

**THIS OPINION IS
NOT A PRECEDENT
OF THE TTAB**

Mailed: August 30, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re DAP Brands Company

Serial No. 77116207

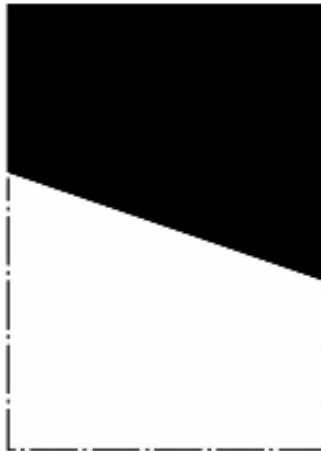
Thomas W. Flynn of Wood, Herron & Evans, LLP for DAP Brands Company.

Ramona Ortiga Palmer, Trademark Examining Attorney, Law Office 117 (Brett Golden, Managing Attorney).

Before Quinn, Hairston and Grendel, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by DAP Brands Company to register the matter shown below,



for "adhesives for household purposes" in International Class 16.¹

The trademark examining attorney² has refused registration pursuant to Sections 1, 2, and 45 of the Trademark Act on the ground that the matter sought to be registered does not function as a trademark to distinguish applicant's goods from the goods of others. The examining attorney also made a requirement for an acceptable description of the mark.

When the refusal and requirement were made final, applicant appealed. Applicant and the examining attorney have filed briefs.

Requirement for an acceptable description of the mark

We first turn to the examining attorney's requirement for an acceptable description of the mark. As noted, the application as originally filed contained the following description of the mark:

The mark consists of the color black extending across the upper portion of the packaging for the product, with the lower edge of the mark

¹ Application Serial No. 77116207, filed February 26, 2007, based on use in commerce, alleging first use and first use in commerce as of June 1, 2006. The application as originally filed contained the following description of the mark: "The mark consists of the color black extending across the upper portion of the packaging for the product, with the lower edge of the mark extending angularly downwardly from the left edge to the right edge of the packaging."

² The current examining attorney was not the original examining attorney in this application.

extending angularly downwardly from the left edge to the right edge of the packaging.

The examining attorney held that this description of the mark was incomplete, and required applicant to submit an acceptable description of the mark. In particular, the examining attorney stated that further clarification was needed because it was unclear whether the white portion of the drawing is part of the mark. The examining attorney also suggested that applicant adopt the following description of the mark:

The mark is a geometric shape that appears on the background of the applicant's product packaging. The mark consists of a black quadrilateral extending across the upper portion of the packaging for the product, with the bottom left edge of the mark extending at a downward angle from the left edge to the right edge of the packaging. The mark bisects the rectangular product packaging into two equal quadrilaterals. The dotted outline of the product packaging is intended to show the position of the mark on the goods and is not part of the mark. The applicant makes no claim to the rectangular product packaging itself, only to the geometric design located on the upper top portion of the packaging. The applicant makes no claim to the color white appearing in the lower portion of the mark. The color white appearing in the drawing constitutes background, outlining, shading or transparent areas, and is not part of the mark.

Applicant, however, declined to adopt the description suggested by the examining attorney and instead, submitted the following amended description:

The mark consists of a black band extending across the upper portion of the packaging for the goods. The black band has upper and lower edges which extend in straight lines between straight side edges, but the lower edge extends downwardly from left to right away from the upper edge. The dotted outline of the product packaging is intended to show the position of the mark on the packaging for the goods and is not part of the mark.

The examining attorney held that the amended description of the mark was unacceptable. Again, the examining attorney stated that it was unclear from this description whether the white portion of the drawing is part of the mark.³

TMEP Section 808.02 (6th ed. rev. 2 2010) provides in pertinent part that, "[a] description cannot be used to restrict the likely public perception of a mark. A mark's meaning is based on the impression actually created by the mark in the minds of consumers, not on the impression that the applicant states the mark is intended to convey. However, an examining attorney may defer to the applicant's phrasing of a description, so long as the description is accurate and complete. For example, if an element in a mark could reasonably be characterized in more than one

³ We note that the current examining attorney apparently overlooked the amended description of the mark because she stated in her brief, at unnumbered p. 8, that "[no] alternative description of the mark was provided by applicant." Thus, she did not specifically address the acceptability of the amended description of the mark in her brief.

way, the examining attorney should accept the applicant's selection of one characterization over the other in the description." Further, TMEP Section 807.08 provides in pertinent part that, "[f]or any drawing using broken lines to indicate placement of the mark, or matter not claimed as part of the mark, the applicant must include a written description of the mark and explain the purpose of the broken lines, e.g., by indicating that the matter shown by the broken lines is not a part of the mark and that it serves only to show the position of the mark."

We find that applicant's amended description of the mark contains an accurate characterization of the mark and, in particular, a sufficient explanation of the purpose of the broken or dotted lines in the drawing. In other words, it is clear in the amended description that the "white portion" of the drawing is not part of the mark. In view of the foregoing, the examining attorney's requirement for an acceptable description of the mark is not well-taken.

Refusal on the ground that the matter sought to be registered does not function as a trademark

We next turn to the refusal to register on the ground that the matter sought to be registered does not function as a trademark and, thus, is not registrable. It is the examining attorney's position that the matter sought to be

registered is merely a background design that is not sufficiently distinctive or unique to create a commercial impression separate and apart from the words and/or other designs in connection with which it is used. Further, the examining attorney contends that non-distinctive ornamental background designs such as applicant's are commonly used as carriers for words on packaging. In support of her position, the examining attorney points to the evidence she submitted showing that third parties use "background designs that bisect or segment product packaging into various segmented portions," thus allowing "a marketer to set off, or quickly call attention to, a particular part of the product package so the consumer can easily find and view the material contained in that part." (1/5/2009 Final Office Action, p. 3) In this connection, the examining attorney made of record examples of blister packs for adhesives and other products shown at third-party websites. Each of the blister packs includes a background design that displays a word mark and/or other wording.

Applicant, in urging reversal of the refusal to register, argues that the matter it seeks to register "is not merely an ornamental or background feature, but instead has been designed to and does stand out and catch the eye of the prospective purchaser." (Brief, p. 6). According

to applicant, the matter sought to be registered "[is] like Applicant's Solid Black Band and Narrow Black Band of its two existing registrations" in that it "makes Applicant's products stand out from those of its competitors and thus share in the goodwill established by Applicant in its products." (Id.) Applicant points to its Registration Nos. 2655831 and 2781124 as evidence that the Office has allowed similar marks to register.

We begin our discussion by reviewing applicant's specimen of record, which is reproduced below:



Contrary to applicant's contention, it is clear from the specimen that the matter sought to be registered is a background design for applicant's word marks, e.g. DAP, STICKAROUNDS, and GELTAPE, as well as other wording. Where as here, an applicant seeks to register a background design that is used in connection with a word mark, that background design may be registered as a trademark only if it creates a commercial impression separate and apart from the word mark in conjunction with which it is used. *In re Anton/Bauer Inc.*, 7 USPQ2d 1380 (TTAB 1988). If the background design is inherently distinctive, it may be registered without evidence that it is recognized as a trademark; if it is not inherently distinctive, then proof of acquired distinctiveness as provided under Section 2(f) is required. *In re E.J. Brach & Sons*, 256 F.2d 325, 118 USPQ 310 (CCPA 1958). In particular, common geometric shapes such as circles, squares, rectangles, triangles and ovals, when used as background for the display of word marks, are not regarded as trademarks for the goods to which they are applied absent evidence of distinctiveness of the background design alone. *In re Anton/Bauer Inc.*, *supra* at 1381. The "black band" applicant seeks to register is in the shape of a trapezoid that covers the top portion of the blister pack for its adhesives. This

trapezoid is very similar to the circles, squares, rectangles, triangles and ovals discussed above, and, as used on the specimen, it does not stand out as a mark by itself.

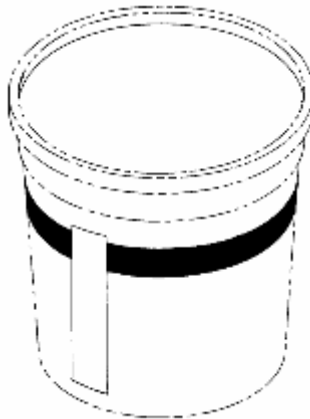
Furthermore, the evidence submitted by the examining attorney shows that third parties, including other adhesives manufacturers, use background designs of varying shapes on blister packs for the display of word marks and other wording. Several examples are reproduced below:





Thus, the purchasing public would be unlikely to regard the black trapezoid applicant seeks to register as identifying and distinguishing applicant's adhesives and indicating source.

Applicant also points to its Registrations Nos. 2655831 and 2781124, both for adhesives, as evidence that the Office has allowed similar marks to register. The marks in these registrations are shown below:



Registration No. 2655831 issued under the provisions of Section 2(f). The mark is described as follows: "The mark consists of a narrow black band extending across the top of the packaging for the goods and a vertical stripe at a position left of center of the front of the packaging."



Registration No. 2781124 issued under the provisions of Section 2(f). This registration does not contain a description of the mark.

It is well settled that each case must be decided on its own facts, and it is important to note that each of these registrations issued on the Principal Register under the provisions of Section 2(f). This is in contrast to the present case where applicant has not made a claim of acquired distinctiveness under Section 2(f).

Finally, applicant relies on *Layton Pure Food Co. v. Church & Dwight Co.*, 182 F. 24 (8th Cir. 1910) to support its position that the matter sought to be registered is inherently distinctive. In *Layton*, the Court recognized the trademark significance of a colored annular band apart from the words used in connection therewith. Apart from the fact that *Layton* was an infringement case, the Court noted that it was through "long use" that the colored

annular band had "come to indicate not only origin, but very clearly the quality of the baking soda and baking powder" *Layton*, 182 F. at 31-32. To reiterate, applicant has not claimed that the black trapezoid it seeks to register has become distinctive through use in commerce under the provisions of Section 2(f).

In view of the foregoing, we find that applicant's black trapezoid is a background design that does not create a commercial impression separate and apart from the word marks in conjunction with which it is used. Thus, it does not function as an indicator of the source of applicant's goods.

Decision: The requirement for an acceptable description of the mark is reversed. The refusal to register on the ground that the matter sought to be registered does not function as a trademark is affirmed.