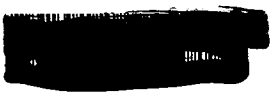
UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/630769

MARK: GOOD DESIGN



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GENERAL TRADEMARK INFORMATION:
http://www.uspto.gov/main/trademarks.htm

APPLICANT: The Chicago Athenaeum

CORRESPONDENT'S REFERENCE/DOCKET NO:
5127/53679
CORRESPONDENT E-MAIL ADDRESS:

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE:

Applicant is requesting reconsideration of a final refusal issued/mailed June 15, 2007.

After careful consideration of the law and facts of the case, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to the point at issue.

Applicant's primary argument is that "good design" is a unitary phrase, and this argument is largely a restatement of the argument presented in the applicant's April 27, 2007 response which was subsequently addressed in the examining attorney's June 15, 2007 final action.

The applicant further argues that the term "design" is not generic or a generic equivalent for its services, and that is in fact suggestive for the same. Specifically, the applicant argues that the applicant's goods/services have something to do with "design" but what that connection to "design" is and what type of "design" is being referred to is not immediately understood or conveyed by the mark itself. The applicant further notes in this argument that wording "design competition" and "design award", terms of art cited in the examining attorney's argument and evidence, do not appear in the applicant's mark, and without the use of said terms in the mark, the mark does not immediately convey or identify the services at issue.

With regard to this argument, the determination as to whether a term is descriptive or generic is determined in relation to the identified services, not in the abstract. *See, In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (CCPA 1978). Applicant's services, as identified, are design awards and design competitions. These are terms of art as shown in the previously attached evidence of record. See the attached additional publication entries from the Lexis-Nexis® database, confirming the same. A two-part test is used to determine whether a designation is generic:

(1) What is the class or genus of goods or services at issue?

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(2) Does the relevant public understand the designation primarily to refer to that class or genus of goods or services?

See H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986); TMEP §1209.01(c)(i). The services at issue are design awards and design competitions. The relevant public understands the term "design" as referring to these services. Accordingly, design is a generic term in the context of the recited services. Moreover, a term (such as "design" herein) that serves as the common descriptor of a key ingredient, characteristic or feature of the goods or services is also generic and thus incapable of distinguishing source.

Finally, the applicant argues that the applicant's prior, now expired, registration for the same mark and the same services did not require a disclaimer of design. This, applicant contends, supports the applicant's position that the term "design" should not be disclaimed from the instant mark. Each case must be decided on its own merits. Previous decisions by examining attorneys in approving other marks are without evidentiary value and are not binding on the agency or the Board. *In re Sunmarks Inc.*, 32 USPQ2d 1470 (TTAB 1994); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984). Moreover, the examining attorney believes that the argument and evidence contained in the record herein, supports the disclaimer requirement.

Attached as further supporting evidence of requiring the disclaimer are definitions from The American Heritage® Dictionary of the English Language, Fourth Edition and copies of the applicant's webpage.

Accordingly, applicant's request for reconsideration is *denied*. The time for appeal runs from the date the final action was issued/mailed. 37 C.F.R. Section 2.64(b); TMEP Section 715.03(c). If applicant has already filed a timely notice of appeal, the application will be forwarded to the Trademark Trial and Appeal Board (TTAB).

/John S. Yard/
Trademark Examining Attorney
Law Office 115
(571) 272-9486

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at http://tarr.uspto.gov. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

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