

BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE

BIRTHSTONE.COM

Mark:

Serial No. 90/254,606

Owner: Birthstone, LLC

RESPONSE TO OFFICE ACTION

This is in response to the Office Action which issued on March 15, 2021 in connection with U.S. Application Serial No. 90/254,606 for the above referenced stylized mark BIRTHSTONE.COM in connection with: jewelry, in International Class 014; online retail store services featuring jewelry, in International Class 035.

The Examiner refused registration on the grounds that a disclaimer is required of the word BIRTHSTONE.COM because it is merely descriptive of a feature of applicant's goods and services pursuant to 15 U.S.C. §1052 (e)(1). In support of her position, the Examiner offered as evidence the definition of the term "birthstone" as found in the Merriam-Webster® dictionary (a gemstone associated symbolically with the month of ones' birth) and noting that Applicant's specimens "show that the applicant's goods include birthstone jewelry and that the applicant provides birthstone jewelry through its services."

Applicant respectfully disagrees that a disclaimer is required in these circumstances.

Applicant sells a wide variety of jewelry on its e-commerce platform including jewelry that incorporates gemstones generally associated with a variety of things including anniversaries and birth months as well as Biblical and zodiacal affiliations. While birthstone jewelry is

included among the various goods Applicant sells, it is by no means the only products sold by Applicant under the subject mark.

To be descriptive a mark must “*immediately* convey information as to the qualities, features or characteristics of the goods and/or services with a ‘*degree of particularity*.’” *Plus Prods. v. Med. Modalities Assocs., Inc.*, 211 USPQ 1199, 1204-1205 (TTAB 1981) (emphasis added). “A minor degree of descriptiveness does not destroy the suggestive, or trademark, significance. There must be a shade of descriptive meaning present or the suggestion process will not occur.” 1 J. Gilson, *Trademark Protection and Practice* §2.04[2]. Said another way, “[a] mark with suggestive as well as descriptive qualities may not be deemed merely descriptive.” *Macia v. Microsoft Corp.*, 327 F. Supp. 2d 278, 283 – 85 (D. Vt. 2003).

Here, Applicant’s stylized BIRTHSTONE.COM mark does not *immediately* convey information regarding the qualities, features or characteristics of Applicant’s goods and services, *i.e.*, jewelry and related online retail store services, with a *degree of particularity*. To reach a conclusion regarding the nature of Applicant’s goods and services, and then only with respect to a very small portion of those goods and services, consumers must exercise a degree of imagination, thought, or perception. This mental leap that is required between Applicant’s mark and the small portion of Applicant’s goods and services relating to jewelry containing a birthstone means that the connection between them is not immediate or instantaneous. It therefore cannot be said that “BIRTHSTONE” is merely descriptive as it relates to Applicant’s goods and services. *See Id. See also*, J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §11:67 (5th ed. 2018) (noting that “[i]f the mental leap between the word

and the product's attributes is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness.”)

There is no *per se* rule prohibiting registration of a mark that includes a word which may be associated with one of the goods or services sold by the applicant. Indeed, “[t]he great variation in facts from case to case prevents the formulation of specific rules for specific fact situations. Each case must be decided on its own merits. See *In re Ampco Foods, Inc.*, 227 USPQ 331 (TTAB 1985); *In re Venturi, Inc.*, 197 USPQ 714 (TTAB 1977).” Trademark Manual of Examining Procedure, § 1209.01(b). Moreover, the Supreme Court recently held that there is no *per se* rule that a mark incorporating the top-level domain .com must be refused registration simply because the other wording may be generic (or, by extension, descriptive). *United States Patent and Trademark Office, et al. v. Booking.com B.V.*, 140 S.Ct. 2298, 207 L.Ed.2d 738 (2020) (“[W]hether any given “generic.com” term is generic for federal trademark registration purposes depends on whether consumers in fact perceive that term as the name of a class or, instead, as a term capable of distinguishing among members of the class”).

It is quite common for a trademark or service mark to incorporate a word that, arguably, is associated with a good or service offered by the owner. For example, the national retailer Staples® sells a variety of office supplies including, among others, staples. Applicant notes that the company owns a host of registrations and allowed applications for various STAPLES and STAPLES.COM formative marks in connection with office supplies and retail services in the field of office supplies, none of which contain a disclaimer of the word STAPLES¹.

¹ See, Reg. No. 4,968,233; Reg. No. 1,512,125; Reg. No. 1,438,390; Reg. No. 1,459,182; Reg. No. 2,397,238; Reg. No. 5,910,277; and Ser. No. 88/131,261

Staples and staplers are common office supplies - one might even say they are a staple in the office supply industry. Most importantly, Staples[®] sells staples at their brick-and-mortar stores and online e-commerce sites under the STAPLES mark. (See attached **Ex. A**) Moreover, Staples[®] even sells STAPLES branded staples. (See attached **Ex. B**.) Nevertheless, they maintain several registrations for STAPLES in connection with various office supplies and retail services in the field of office supplies. Staplers are among the goods identified in Registration 496,8233 for STAPLES; no disclaimer was required, and it appears from the available online record that no descriptiveness refusal issued.

Dairy Queen[®], known for its soft-serve ice cream, sells a variety of quick service foods including dairy-based desserts. Nevertheless, Registration 1,596,949 for the mark DAIRY QUEEN in connection with: restaurant services, retail soft serve ice milk confectionery store services; retail ice cream confectionary store services, in International Class 042 contains no disclaimer, despite that the recitation of services referencing ice milk and ice cream, both of which are dairy products.

Similarly, Red Lobster[®] sells a full menu of food (mainly seafood), including lobster—their claim to fame. Like STAPLES and DAIRY QUEEN, Registration 1,128,443 for RED LOBSTER in connection with: restaurant services, in International Class 042 contains no disclaimer, even though lobster is the main dish that they serve.

Staples are among the goods sold by Staples[®], dairy confections are among the foods sold at Dairy Queen[®], and lobster is among the food sold at Red Lobster[®] yet the Office found no disclaimer was necessary in these analogous situations. In the case of the subject mark, like those of STAPLES, DAIRY QUEEN and RED LOBSTER, gemstones associated with anniversaries, birth months, and Biblical and zodiacal affiliations are a mere component part of

some of the goods Applicant sells. Thus, Applicant respectfully submits that this distinction puts Applicant's stylized BIRTHSTONE.COM mark even closer to the suggestive end of the descriptive-suggestive continuum than the aforementioned STAPLES, DAIRY QUEEN, and RED LOBSTER marks.

Finally, even if, for the sake of argument only, the Examiner is correct in concluding that "BIRTHSTONE.COM" is descriptive of a certain small portion of Applicant's goods and services, Applicant's goods and services do not merely relate to birthstone jewelry, but are much broader and include, e.g., jewelry that incorporates gemstones generally associated with a variety of things such as anniversaries and Biblical and zodiacal affiliations². Thus, even if the Examiner were correct in concluding that "BIRTHSTONE.COM" is descriptive of a specific, small portion of Applicant's goods and services, it does not follow that "BIRTHSTONE.COM" is descriptive with respect to all of those goods and services. In that case, Applicant submits that a broad disclaimer is unnecessary and inappropriate with respect to the remaining goods and services. *See* T.M.E.P. § 1213. (disclaimer may be limited to pertain to only certain classes, or to only certain goods or services). As such, to the extent *any* disclaimer is necessary Applicant should only be required to disclaim "BIRTHSTONE.COM" with respect to specific types of jewelry and related services, for example:

No claim is made to the exclusive right to use "BIRTHSTONE.COM" in connection with jewelry and retail and online retail store services featuring jewelry which incorporates a gemstone associated in the mind of consumers with a particular birth month.

² The term "birthstone" must be defined by confirming what is in the mind of a consumer at the time of purchase. For example, a purchaser may opt for a pendant with a Ruby gemstone because their significant other's birthday is in July, the month traditionally associated with a Ruby. However, the purchaser may also be purchasing a set of Ruby earrings for their spouse to commemorate their fifteenth wedding anniversary (the particular anniversary year associated with a Ruby). Conversely, it is possible that a consumer opts for a ring with a Ruby gemstone not because their birthday is in July or they have been married for fifteen years but because they happen to be fond of Rubies or they are selecting a piece of jewelry to coordinate with certain apparel. Thus, it cannot be presumed that the purchase of a piece of jewelry with a particular gemstone is being done for a certain purpose without identifying the actual intent of the consumer.

For the foregoing, Applicant respectfully requests that the Examiner rescind the disclaimer requirement and allow Applicant's mark to proceed to publication.

EXHIBIT A

Staples Products Deals Services Search Sign In Help Shopping Cart

STAPLES REWARDS Get it Today Our Sites Lists Chat Set Your Store

STAPLES REWARDS Learn about free benefits & savings.

- FREE DELIVERY, NO MINIMUM** with Base+ free trial
- UP TO 5% BACK IN REWARDS** in store and online.
- MEMBER EXCLUSIVE DEALS** Additional savings, coupons and more.
- \$2 BACK IN REWARDS ON RECYCLED INK & TONER** up to 20 per month.*
- PROGRAM HIGH** See how to get benefits.

Home > Office Supplies > Office Basics > Staples

Staples Sort by Best Match

Brand Rating Staple Pack Size All Filters













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|  <p>Staples Standard Staples, 1/4" Leg Length, 5000 Staples/Box, 2 Boxes/Pack (13425-US)</p> <p>★★★★★ 420</p> <p>\$7.29</p> <p>\$7.29 10000/Pack</p> <p>1 <input type="button" value="Add"/></p> |  <p>Swingline® S.F.® 48 Premium Staples, 1/4" Length, 210/Per Strip, 5,000/Box (35450)</p> <p>★★★★★ 684</p> <p>\$9.29</p> <p>\$9.29 5000/Box</p> <p>Pick up in 1 hour</p> <p>1 <input type="button" value="Add"/></p> |  <p>Swingline® Optima™ High Capacity Staples, 3/8" Length, 125/Strip, 2,500/Per Box (35550)</p> <p>★★★★★ 211</p> <p>\$9.29</p> <p>\$9.29 2500/Box</p> <p>1 <input type="button" value="Add"/></p> |  <p>JAM Paper Colorful Staples, 1/4" Leg Length, Pink, 5000/Box (335PZ)</p> <p>★★★★☆ 2</p> <p>\$12.49</p> <p>\$12.49 1/Each</p> <p>1 <input type="button" value="Add"/></p> |
| <p>14% off</p>  <p>TRU RED™ Standard Staples, 1/4" Leg Length, 5000 Staples/Box, 2/Pack (TR58091)</p> <p>★★★★★ 50</p> <p>\$1.95 \$2.29</p> <p>10000/Box</p> <p>Pick up in 1 hour</p> <p>1 <input type="button" value="Add"/></p> |  <p>Swingline® Heavy Duty Staples, 3/8" Length, 5,000/Box (79398)</p> <p>★★★★★ 20</p> <p>\$13.79</p> <p>5000/Box</p> <p>Pick up in 1 hour</p> <p>1 <input type="button" value="Add"/></p> | <p>14% off</p>  <p>TRU RED™ High-Capacity Staples, 1/2" Leg Length, 5000 Staples/Box (TR58094)</p> <p>★★★★☆ 4</p> <p>\$6.24 \$7.29</p> <p>5000/Box</p> <p>Pick up in 1 hour</p> <p>1 <input type="button" value="Add"/></p> |  <p>TRU RED™ Premium Staples, 1/4" Leg Length, 5000 Staples/Box (TR58088)</p> <p>★★★★★ 26</p> <p>\$4.29</p> <p>5000/Box</p> <p>Pick up in 1 hour</p> <p>1 <input type="button" value="Add"/></p> |
|  <p>Bostitch® PowerCrown Chisel Tip Staples, 0.38" Leg Length, 5000/Box (SBCR21153/8)</p> <p>★★★★☆ 29</p> <p>\$11.29</p> <p>5000/Box</p> <p>1 <input type="button" value="Add"/></p> |  <p>Bostitch® Premium Standard Staples, 0.25" Leg Length, 5000 Staples/Box (SBS191/4CP)</p> <p>★★★★★ 39</p> <p>\$2.79</p> <p>5000/Box</p> <p>1 <input type="button" value="Add"/></p> |  <p>Swingline® Staples</p> <p>★★★★★ 434</p> <p>Prices vary</p> <p>\$5.49</p> <p>Choose options</p> |  <p>JAM Paper Colorful Staples, 1/4" Leg Length, Green, 5000/Box (335GRZ)</p> <p>★★★★☆ 1</p> <p>\$13.49</p> <p>1/Each</p> <p>1 <input type="button" value="Add"/></p> |

EXHIBIT B

[Back](#) [Home](#) > [Office Supplies](#) > [Office Basics](#) > [Staples](#)

Staples Standard Staples, 1/4" Leg Length, 5000 Staples/Box, 2 Boxes/Pack (13425-US)

Item #: 648695 | Model #: 13425-US

4.5 [470 Reviews](#) | [1 Question](#) | [Share](#)

\$7.29

10000/pack

Delivered Mon, Sep 20 **\$7.29**
to **Chicago, IL**

Store pick up **\$7.29**

Auto Restock **\$6.93** **Save \$0.36**

Quantity

1

Add to cart

[Compare](#) [Add to list](#)

