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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85405171

MARK: COLLEGE BIDS



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Peter Teshar

CORRESPONDENT'S REFERENCE/DOCKET NO:

TESH.13842

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant Peter Teshar has appealed the examining attorney's final refusal of registration under Section 2(e)(1) on the basis that the proposed mark "COLLEGE BIDS" is merely descriptive as to applicant's "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.” Applicant also has appealed the final requirement to disclaim “COLLEGE” pursuant to Trademark Act Section 6, 15 U.S.C. §1056(a), as to the following services: providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods, buyers' and sellers' performance, and delivery and overall trading experience in connection with the foregoing, all for commercial purposes.

FACTS

Applicant applied to register the mark “COLLEGE BIDS” for the following services: on-line trading services in which seller posts items to be sold at a set price, or alternatively to be offered in an auction-style format where bidding is done electronically, and providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods, buyers' and sellers' performance, delivery and overall trading experience in connection therewith. Registration was refused under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), in part on the basis that the proposed mark is merely descriptive of the services. A partial requirement for a disclaimer of “COLLEGE” and a requirement for clarification of the identification of services also were issued.

Applicant disclaimed “BIDS” and amended the identification of services to the following: 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; and providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods, buyers' and sellers' performance, and delivery and overall trading experience in connection with the foregoing, all for commercial purposes. The identification was accepted. However, a final refusal under Section 2(e)(1) was issued as to applicant’s “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.” The requirement for a disclaimer of “COLLEGE” also was made final as to the following services: providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods, buyers' and sellers' performance, and delivery and overall trading experience in connection with the foregoing, all for commercial purposes.¹ Applicant subsequently filed a Notice of Appeal.

ISSUES

The issues on appeal are 1) whether the proposed mark “COLLEGE BIDS” is merely descriptive of applicant’s following services pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1): 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, and 2) whether the word “COLLEGE” in applicant’s mark is merely descriptive of applicant’s following services so that a disclaimer of this wording is required pursuant to Section 6 of the Trademark Act, 15 U.S.C. §1056(a): providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods, buyers' and sellers' performance, and delivery and overall trading experience in connection with the foregoing, all for commercial purposes.

ARGUMENTS

I. Mark is Merely Descriptive as to Certain Services

¹ Applicant was advised that if the disclaimer of “COLLEGE” was provided, then the disclaimer of “BIDS” must be withdrawn as to the services subject to the disclaimer because an entire mark may not be disclaimed. *See* TMEP §1213.06. Applicant also was advised that a disclaimer of “BIDS” would not be required as to the services subject to the refusal under Section 2(e)(1) until the application was successfully amended to seek registration on the Supplemental Register or under Section 2(f). Finally, applicant was advised that the application may be divided.

Registration may be refused when an applied-for mark merely describes a feature of an applicant's goods and/or services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); see TMEP §§1209.01(b), 1209.03 *et seq.* A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods and/or services. TMEP §1209.01(b); see, e.g., *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)).

The determination of whether a mark is merely descriptive is made in relation to an applicant's goods and/or services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); see, e.g., *In re Polo Int'l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the "documents" managed by applicant's software rather than the term "doctor" shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of "computer programs recorded on disk" where the relevant trade used the denomination "concurrent" as a descriptor of a particular type of operating system).

"Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

If a mark comprises more than one term and if the individual components of the mark retain their descriptive meaning in relation to the goods and/or services in the composite mark, then generally the resulting composite mark is itself descriptive and not registrable. *In re Phoseon Tech., Inc.*, 103 USPQ2d

1822, 1823 (TTAB 2012); TMEP §1209.03(d); *see, e.g., In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs, and pillows where the evidence showed that the term “BREATHABLE” retained its ordinary dictionary meaning when combined with the term “MATTRESS” and the resulting combination was used in the relevant industry in a descriptive sense); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services, because such wording “is nothing more than a combination of the two common descriptive terms most applicable to applicant’s services which in combination achieve no different status but remain a common descriptive compound expression”).

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods and/or services is the combined mark registrable. *See In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013).

In this case, applicant’s mark is “COLLEGE BIDS.” “COLLEGE” refers to an institution of higher learning, and “BID” refers to an offer such as the price one will pay or charge.² “COLLEGE BIDS,” therefore, refers to college-related bids or offers.

Applicant’s services include the following: 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. The services are broadly identified. It is, therefore, presumed that applicant's 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.

² Please see the definitions attached to the February 26, 2013 final Office action, pp. 2-17.

In applicant's February 4, 2013 response, applicant confirmed that the consumers of its services could include colleges. A mark that describes an intended user or group of users of a product or service is merely descriptive. *E.g., 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); *In re Camel Mfg. Co.*, 222 USPQ 1031 (TTAB 1984) (holding MOUNTAIN CAMPER merely descriptive of intended users of retail and mail order services in the field of outdoor equipment and apparel); see TMEP §1209.03(i). Accordingly, "COLLEGE" in the mark is merely descriptive of at least one group of the intended users of the services.

Moreover, the excerpt from applicant's website attached to the February 26, 2013 final Office action says, in part:

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.

This excerpt refers to students, school events, spring break activities, jobs, educational information, and trading services for school items, which presumably include college students, college events, spring break activities for college students, college jobs or jobs for college students, college-related educational information, and trading services for college-related items.

Even more significant is that the excerpt from applicant's website shows that consumers must identify their "college" in order to sign up for applicant's services. Thus, it appears that 1) applicant's services are being targeted, at least in part, to colleges and college communities and 2) applicant's trading services feature college-related items. In light of the foregoing, "COLLEGE" in the mark merely

describes features of the services, namely, some of the intended users and a relevant field or subject matter of the services.

With respect to “BIDS” in the mark, the wording “on-line trading services in which a seller posts items to be sold at a set price” in the identification of services is broadly stated. It is, therefore, presumed that the services include those featuring bids and bidding. Meanwhile, the wording “online trading services in which a seller posts items to be sold in an auction-style format where bidding is done electronically” in the identification specifically identifies bidding/bids as a feature of the services. Significantly, in applicant’s February 4, 2013 response, applicant said that its services are available to those “who wish to bid on the items and goods of other users of applicant’s services.” It is, therefore, clear that “BIDS” in the mark merely describes a feature of the services.

The foregoing establishes that each word in the mark merely describes a feature of the services. Moreover, each of the individual components in the composite mark retains its descriptive meaning in connection with the services, and the composite mark does not appear to have any unique, incongruous, or otherwise non-descriptive meaning in connection with the relevant services. Accordingly, applicant’s mark “COLLEGE BIDS” is merely descriptive of applicant’s “on-line trading services in which a seller posts items to be sold at a set price” and “online trading services in which a seller posts items to be sold in an auction-style format where bidding is done electronically.”

Applicant argues that “COLLEGE” in the mark does not merely describe the intended users. In particular, applicant argues that previous cases have found a term merely descriptive of intended users only when the term “more or less” merely described “the entire group of intended users.” It is applicant’s position that a term describing only a “fraction or portion of presumed or potential users of applicant’s services” is not merely descriptive. Applicant’s brief, pp. 4-6. Moreover, applicant states

that its mark is “not limited, restricted, or otherwise intended for any one specific group of users or any one collective interest.” Applicant’s brief, p. 5.

The examining attorney respectfully disagrees. “A mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if a mark describes only one significant function, attribute, or property. *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); see *In re Oppedahl & Larson LLP*, 373 F.3d at 1173, 71 USPQ2d at 1371.

Moreover, the Trademark Trial and Appeal Board has previously held marks to be merely descriptive even when they describe only one of the intended groups of users. For example, in the non-precedential decision in *In re Mark Holdings, LLC*, 2013 TTAB LEXIS 95 (February 25, 2013), the Board held “LENDING STORE” merely descriptive, in part, because it described one of the groups of intended users of an applicant’s “business marketing services for the financial products industry.” Accordingly, “COLLEGE” in applicant’s mark need not describe all of the intended users to be deemed merely descriptive; it is sufficient that it describes only one feature, i.e., one group of intended users.

Applicant also argues that if a term could be deemed merely descriptive because it describes one group of users, then registered marks containing names such as “CRAIGSLIST” could improperly be held merely descriptive.³ Applicant’s brief, p. 7. The examining attorney disagrees with the analysis.

As a preliminary matter, the mark “CRAIGSLIST” is not at issue here, and each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d

³ The examining attorney objects to applicant’s discussion of the registered “CRAIGSLIST” mark on the basis that no registration information for the mark has been made of record. The evidentiary record should be complete prior to the filing of an appeal. TBMP §1207.01.

1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009).

However, the examining attorney notes that “CRAIGS” in “CRAIGSLIST” appears to a possessive term and is distinguishable from “COLLEGE” in this case because it would not be perceived to identify a group of persons. Instead, “CRAIGS” would be perceived as indicating ownership or possession by a particular person named “CRAIG.”

Applicant further argues that the mark is not merely descriptive because 1) there is nothing in its business model that requires the goods and services being sold via applicant’s services to be associated with colleges or college-related activities, and 2) applicant is not directing or indicating what items may be offered for sale on its website. Applicant’s brief, pp. 9-10. Applicant also argues that its mark is arbitrary in connection with its auction services much like Apple Inc.’s registered marks “APPLE” and apple logo are unrelated to the computer and electronic goods on which they are used.⁴ Applicant’s brief, p. 8.

The examining attorney disagrees. Even assuming *arguendo* that “APPLE” and an apple logo are registered and are arbitrary as to the computer and electronic goods that they cover, the present case is distinguishable because “COLLEGE” merely describes a feature of applicant’s services. Applicant has confirmed that “colleges” are among the potential users of the services (though not the sole intended users). The excerpt from applicant’s website referred to above also establishes that 1) applicant’s services are, at least in part, directed to college students or members because users are asked to identify their “college” when signing up, and 2) applicant provides an auction-style trading system that allows users to sell, buy and trade new and used *school items*. Because applicant’s services are broadly identified, it is presumed that the school items provided include all types of school items including

⁴ The examining attorney objects to applicant’s discussion of the registered “APPLE” and apple logo marks on the basis that no registration information for the marks was made of record. The evidentiary record should be complete prior to the filing of an appeal. TBMP §1207.01.

college items, e.g., college books, college memorabilia, college-related clothing. Accordingly, “COLLEGE” merely describes at least one feature of the services, namely, a field or subject matter.

Moreover the discussion above establishes that, unlike the term “APPLE” or an apple logo, applicant’s mark merely describes at least some of the intended users of the services in this case. Thus, “COLLEGE” in the mark is merely descriptive.

Finally, applicant argues that because other providers of online bidding and auction services are unlikely to want to use “COLLEGE BIDS” to describe their services and because applicant is unaware of others actually using the term “COLLEGE BIDS,” the mark is not merely descriptive. Applicant’s brief, pp. 9-10. The examining attorney respectfully disagrees.

The fact that an applicant may be the first and only user of a merely descriptive designation does not necessarily render a word or term incongruous or distinctive; as in this case, the evidence shows that “COLLEGE BIDS” is merely descriptive. *See In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012); *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001); TMEP §1209.03(c).

II. Partial Disclaimer is Required

A “disclaimer” is a statement in the application record that an applicant does not claim exclusive rights to an unregistrable component of a mark; a disclaimer of unregistrable matter does not affect the appearance of the mark or physically remove disclaimed matter from the mark. *See Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 978, 144 USPQ 433, 433 (C.C.P.A. 1965); TMEP §1213. An unregistrable component of a mark includes wording and designs that are merely descriptive of an applicant’s goods and/or services. 15 U.S.C. §1052(e); *see* TMEP §§1209.03(f), 1213.03 *et seq.* Such words or designs need to be freely available for other businesses to market comparable goods or services and should not

become the proprietary domain of any one party. *See Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re Aug. Storck KG*, 218 USPQ 823, 825 (TTAB 1983).

As discussed above, a word is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of the relevant goods or services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

In this case, applicant's mark contains the term "COLLEGE," and applicant's services include "providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods, buyers' and sellers' performance, and delivery and overall trading experience in connection with the foregoing, all for commercial purposes." "COLLEGE" refers to an institution of higher learning.⁵

In applicant's February 4, 2013 response, applicant confirmed that the consumers of its services could include colleges. As noted above, a mark that describes an intended user or group of users of a product or service is merely descriptive. *In re Planalytics, Inc.*, 70 USPQ2d at 1453. Accordingly, "COLLEGE" in the mark is merely descriptive of at least one group of the intended users of the services.

Moreover, the excerpt from applicant's website attached to the February 26, 2013 final Office action includes a sign up form where users are asked to identify their "college," and it says, in part:

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.

This excerpt refers to students, school events, jobs, spring break activities, educational information, and school items, which presumably include college students, college jobs or jobs for college students,

⁵ Please see the definitions attached to the February 26, 2013 final Office action, pp. 2-9.

college events, spring break activities for college students, college-related educational information, and college-related items. In light of this and applicant's broad identification, it is presumed that applicant's services feature the providing of evaluative feedback and ratings regarding college-related goods and services, e.g., college memorabilia and clothing. Thus, "COLLEGE" in the mark also merely describes a field or subject matter of the services.

It is noted that, in its brief, applicant did not directly address the requirement for a disclaimer. However, to the extent that applicant's arguments against the refusal under Section 2(e)(1) are applicable to the disclaimer requirement, the examining attorney's arguments above are hereby incorporated by reference.

In particular, a term may be merely descriptive even if it does not describe the "full scope and extent" of the applicant's goods or services. *In re Oppedahl & Larson LLP*, 373 F.3d at 1173; TMEP §1209.01(b). In this case, the foregoing establishes that "COLLEGE" merely describes at least one feature of applicant's services for "providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods, buyers' and sellers' performance, and delivery and overall trading experience in connection with the foregoing, all for commercial purposes." Thus, it is merely descriptive.

Moreover, the fact that an applicant may be the first and only user of a merely descriptive designation does not necessarily render a word or term incongruous or distinctive; as in this case, the evidence shows that "COLLEGE" is merely descriptive. *See In re Phoseon Tech., Inc.*, 103 USPQ2d at 1826; TMEP §1209.03(c). Accordingly, even if applicant is the only user of the term "COLLEGE" in connection with services for "providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods, buyers' and sellers' performance, and delivery and overall trading

experiences, all for commercial purposes,” a disclaimer of the merely descriptive term “COLLEGE” is required.

CONCLUSION

For the reasons set forth above, the proposed mark “COLLEGE BIDS” is merely descriptive of applicant’s following services: 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. The examining attorney, therefore, respectfully requests that the refusal under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), be affirmed.

For the reasons discussed above, the word “COLLEGE” also is merely descriptive of applicant’s services for “providing evaluative feedback and ratings of sellers’ goods and services, the value and prices of sellers’ goods, buyers’ and sellers’ performance, and delivery and overall trading experience in connection with the foregoing, all for commercial purposes.” Accordingly, the examining attorney respectfully requests that the disclaimer requirement pursuant to Section 6 of the Trademark Act, 15 U.S.C. §1056(a), also be affirmed.

Respectfully submitted,

/MaureenDallLott/

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