLLEGE” describes a feature or potential user of Applicant’s services and that the combined term “COLLEGE BIDS” “merely describes features of the services, which presumably include bids by, for or related to colleges.” The Examining Attorney further asserts that the combined wording of Applicant’s applied-for-mark “does not appear to have any non-descriptive meaning.” Applicant respectfully traverses these assertions for at least the following reasons.

Applicant’s applied-for-mark will be utilized in connection with a website that offers users the ability to offer for sale or auction off items to others. It will be a forum for communication and interaction, where selling and purchasing items may be at the forefront. Applicant further argued that there is nothing in Applicant’s business model that restricts or requires the goods and services being sold thereon to be associated with colleges or college-related activities. Indeed, Applicant’s business model embraces the buying and selling of goods and services as varied as the individual user.

Intended Users

The Examining Attorney has erroneously responded to Applicant's previously presented arguments by asserting that "a mark that describes an intended user or groups of users of a product or service is merely descriptive," citing in support of that position *In re Planalytics, Inc.*, 70 USPQ2d 1453 (TTAB 2004) (holding GASBUYER merely descriptive of intended user of risk management services in the field of pricing and purchasing natural gas) and *In re Camel Mfg. Co.*, 222 USPQ 1031 (TTAB 1984) (holding MOUNTAIN CAMPER merely descriptive of intended users of retail mail order services in the field of outdoor equipment and apparel). See Office Action dated 8/5/2012, page 3. The Examining Attorney further argues that because Applicant has described its services broadly, "it is presumed that the services are available to all consumers, including colleges" and that "colleges are among the intended users of the services" and that "items offered for sale include those related to colleges." See Office Action dated 8/5/2012, page 3. Further, in the Final Office Action, The Examining Attorney further argues that in Applicant's response dated February 4, 2013 answered "yes" in response to a question asking if colleges could be among applicant's potential consumers.

The Examining Attorney additionally ads that Applicant's website states:

What is CollegeBids? - It is a social media site oriented to students. We have information on sporting events, apartment listings, travel and food discounts, jobs, spring break activities and the best nightlife party events at your school or in your community. We even have educational information as well. What makes us different is our auction style trading system where you can sell, buy and trade new and used valuables and school items. But most importantly, it is a great place to meet new friends.

The Examining Attorney then indicates that this phrase, which does not include the term "college," except for in the trademark that is the subject of this appeal, indicates that the one of the subject

matters or fields of the services is “college” including services related to information on colleges, their education and related college goods and services.

The Examining Attorney’s arguments must fail for at least the following reasons: 1) the arguments and accompanying case law cited above are inconsistent with the present application; and 2) the Examining Attorney’s assertions are grounded in a misapplication of the Trademark Law, and, if upheld, would open a slippery slope.

First, the application of the case law cited above is inconsistent with the facts of the present application and therefore not applicable in supporting a refusal to register the applied-for-mark under descriptiveness. In each of the cases cited above, the holding of descriptiveness was reached because the marks themselves described more or less the entire group of intended users. For example, the mark GASBUYER was upheld as descriptive of “risk management services in the field of pricing and purchasing natural gas” (emphasis added). The services offered under the GASBUYER mark were specifically intended for consumers that had a clear-cut interest in the management of risk associated with the pricing and purchasing of natural gas. These same services would not be used by any other consumer other than those described above. Thus, by default, any user of the services offered under the GASBUYER mark must have been necessarily included in the intended group of users (i.e., natural gas buyers). As a result, the TTAB found that because the GASBUYER mark was thus restricted to a specific group of intended users (i.e., gas buyers), it was descriptive. Similar reasoning was applied to the MOUNTAIN CAMPER mark.

If the reasoning espoused in the case law above were to be applicable in the present application, Applicant’s COLLEGE BIDS mark would have to describe the entire group of intended users, and not merely a presumed fraction thereof. Such is not the case. Specifically,

unlike the marks described above, Applicant's COLLEGE BIDS mark is not limited, restricted, or otherwise intended for any one specific group of users or any one collective interest. Indeed, as has been stated previously, and as has been acknowledged by the Examining Attorney, the users of Applicant's services may be as varied as the items sold by these selfsame users. Also, while the Examining Attorney has indicated that a "yes" answer to the questions of will Applicant's services be available to colleges and institutions of higher learning indicates that if colleges are an intended group of users, the Examining Attorney opted to not include the entire statement of Applicant, which reads,

"In regard to the questions above, Applicant's services will be available to all sellers, regardless of affiliation, who wish to auction their items and goods for purchase by any other user of Applicant's services and will also be available to all buyers, regardless of affiliation, who wish to bid on the items and goods of other users of Applicant's services. The availability of Applicant's services, as well as the items themselves to be auctioned, will not be limited, or otherwise restricted, to any particular group or collective interest. While any items that are legal can be posted on the site by anyone, it is anticipated that the items would be posted by individuals that are registered and not posted by colleges or institutions of higher learning.

"Thus, the answer to the questions above must be "yes." With hundreds of thousands of college students across the nation, it is anticipated that at times a college student may wish to auction an item or purchase an item utilizing Applicant's services. Likewise, with hundreds of millions of other persons across the nation, it is equally anticipated that a stay-at-home mom, a corporate CEO, a politician, a military veteran, a hospital nurse, a lawyer, a trademark examiner, and any other person from any other walk of life may wish to auction an item or purchase an item utilizing Applicant's services. It would be unreasonable to assume otherwise."

So, while Applicant may not restrict colleges or institutions of higher education from utilizing the services, it is not an intended group of users. For at least these reasons, Applicant respectfully submits that the Examining Attorney's descriptiveness assertion based on the cited case law must fail.

Second, if the Examining Attorney's reasons for refusing the COLLEGE BIDS mark under descriptiveness were to hold, it would open a slippery slope not grounded in current Trademark Law.

The Examining Attorney refuses registration of the COLLEGE BIDS mark based on the presumption that Applicant's services are available to all consumers, including colleges" and that "colleges are among the intended users of the services" and that "items offered for sale include those related to colleges." See Office Action, page 3. The Examining Attorney indicates that the term "college" describes a potential user of Applicant's services. See Office Action, page 3. Essentially, the Examining Attorney sets forth the position that because a fraction or portion of presumed or potential users of Applicant's services offered under the COLLEGE BIDS mark may in fact attend college or may be selling a college-related item, the COLLEGE BIDS mark is therefore descriptive of Applicant's services. Such rationale is not grounded in Trademark Law and would open a slippery slope that cannot hold.

It is clear that Trademark Law recognizes categories of marks, including fanciful, arbitrary, suggestive, descriptive, and generic marks. *See Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976). Fanciful, arbitrary, and suggestive marks are all accorded trademark protection and are registrable on the Principal Register without proof of "secondary meaning." *Id.* Descriptive marks may be accorded trademark protection and registered on the Principal Register should the mark, although descriptive, become distinctive of the applicant's goods in commerce. *Id.* Generic marks are not accorded trademark protection and cannot be registered on the Principal Register. *Id.*

Based on the above, if the Examining Attorney's same rationale used in rejecting Applicant's mark under descriptiveness were to be applied to other marks currently registered on

the Principal Register, then arbitrary marks such as CRAIGSLIST must also be refused registration under descriptiveness. That is, if Applicant's mark is descriptive because it may describe a feature or characteristic of a fraction of the users of Applicants services, then so too is CRAIGSLIST a descriptive mark. For example, under the Examining Attorney's rationale, because there might be some persons by the name of "Craig" that utilize the services offered under the CRAIGSLIST mark or because there might be items owned by "Craig" listed for sale among the numerous items posted on the website under the CRAIGSLIST mark, then the CRAIGSLIST mark must necessarily be descriptive of these groups of persons or items and must therefore be a descriptive mark. Such a rationale cannot hold. Such a rationale establishes a slippery slope of categorizing, prosecuting, and enforcing trademarks that is inconsistent with established Trademark Law.

Consequently, merely because Applicant's COLLEGE BIDS mark may describe a characteristic or attribute of a fraction or small portion of users of Applicant's services or items sold under Applicant's services does not categorize Applicant's mark as descriptive.

Instead, Applicant suggests that because the term "COLLEGE" is arbitrarily associated with its description of goods and services, the COLLEGE BIDS mark should be categorized as arbitrary and, as such, has no need of providing "secondary meaning" to be registered on the Principal Register. As noted by the Examiner, the term "college" is related to "an institution of higher learning." See Office Action, page 2. Applicant cannot understand how an online auction site and the term "college" are at all related. An online auction site and an institution of higher learning are not the same thing, and are not even arguably similar. In fact, for the Examining Attorney's reasoning to hold, eBay, Inc. would also have to be considered an institution of higher learning. Clearly, this isn't the case. And it would be unreasonable to argue otherwise.

To further Applicant's argument that the COLLEGE BIDS mark is arbitrary, consider the trademarks APPLE and the apple logo, which are famous marks of Apple, Inc. and are associated with their computer and electronic goods and services. These marks have nothing to do with fruits at all, because Apple, Inc. is not in the fruit industry. As such, APPLE and the apple logo are categorized by trademark law as arbitrary marks. Similarly, because the term "college" is not at all related to an online auction site, the COLLEGE BIDS mark is arbitrary as it relates to its associated description of goods and services. Moreover, even if APPLE sells its products to consumers, some of whom may be apple orchards, apple growers, or apple distributors does not detract from the arbitrary nature of the marks. Likewise, even if a college student or a person selling college-related items registers and uses Applicant's online auction site, it does not detract from the arbitrary nature of Applicant's mark.

Nevertheless, even if the Examining Attorney cannot agree that Applicant's mark is arbitrary as it relates to the description of goods and services, it is at the very most suggestive, and not descriptive, of the same. A term is merely descriptive if it immediately describes an ingredient, quality, characteristic or feature thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods or services, whereas, on the other hand, "[s]uggestive 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," as recited in TMEP § 1209.01(a) (emphasis added). *See In re MBNA Bank, N.A.*, 340 F.3d 1328, 67 U.S.P.Q.2d 1778 (Fed. Cir. 2003); *see also Stix Products, Inc. v. United Merchants & Mfr., Inc.*, 295 F. Supp. 479, 488, 160 U.S.P.Q. 477 (S.D.N.Y. 1968); *see also Thomas McCarthy, McCarthy's on Trademarks and Unfair Competition* § 11:19 at 11-26. As a result, simply because a mark imparts information about the characteristics of the goods or

services does not render it incapable of functioning as a trademark. *In re DC Comics, Inc*, 215 U.S.P.Q. 394, 396 (CCPA 1982). Indeed, a mark does not have to be devoid of all meaning in relation to the goods and services to be registrable. TMEP § 1209.01(a).

As has previously been stated, Applicant's applied-for-mark will be utilized in connection with a website that offers users the ability to offer for sale or auction off items to others. It will be a forum for communication and interaction, where selling and purchasing items may be at the forefront. However, there is nothing in Applicant's business model that requires the goods and services being sold thereon to be associated with colleges or college-related activities. The business model embraces the buying and selling of goods and services as varied as the individual user.

In view of Applicant's business model and Applicant's description of goods and services, Applicant disagrees with the Examining Attorney's assertion that the term "college" is descriptive of the goods and services associated with the COLLEGE BIDS mark. In fact, Applicant strongly asserts that the term "college" has no descriptive meaning at all related to Applicant's goods and services.

Other Factors

In addition to the above, many other factors also weigh in favor of Applicant's COLLEGE BIDS mark being suggestive and not merely descriptive.

Other sellers and providers of online bidding services and online auction providers are, without prior knowledge of Applicant's mark, not likely to want to use it to describe their own online auction services. Further, Applicant is unaware of other sellers using the applied-for-

mark to describe their products and/or services. This weighs in favor of Applicant's mark being suggestive. See Thomas McCarthy, McCarthy's on Trademarks and Unfair Competition § 11:71.

In addition, it should be noted that Applicant is not limiting or directing the items that qualify for sale on the website. Applicant is strictly providing the service and the users will define the products. Accordingly, the services provided by Applicant are not determinative of the goods being sold by the users accessing the website which further mitigates against any claim of descriptiveness.

In view of the above, Applicant's use of the term COLLEGE BIDS will identify the source of Applicant's services. Applicant's use of the mark will function as a trademark, and not as a descriptor. The mark will clearly be presented to the public as an indication of origin, thus it is submitted that the mark is not primarily descriptive. Moreover, as mentioned above, Applicant's mark is not being used by competitors to describe similar goods, nor would competitors be deprived of their ability to describe their goods by the registration of Applicant's mark. Many other terms are available to competitors to promote their goods. Consequently, competitors will not suffer a hardship by the registration of these terms in Applicant's mark.

III. CONCLUSION

Applicant has adopted a term that is arbitrarily related to the goods and services offered under the mark. Further, Applicant's mark does not convey an immediate idea of the qualities or characteristics of the associated goods or services, and therefore, requires consumers to make a mental leap to deduce the nature of the goods or services. Such arbitrary and/or suggestive marks are registrable on the Principal Register and have in fact been registered by the Patent and Trademark Office. Moreover, the terms in

Applicant's mark do not hamper a competitor's ability to promote their goods or services and are used in a trademark manner to identify the source of the goods. For the reasons set forth herein, Applicant submits that its Mark is not confusingly similar to the cited marks and the Examining Attorney's decision should be reversed and Applicant's application passed to publication.

Respectfully submitted,
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