

This Opinion is not a
Precedent of the TTAB

Mailed: August 12, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Currency Cases LLC
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Serial No. 86391147
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Zachary D. Messa of Johnson Pope Bokor Ruppel & Burns LLP,
for Currency Cases LLC.

Donald Johnson, Trademark Examining Attorney, Law Office 104,
Dayna Browne, Managing Attorney.

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Before Seeherman, Mermelstein and Goodman,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Currency Cases LLC (“Applicant”) seeks registration on the Principal Register of
the mark CURRENCY CASES (in standard characters) for

Storage apparatus that attaches to mobile device with
adhesive in International Class 9.¹

The Trademark Examining Attorney has refused registration of Applicant’s mark
on three bases: 1) that Applicant’s mark is merely descriptive of its identified goods

¹ Application Serial No. 86391147 was filed on September 10, 2014, based upon Applicant’s
allegation of a *bona fide* intent to use the mark in commerce under Section 1(b) of the
Trademark Act.

under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1); 2) failure to comply with an information requirement, under Trademark Rule 2.61(b); and 3) the identification of goods is indefinite.

After the Trademark Examining Attorney made the refusals final, Applicant appealed to this Board. We affirm the Section 2(e)(1) refusal and the refusal based on an indefinite identification.

I. Evidentiary Issue

Before proceeding to the merits of the refusals, we address an evidentiary matter. In connection with the identification of goods requirement, the Examining Attorney submitted for the first time with his appeal brief a dictionary definition of “mobile” “as capable of moving or being moved” along with a request that the Board take judicial notice thereof.² (6 TTABVUE, 6, 14). Applicant, in its reply, also in connection with the identification requirement, requests that we take judicial notice of the dictionary definition of “mobile device” as “a portable, wireless computing device that is small enough to be used while held in the hand.”³ (7 TTABVUE 3, 5). The Examining Attorney’s and Applicant’s requests are granted inasmuch as the Board may take judicial notice of dictionary definitions including online definitions if the dictionary is readily available and verifiable. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

² Merriam-Webster Dictionary.

³ Random House Dictionary.

So that we may come to a more informed determination on the Examining Attorney's refusal to register under Section 2(e)(1), we will first consider the refusals based upon the sufficiency of the identification of goods and request for additional information.

II. Identification of Goods

Applicant has identified its goods as "storage apparatus that attaches to mobile device with adhesive." The Examining Attorney has rejected this identification as indefinite because the wording "storage apparatus" and "mobile device" lacks specificity and identifies goods in more than one class. In particular, the Examining Attorney submits that the wording "storage apparatus" is misclassified as it could include electronic storage devices in International Class 9, physical storage devices, such as money clips, in International Class 16, or wallets that attach to an electronic device in International Class 18, while the wording "mobile devices" could include not just mobile phones but mobile radios, portable telephones, computers, hot spot devices in International Class 9 or hand held units for playing electronic games in International Class 28. (6 TTABVUE 5-6; December 22, 2014 Office Action p.1). Applicant argues that it cannot adopt the suggested amendments of the Examining Attorney because they "inappropriately limit[] the use of Applicant's goods" and that its present identification is acceptable because it "falls squarely" within the acceptable identification in the Trademark ID Manual of "cases adapted for mobile phones." (4 TTABVUE 7). Applicant also points to the definition of mobile device which is defined as "a portable wireless computing device that is small enough to be

used while held in the hand” as having a “specific, clear, accurate and concise meaning, rendering Applicant’s description of goods sufficiently definite to be understood by those attempting to ascertain applicant’s rights should registration issue for that identification.” (7 TTABVUE 2).

An applicant must identify the goods specifically to provide public notice, to enable the USPTO to classify the goods and services properly, and to enable the Office to reach informed judgments concerning likelihood of confusion. The USPTO has discretion to require the degree of particularity deemed necessary to clearly identify the goods covered by the mark. *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541, 1543-44 (Fed. Cir. 2007); *In re Water Gremlin Co.*, 635 F.2d 841, 208 USPQ 89, 91 (CCPA 1980). Terminology that includes items in more than one class is considered indefinite. *In re Omega SA*, 83 USPQ2d at 1544.

We agree that without clarification as to the type of storage apparatus, the identification of goods is indefinite. The terminology in the present recitation of goods, as pointed out by the Examining Attorney, identifies a variety of goods falling in different classes. For example, “storage apparatus” could identify a wallet, a case, a pouch, or some other type of container, and the Applicant was required to identify the type of container as well as the type of goods the container would carry. As is apparent from the Examining Attorney’s arguments on appeal and suggestions in the Office Actions, fitted cases are classified with the product they are designed to carry (cases adapted for mobile phones), while money clips and wallets (e.g., card wallets, key wallets) are classified in International Classes 16 and 18 respectively. We disagree

with Applicant's argument that its goods fall within the acceptable identification of "cases adapted for mobile phones." Those cases are fitted cases for holding a mobile phone, and it appears that Applicant's case is not designed to hold the mobile device, but to be affixed to its exterior.

Accordingly, because the term "storage apparatus" in the identification of goods is indefinite, we affirm the refusal.

III. Requirement for Additional Information

The Examining Attorney required Applicant to submit the following information about the goods in the first Office Action:

To permit proper examination of the application, applicant must submit additional product information about the goods. ... The requested product information should include fact sheets, instruction manuals, and/or advertisements. If these materials are unavailable, applicant should submit similar documentation for goods of the same type, explaining how its own product will differ.

If the goods feature new technology and no competing goods are available, applicant must provide a detailed description of the goods.

The submitted factual information must make clear how the goods operate, their salient features, and their prospective customers and channels of trade. Conclusory statements regarding the goods will not satisfy this requirement.⁴

⁴ The Examining Attorney also required Applicant to explain how its own product differs from the products shown and/or described in the evidence attached to the Office action. Although the Examining Attorney mentions this requirement in its brief, this particular requirement was not renewed when the information requirement was made final, and we therefore do not consider it herein.

In its response to the Office Action, Applicant did not specifically address the requests made in the information requirement.⁵ We note that it did state in its response to the mere descriptiveness refusal that

Applicant's goods are described as a storage apparatus that attaches to a mobile device with adhesive. The contents of the storage apparatus is not limited to currency, but also includes driver licenses, business cards, hotel room key cards as well as a variety of other non-currency related items. (June 22, 2015 response to Office Action p. 4).⁶

Applicant did not address the information requirement in its main brief. In its reply brief, Applicant asserted that it complied with the requirement by providing a detailed description of the goods that was not conclusory in nature, and specifically noting the language quoted above.

Trademark Rule 2.61(b) provides that “[t]he Office may require the applicant to furnish such information ... as may be reasonably necessary to the proper examination of the application.” An examining attorney generally has considerable discretion in deciding whether and what information should be requested pursuant to Trademark Rule 2.61(b). A request for information must be reasonable. *See In re Planalytics Inc.*, 70 USPQ2d 1453, 1457 (TTAB 2004) (noting that “there [was] no

⁵ Applicant apparently misunderstood the request for information, regarding it as a refusal based on the misclassification of the goods. See June 22, 2015 response, stating that the initial Office action refused registration because 1) the mark is merely descriptive, 2) the statement of goods is indefinite, and 3) the goods are misclassified.

⁶ This statement was made in connection with Applicant's arguments as to the meaning of the term “currency” as used in connection with Applicant's goods and its contention that the term was not merely descriptive because Applicant's goods store non-currency items.

argument that the [information] requirement was not reasonable or legitimate”), citing *In re Page*, 51 USPQ2d 1660, 1665 (TTAB 1999).

We find that the Examining Attorney’s requirement under Trademark Rule 2.61(b) for additional information about the goods was appropriate. As for Applicant’s response, it certainly would have been more helpful if Applicant had separately addressed the request for information in both its response to the Office action and in its appeal brief, or at least had advised the Examining Attorney in its response, and the Board in its brief, that the information it provided in response to the Section 2(e)(1) refusal was also for the purpose of responding to the requirement for information. However, we find that the information Applicant provided, although Applicant could have been more forthcoming, was sufficient, and therefore we reverse the refusal based on the requirement for information under Trademark Rule 2.61(b).

IV. Mere Descriptiveness

Section 2(e)(1) of the Trademark Act precludes registration of a mark that, when applied to the goods or services of the applicant, is merely descriptive of them. 15 U.S.C. § 1052(e)(1). “A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)).

Whether a term is merely descriptive is determined not in the abstract, but “in relation to the particular goods [or services] for which registration is sought, the

context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods [or services] because of the manner of its use or intended use.” *In re Bayer*, 82 USPQ2d at 1831. *See also In re Chamber of Commerce*, 102 USPQ2d at 1219. When a composite mark combines two or more descriptive terms, the descriptiveness analysis turns on whether the combination of terms evokes a new and unique commercial impression. While a combination of merely descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning, *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968), the mere combination of descriptive words does not necessarily create a nondescriptive word or phrase. If each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371-72 (Fed. Cir. 2004).

Both the Examining Attorney and Applicant have submitted dictionary definitions. (June 22, Response to Office Action p. 8; July 13, 2015 Office Action, p.5). Although Applicant submitted multiple definitions for the term “currency,” the most relevant definition is “any form of money in actual use as a medium of exchange.”⁷ As to the definition for the term “case,” the Examining Attorney identifies the following as most relevant: “[a] container; a receptacle: a jewelry case....”⁸

⁷ The American Heritage New Dictionary of Cultural Literacy, Third Edition.

⁸ The American Heritage Dictionary of the English Language.

The Examining Attorney also provided Internet webpages showing and describing cases that hold money, or currency, some of which are used in connection with mobile phones, in order to show that “CURRENCY CASES – means cases for currency or compartments in which money, checks and the like are stored...” (6 TTABVUE 9, December 22, 2014 Office Action, pp. 1, 3-5; July 13, 2015 Office Action p.1, 3).



From Compartmental Cellular Covers to Rugged iPhone Cases

Published: Apr 30, 2011 • References

As sleek and slim as smartphones are these days, these mobile money holders aim to combine two precious protective cases together to free up some space in our pockets. A mobile case and a wallet is all I need when I go out. Just hook me up with my iPhone, money and keys, and I'm good to go.

Most of these phone case-wallet hybrids simply put compartmental pockets on the backside of the mobile covers, while others offer a fold-out design. The most interesting holder is the arm strap gym bag that lets you carry even more personal items on your body. Check out the mobile money holders and make some more room in that back pocket of yours.

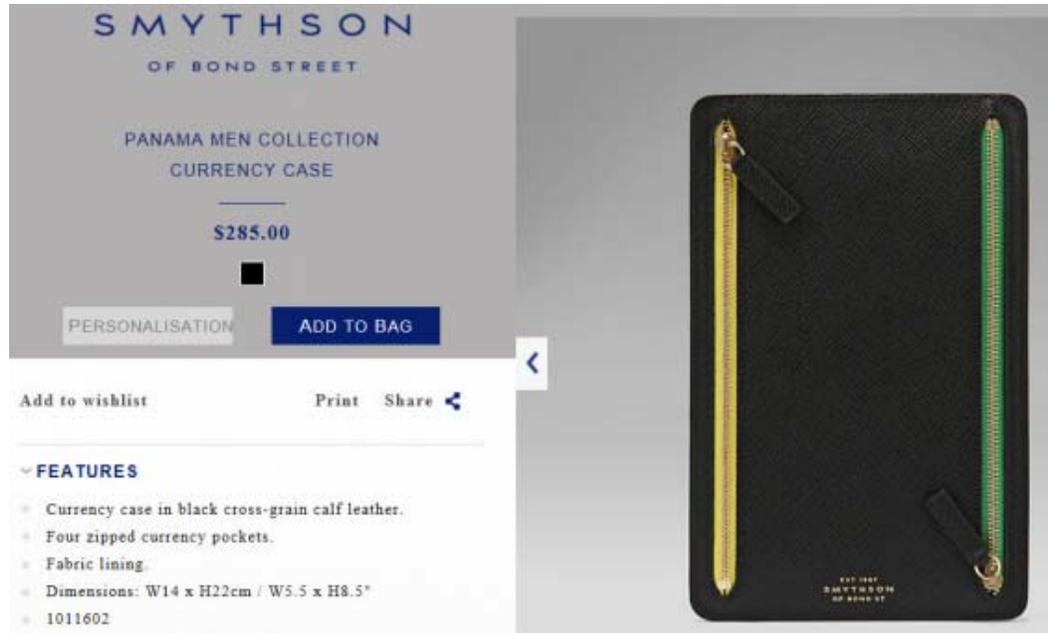
All-in-one Iphone 4 Case, Money clip, bottle opene



About this Product

This is an iPhone 4/4s case

Are you tired of carrying a bunch of other stuff in your pockets? do you ever wonder i wish i could just get one item that does it all? Well after a lot of research and personal pocket experience i have ben able to design a product that covers pretty much everything you will need out in the road.. Wallet, :redit card holder, id holder, bussiness card organizer, money clip.. and YES a bottle OPENER.. all in a tiny very compact case that will also prevent damages to your iPhone.. this is like the Macgyver of he iPhone cases.. this is like the swiss army of wallets.. this is like the master of money clips.. this is nsanity and this case can be yours for the cheap price of \$\$ **prices depend on the materials.. ** This Design has been printed and tested.. You can now safely purchase it.



The Examining Attorney also provided two webpages headed “Currency Cases™,” from the website currencycases.com. (July 13, 2015 Office Action pp. 2-3). The Examining Attorney points to the pictures displayed on the webpage and submits that “currency cases” “are cases or receptacles used to carry money and the other usual contents of a wallet and that are attached to mobile phones.” (6 TTAVUE 9). These webpages apparently show what Applicant’s products look like according to the statement by Applicant in its reply brief (7 TTABVUE 4): “Applicant, however, concedes that the Examining Attorney’s description of the product at currencycases.com with the exception that the product is to be attached exclusively to mobile phones and that the product is limited to the storage of money.”



Currency Cases



Currency Cases - Black
\$ 9.95



Currency Cases - Dark Blue Jean Pocket
\$ 9.95



Currency Cases - Florida
\$ 9.95



Currency Cases - Red
\$ 9.95



Currency Cases - Royal Blue
\$ 9.95



Currency Cases - Tan
\$ 9.95

How To Use

- The application and use of your Currency Cases is easy and can be done in 5 simple steps.
- Step 1. Buy your Currency Case.
 - Step 2. Get your smartphone, clean off the back.
 - Step 3. Peel the back of the Currency Case to reveal the 3M Adhesive.
 - Step 4. Apply your Currency Case firmly to the back of your smartphone. Make sure it sticks on every corner.
 - Step 5. Put your cards and cash in your Currency Cases, throw away your wallet, and you are good to go!



The Examining Attorney argues that CURRENCY CASES is merely descriptive of “cases for currency or compartments in which money, checks and the like are stored” as evidenced by the dictionary definitions for “currency” and “case,” the website evidence advertising “currency cases” that attach to mobile phones, and the website evidence of wallets and other cases, used in connection with mobile phones or separately, in which money and other usual contents of a wallet are stored. (6 TTABVUE 9).

Although acknowledging that its goods may be used to carry currency, Applicant contends that its mark is suggestive as it does not convey directly or indirectly “the vital purpose, characteristic or quality of Applicant’s goods” since its storage apparatus also can “hold driver licenses, business cards, hotel room key cards” as well as currency. (4 TTABVUE 4, 5). Applicant further contends that “[t]he presence of the multiple definitions and connotations for the term ‘currency,’ combined with the fact that Applicant’s storage apparatus is not limited to storage of currency-like items, creates a mental pause in the mind of the consumer as to the goods offered under Applicant’s Mark.” (4 TTABVUE 4, 5).

We agree with the Examining Attorney that CURRENCY CASES is merely descriptive of Applicant’s “storage apparatus that attaches to mobile device with adhesive.”

The term “currency” identifies money, which is an item carried or stored in Applicant’s storage apparatus, as Applicant has acknowledged. Although Applicant contends that the term “currency” is not merely descriptive in connection with its

goods because its storage apparatus also holds non-currency items, a term need not describe each and every specific feature of an applicant's goods in order to be considered merely descriptive; it is sufficient if the wording describes a significant feature or function of the goods. *See In re Chamber of Commerce*, 102 USPQ2d at 1219. *See also In re Oppedahl & Larson*, 71 USPQ2d at 1371 (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)). ("A mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services."). As to Applicant's argument regarding multiple meanings of the term "currency," the fact that a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). As the Examining Attorney has pointed out, Applicant's argument disregards the relationship of the mark to the identified goods. Applicant's own statements show that one of the items that can be placed in its storage apparatus is currency (money), and that this term identifies a significant feature of Applicant's goods.

As to the term "case," Applicant's goods are identified as a storage apparatus, and Applicant has not disputed the definition provided by the Examining Attorney for the term "case." Additionally, Applicant's statement in its brief that its goods fall within the definition of cases adapted for mobile phones, and the pictures of other "Currency Cases" at currencycases.com shows that the goods are considered cases.

Based on the meanings of the individual terms "currency" and "cases," as they would be understood in the context of storage apparatus which could be attached to

mobile devices, we find that the combination CURRENCY CASES is merely descriptive of Applicant's goods. The individual merely descriptive terms retain their descriptive character when combined to form the composite CURRENCY CASES. CURRENCY CASES, when used in connection with storage apparatus that attaches to mobile device with adhesive, would immediately convey to consumers that this apparatus is a case that can hold currency.

Decision: The Section 2(e)(1) descriptiveness refusal and the requirement for an acceptable identification are affirmed; the Trademark Rule 2.61(b) requirement for information is reversed.