

**LETTERMARK, App. Ser. No. 88/452,421**

**REMARKS IN SUPPORT OF REGISTRATION**

These Remarks are in response to the Office Action issued in connection with the instant application on August 23, 2019, wherein, among other things, registration of Applicant's LETTERMARK mark was refused under Section 2(e)(1) of the Trademark Act on the grounds that the mark, as a whole, is merely descriptive of a feature of the goods specified in the application. The Office Action further requires Applicant's responses to various informational inquiries and that Applicant submit documents providing information regarding Applicant's LETTERMARK-branded products, including any materials showing its use of LETTERMARK, and if information regarding such products is not available, documents providing information for goods of the same type.

**I. Request for Information**

The Examining Attorney has posed specific questions relating to Applicant's paper goods for which Applicant provides the following responses:

1. Do applicant's paper goods feature lettermarks or letter marks?

**Answer:** No.

2. Do applicant paper goods feature logos that are comprised of a few letters?

**Answer:** No.

3. Do applicant's paper goods feature logos that are comprised of a company's initials?

**Answer:** No.

4. Do applicant's competitors use lettermarks or letter marks to advertise similar goods?

**Answer:** No.

5. Who is the typical consumer of applicant's goods?

**Answer:** Office supply dealers and paper merchants, end-users of products purchased from those sources, printers, publishers, design/creative professionals.

6. Where are applicant's goods typically purchased, e.g., online or brick-and-mortar store venues?

**Answer:** Applicant's products are purchased both online and in brick-and-mortar office supply store venues.

Applicant advises the Examining Attorney that its LETTERMARK-branded products are not yet available, so it is unable to provide materials specifically describing them. Accordingly, Applicant attaches hereto as Exhibit A a substantial amount of information describing and promoting its paper products similar to those to be promoted and sold in connection with its LETTERMARK mark. As the

Examining Attorney will note, none of these products are pre-printed paper products, but rather, are unprinted paper products manufactured and sold for use by Applicant's customers for their own printing, copying and writing needs. As confirmed in its responses to the Examining Attorney's specific questions above, Applicant does not use "lettermark" or "letter mark" anywhere in these materials. The only use Applicant will make of LETTERMARK is as its proprietary trademark for the associated products.

## II. Applicant's Mark is Not Merely Descriptive of Applicant's Paper Products

In order to reach the conclusion that LETTERMARK is descriptive as applied to the goods covered by Applicant's application, i.e. "copy paper, printing paper, writing paper, recycled paper for printing, colored printing paper, punched and perforated paper," the Examining Attorney states:

Specifically, the attached evidence Internet websites from makers, sellers and commentators about stationery shows this wording means, "A **lettermark** is a typography-based logo that's comprised of a few letters, usually a company's initials. It uses text to create a unique typographic mark. Similar to a **lettermark**, a wordmark logo is a font-based logo that focuses on a business' name alone." <https://bashooka.com/inspiration/40-creative-lettermark-wordmark-logo-designs/> (emphasis in the original). Therefore, the wording merely describes a feature of applicant's **printed writing paper**, e.g. a purchaser may wish to purchase its writing paper featuring its own lettermark.

(emphasis added).

In further support of this conclusion, the Examining Attorney provides links to various Internet websites, downloads from which are also attached to the Office Action. Although Applicant agrees that the various articles contained in these materials corroborate the fact that a "lettermark" is a type of logo comprised of letters as opposed to, for example, words, none of the materials and information supports the conclusion that "lettermark" is descriptive of Applicant's paper goods or of any attribute of Applicant's goods. Moreover, contrary to the Examining Attorney's description of the materials, none show use of LETTERMARK "in reference to 'copy paper, printing paper, writing paper, recycled paper for printing, colored printing paper, punched and perforated paper'." In fact, the Examining Attorney must mischaracterize Applicant's products as "printed writing paper" (see emphasis added in above Office Action excerpt) in order to draw even an attenuated purported connection between the term "lettermark" and Applicant's products. Indeed, pursuant to long-standing trademark principles as applied to the information in the Examining Attorney's own evidence and definition of the term "lettermark" as set out therein, these materials clearly demonstrate that Applicant's mark is in fact an arbitrary mark, with no meaning as it applies to Applicant's goods, or, at the very least, a suggestive and inherently distinctive mark, as discussed more fully below.

It is well-established that a mark or term is "merely descriptive" if it *immediately* describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services, *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985) (emphasis added); *see also, In re Gyulay*, 820 F.2d 1216, 3 USPQ 2d 1009 (Fed. Cir. 1987); *In re Bed and Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re Metpath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Inc.*, 204 USPQ 591 (TTAB 1979), and/or if it tells consumers and potential consumers **only** what the goods/services, their ingredients, qualities or characteristics are. *In re Quik-Print Copy Shops, Inc.*, 205 USPQ 505, 507 n.7 (C.C.P.A. 1980) (emphasis added) (noting that "merely" is considered to be "only"). More specifically, the descriptiveness evaluation is to be based solely on the meaning of the applied for mark relative to the precise goods or services specified in application, *See, In re Vehicle Information Network Inc.*, 32 USPQ2d 1542 (TTAB 1994). It is not a determination made in a vacuum. *See, In re Vehicle Information Network Inc.*, 32 USPQ2d 1542 (TTAB 1994). In that regard, Applicant notes that the courts and legal

experts both repeatedly and consistently focus their holdings, explanations and analysis regarding the descriptive nature of a mark on the relationship between the particular mark and the particular goods or services with which that mark is used. See, 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §11:16 (4th ed. 1997) and cases cited therein.

Moreover, a mark need not be devoid of all meaning to be registerable. *United Lace & Braid Mfg. Co. v. Barthels Mfg. Co.*, 221 F. 456 (D.N.Y. 1915) (BEADED shoelace tips held merely suggestive); *General Shoe Corp. v. Rosen*, 111 F.2d 95, 98, 45 USPQ 196 (4th Cir. 1940), *reh. denied*, 112 F.2d 561, 45 USPQ 590 (4th Cir. 1940). In fact, trademarks frequently comprise a term that is generally used in the English language. Where a trademark comprises a word that is in common linguistic use, as is the case here, but does not describe any ingredient, function, feature, quality or characteristic of the particular associated goods, which is the case here, that mark is said to be “arbitrary” and consequently one of the strongest types of trademarks. *TMEP* §§1209 and 1209.01(a).

Similarly, even in those instances where it is possible to ascribe *some* meaning or relationship between a mark and its associated products, when some amount of imagination, thought, perception or multi-stage reasoning is required to make that association, the mark is considered “suggestive” and, consequently, inherently distinctive and entitled to registration. See, e.g., *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S.Ct. 2753, 23 USPQ2d 1081, 1083 (1992), *reh'g. denied*, 113 S.Ct. 20 (1992); *In re Tennis in the Round Inc.*, 199 USPQ 496 (TTAB 1978). Taken together, the fact that a mark is comprised of a definable term that has a well-accepted and/or commonly-understood meaning is not conclusive evidence that the mark is descriptive unless and until there is evidence that the mark has a direct meaning relative to the exact goods/services with which it is intended to be used or a feature, function or characteristic of those specific goods/services.

It is well-recognized that the Examining Attorney has the burden of proving a mark’s descriptiveness. See, e.g., *In re Merrill, Lynch, Pierce, Fenner & Smith*, 4 U.S.P.Q.2d 1141, 1143 (Fed. Cir. 1987). In the instant case, the Examining Attorney’s evidence supports the fact that “lettermark” is a term generally used in the English language as a branding *concept* used to identify a particular type of logo or mark that is comprised of a few letters, for example, CBS, which is typically an abbreviation of a company name used for identification and branding purposes. The term is used to differentiate that type of logo or mark from other types of marks such as “wordmarks” and “brandmarks.” As reflected in the Examining Attorney’s evidence, monograms, initials and acronyms are all types of “lettermarks.” (See, for example, the articles entitled “*Difference Between Wordmark, Lettermark & Brandmark*” <https://www.designbolts.com/2016/07/27/difference-between-wordmark-lettermark-brandmark/>; “*Types of logos*,” <https://www.jessicajonesdesign.com/types-of-logos/> and “*The 7 Types of Logos (and how to use them)*,” <https://99designs.com/blog/tips/types-of-logos/>). There is no evidence or information in the Examining Attorney’s materials substantiating or even intimating that “lettermark” has a recognized meaning that immediately or directly refers to or describes any type of physical product or any function, feature or characteristic of any type of physical product, be it paper products similar to Applicant’s goods or otherwise.

If one were to apply attenuated reasoning to the meaning of “lettermark” as it *might* apply to Applicant’s goods, the only way to draw any connection between Applicant’s goods and the term would be to imagine a chain of successive events, such as (1) a purchaser of Applicant’s goods *could* decide to adopt a “lettermark” for its branding or personal identification purposes, purchase Applicant’s paper goods that can be used for the purpose of transforming the paper into printed stationary or another type of printed marketing materials, and elect itself or through a third-party to type, print or otherwise inscribe or affix its lettermark on the unprinted purchased paper; or (2) a professional printer is retained by a customer to print custom-ordered paper products bearing the customer’s lettermark, the printer purchases Applicant’s

printing/copying/writing paper for purposes of printing the custom-ordered paper goods, and then includes that lettermark in the content printed on the goods it then sells to its customer.

In neither of the foregoing scenarios does the possible placement of a lettermark onto Applicant's goods by one of its customers mean, in turn, that "lettermark" is merely descriptive of Applicant's paper products or any feature or characteristic of the products, no more so than would, for example, the word "squiggle" be descriptive of printing, copying or writing paper merely because a purchaser of the products might place such a marking on them when used for the purchaser's own purposes. Similarly, a "lettermark" could be inscribed or affixed to any number of physical goods other than paper, for example, pens, caps, t-shirts, paper weights, and a plethora of other products commonly used as marketing collateral, but the term is no more "merely descriptive" of those goods when not otherwise marketed and sold with a pre-affixed lettermark on them than it is of Applicant's unprinted paper goods. If consumers must manipulate the meaning of a term or phrase and/or use multi-stage reasoning in order to arrive at *any* connection between the term or phrase and the associated goods, as would be the case in the situations outlined above, such manipulation must be viewed as the very "mental gymnastics" that define inherently distinctive suggestive, not descriptive, marks. See, *General Shoe Corp. v. Rosen*, 111 F.2d 95, 98, 45 U.S.P.Q. 196 (4th Cir. 1940), *reh. denied*, 112 F.2d 561, 45 U.S.P.Q. 590 (4th Cir. 1940).

The categorization of LETTERMARK as an arbitrary or at the very least suggestive mark when used in association with Applicant's paper products is supported by Applicant's explicit statement that, among other things, the products it manufactures and sells do not contain lettermarks or logos, and its competitors do not use the terms "lettermark" or "letter mark" to promote or describe their products or any features, functions or characteristics of their products. To further substantiate Applicant's statement in that regard, Applicant attaches hereto as Exhibit B relevant excerpts from numerous online glossaries of technical and commercial terms used in the pulp, paper, printing, publishing and related industries, none of which includes "lettermark" or "letter mark" as a term used in any of these industries.

Finally, while Applicant strongly asserts that there is no doubt as to the inherently distinctive nature of Applicant's mark as applied to Applicant's goods, in any event, it is well settled that in those cases where the determination of the "descriptive" nature of the mark *is* in question, any doubts are to be resolved in favor of the applicant. For example, in *In re Shutts*, 217 USPQ 363 (TTAB 1983), the Board stated:

We recognize that the suggestive/descriptive dichotomy can require the drawing of fine lines and often involves a good measure of subjective judgment. . . . At the very least, however, we have doubts about the "merely descriptive" character of the mark before us and, unlike the situation in determining likelihood of confusion under Section 2(d) of the Trademark Act, it is clear that such doubts are to be resolved in favor of applicants.

*Id.* at 365. Likewise, in *In re J. Ray McDermott & Co.*, 170 USPQ 524 (TTAB 1971), the Board concluded:

In situations such as this involving the question of descriptiveness of a term, we believe that any doubt in this matter should be resolved in applicant's behalf and the mark be published for opposition purposes in accordance with Section 12(a) of the statute.

*Id.* at 524. See also, *In re Priefert Mfg. Co.*, 222 USPQ 731, 733 (TTAB 1984) ("Our decision is not without doubt, but in such a case, it seems to us that the doubt should be resolved in favor of publication of the mark pursuant to Section 12(a) of the Act.").

### **Conclusion**

In light of the information provided herewith and the foregoing Remarks, Applicant respectfully requests that the Examining Attorney withdraw the Section 2(e)(1) descriptiveness refusal and, inasmuch as the application is now in condition to be approved for publication, that the Examining Attorney approve the instant application to proceed to immediate publication.