Hearing:
October 5, 2005

Mailed:
December 7, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Curriculum Associates, Inc.

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Serial No. 76433945

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Charles Hieken of Fish & Richardson P.C. for Curriculum Associates, Inc.

Ira Goodsaid, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

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Before Seeherman, Bottorff and Bucher, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Curriculum Associates, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register PALABRA LISTA as a trademark for "printed educational materials for teaching Spanish vocabulary."[1] Applicant has provided a translation of "palabra lista" as

[1] Application Serial No. 76433945, filed July 24, 2002, and asserting first use and first use in commerce as of July 1, 1993.

meaning "word list." Registration has been refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark is merely descriptive of the identified goods. Specifically, the Examining Attorney contends that the mark "aptly describes the goods, which appear to be a list of Spanish vocabulary." Office action dated January 22, 2003.

The appeal has been fully briefed, and applicant and the Examining Attorney appeared at an oral hearing before the Board. With applicant's reply brief it attached what it described as "863 records of word marks including LIST that are the subject of numerous applications and registrations." The Examining Attorney has objected on the basis that this material was not timely submitted. We agree. Trademark Rule 2.142(d) provides that the record in an appeal should be complete as of the time the appeal is filed. Because the material submitted with applicant's reply brief is manifestly untimely, it has not been considered.[2]

[2] Even if we were to consider the material, it would not support a different result herein. The material consists of a list of marks containing either the word "list" or the element "list" contained within a larger word, e.g., LISTAREPA, along with the serial number and/or registration number, and an indication of whether the application/registration is "live" or "dead." There is no indication of the goods or services. The fact that third parties may have attempted to register marks containing "list" elements (for unknown goods and services) and may or may not have

We affirm the refusal of registration.

A mark is merely descriptive, and therefore prohibited from registration by Section 2(e)(1), if it immediately conveys knowledge of the ingredients, qualities or characteristics of the goods or services with which it is used. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). It does not have to describe every quality, characteristic, function, ingredient, attribute or feature of the product or service; it is enough if it describes a single significant quality, feature, function, etc. In re Venture Lending Associates, 226 USPQ 285 (TTAB 1985). Moreover, the question of whether a particular term is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the significance that the mark is likely to have, because of the manner in which it is used, to the average purchaser as he encounters goods bearing the mark in the marketplace. In re Abcor Development Corp., 588 F.2d 811,

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been successful (a large number of the applications and registrations which appear on the list submitted by applicant are marked “dead”) is of no persuasive value that applicant’s mark, as used in connection with its goods, is not merely descriptive.

200 USPQ 215 (CCPA 1975); In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986).[3]

Moreover, in determining whether PALABRA LISTA is merely descriptive, no distinction may be made based on the fact that the mark consists of Spanish words. It is well settled that the foreign equivalent of a merely descriptive English term is no more registrable than the English term itself. In re Atavio Inc., 25 USPQ2d 1361 (TTAB 1992). Thus, if the term "word list" is merely descriptive, PALABRA LISTA must be considered merely descriptive as well.

In support of his position, the Examining Attorney has made of record materials from the internet which use the term “word list” to describe entries of words in a foreign language, with their English translation. For example, an excerpt entitled “Latin Word List” is stated to contain 8,000 entries. The introductory paragraph includes the statement that “this is only a word list offering some possible translations and is no substitute for working closely with a good dictionary. …You may obtain this word

[3] Because we note that applicant has, in response to the Examining Attorney’s citations of cases involving descriptive marks, attempted to distinguish the factual situations of those cases, we point out that the cases we have cited are for the principles contained therein as to what constitutes a descriptive mark, and not because we consider applicant’s mark and goods to be similar to or the same as those involved in those decisions.

list….[4] Other excerpts are entitled, respectively, Khowar English Dictionary and Word List,"[5] "Ainu-English Word List,"[6] and Patrin Romanichal Word List,"[7] and all consist of a columns of words, the first column being words in the foreign language, the second being the English translation of each word.

We also note that the specimen submitted by applicant, which is in Spanish, is a manual which consists primarily of lists of words, arranged in different categories. For example, one list is of "Animales y colores" (animals and colors).

It is clear that a significant feature of applicant's goods is that they contain word lists. It is also clear that the public recognizes the term "word list," when used in the context of educational materials for learning a foreign language, as meaning a listing of foreign words. Further, at the oral hearing, applicant acknowledged that its materials do contain word lists. At the oral hearing, applicant's counsel made the statement that its mark is not descriptive because, although its materials include word lists, they do not necessarily have to do so. Obviously,

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[4] www.ku.edu/ftp/pub/history/Europe/Medieval/aids/latwords.html.
[5] www.ishipress.com/khow-lst.htm
[6] www.coastalfog.net/languages/ainuenglish.html.
[7] www.geocities.com/Paris/5121/rumney.htm.

we must consider applicant's mark as it is used with its goods. These goods contain word lists as a significant feature of the materials, and therefore PALABRA LISTA, the Spanish equivalent of "word list," describes the materials.[8] Applicant also points out that in the evidence submitted by the Examining Attorney the term "word list" is preceded by the name of the foreign language from which the words are taken, e.g., "Latin Word List," "Romanichal Word List." To the extent that applicant takes the position that, because "Spanish" (or its Spanish equivalent) does not precede "Palabra Lista," it does not immediately describe the goods because one would not know the language of the words listed, we are not persuaded by this argument. First, it is not necessary, in order to be found descriptive, that the mark describe the specific language of the "word list" found in the educational materials. Second, the descriptiveness of the mark must be considered in connection with the goods with which it is used. See Abcor, supra. Applicant's goods are identified as "printed educational materials for teaching Spanish vocabulary," and consumers of the goods would therefore immediately

[8] If the materials did not contain word lists, a refusal on the ground that the mark is deceptively misdescriptive would have been in order.

understand that the "word list" or PALABRA LISTA in question would be in Spanish. Finally, because the mark is in the Spanish Language, it would require no thought or imagination or perception on the part of consumers to understand the nature of the word lists.

At the oral hearing, applicant's attorney asserted that its mark has been in use for some time and, indeed, applicant claims use as of July 1, 1993. However, length of use is one of the considerations that goes into a determination of whether a mark has acquired distinctiveness; because applicant is not seeking to register its mark pursuant to the provisions of Section 2(f), the length of use of the mark is irrelevant to our consideration.[9]

Finally, at the oral hearing applicant argued the Board implement the policy of the Trademark Act by registering its mark so that the public would be on notice of it, and further stated that this would not prevent the public from using the term in a descriptive manner. While

[9] We note that in the first Office action the Examining Attorney stated that, because he believed that the applied-for term was generic, he could not recommend an amendment to proceed under Trademark Act Section 2(f). However, despite this statement, applicant was not precluded from so amending its application if it wished to attempt to register the mark under Section 2(f). Accordingly, applicant cannot now rely on an argument which would only be pertinent to a Section 2(f) claim.

we agree with applicant that it is a policy of the Trademark Act, and the U.S. Patent and Trademark Office, to register trademarks, it is also a statutory prohibition to register marks which are merely descriptive. Because we find that applicant's mark is merely descriptive of its goods, we must follow that statutory requirement and policy and affirm the refusal of registration.

Decision: The refusal of registration is affirmed.