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This Opinion Is Not a Precedent of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Publications International, Ltd.

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Serial No. 77103024

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Dorothy M. Weber of Shukat Arrow Hafer Weber & Herbsman, LLP for Publications International, Ltd.

Michael J. Souders, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

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Before Drost, Taylor and Wellington, Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Publications International, Ltd. (applicant) applied to register BRAIN GAMES, in standard character form, on the Principal Register as a mark for "printed publications, namely, books and magazines containing games, puzzles and other cognitive exercises" in International Class 16.[1] The application is based on Section 1(a) (use in commerce) and

[1] Application Serial No. 77103024 was filed on February 8, 2007.

identifies January 9, 2007 as the date the mark was first used in commerce.

The examining attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), stating that the proposed mark "merely describes the subject matter of applicant's publication[s]" and that "mental and cognitive games are known as 'brain games'." Office action issued May 29, 2007.

In response, applicant pointed to a third-party application (now registered) for the mark MIND GAMES that, applicant contends, is "no less descriptive" than applicant's mark.[2] Applicant requested that "the same standard" that was applied to that application be applied to its mark. In the alternative, applicant argued that its mark was entitled to registration under Section 2(f) because it has acquired distinctiveness.

The examining attorney ultimately maintained the descriptiveness refusal and rejected applicant's claim that the mark has acquired distinctiveness.[3] Applicant

[2] Registration No. 3370566 issued on January 15, 2008.

[3] In the Office action (dated June 30, 2008) making the refusal final, the examining attorney stated under the subheading "Mark is Merely Descriptive" that the proposed mark "is generic and incapable of serving as a source identifier for the goods" and later repeated that the mark "is generic for the goods because…." The issue of genericness was not previously raised; moreover, neither applicant nor the examining attorney addressed genericness as an issue on appeal. Accordingly, this appeal is

concurrently filed a request for reconsideration and an appeal. The examining attorney denied the request for reconsideration. Both applicant and the examining attorney filed briefs.

Before discussing the substantive issues on appeal, we first address an evidentiary issue. Specifically, the examining attorney has objected to applicant's submission of evidence with its appeal brief. As described by applicant, the additional evidence consists of "two pages from applicant's current 2008-2009 sales catalog which shows the goods bearing the mark, of which catalog approximately 2,500 copies have been or will soon be distributed at trade shows, to retailers, distributors and customers." Brief, (unnumbered) p. 4.

Because applicant's submission of these additional materials with its brief are manifestly untimely, they are not properly of record and are given no consideration. 37 CFR § 2.142(d); see also, TBMP § 1207 (2d ed. rev. 2004).[4]

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limited solely to the descriptiveness refusal and whether the mark has acquired distinctiveness.

[4] Although we have not considered this evidence in our decision, we do not hesitate to point out that, by applicant's own account, the catalog had not yet necessarily been distributed ("copies have been or soon will be distributed"). Thus, even if we were to consider these materials, we cannot conclude that they have reached consumers and have had any effect on whether the mark has acquired distinctiveness.

We now turn to the merits of the refusal to register applicant's proposed mark. We consider first the descriptiveness refusal.

A mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information regarding a function, purpose, or use of the goods or services. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). *See also In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) (A "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service"); *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). To be merely descriptive, a term need only describe a single significant quality or property of the goods. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); *Meehanite Metal Corp. v. International Nickel Co.*, 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959).

The examining attorney submitted evidence with his Office actions and in response to the request for reconsideration showing descriptive use by third parties of the term "brain games" in connection with a variety of cognitive and mental exercise games. For example, at one

website (www.washington.edu), under the subheading "Brain Games", there are several games identified, such as crossword puzzles, word search games, "brain bingo", etc.[5] It is evident from this website that the games are to test or improve one's cognitive skills. At another website (www.resources.kaboose.ccrr), under the heading "Brain Games", it says "Who said learning can't be fun? Enjoy these games about cool stuff like dinosaurs, space and more!"[6] Another retail website (www.amazon.com) advertises software and books and employs the term "brain games" to describe the content of the goods, namely, mental exercises presented in a game or entertaining manner.[7] At the website www.prevention.com, again under the heading "Brain Games" visitors are asked to "[s]harpen your memory and your mind with these games scientifically developed to give your brain a workout" and listing a string of names for games to be played.[8]

The examining attorney also submitted internet evidence of third parties who offer services or resources to help improve one's learning and memory skills through the use of "brain games." For example, at one website

[5] Submitted with Office action dated May 29, 2007.
[6] *Id.*
[7] *Id.*
[8] Submitted with examining attorney's response (dated January 8, 2009) to applicant's request for reconsideration.

(www.lumosity.com), "brain games" is not only used as heading, but a "brain training program" is touted as "consisting of engaging in brain games and exercises developed by some of the leading neuroscientists in the country."[9] The evidence also shows that the term "brain games" may be used in different fields and for different purposes. At the National Institute for Drug Abuse (NIDA) website "NIDA for Teens" (www.teans.drugabuse.gov), a separate page titled "Brain Games" allows visitors to "Exercise your brain and test your knowledge of drugs and the way they affect the brain and body."[10]

The examining attorney argues that, based upon the evidence, the term "brain games" is used to describe "a genre of games designed to improve one's cognitive abilities and exercise the mind." Brief, (unnumbered) p. 3. He points out that the "brain games" referenced in the evidence "are of the same type of games identified in applicant's identification of goods" inasmuch as they involve cognitive exercises. *Id.* at 4. He concludes that "[c]onsumers viewing the applied-for mark on the books and magazines of the applicant will immediately and without

[9] Submitted with Office action dated June 30, 2008.
[10] Submitted with examining attorney's response (dated January 8, 2009) to applicant's request for reconsideration.

hesitation understand that the games contained therein are 'BRAIN GAMES'." *Id.* at 3.

Upon review of the evidence and for the reasons aptly identified by the examining attorney, we find that the term "brain games" is merely descriptive of applicants' identified goods. We agree that the evidence shows that "brain games" is a common term used to describe a certain type of game, i.e., one that exercises the mind and seeks to improve cognitive skills. Here, very little exercising of the brain is needed for consumers to understand the highly descriptive nature of "brain games" when it is used on "printed publications, namely, books and magazines containing games, puzzles and other cognitive exercises."

Indeed, applicant does not contest any of the evidence presented by the examining attorney or contradict the examining attorney's analysis thereof. Rather, applicant's relies merely on the Office's treatment of one third-party application for the (now registered) mark MIND GAMES. However, as the examining attorney pointed out to applicant on several occasions and is oft-stated, each application is decided on its own facts and the evidence of record. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). See also, *In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001). And, as the examining attorney

suggested in his brief, one possible consideration involving the mark MIND GAMES is the alternative meaning(s) of that term. Here, no such double-entendre for the term BRAIN GAMES has been argued.

Having found that applicant's mark is merely descriptive, we now address applicant's alternative claim that it has acquired distinctiveness. Applicant has the burden to establish a prima facie case of acquired distinctiveness. See *Yamaha International Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). The greater the degree of descriptiveness, the greater the evidentiary burden on the user to establish acquired distinctiveness. *See Yamaha Int'l Corp., supra.* The sufficiency of the evidence offered to prove secondary meaning should be evaluated in light of the nature of the designation. Highly descriptive terms, for example, are less likely to be perceived as trademarks and more likely to be useful to competitors than are less descriptive terms. More substantial evidence of secondary meaning thus will ordinarily be required to establish their distinctiveness.

In support of the claim that its mark has acquired distinctiveness, applicant submitted photographs showing applicant's display of goods bearing the mark at its booth

at the Frankfurt Book Fair; a page from applicant's 2007-2008 sales catalog which (according to applicant's counsel) "2,000 copies have been distributed at trade shows, to retailers, distributors and customers; and a copy of a letter received by applicant "illustrating the association of the public of the mark to applicant." Brief, (unnumbered) p. 3. Further, applicant's attorney made several representations in applicant's responses to the Office actions, the request for reconsideration and applicant's brief, including: that applicant has "sold its series of books and magazines bearing the mark, 'BRAIN GAMES', currently consisting of as many as thirty-five (35) different titles, since November 2006"; that these goods have "been distributed by applicant through Wal-Mart department stores, Amazon.com, Barnes & Noble, [and others]"; that applicant has "expended substantial advertising costs in connection with the Series including $50,000 at the Frankfurt Book Fair in October 2007"; that "[t]o date, applicant has sold 1,681,139 copies of the titles in the series"; and that "[t]hese sales have resulted in combined revenues for applicant of $5,743,981."

Applicant's evidence and its attorney's statements fall far short of establishing that purchasers of applicant's goods recognize BRAIN GAMES as a distinctive

source indicator for such goods. Because the proposed mark is so highly descriptive of the identified goods, as shown by the evidence submitted by the examining attorney, substantially more evidence than what applicant has submitted would be needed for us to find that the term has become distinctive of the goods. First, we note that only a little more than two years have passed since applicant's alleged date of first use in commerce. Furthermore, applicant's only direct evidence of acquired distinctiveness consists of one letter received from a third party. And, except for the advertising expenditure for the Frankfurt Book Fair, we have no statements or evidence showing annual advertising expenditures for goods bearing applicant's proposed mark. Finally, even accepting counsel for applicant's unsupported representations regarding the number of copies sold and combined revenues which, on their face, appear to be substantial, we have no further information to put these numbers into context, i.e., whether applicant's share of the market is significant. In any event, it has often been held that gross sales and advertising expenditures may be indicative of applicant's success, they are necessarily enough to prove secondary meaning. This is particularly so when the mark at hand is highly descriptive. See *In re Boston Beer*

Co. L.P., 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately eighty-five million dollars, and annual advertising expenditures in excess of ten million dollars - two million of which were spent on promotions and promotional items which included the phrase THE BEST BEER IN AMERICA - found insufficient to establish distinctiveness, in view of the highly descriptive nature of the proposed mark); *In re E.I. Kane, Inc.*, 221 USPQ 1203, 1206 (TTAB 1984) (refusal to register OFFICE MOVERS, INC., for moving services, affirmed notwithstanding §2(f) claim based on, *inter alia*, evidence of substantial advertising expenditures. "There is no evidence that any of the advertising activity was directed to creating secondary meaning in applicant's highly descriptive trade name"); *In re Kwik Lok Corp.,* 217 USPQ 1245 (TTAB 1983) (evidence held insufficient to establish acquired distinctiveness for configuration of bag closures made of plastic, notwithstanding applicant's statement that advertising of the closures involved several hundred thousands of dollars, where there was no evidence that the advertising had any impact on purchasers in perceiving the configuration as a mark).

In conclusion, we find that prospective purchasers or

users of printed publications, namely, books and magazines containing games, puzzles and other cognitive exercises will have no need to pause or cogitate on the possible meaning of applicant's applied-for mark BRAIN GAMES, when considered on said goods. The evidence is clear that the consuming public will immediately understand the term as identifying a type of game, namely, one that exercises the mind and improves the cognitive skills. Moreover, applicant has not demonstrated that this highly descriptive term has acquired distinctiveness in connection with the identified goods.

Decision: The refusal to register on the ground of mere descriptiveness is affirmed, and we find that applicant has failed to establish acquired distinctiveness of BRAIN GAMES as used on the identified goods.