

This Opinion is not a
Precedent of the TTAB

Mailed: October 2, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Caleb Suresh Motupalli
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Serial No. 86573858
—

Caleb Suresh Motupalli, appearing *pro se*.

Allison Holtz, Trademark Examining Attorney, Law Office 111,
Robert L. Lorenzo, Managing Attorney.

—
Before Wellington, Lykos, and Larkin,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Caleb Suresh Motupalli (“Applicant”), an individual, seeks registration on the
Principal Register of the standard character mark **PERSON**¹ for, as amended:

¹ The mark in the drawing page of the application appears as “Person,” but Applicant has claimed the mark to be in standard character format with no claim as to special form. We find no significance to the mixed use of upper and lower case lettering in the drawing and we assess the descriptiveness of a standard character mark by reference to the word, not how it might be depicted in use (or even in the application in view of the standard character claim). See *In re Calphalon Corp.*, 122 USPQ2d 1153 (TTAB 2017).

Wearable computer peripherals; Wearable computers; Wearable digital electronic devices comprised primarily of headsets with ear phones and microphone, virtual and augmented reality eyewear, a projector, a telephone, display screens for viewing, and featuring software for the collection, organizing, modifying, transmission, storage and sharing of data and information in the field of personal life; software for personal management, namely, software for organizing data and information, sending and receiving texts, emails, data and information; smart phones; tablet computers; and portable computers; display screens; goods featuring a wristwatch, namely, smart watches in International Class 9.²

The Examining Attorney has refused registration on the basis that the mark is merely descriptive of Applicant's goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

Background

The prosecution of this application has been somewhat tortured and there is no shortage of Office Actions and responses from Applicant. The following is an abbreviated version of events leading to up to this decision.

In the first Office Action, the Examining Attorney made requirements involving a more definite identification of goods and the submission of acceptable specimens of use, but did not assert a substantive basis for refusal.³ After a series of back and forth of Office Actions and Applicant's responses, including multiple requests for reconsideration, the Examining Attorney accepted an amendment to the

² Application Serial No. 86573858, filed on March 24, 2015, based on use of the mark in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging March 17, 2015 as the date of first use and first use in commerce.

³ Office Action issued on June 28, 2015.

identification of goods but maintained and made final the requirement for an acceptable specimen of use.⁴

Applicant filed an appeal of the specimen refusal together with a request for reconsideration.⁵ The Board instituted the appeal but suspended the proceeding to remand the application to the Examining Attorney to address the request for reconsideration.⁶ The Examining Attorney eventually approved Applicant's specimen of use and approved the application for publication for opposition.⁷

However, after the application was approved for publication, the Examining Attorney issued an Office Action "in response to an Official Gazette Query conducted by the Commissioner's Office" and, for the first time, asserted the descriptiveness

⁴ Office Actions issued on August 3, 2015; October 25, 2015; November 23, 2015; December 19, 2015; March 21, 2016; April 17, 2016; and May 17, 2016 ("final" Office Action). Applicant's responses, including requests for reconsideration, filed on June 29, 2015; October 2, 2015; October 25, 2015; November 24, 2015; February 27, 2016; March 22, 2016; and April 26, 2016.

⁵ 1 TTABVUE.

⁶ 2 TTABVUE.

⁷ We note that, as originally filed, the application contained a statement that the mark has "become distinctive of the goods/services, as demonstrated by the attached evidence," under Section 2(f) of the Trademark Act. Prior to approving the application for publication, but after the application had been remanded, the Examining Attorney advised Applicant that the Section 2(f) acquired distinctiveness statement in the application was unnecessary because the mark "appears to be inherently distinctive" and is thus "eligible for registration on the Principal Register without proof of acquired distinctiveness." See Office Action issued on June 12, 2016. The Examining Attorney offered Applicant the opportunity to delete the Section 2(f) claim, pursuant to TMEP § 1212.02(d) (April 2017). Applicant did not respond. While a statement from an applicant that a mark has acquired distinctiveness may be construed as an admission that the mark is merely descriptive, and thus not inherently distinctive, the Section 2(f) claim was not pursued by Applicant or addressed again by the Examining Attorney on appeal. Moreover, based on Applicant's arguments later during prosecution and on appeal, he clearly does not concede that his mark is merely descriptive but argues that it is "inherently distinctive." See Applicant's response filed February 6, 2017. In view of our ultimate decision in this appeal, we agree with the Examining Attorney's initial holding that the acquired distinctiveness statement is unnecessary. The Section 2(f) claim is therefore deleted from the application file record.

refusal now before us.⁸ This set off another series of back and forth of Office Actions, and Applicant's responses, including requests for reconsideration, leading to the descriptiveness refusal being made final.⁹

The appeal was resumed by the Board. Applicant and the Examining Attorney fully briefed the descriptiveness refusal.¹⁰

The Descriptiveness Refusal

The distinctiveness of a proposed mark spans a spectrum from coined and fanciful terms to arbitrary to suggestive and then along a descriptiveness continuum (going from merely descriptive to generic terms). See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759 (2d Cir. 1976) (discussing spectrum of distinctiveness of marks.) A mark is deemed to be merely descriptive within the meaning of Section 2(e)(1) and will be refused registration on the Principal Register if it immediately conveys knowledge of a quality, feature, function, characteristic or purpose of the goods or services for which it is used. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987)); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). See also *In re TriVita, Inc.*, 783 F.3d 872, 114

⁸ Office Action issued on September 5, 2016.

⁹ See Applicant's responses filed on September 9, 2016; February 6, 2017; March 10, 2017. Office Actions issued on October 11, 2016; March 5, 2017 (making descriptiveness refusal "final"); and April 9, 2017.

¹⁰ 10 TTABVUE (Applicant's brief); 13 TTABVUE (Examining Attorney's brief); and 14-15 TTABVUE (Applicant's reply).

USPQ2d 1574, 1575 (Fed. Cir. 2015). On the other hand and moving to the other side of the spectrum, a mark is suggestive and registrable on the Principal Register if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. *See In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ2d 505 (CCPA 1980); *In re Tennis in the Round, Inc.*, 199 USPQ 496, 498 (TTAB 1978); *see also In re Shutts*, 217 USPQ 363, 364-65 (TTAB 1983); *In re Universal Water Sys., Inc.*, 209 USPQ 165, 166 (TTAB 1980). Distinguishing between a merely descriptive term and a suggestive one is not always easy and the line between the two is sometimes fine. *See In re Recovery, Inc.*, 196 USPQ 830, 832 (TTAB 1977) (acknowledging “difficulty in determining the suggestiveness or descriptiveness” of the term RECOVERY which seems “at first blush, to possess a descriptive significance” in connection with the involved services, but “to articulate the manner in which the term ... describes those services, one cannot come up with an immediate response, but rather must engage in a mental process involving imagination, speculation, and possibly stretching the meaning of the word to fit the situation.”).

The determination of whether a mark is merely descriptive or only suggestive must be made in relation to the goods or services for which registration is sought, not in the abstract. *In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Bayer*, 82 USPQ2d at 1831. This requires consideration of the context in which the mark is used or intended to be used in connection with those goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. *In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re*

Bayer, 82 USPQ2d at 1831; *In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987). Evidence that a term is merely descriptive to the relevant purchasing public “may be obtained from any competent source, such as dictionaries, newspapers, or surveys.” *In re Bayer*, 82 USPQ2d at 1831 (quoting *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986)); *see also*, *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707 (Fed. Cir. 2017) (involving competence of source of evidence.)

The Examining Attorney argues that the evidence she submitted “with regard to the nature of ‘wearable’ goods show[s] that the term PERSON describes a significant feature of these goods for wear on the human body, distinguishing them from a wearable device for, for example, a dog or a horse.”¹¹ The evidence in support of the refusal is minimal. It includes two examples of third-party use of the term “person” in connection with wearable electronic devices; the following are relevant excerpts:

Wearable POV Camera Systems

BSI has taken the specialized cameras we use in racing and adapted them for person-wearable applications. Our mini point-of-view or POV camera offers stunning 1080i resolution and stabilizing technology that creates high quality HD video output. When this small, lightweight camera is paired with BSI's mini transmitter it's possible to broadcast the video wirelessly live during a broadcast. BSI can also enable remote camera control by adding a data receiver to the system. Each person-wearable camera system is customized for the particular application in which it will be used to capture the most compelling video and maximize the comfort of the wearer.

Person-Wearable POV Camera Systems:

- Ref Cam
- Jockey Cam

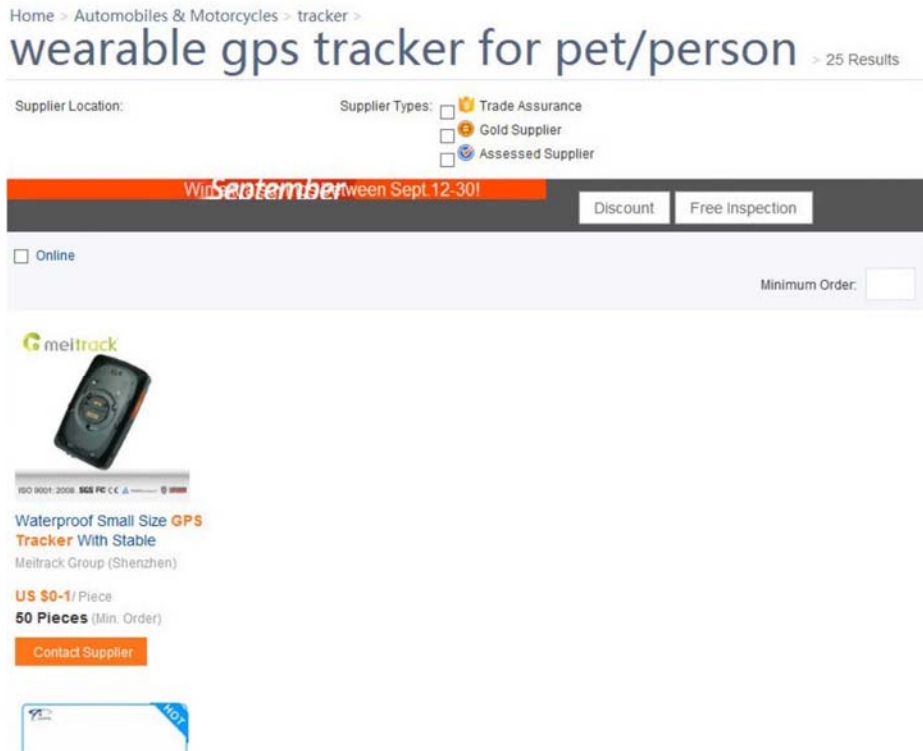


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[from www.broadcastsportsinc.com];¹² and

¹¹ 13 TTABVUE 7.

¹² P. 6, Office Action issued on September 5, 2016.



[from www.alibaba.com website].¹³

The Examining Attorney also submitted internet printouts showing the term “wearable computing” is defined as “electronic devices that are worn on the body or clothes,”¹⁴ as well as the following definitions:¹⁵

PERSON: a human being; a person who likes or enjoys something specified; {law} the body or clothing of a person, especially when considered as a place to hide things.

CONSUMER: A person who buys goods and services.

¹³ *Id.* at p. 7.

¹⁴ From “The Free Dictionary” website (www.encyclopedia2.thefreedictionary.com). *Id.* at p. 18.

¹⁵ From “Merriam-Webster” website (www.merriam-webster.com); pp. 6-26, Office Action issued on October 11, 2016.

Based on this evidence, the Examining Attorney concludes that Applicant's mark "describes the intended users of applicant's goods."¹⁶

Applicant, on the other hand, essentially argues in his appeal brief that the Examining Attorney has taken too broad of an approach with respect to the term "person" and the descriptiveness refusal. Applicant asserts, "if PERSON is descriptive for this reason then it is descriptive of virtually all goods, as long as the goods are used by humans."¹⁷ The Examining Attorney, replying to this specific argument from Applicant, commented that she "agrees that Applicant has correctly stated the policy."¹⁸

On the record before us, we do not find that the term PERSON, by itself, conveys any meaningful information regarding a quality, feature, function, characteristic or purpose of the identified goods. As defined, the term is extremely broad and simply means a human being; thus, a "person" will necessarily be the consumer for all goods and services imaginable. As to the Examining Attorney's argument that it will be understood as describing the type of end user of the goods, i.e., distinguishing the end-user from a possible non-human user of goods, the evidence to support this is inadequate. First, we note we only have printouts from two websites. This hardly demonstrates frequency nor does it offer any sense of parlance whereby "person" is used in connection with wearable electronic goods in the manner suggested by the

¹⁶ 13 TTABVUE 8.

¹⁷ 10 TTABVUE 3.

¹⁸ 13 TTABVUE 6.

Examining Attorney. In this regard, we note the website evidence appears to show “person” being used differently. With respect to the Alibaba website advertising a GPS tracking device, the preceding language “for pet/...” preceding “person” certainly helps clarify a particular meaning and significance of “person.” On the other hand, the second website involves “Person-Wearable POV [point of view] Camera Systems,” and emphasizes the location of the “person-wearable” product and “maximize[ing] the comfort of the wearer.” That is, instead of identifying a human end user (to distinguish from a non-human end user), the term “person” seems to be indicating where the camera is placed, *e.g.*, wearable on the body or “on the person.”

Ultimately, the term “person” can literally be a reference to anyone and be understood in many different manners. There is insufficient evidence demonstrating that consumers would readily understand it in connection with the identified goods as conveying the information that the intended end user is a human being. The “immediate idea” of a quality, feature, function, or characteristic of the goods or services conveyed by a descriptive term “must be conveyed forthwith with a ‘degree of particularity.’” *Goodyear Tire & Rubber Co. v. Continental General Tire Inc.*, 70 USPQ2d 1067, 1069 (TTAB 2003) (citing *In re TMS Corp. of the Americas*, 200 USPQ 57, 59 (TTAB 1978) and *In re Entenmann’s Inc.*, 15 USPQ2d 1750, 1751 (TTAB 1990)). Here, we find that PERSON does not do that in connection with Applicant’s wearable computer and electronic goods, as identified in the application; rather, the term is too vague as to what or how a “person” is being referred to – whether it is the consumer, the end user of the goods, or if the term is somehow an expression of the goods being

worn “on the person” – rendering the mark at least suggestive, not merely descriptive, of the goods and thus registrable on the Principal Register.

Decision: The refusal to register Applicant’s mark is reversed.