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

Proceeding	86777733
Applicant	Mario Dedivanovic
Applied for Mark	THE MASTER CLASS
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In re Mario Dedivanovic

Applicant

Serial No.: 86777733

Applicant: Dedivanovic, Mario
Applicant's Mark: THE MASTER CLASS
Applicant Serial No.: 86777733(Class 41)

APPLICANT'S APPEAL BRIEF

FACTS AND PROCEDURAL HISTORY

Mario Dedivanovic "Applicant" respectfully asks this Board to approve his application for THE MASTER CLASS for the limited goods that remain in the application. Applicant advertised and promoted all of the classes on Instagram and Applicant's Instagram account had 3 million followers as of February 17, 2017 and at least 2 million followers for the two years prior to February 17, 2017. As of September 2017, Applicant had 3.7 million followers on Instagram.

Applicant submitted a Declaration on September 1, 2017 to Supplement the Declarations of February 16, 2017 and February 17, 2017, which were filed on February 17, 2017 with accompanying exhibits.

With respect to the February 17, 2017 Declaration, in the Office Action dated March 11, 2017, the Examiner concludes that "Applicant has provided no evidence as to how many people have actually viewed these advertisements". The February 17, 2017 Declaration certifies that Applicant advertised and promoted all of the classes on Instagram, attaching a sampling of the advertisements. The Declaration goes on to say that Applicant's Instagram account had 3 million

followers as of February 17, 2017 and at least 2 million followers for the two years prior to February 17, 2017. Accordingly, the advertisements attached to the February 17, 2017 Declaration, were disseminated to between 2 million and 3 million followers. There are no invoices for this extensive promotion because the postings on Instagram account and other social media do not incur a charge.

In the March 11, 2017 Office Action, the Examiner has attached approximately ten (10) third party uses of the term MASTER CLASS to describe beauty classes taking place in late 2016 and early 2017. Applicant was the first one ever to use the term MASTER CLASS to relate to educational demonstrations in the field of makeup application as set forth in Applicant's October 5, 2015 Application for the trademark.

On September 1, 2017, Applicant submitted additional advertisements for a New York City performance that took place on August 19, 2017 along with photographs of the event which were disseminated via Instagram to excess of 3 million followers. The advertisements were published at least 100 times via Instagram account in the months of April, May, June, July and August and the photos were published each day on August 20 thru August 30. There is no mechanism on Instagram to determine how many people actually viewed the still photos but the promotion resulted in a sold out show. Attached to Applicant's September submission, was a payout summary of an additional \$944,325.16 in ticket sales for the August 19, 2017 MASTER CLASS which increase total sales volume to almost \$4 million.

ARGUMENT

POINT I

The Trademark Office has not met It's Burden

“The Trademark Office bears the burden of establishing that [a phrase]. . . is generic, by adducing sufficient evidence of the phrase's meaning to the relevant purchasing public. A strong showing is required when the Office seeks to establish that a term is generic, not descriptive, for specific goods or services to which the applicant has attached it”. In re K-T Zoe Furniture, Inc., 16 F.3d 390, 393 (Fed. Cir. 1994).

It is respectfully submitted that the term THE MASTER CLASS is not generic for the services contained in the application "educational demonstrations in the field of make-up application". Respectfully, the word "make up application demonstration" would be generic for this service. Alternatively, "make up application demonstrations" can also be generic for this service.

While the term THE MASTER CLASS may be “descriptive” or “suggestive” of a demonstration of make up application, there is no dictionary definition of the term THE MASTER CLASS that would make it “generic” for the services "educational demonstrations in the field of make-up application". See In re Seats, Inc.; In re Merrill Lynch, Pierce, Finner & Smith, Inc.:

“The Board did not find that SEATS was generic. Nor could it have so found. The term ‘seats’ may be generic in relation to chairs or couches or bleachers. It is clearly not generic to reservation services. Contrary to the Board's statement, Seats is not selling seats, as would for example a furniture merchant, but is selling a reservation service, and consideration of whether generic terms are *per se* unregistrable, is not here involved.” In re Seats, Inc., 757 F.2d 274, 277

(Fed. Cir. 1985) *citing Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 105 S.Ct. 658, 83 L.Ed.2d 582 (1985).

“As Judge Rich explained in *In re Abcor Development Corp.*, 588 F.2d 811, 816, 200 USPQ 215, 219 (CCPA 1978) (Rich, J., concurring) (emphasis in original), a term that immediately and unequivocally describes the purpose and function of Applicant's goods is a name for those goods, for “[t]hat is what *names* do. They tell you what the thing *is*.” The term CASH MANAGEMENT ACCOUNT was not shown to meet this standard . . .for “financial services involving the use of plastic credit cards by the cardholders for loans to cardholders from their brokerage equity account.” *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1571 (Fed. Cir. 1987).

THE MASTER CLASS is also not “generic” for a second service identified in the application, namely "providing classes, seminars, workshops, and training in the field of beauty". Here, the dictionary definition "a lesson for advanced students given by someone who is an expert" is not generic for the services "classes, seminars, workshops, and training in the field of beauty". A generic term for the said services would likely be "beauty classes", "beauty training", "beauty workshops", "beauty seminars".

While the term THE MASTER CLASS may suggest or even describe to the general public that the class that they will be attending relates to workshops, training, seminars, or classes in the field of beauty, it is respectfully submitted that it is not “generic” for those services.

“Ginn's registration is of the title of ‘a magazine directed to the field of firefighting.’ In addition to Ginn's publication, the record shows that there are a number of other publications directed to that field. The class of magazines at issue is, therefore, those directed to the field of firefighting. However, we can discern no record evidence

which suggests that the relevant portion of the public refers to a class of firefighting publications as 'Fire Chief.' Furthermore, the term 'Fire Chief,' is neither the name of the fire-fighting industry nor about the fire-fighting industry. We therefore conclude that the board clearly erred in finding Ginn's mark FIRE CHIEF, for a magazine directed to the field of firefighting, to be generic. At most, it is descriptive and should be retained on the Principal Register unless the IAFC has proved that it never acquired secondary meaning, subject, of course, to the other statutory requirements for maintaining registrations." H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 991 (Fed. Cir. 1986).

Moreover, the public does not refer to educational demonstrations in the field of beauty as THE MASTER CLASS nor is it not the name of the industry. Thus, THE MASTER CLASS is not "generic" and the Trademark Office has not met its burden.

POINT II

The Mark has Achieved Distinctiveness

In the interest of streamlining the issues for the honorable Examiner, Applicant consented to removal of the word "classes" from the second category of services which will now read "seminars, workshops, and training in the field of beauty".

It is respectfully submitted that THE MASTER CLASS is suggestive for both categories of services "educational demonstrations in the field of make-up application" and "seminars, workshops, and training in the field of beauty". In the event that the Examiner adheres to its determination that THE MASTER CLASS is "merely descriptive" of either or both groups of Applicant's services, the Applicant respectfully submits that the mark has achieved "acquired distinctiveness" in that it has used the mark for more than five years on a continuous basis.

“When an applicant claims acquired distinctiveness in the alternative, the examining attorney must treat separately the questions of: (1) the underlying basis of refusal; and (2) assuming the matter is determined to be registrable, whether acquired distinctiveness has been established”. TMEP §1212.02(c).

An independent ground for determining that the mark has "acquired distinctiveness" is supported by the extensive sales and/or advertising achieved by the mark. It is noted that in a prior response to this honorable Examiner's January 26, 2016 Office Action, Applicant's predecessor attorney's claim of "acquired distinctiveness" was devoid of support. It is respectfully submitted that deficiency (duly noted by the Examiner in the August 17, 2016 Office Action), is hereby corrected by way of the attached Declaration of the Applicant dated February 16, 2017 showing extensive sales of the services identified by the mark, exceeding \$3 million.

A separate Declaration from the Applicant dated February 17, 2017 shows the promotion of the Applicant's mark and services identified by the mark. While the exact dates of the advertisements are not contained in the February 17, 2017 Declaration, the Applicant certifies that on at least three days prior to each event, the subjective advertisement appeared in each of the three social media accounts identified in the Declaration.

Applicant respectfully submits that he has established not only secondary meaning through widespread advertisement, sales and use of the mark, but have five years of exclusive use of the mark. His Application certifies that he used THE MASTER CLASS at least as early as January 2011 and the Examiner did not provide evidence of any third party uses before late 2016. Accordingly, even if the descriptiveness determination is adhered to, Applicant's exclusive use of the mark for 5 years and his widespread sales/advertising each independently support approval for Registration. Applicant respectfully submits that third party users that started copying his innovation and creativity of coining the term MASTER CLASS for demonstrations of makeup

application should not be allowed to prevent me from obtaining a Trademark Registration for his Trademark.

It is respectfully submitted that the Examiner's citation to some junior use of the mark by Third Parties is misplaced. It is true that research showing that third parties in applicant's field or closely related fields use the same or substantially the same wording as the mark, or very similar wording as the mark, tends to indicate the mark is at least highly descriptive". TMEP 1212.01

"However, claiming distinctiveness in the alternative is *not* an admission that the proposed mark is not inherently distinctive". TMEP §1212.02(b).

"An applicant may argue the merits of an examining attorney's refusal and, in the alternative, claim that the matter sought to be registered has acquired distinctiveness under §2(f). Unlike the situation in which an applicant initially seeks registration under §2(f) or amends its application without objection, the alternative claim does not constitute a concession that the matter sought to be registered is not inherently distinctive. *See In re Thomas Nelson, Inc.*, 97 USPQ2d 1712, 1713 (TTAB 2011) ; *In re E S Robbins Corp.*, 30 USPQ2d 1540, 1542 (TTAB 1992); *In re Profl Learning Ctrs., Inc.*, 230 USPQ 70, 71 n.2 (TTAB 1986) ". 1212.02(c)

"The five years of use in commerce does not have to be exclusive, but must be "substantially" exclusive. **15 U.S.C. §1052(f); 37 C.F.R. §2.41(a)(2)**. This makes allowance for use by others that may be inconsequential or infringing, which does not necessarily invalidate the applicant's claim". *L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349, 1352, 52 USPQ2d 1307, 1309 (Fed. Cir. 1999).

"An evidentiary showing of secondary meaning, adequate to show that a mark has acquired distinctiveness indicating the origin of the goods, includes evidence of the trademark owner's method of using the mark, supplemented by evidence of the effectiveness of such use to cause the purchasing public to identify the mark with the source of the product". TMEP 1212.06

The numerosity of Applicant's classes and the steady increasing enormous success shows the purchasing public's identification of the mark with the source. See e.g. *PTAK BROS. JEWELRY, INC*

v. Ptak, 2007 WL 1536934 (S.D.N.Y. 2007)(Chin, D.J.) Advertising by social media and the internet has now become so prevalent that the Examiner cannot rely purely upon paid for advertising.

The Internet has become integral to daily life in the United States, with Census Bureau data showing approximately three-quarters of American households used the Internet in 2013 to engage in personal communications, to obtain news, information, and entertainment, and to do banking and shopping. See *In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1642 (TTAB 2015) (taking judicial notice of the following two official government publications:

(1) Thom File & Camille Ryan, U.S. Census Bureau, Am. Cmty. Survey Reports ACS-28, *Computer & Internet Use in the United States: 2013* (2014), available at <http://www.census.gov/content/dam/Census/library/publications/2014/acs/acs-28.pdf> and

(2) The Nat'l Telecomms. & Info. Admin. & Econ. & Statistics Admin., *Exploring the Digital Nation: America's Emerging Online Experience* (2013), available at http://www.ntia.doc.gov/files/ntia/publications/exploring_the_digital_nation_-_americas_emerging_online_experience.pdf).

Thus, the widespread use of the Internet in the United States suggests that Internet evidence may be probative of public perception in trademark examination.

CONCLUSION

Wherefore, it is respectfully submitted that the mark has achieved "acquired distinctiveness" both because it has been continuously used for more than five years and because of the extensive sales, promotion and advertising that it is respectfully submitted have caused the public to equate the Applicant as the source of the services provided under the mark.

Dated: New York, New York
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