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Sent: 6/14/2018 10:43:56 AM

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Subject: U.S. TRADEMARK APPLICATION NO. 87205484 - WORLD'S GREATEST VIDEOS - 82462.00027 - EXAMINER BRIEF

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Files: 87205484.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 87205484

MARK: WORLD'S GREATEST VIDEOS



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CORRESPONDENT'S REFERENCE/DOCKET NO:

82462.00027

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

In this case, Applicant appeals the Trademark Examining Attorney's Final Refusal of the proposed mark, WORLD'S GREATEST VIDEOS in standard character. The refusal is based upon Section 2(e)(1) of the Trademark Act, as the mark is merely descriptive in a laudatory fashion of the applicant's listed services. Further, the examining attorney has determined that the mark is so descriptive that a

claim of 2(F) for acquired distinctiveness supported by minimal evidence is not sufficient to overcome the incumbent refusals.

STATEMENT OF THE CASE

The Applicant applied to register the standard character mark “WORLD’S GREATEST VIDEOS” on the Principal Register in connection with Class 38 “Audio and video broadcasting services over the Internet or other communications network featuring the uploaded, posted, shown, displayed, and tagged videos of others; electronically transmitting information, audio, and video clips,” Class 41 “Entertainment services, namely, conducting contests and sweepstakes by broadcasting audio and video clips over the Internet or other communications network,” and Class 42, “Providing a web site that gives computer users the ability to upload and share user-generated videos, on a wide variety of topics and subjects.” Registration was initially refused on January 26, 2017 under Trademark Act Section 2(e)(1) as being merely descriptive of the services, and Applicant was likewise put on notice of two prior filed applications.

Applicant responded on July 20, 2017 noting that the prior filed applications had been assigned to them, and argued against the 2(e)(1) refusal. That refusal was rendered final by the examining attorney on 8/3/2017. A request for reconsideration was filed on 2/2/2018 along with a notice of appeal, and that request was denied by the examining attorney 2/8/2018.

This appeal follows the Examining Attorney’s final refusal of the mark on the grounds that the applied-for mark is merely descriptive of the identified services under Section 2(e)(1) of the Trademark Act. 15 U.S.C. § 1052(e)(1).

ISSUE ON APPEAL

Whether registration has been properly refused because “WORLD’S GREATEST VIDEOS” is merely descriptive as applied to the applicant’s listed services in Classes 38, 41 and 42 44, and therefore

unable to function a source identifier in commerce under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1).

As a preliminary matter, Applicant has submitted new evidence with its appeal brief. Specifically, Exhibit B, a list of third party registrations, as well as a discussion of those registrations.

The record in an application should be complete **prior** to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

Because applicant's new evidence was untimely submitted during an appeal, the trademark examining attorney objects to this evidence and requests that the Board disregard it. *See In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A*, 109 USPQ2d 1593, 1596 (TTAB 2014); *In re Pedersen*, 109 USPQ2d 1185, 1188 (TTAB 2013); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

ARGUMENTS

Trademark Act Section 2(e)(1) bars registration of an applied-for mark that is merely descriptive of some aspect of the Applicant's services. A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). 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)).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the services for which registration is sought, the context in which it is being used on or in connection with the services, 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; that a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). In other words, "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the ... services are will

understand the mark to convey information about them.” *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002).

The question, therefore, becomes whether Applicant’s proposed mark – WORLD’S GREATEST VIDEOS – *immediately* conveys an idea of a characteristic or feature with respect to a central aspect of the following services:

- Class 38: Audio and video broadcasting services over the Internet or other communications network featuring the uploaded, posted, shown, displayed, and tagged videos of others; electronically transmitting information, audio, and video clips
- Class 41: Entertainment services, namely, conducting contests and sweepstakes by broadcasting audio and video clips over the Internet or other communications network
- Class 42: Providing a web site that gives computer users the ability to upload and share user-generated videos, on a wide variety of topics and subjects

It is well established, indeed, that “[a] mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s ... 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). A mark need not immediately convey an idea of each and every specific feature of the goods in order to be considered merely descriptive; rather, it is sufficient that the mark describes one significant attribute, function or property of the goods. *In re Chamber of Commerce of the United States of America*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). This is the case here, as WORLD’S GREATEST VIDEOS immediately describes a significant attribute of applicant’s services – the subject matter and purpose of those services, to provide consumers with access to, and the ability to upload, the “world’s greatest videos.”

MEANING OF THE PROPOSED MARK TO CONSUMERS

When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods, the combination results in a composite that is itself merely descriptive. *See e.g., In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004) (PATENTS.COM merely descriptive of computer software for managing a database of records that could include patents, and for tracking the status of the records by means of the Internet); *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332 (TTAB 2009) (BATTLECAM merely descriptive for computer game software); *In re Carlson*, 91 USPQ2d 1198 (TTAB 2009) (URBANHOUSING merely descriptive of real estate brokerage, real estate consultation and real estate listing services); *In re Tower Tech*, 64 USPQ2d at 1314 (SMARTTOWER merely descriptive of commercial and industrial cooling towers); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer programs for use in developing and deploying application programs); *In re Putman Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE merely descriptive of news and information services in the food processing industry).

The term "WORLD" is defined as, "[o]f or relating to the world," and "great" means, "[s]uperior in quality or character." *See previously attached evidence from American Heritage Dictionary to Examiner's Action of 1/26/2017*. The applicant has agreed "VIDEO" is a generic term when used in connection with its services, and thus the examiner has not provided a definition (although the term regularly appears in Applicant's identification of services, leaving little doubt they are considered a central facet/focus of the services themselves).

The wording "WORLD'S GREATEST," therefore, is a laudatory phrase describing the quality or caliber of the videos that are the subject of all of applicant's services. The phrase would be understood as stating that said videos are the highest quality videos to be found in the world – the "world's greatest" – and are being broadcast, uploaded, posted, shown, displayed, tagged, etc., that are being broadcasted for conducting contests (by determining whose video is, in fact, the "world's greatest") and providing a website where consumers upload and share the highest quality videos in the world – the "world's greatest."

Applicant argues that WORLD'S is not descriptive because the term "WORLD" possesses multiple possible meanings in reference to the services, and that it cannot therefore be "merely descriptive." Although the examiner acknowledges that WORLD has more than one literal definition, this is not the

term appearing in applicant's mark. "WORLD'S" is a possessive, therefore limiting the definitions which a consumer would perceive from the mark as a whole to those which would be considered logical or sensible. Further, the dominant possible remaining definitions of "world" are *all* descriptive of the videos that are the central focus of applicant's services: the videos are the greatest to be found on/among "the earth, together with all of its countries and people." The videos are the greatest to be found among "all of the people and societies on the earth." The videos are "one of the most important things of their class." And so forth.

Finally, it is worth noting that descriptiveness is considered in relation to the relevant goods and/or services. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). "That a term may have other meanings in different contexts is not controlling." *In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1087 (TTAB 2012) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)); TMEP §1209.03(e). Here, a consumer perceiving the term WORLD'S as part of the phrase WORLD'S GREATEST would immediately perceive the term to be a reference to the *known* world, i.e., the earth. Applicant's claim that "none of the meanings describe audio and video broadcasting services, entertainment services, or the service or[sic] providing a website for others" wholly ignores that a mark may be descriptive even if only describes a feature, aspect, or central focus of such services. This is the case here. Applicant's proposed mark describes a quality or characteristic of the *videos*, and therefore the service of providing those videos. Applicant is broadcasting and providing a website which is hosting, the "*world's greatest videos*." That is, the highest quality/caliber videos in the world (or on the *earth*, as it were).

Nor is the descriptiveness of "WORLD'S" an issue of first impression before the trademark Trial and Appeal Board. In the case of *In re 800-Gifthouse, Inc.*, the applicant filed an application to register the mark WORLD'S FAVORITE FLORIST for "receiving orders for flowers and floral products, transmitting them to and/or causing them to be filled by participating florists in the vicinity of the recipient" in Class 35 and "retail flower and plant store services" in Class 42. *In re 800-Gifthouse, Inc.*, 1999 TTAB Lexis 409. The Court's reasoning included an assertion that the Applicant's use of the word WORLD'S is for the same purpose as the use of AMERICA'S in the previous case AMERICA'S FRESHEST ICE CREAM, which was "to merely reinforce the laudatory nature of the designation, or, in other words, to simply add to the boastfulness of the claim." The language WORLD'S was found to be laudatory. *Id. at 6*. Indeed, the Court in that case remarked on the holding in *In re Royal Viking Line A/S*, 216 USPQ 795, 797 (TTAB 1982), where the Board held the words WORLD CLASS merely descriptive for cruise ship services, stating

that these words were used "in a laudatory manner much like one would use 'first class' or 'world's finest' or 'world's best,' to convey to purchasers the superior nature of applicant's services. *Id. at 6.*

Most recently, in the case *In re Paradise Mountain Organic Estate Coffee Ltd*, Serial No. 86407960, the TTAB held the mark THE WORLD'S MOST SUSTAINABLE to be merely descriptive when used on coffee, tea and related products. Reviewing the examiner's evidence of third party use of the language in the relevant industry, as well as the descriptive definitions of the composite terms at issue, the Board noted that the evidence was of the sort which established the laudatory descriptiveness of the proposed language. *Id. at 11.* The Board in that case even compared the facts to *In re Boston Beer Co., L.P.*, 198 F.2d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999), in which the TTAB found "THE BEST BEER IN AMERICA" for beer to be "a common, laudatory advertising phrase which is merely descriptive of Boston Beer's goods. Indeed, it is so highly laudatory and descriptive of the qualities of its product that the slogan does not and could not function as a trademark to distinguish Boston Beer's goods and serve as an indication of origin."

A cancellation proceeding in the case of *Ralston Purina Company v. Grain Processing Corporation*, 2001 TTAB LEXIS 362, although not binding in this case is nevertheless further instructive on the descriptiveness of WORLD'S when followed by a laudatory term and the noun that is the subject of the goods/services. Ralston Purina Company petitioned to cancel a registration owned by Grain Processing Corporation for WORLD'S BEST CAT LITTER for "cat litter." The Petitioner argued that WORLD'S BEST CAT LITTER was a geographically defined superlative coupled with the name of the involved goods, and as such was incapable of functioning as a trademark for the goods under Section 23 of the Trademark Act. The Court in this case specifically stated "[a]t the outset, we note that there is no dispute that WORLD'S BEST CAT LITTER is a laudatory phrase... The phrase WORLD'S BEST CAT LITTER is a combination of the common laudatory phrase WORLD'S BEST and the generic wording CAT LITTER. " *Id. at 4-5.* The phrase WORLD'S BEST is immediately analogous to WORLD'S GREATEST, as both BEST and GREATEST denote something being the most superior of its type. Yet in the mentioned case, the Court paused only to state that the phrase "WORLD'S BEST" was indeed laudatory, rather than discussing the possibility it was not. *Id.* The Court went on to further elaborate:

"WORLD'S BEST is such a common superlative, highly descriptive phrase that, even assuming respondent's cat litter has been determined to be the "world's best," if a better or equally good cat litter is produced in the future, the new producer(s) should be entitled to use that designation in selling its goods. Stated differently, WORLD'S

BEST is the type of superior claim that should be freely available to all competitors in any given field to refer to their products or services subject to the limits of the law.

Id. at 6-7.

Yet even if not taken as the legal equivalent of BEST, the laudatory descriptiveness of GREATEST is nevertheless likewise not an issue of first impression at the Board. For example, the proposed mark THE GREATEST BAR came before the Board fighting a refusal under Section 2(e)(1), in the case *In re The Place, Inc.*, 76 USPQ2d 1467 (TTAB 2005), a precedential holding. In it, the TTAB noted specifically that “we find that the word GREATEST is laudatory and merely descriptive,” and took “judicial notice that “great” is defined, in pertinent part, as “markedly superior in character or quality to others of the same class.” *Webster’s Third New International Dictionary (1993) at page 994.* The same dictionary, at page 778, defines “-est” as “used to form the superlative degree of adjectives and adverbs of one syllable.” The Court went on to hold that the term GREATEST “immediately informs purchasers that applicant’s restaurant and bar is “the greatest,” i.e., “markedly superior in character or quality” when compared to other restaurants and bars.” *Id. at 1468.*

“Marks that are merely laudatory and descriptive of the alleged merit of a product [or service] are . . . regarded as being descriptive” because “[s]elf-laudatory or puffing marks are regarded as a condensed form of describing the character or quality of the goods [or services].” *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1256, 103 USPQ2d 1753, 1759 (Fed. Cir. 2012) (quoting *In re The Boston Beer Co.*, 198 F.3d 1370, 1373, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999)); see *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (holding THE ULTIMATE BIKE RACK merely laudatory and descriptive of applicant’s bicycle racks being of superior quality); *In re The Boston Beer Co.*, 198 F.3d at 1373-74, 53 USPQ2d at 1058-59 (holding THE BEST BEER IN AMERICA merely laudatory and descriptive of applicant’s beer and ale being of superior quality); TMEP §1209.03(k). In fact, “puffing, if anything, is *more* likely to render a mark merely descriptive, not less so.” *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d at 1256, 103 USPQ2d at 1759.

Here, the phrase “WORLD’S GREATEST” is merely laudatory of the quality of the **videos** that are the central, core feature of applicant’s services because it describes the superior quality of the videos from anywhere in the world that are being broadcasted, used in connection with contests or sweepstakes, or uploaded and shared on a website. The applicant has not disputed the assertion that “videos” is common commercial descriptor for a central, core aspect of their services, and as such it is the immediate subject matter of Applicant’s laudatory puffery.

OFFICE PRACTICE

Several third-party registrations submitted previously by the examiner likewise show the wording “WORLD’S GREATEST” is a laudatory phrase, and therefore is probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on acquired distinctiveness, or registered on the Supplemental Register. *See Inst. Nat’l des Appellations D’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 1581-82, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006). The wording “WORLD’S GREATEST” has been held as a laudatory phrase for numerous types of goods and services, including services similar to the applicant’s services, because these registrations appear on the Supplemental Register or have claimed distinctiveness under Section 2(f) of the Trademark Act. Thus, the full wording “WORLD’S GREATEST VIDEOS” should likewise be considered merely laudatory of a characteristic or quality of the applicant’s videos that are the central subject of all three classes of services. *See Attachments to the Examiner’s Action of 1/26/2017 for the marks WORLD’S GREATEST CITY OF THE ARTS AND OUTDOORS (Supplemental Register), THE WORLD’S GREATEST BANK (Section 2(f)), THE WORLD’S GREATEST HOT SANDWICH (Supplemental Register), THE WORLD’S GREATEST FITTING UNDERWEAR (Section 2(f)), THE WORLD’S GREATEST FOOD STORE (Supplemental Register), WORLD’S GREATEST SKATEBOARDING CONTEST (Supplemental Register), WORLD’S GREATEST AIRCRAFT COLLECTION (Section 2(f)), THE WORLD’S GREATEST MEMORABILIA (Supplemental Register), WORLD’S GREATEST AVIATION CELEBRATION (Section 2(f)), THE WORLD’S GREATEST TRIBUTE BANDS (Supplemental Register), THE WORLD’S GREATEST COLLECTOR CAR AUCTIONS (Section 2(f)), and WORLD’S GREATEST GADGET REVIEWER (Supplemental Register).*

SIGNIFICANCE TO CONSUMERS

Revisiting the rule for a determination of a mark’s descriptiveness, the examiner makes particular note here that one of the strongest considerations under Section 2(e)(1) is that of the possible significance that the term/phrase would have to the average purchaser of the goods or services because

of the manner of its use. To this end, the examiner has previously attached broad, widespread third party use of this identical phrase in commerce by other entities providing applicant's services, as well as consumers utilizing the phrase in a laudatory, descriptive fashion for their own videos or compilations of the videos of others. *See attachments to Examiner's Denial of a Request for Reconsideration, on 2/8/2018.*

These attachments include the following:

Patreon: "Jesse Cowell is creating The **world's greatest VIDEOS!**"

A YouTube playlist of user-uploaded videos titled "**World's Greatest Videos**"

A list of user-uploaded videos on DDVidz.com titled "**World's Greatest Videos.**"

An ad in a paper describing a collection of videos as "**World's Greatest Videos.**"

A list of videos being broadcast that are user-uploaded on Pictame titled "**World's Greatest Videos.**"

A post on BSAAlert.com that allows user uploading and broadcasting of videos, asking "What are the **world's greatest videos?**"

WGVS with user uploaded video, broadcasting of videos, and contests on who will have the next "**World's Greatest Video**"

A user-driven site in which consumers can "Be inspired by the **world's greatest videos.**"

Such evidence speaks strongly to the perception of the average consumer, that is, that the language at issue – WORLD'S GREATEST VIDEOS – is laudatory, descriptive language speaking to a particular quality or caliber aspect of the videos being offered over the Internet, being broadcast, as the subject of contests (who can submit the *world's greatest video?*) as well as of user-shared videos. These

are all services provided by the applicant under the proposed language, and consumers encountering this language would immediately perceive it as laudatory of the videos which are the central purpose/feature of the services themselves. Every service surrounds and is centered upon *videos* which the applicant is claiming are the *greatest* in the *world*. This language is, indeed – as suggested by the offered subsection of third party usage – already been utilized descriptively by a broad variety of parties for precisely the same services, indicating it is considered a commonplace, laudatory phrase in the marketplace.

CONCLUSION

The examining attorney respectfully submits that dictionary definitions, consumer use of the mark and understanding of the overall connotation of the mark, as well as a substantial line of case law from this Court on laudatory phrases, all support the finding that the proposed mark WORLD'S GREATEST VIDEOS is merely descriptive of a core subject or aspect of the services– videos that are considered the highest quality in the world. For the foregoing reasons, the examining attorney requests that the Trademark Trial and Appeal Board affirms the refusal to register the proposed mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

Respectfully submitted,

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