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ENKEB-858T

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UNITED STATES PATENT AND TRADEMARK OFFICE

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MARK: THE FINEST ARCHITECT



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: The Enkeboll Co.

CORRESPONDENT'S REFERENCE/DOCKET NO:

ENKEB-858T

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the examining attorney's refusal to register THE FINEST ARCHITECTURAL WOODCARVINGS IN THE WORLD (standard character mark) under Section 2(e) (1) of the Trademark Act on the basis that it is merely descriptive of the identified services. Trademark Act Section 2(e) (1), 15 U.S.C. § 1052(e) (1).

FACTS

On November 7, 2007 The Enkeboll Co., doing business as Enkeboll Designs applied to register THE FINEST ARCHITECTURAL WOODCARVINGS IN THE WORLD for "advertising and promotional services pertaining to architectural woodcarving products" in International Class 35. The examining attorney refused registration under Section 2(e) (1) of the Trademark Act, 15 U.S.C. § 1052(e) (1) on the basis that the proposed mark is merely descriptive of the identified services. The

examining attorney issued a final refusal on June 20, 2008. The applicant then filed this appeal.

ISSUE

The issue on appeal is whether the proposed mark THE FINEST ARCHITECTURAL WOODCARVINGS IN THE WORLD is merely descriptive of the applicant's services within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

ARGUMENTS

Section 2(e) (1) - The Mark Is Merely Descriptive

A. Overview of a Merely Descriptive Analysis

A mark is merely descriptive under Trademark Act Section 2(e) (1), 15 U.S.C. § 1052(e) (1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1987); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP §1209.01(b).

The determination of whether a mark is merely descriptive is considered in relation to the identified services, not in the abstract. *In re Polo International Inc.*, 51 USPQ2d 1061 (TTAB 1999) (Board found that DOC in DOC CONTROL would be understood to

refer to the “documents” managed by applicant’s software, not “doctor” as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (CONCURRENT PC-DOS found merely descriptive of “computer programs recorded on disk;” it is unnecessary that programs actually run “concurrently,” as long as relevant trade clearly uses the denomination “concurrent” as a descriptor of this particular type of operating system); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985) (“Whether consumers could guess what the product is from consideration of the mark alone is not the test”); TMEP §1209.01(b). Additionally, a mark need not describes all of the purposes, functions, characteristics or features of the goods to be merely descriptive. For the purpose of a Section 2(e)(1) analysis, it is sufficient that the mark describe only one attribute of the services to be merely descriptive. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973); TMEP § 1209.01(b).

A mark that combines descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning. However, if each component retains its descriptive significance in relation to the services, the combination results in a composite that is itself descriptive. *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) (SMARTTOWER merely descriptive of “commercial and industrial cooling towers and accessories thereof, sold as a unit); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer software for use in development and deployment of application programs on global computer network); *In re Putman Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE held to be merely descriptive of news and information service for the food

processing industry); *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) (SCREEN FAX PHONE merely descriptive of “facsimile terminals employing electrophoretic displays”); *In re Entenmann’s Inc.*, 15 USPQ2d 1750 (TTAB 1990), *aff’d per curiam*, 928 F.2d 411 (Fed. Cir. 1991) (OATNUT held to be merely descriptive of bread containing oats and hazelnuts).

Last, laudatory words or terms that attribute quality or excellence to goods and/or services are considered merely descriptive. TMEP §1209.03(k). Thus, laudatory terms, phrases and slogans are nondistinctive and unregistrable on the Principal Register without proof of acquired distinctiveness. *See In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001) (holding THE ULTIMATE BIKE RACK a laudatory, descriptive phrase that touts the superiority of applicant’s bicycle racks); *In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (holding THE BEST BEER IN AMERICA a laudatory, descriptive phrase for applicant’s beer and ale); *In re The Place, Inc.*, 76 USPQ2d 1467 (TTAB 2006) (holding THE GREATEST BAR a laudatory, descriptive term for applicant’s restaurant and bar since term “greatest” immediately informs prospective purchaser that applicant’s establishment is superior in character or quality when compared to other restaurants and bars); *In re Dos Padres, Inc.*, 49 USPQ2d 1860 (TTAB 1998) (holding QUESO QUESADILLA SUPREME a laudatory, descriptive term for applicant’s cheese).

**B. The Proposed Mark “THE FINEST ARCHITECTURAL WOODCARVINGS
IN THE**

WORLD” is Merely Descriptive of the Applicant’s Services

The record contains evidence that supports the refusal to register under Section 2(e)(1). The dictionary defines the terms as:

Finest Surpassing in quality.

Architectural Pertaining to architecture, its features, characteristics, or details.

Woodcarving The art of creating or decorating objects of wood by carving with a sharp hand-held tool.

World The earth.
 The earth with its inhabitants.

Please see dictionary definitions attached to the outgoing action dated 2-16-08.

The record also contains copies of prior registrations that consist of very similar marks as the proposed mark which have been registered either under Trademark Act under Section 2(f), or the Supplemental Register. For example:

1. THE FINEST ICE CREAM IN THE WORLD registered on the Principal Register under Trademark Act Section 2(f) for “ice cream” in International Class 30 (Registration Number 1,615,913)

2. THE FINEST BERRIES IN THE WORLD registered on the Principal Register under Trademark Act Section 2(f) for fresh strawberries, raspberries, blueberries and blackberries” in International Class 31. (Registration Number 2,116,,219)

3. THE WORLD’S FINEST STICKS registered on the Supplemental Register for “drumsticks”” in International Class 15 (Registration Number 2,993,453)

4. THE WORLD ‘S FINEST ILLUMINATION TOOLS registered on the Supplemental Register for “flashlights” in International Class 11 (Registration Number 3,069,566)

5. THE WORLD’S FINEST WEAPONLIGHTS registered on the Supplemental Register for “target illuminators for firearms” in International Class 13 (Registration Number (3,059,744)

6. THE WORLD’S FINEST TACTICAL GEAR registered on the Principal Register under Trademark Act Section 2(f) for “tactical gear and tactical equipment for military, law enforcement and defense applications, namely, protective clothing; protective eyewear; protective sunglasses; protective goggles and masks; protective helmets; gloves for protection against accidents and injury, namely, protective gloves, driving gloves, shooting gloves, hazmat gloves, water operation diving gloves, assault gloves, viral barrier gloves, rescue gloves, rappelling gloves, and glove liners; protective clothing, namely, flame retardant balaclavas, slash resistant balaclavas, thermal balaclavas, tactical vests, modular tactical vests, rapid entry vests, mesh vests, armor bearing vests, rescue bearing vests, medical and paramedic vests, combination ballistic/flotation vests, load-bearing vests, harnesses and slings used for keeping clothing and tactical equipment in place; protective elbow pads, knee pads, shin pads and shinguards; disturbance control gear,

namely, hard shell riot suits and soft shell riot suits; hand-held tactical and protective shields; bags for tactical gear and tactical equipment” in International Class 9 (Registration Number 3,209,132)

Last, the record also contains evidence which includes articles obtained via the *Lexis/Nexis*® research database that consist of similar wording as the instant application. These stories show that the phrase “finest in the world” is a common phrase, often used to attribute a laudatory meaning to the mentioned goods or services.

The sum of the evidence clearly demonstrates that the proposed mark is merely descriptive when used in connection with the identified services. When the mark is used in connection with the identified services the components retain their ordinary descriptive meanings. The term FINEST is a laudatory word which touts the quality of woodcarvings that are advertised and promoted, ARCHITECTURAL WOODCARVINGS identifies the items and the term WORLD indicates the scope of the services. As such consumers would immediately view it as attributing excellence or superior quality to the architectural woodcarving products that applicant advertises and promotes thru its services. Thus, the proposed mark is merely descriptive under Trademark Act Section 2(e) (1).

The applicant argued that the mark is not merely descriptive, because the “proposed mark does not include language which describes the related advertising and promotional services with particularity.” Page 10 of Applicant’s brief. The applicant asserts that the proposed mark simply refers to woodcarvings. Therefore imagination, thought or

perception is needed to determine the nature of its services. This is not the true test for determining whether the proposed mark is merely descriptive. The determination of whether a mark is descriptive within the meaning of Section 2(e)(1) must be determined not in abstract, but in relation to the services for which registration is sought, context in which it is used, and significance it is likely to have to average purchasers as they encounter the services in marketplace. *In re TMS Corp of the Americas*, 200 USPQ 57 (TTAB 1978) and *In re International Spike, Inc.*, 190 USPQ 505 (TTAB 1976).

Applicant cites *In re House Store Ltd* 221 USPQ 92 (TTAB 1983) to support its claim that the proposed mark is not merely descriptive. In that case, the Trademark Trial and Appeal Board reversed a refusal under Trademark Act Section 2(e)(1). The applicant sought to register THE HOUSE STORE for “retail store services in the field of furniture and housewares.” In reversing the refusal because the services could include a broad range of consumer goods, the Board said at page 93 that “HOUSE would cover furniture stores, appliance stores, linen and drapery shops and a myriad of retail product stores.” This is not the situation in the present case. The proposed mark when used with the services, clearly indicates that the applicant’s advertising and promotional services will be rendered in connection with architectural woodcarving products. There can be no other meanings of the words that comprise the proposed mark. Indeed, applicant has not set forth any other meanings of the wording that comprises the proposed mark.

Next, Applicant argued that the proposed mark is not merely descriptive because it would not immediately inform consumers of the nature of the related services. A mark is

merely descriptive if it conveys an immediate idea of the ingredients, qualities, or characteristics of the identified goods and/or services. *See In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005); *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001).

Applicant asserts that it is seeking registration of the proposed mark for advertising and promotional services not woodcarvings and since such wording is not mentioned in the mark it is not merely descriptive. The applicant seeks to register the proposed mark that involves advertising and promotional services as such activities relate to architectural woodcarving products. It is likely that applicant will develop campaigns to advertise and promote architectural woodcarving products of others. When the proposed mark is used in connection with such activities, it is likely that consumers would believe that it describes a feature of applicant's services.

Applicant argued that the third party registrations that consist of similar wording as the proposed mark are not persuasive evidence of mere descriptiveness. Applicant asserts that the third party registrations all include laudatory language referring directly to the identified goods and services whereas the proposed mark does not. However, some of the service mark registrations feature marks which do not directly reference the related services. For example:

1. THE WORLD'S FINEST WALKING SHOES registered on the Supplemental Register for "retail shoe store services" in International Class 35 (Registration Number 2,350,950)

2. THE WORLD'S FINEST APPLES registered on the Principal Register under Trademark Act Section 2(f) with regard to WORLD'S FINEST and disclaimer of APPLE for "fresh apples" in International Class 31 and "association services, namely, promoting public awareness of the benefit of consuming apples" in International Class 42 (Registration Number 2,240,052)
3. WORLD'S FINEST FUND RAISING PROGRAMS registered on the Supplemental Register for "promoting the fund raising efforts of others by providing candy products customized to the specifications of fund raisers, and providing sales record keeping forms customized to the specifications of fundraisers for use by fundraisers (Registration Number 2,619,091)
4. SIMPLY THE FINEST CUSTOM COUTURE CLEANER IN THE WORLD Registered on the Principal Register under Trademark Act Section 2(f) for "stain removal kit for fabric and garments, namely, kits comprised primarily of a cleaning formula, rinse solution, stain guide and absorbent material" in International Class 16 and "fabric and garment cleaning, preservation and restoration services" in International Class 37 (Registration Number 3,172,800)
5. THE WORLDS FINEST CRYSTAL registered on the Principal Register under Trademark Act Section 2(f) for "catalog in the field of crystal" in International Class 16 and "retail stores, online retail store services and catalog ordering services Featuring crystal" in International Class 35 (Registration Number 3,116,790]

These marks are very similar to the proposed mark and all were either registered under Trademark Act Section 2(f), Supplemental Register and in one case register on the Principal Register with Section 2(f) in part and disclaimer. This evidence clearly

indicates that the office considered similar marks to be laudatorily descriptive. And since applicant's services involve advertising and promotional of *architectural woodcarving* products, the wording THE FINEST ARCHITECTURAL WOODCARVINGS IN THE WORLD is laudatory when used in connection with the services.

Applicant also argues that the proposed mark does not include any laudatory language and as such is not merely descriptive. It is applicant's position that when used in connection woodcarving "finest" would connote "delicately fashioned." However, descriptiveness is considered in relation to the relevant goods and/or services and the meaning imparted by the mark as a whole. The fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness. *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979); TMEP §1209.03(e). Moreover, the term FINEST has previously been deemed laudatory by the Office. The Assistant commissioner for Trademark ordered cancellation of AMERICA'S FINEST for "overalls" which was register on the Supplemental Register. The Assistant Commissioner held that the wording was not capable of distinguishing the goods and that the "term AMERICA'S FINEST OVERALL has been used by respondent as a laudatory phrase in advertising. "It represents mere puffing or touting in advertising and seeking customers for its overalls, and on the basis of the record and as used, it neither identifies nor distinguishes respondent products." *Kotzin v. Levi Strauss & Company*, 111 USPQ 161 (Comr., 1956). In a more recent decision, the Trademark Trial and Appeal Board upheld a Section 2(e)(1) refusal of the mark FINEST LATIN AMERICAN REFRIGERATED FOODS for food items, wherein the Court stated that "the word FINEST conveys information to the potential purchaser

about the alleged quality of applicant's foods....” *In re Tropical Cheese Industries, Inc.* Ser. No. 75407503 (2000 TTAB). To view and print this decision, visit <http://ttabvue.uspto.gov/ttabvue/> and insert the serial number specified. Find the final decision in the prosecution history and left click on it to view it as a .pdf document.

From this record, it is highly unlikely that purchasers who encounter the proposed mark would not believe that the term FINEST used in this context would translate to mean “delicately fashioned.” Rather, they would believe that applicant's mark indicates that the architectural woodcarving products they promote or advertise are superior to others or of the best quality.

A mark is suggestive if some imagination, thought or perception is needed to understand the nature of the goods and/or services described in the mark; whereas a descriptive term immediately and directly conveys some information about the goods and/or services. *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005); TMEP §1209.01(a); *see In re Shutts*, 217 USPQ 363, 364 (TTAB 1983).

Two major reasons for not protecting descriptive marks are (1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace and (2) to avoid the possibility of costly infringement suits brought by the trademark or service mark owner. *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978); TMEP §1209. Businesses and competitors should be free to use descriptive language when describing their own goods and/or services to the public in advertising

and marketing materials. *See In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001).

CONCLUSION

The foregoing demonstrates that the proposed mark is merely descriptive of the applicant's services. Therefore, the examining attorney respectfully requests that the refusal of registration under Trademark Act Section 2(e) (1) be affirmed.

Respectfully submitted,

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