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Sent: 7/1/2014 9:56:46 AM

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85753010

MARK: EAR BUD BAG



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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: US Digital Media, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

PHLV1222-007

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

Applicant has appealed the examining attorney's final refusal to register the proposed mark, EAR BUD BAG, for the goods "Ear bud accessory, namely, ear bud case." The trademark examining

attorney¹ refused on the Principal Register pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1), on the ground that the mark is merely descriptive of the goods.

STATEMENT OF FACTS

The applicant filed this application on October 12, 2012, applying to register the mark EAR BUD BAG for “Ear bud accessory, namely, ear bud case” on the Principal Register.

In the first Office action, dated February 18, 2013, the examining attorney refused registration under Section 2(e)(1) of the Trademark Act and issued requirements for additional information about the goods.

On August 19, 2013, the applicant filed a response arguing against the refusal and responding to the information requirement. Applicant’s response satisfied the information requirement.

On September 10, 2013, the examining attorney maintained and made final the Section 2(e)(1) refusal. The applicant filed a notice of appeal on March 10, 2014 and filed its brief on May 5, 2014, which was forwarded to the examining attorney on May 6, 2014.

ISSUE

The sole issue on appeal is whether the mark EAR BUD BAG is merely descriptive of the applicant’s “Ear bud accessory, namely, ear bud case” pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1).

ARGUMENT

THE APPLIED-FOR MARK IS MERELY DESCRIPTIVE WITHIN THE MEANING OF SECTION 2(E)(1) OF THE TRADEMARK ACT BECAUSE IT IMMEDIATELY CONVEYS THE IDEA OF A SALIENT CHARACTERISTIC OF THE IDENTIFIED GOODS

¹ On May 21, 2104, this case was reassigned to the below-referenced trademark examining attorney.

I. The separate terms of the mark merely describe the use of the goods, and the terms retain their descriptive meaning when combined

The applicant's mark, EAR BUD BAG, merely describes the use of the goods, namely, that the applicant's goods are a container for small earphones. A mark is merely descriptive if it describes a characteristic or use of an applicant's goods. 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)).

Generally, if the individual components of a mark retain their descriptive meaning in relation to the goods, the combination results in a composite mark that 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 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, the mark consists of two elements: the compound noun “EAR BUD” and the noun “BAG.” The term “EAR BUD” means “a small earphone worn in the ear for use with audio devices.” See Dictionary evidence attached to Initial Office action (hereinafter “IOA”) at p. 2 and Final Office action (hereinafter “FOA”) at p. 2. The term “BAG” means “a container of flexible material, such as paper, plastic, or leather, that is used for carrying or storing items” or “a flexible container with an opening at one end.” See Dictionary evidence attached to FOA at pp. 4 and 7. When combined, the terms “EAR BUD” and “BAG” refer to a flexible container that is used to carry or store small earphones. Applicant’s identification states that its goods are an “ear bud” case, and the applied-for mark includes the identical term “EAR BUD” to modify “BAG”. Because both the mark and the identification use the same term to the goods, the mark immediately conveys the use or purpose of the goods. Moreover, in its response, applicant stated that its goods are “a small bag.” See Applicant’s August 19, 2013 Response to the Requirement to Provide Additional Information about the Goods. Therefore, based on the dictionary definitions of the individual terms in the mark and on applicant’s own statements and identification, the mark is merely descriptive because it immediately conveys the purpose and nature of the goods.

II. Third Parties Commonly Use the Composite Mark to Describe the Goods

Purchasers and competitors commonly use the composite mark EAR BUD BAG is to describe goods consisting of a flexible container that is used to carry or store small earphones. Two major reasons for not protecting descriptive marks are (1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace and (2) to avoid the possibility of costly infringement suits brought by the trademark or service mark owner. *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978); TMEP §1209. Allowing applicant to register descriptive wording that

commercial entities already use inherently raises the two primary concerns provided, above. Businesses and competitors should be free to use descriptive language when describing their own goods to the public in advertising and marketing materials. *See In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001). In this case, the evidence clearly demonstrates that third parties need to use the commercial name EAR BUD BAG to describe their bags for ear buds.

First, third-party retailers use the common commercial name EAR BUD BAG to describe their goods. For example, the website TaoBao Products shows a Razer “earbud” bag for sale on its website. *See* FOA, at p. 11. The Northwoods Quilts & More website features a “Brown Polka Dot Earbuds Bag” for sale, and it describes the goods as a “zippered earbud bag”. *See* FOA, at p. 17. Additional evidence shows that AudioSpice offers university-themed earbuds that are accompanied by an “earbud bag.” *See* FOA, at pp. 12-15. This evidence shows that competitors need to use the descriptive wording EAR BUD BAG to describe the goods.

Furthermore, many individuals on blogs and community websites refer to flexible cases for earphones as “ear bud bags.” For example, the evidence from Etsy.com, a website for handmade goods, shows that a search of the phrase EAR BUD BAG (without quotations) yields 122 instances of combinations of the individual terms to describe bags used to hold ear buds. *See* IOA, at pp. 11-12; *see also* FOA at p. 19 (describing a fabric zippered container as “Peace symbol coin purse, money bag, [and] ear bud bag”). The third entry, which is highlighted on page 11 of the IOA, uses the composite phrase EAR BUD BAG to describe the goods. Also, the blog “Love It So Much” describes a small round, zippered container as an “earbud bag.” *See* IOA, at p. 6. In another example, a pin board on Pinterest.com shows one user’s request for another user to make round, flexible container for holding small earphones. *See* IOA, at p. 16. A commenter responded to the request asking “[Y]ou need an ear bud bag?” *Id.* This

evidence shows that purchasers immediately recognize and call for flexible containers holding ear buds as “ear bud bags.”

Moreover, individuals use the common commercial name EAR BUD BAG when generally discussing goods that are containers and cases for holding small earphones. For example, a review of the Condor Urban Go bag by an individual describes a particular feature of the bag as an “ear bud bag.” *See* IOA at p. 15. On a personal blog, “Life of a LittleWorm,” the blogger describes a gift she made for her son to hold his earphones as “Timothys [sic] Earbud Bag.” *See* FOA, at p. 21. A packet for Alaskan Learning Labs includes an instruction to Education Specialists to label their students’ “ear bud bags.” *See* IOA, at p. 66. On another personal blog, Sew Mama Sew, a commenter states, “Love the earbud bag! That’ll make great gifts for the teen/pre-teen girls that I need to make something for.” *See* FOA, at p. 41. Thus, the evidence shows that, even outside of a retail context, individuals use applicant’s mark to refer to bags for ear buds.

Applicant argues that its mark should be allowed registration on the Principal Register because it will not inhibit competition for similar goods, claiming that registration of the mark will not prevent others from using the individual terms “EAR”, “BUD”, or “BAG.” *See* Applicant’s brief, at 7-8. Applicant’s arguments are unpersuasive because, as the evidence discussed above shows, purchasers, competitors, and individuals need to use entire composite phrase EAR BUD BAG to describe their goods consisting of a flexible container that is used to carry or store small earphones. Thus, the evidence of record contradicts applicant’s assertion that “allowing this mark will not offend the major reasons for not protecting descriptive marks.” *See* Applicant’s brief, at 8.

Furthermore, applicant’s suggestion that the examining attorney could require a disclaimer of each of the component words in the mark but still allow registration of the mark on the Principal Register is without merit. *See* Applicant’s brief, at 8. An entire mark may not be disclaimed. TMEP

§1213.06; see 15 U.S.C. §1056(a); *In re Dena Corp. v. Belvedere Int'l Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991); *In re JT Tobacconists*, 59 USPQ2d 1080, 1081 n.1 (TTAB 2001). If the applied-for mark is not registrable as a whole, a disclaimer will not make it registrable. TMEP §1213.06. Here, because no element of the mark is distinctive, a disclaimer of all terms in the mark is, necessarily, a disclaimer of the entire mark. Applicant cites to *United States Steel Corp. v. Vasco Metals Corp.*, 394 F.2d 1009 (C.C.P.A. 1968) to support its claim that “it is possible to disclaim all the separate components of a composite mark and still have a registrable whole of the mark itself”. See Applicant’s brief, at 8. Applicant’s reliance on the *Vasco* case is inapposite because the issue in *Vasco* was whether summary judgment had been properly granted; the discussion of disclaimers was purely dictum in the context of whether the mark in question was different from the mark in prior proceeding. See *In re Burlington Industries, Inc.*, 196 USPQ 718 at *4 (TTAB 1977). Therefore, the *Vasco* case is not relevant to the case at hand.

Taken as a whole, the evidence of record supports the conclusion that applicant’s mark, EAR BUD BAG, merely describes applicant’s goods.

III. No Mental Leap or Imagination Is Required to Associate Applicant’s Goods with the Mark EAR BUD BAG

Applicant argues in its brief that the composite mark is suggestive, not descriptive, because it requires imagination when considered in connection with applicant’s goods. A mark is suggestive if some imagination, thought, or perception is needed to understand the nature of the goods described in the mark; whereas a descriptive term immediately and directly conveys some information about the goods. See *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251-52, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005); TMEP §1209.01(a). Despite applicant’s assertion, the evidence shows that the mark EAR BUD BAG,

based on the definitions of the terms and on applicant's own statements with respect to the goods, clearly and immediately conveys what the goods are: a bag for storing ear buds. The evidence discussed above shows that third-party retailers, individuals selling handmade goods on Etsy, and individuals in a non-retail context all refer to goods consisting of a small flexible container for carrying or storing earphones as an EAR BUD BAG. *See supra Section II.* Applicant's arguments, on the contrary, are merely conclusory statements. Applicant provides no alternative suggestions as to what the mental steps between the mark and the goods might be. Applicant also does not explain what immediate mental image is conjured by the mark and why that image is different from the impression created by combining the terms EAR BUD and BAG. Because the instant application has a Section 1(b) basis, no specimen is available to shed further light on the nature of the goods, and applicant has provided no additional evidence to explain the nature of the goods. The identification unequivocally states that applicant's goods are an accessory, namely, a case, *for ear buds*. Applicant's response to the request for information unequivocally states that applicant's goods are "a small bag" and "a bag." *See Applicant's August 19, 2013 Response to the Requirement to Provide Additional Information about the Goods.* It is clear from the evidence of record and applicant's own statements that its goods are a bag for ear buds, and therefore, no imagination or mental gymnastics are required to connect the mark to the goods.

IV. The Combination of Terms in Applicant's Mark Does Not Create a Unique, Incongruous, or Nondescriptive Meaning in Relation to the Goods

Applicant contends that the mark is not descriptive because the composite mark creates a "new and unique commercial impression when used in connection with ear bud carrying cases." *See Applicant's brief, at 7.* Applicant provides no explanation of what the new or unique commercial impression is; applicant simply offers the unsupported assertion that the combination of terms is inherently distinctive. *Id.*

In support of this claim, applicant relies on *In re Chesapeake Corp. of Virginia*, 420 F.2d 754 (C.C.P.A. 1970). Applicant states that the Federal Circuit² held that together, the mere combination of the descriptive terms “SUPER”, “WATER”, and “FINISH” was held non-descriptive. See Applicant’s brief, at p. 7. However, the facts of that case are distinguishable. In *In re Chesapeake*, the court acknowledged that “water finish” was descriptive of an attribute of the goods, but concluded that “it cannot be said, based on this record, that the unitary designation here in question is no more than a common descriptive name for kraft paper itself. ... The weight of the evidence indicates that the unitary designation SUPERWATERFINISH is considered to be distinctive of appellant’s goods by those in the trade, and we do not consider it to be so highly descriptive as to be incapable of registration.” *In re Chesapeake*, 420 F.2d at 756 (emphasis added). Here, the evidence of record leads to the opposite conclusion. The dictionary definitions, applicant’s own assertions, and the extensive descriptive use by third parties plainly show that competitors and the public use the applied-for mark to describe a bag for small earphones. Applicant has not yet begun using the mark in commerce, and thus, it cannot be said that those in the trade consider the mark to be distinctive of applicant’s goods. Applicant also provides no support for its assertion that its mark is “even more distinctive for an ear bud carrying case than SUPERWATERFINISH was for paper having a super water finish.” See Applicant’s brief, at 7. On the contrary, the applied-for mark is commonly used to describe the goods of others. Therefore, purchasers will immediately understand the mark to indicate the purpose of the goods, namely, that it is a bag used to carry or store ear buds, and not that the applicant is the source of the goods.

V. CONCLUSION

As the evidence of record shows, applicant’s mark is widely used to describe containers that are used to carry and store ear buds. Therefore, the record supports the conclusion that the mark EAR BUD

² The case was decided by the Court of Customs and Patent Appeals, which was the predecessor court to the Federal Circuit.

BAG for “ear bud accessory, namely, ear bud case” is merely descriptive of applicant’s goods. For the foregoing reasons, it is respectfully requested that the refusal to register the mark EAR BUD BAG, pursuant to Section 2(e)(1) of the Trademark Act, be affirmed.

Respectfully submitted,

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