

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

Mailed: February 28, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Shop Vac Corporation

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Serial No. 77542156

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Richard M. Labarge of Marshall Gerstein & Borun for Shop Vac Corporation.

Dominic J. Ferraiuolo, Trademark Examining Attorney, Law Office 102 (Karen M. Strzyz, Managing Attorney).

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Before Walters, Kuhlke and Cataldo, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Shop Vac Corporation has filed an application to register on the Principal Register the standard character mark BENCH VAC for "vacuum cleaners," in International Class 7.<sup>1</sup> The application includes a disclaimer of VAC apart from the mark as a whole.

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<sup>1</sup> Serial No. 77542156, filed August 8, 2008, based on an allegation of a bona fide intention to use the mark in commerce.

The examining attorney has issued a final refusal to register, under 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 in connection with its goods. Additionally, the examining attorney has based his final refusal on applicant's alleged failure to comply with the requirement to provide additional information about the proposed goods.

Applicant has appealed. Both applicant and the examining attorney have filed briefs.

*Mere Descriptiveness*

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness

must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

The examining attorney contends that because applicant did not respond to the request for information about the goods, "it is reasonable to infer from the wording of the proposed mark alone that the wording 'bench' is used to identify or describe a feature and/or use of the goods, namely a 'vac' or vacuum cleaner for use on and/or in connection with a worktable or 'bench.'" (Final Refusal, 11/19/2009.) In support of the mere descriptiveness refusal, the examining attorney submitted the following relevant definitions from *The American Heritage Dictionary* (4<sup>th</sup> ed. 2000) ( [www.Bartleby.com](http://www.Bartleby.com) ):

VAC - A vacuum cleaner.

BENCH - 1. A long seat, often without a back, for two or more persons. ... 5. A strong worktable, such as one used in carpentry or in a laboratory. ...

The examining attorney contends that the mark consists of two individually descriptive terms that result in a merely descriptive composite mark; and he concludes that consumers

will understand the term BENCH as referring to a work table in the context of the goods.<sup>2</sup>

Applicant argues that it is inappropriate in connection with an ITU application for the examining attorney "to speculate about how applicant's goods might be marketed, and that the fact that some vacuum cleaners might be used at a worktable does not warrant a descriptiveness rejection of BENCH VAC for vacuum cleaners." (Brief, p. 2.) In this regard, applicant contends that BENCH identifies, at most, a possible place where the goods might be used, but that "in most cases, the place where a product might be used is not an important enough concern in the purchasing decision to warrant a descriptiveness rejection." (Brief, p. 3.)

Applicant contends that the examining attorney has provided "no evidence that vacuum cleaners are commonly used in connection with workbenches" (*id.*); that "[i]f in fact the applicant decides to market its product that way, the examiner will have a chance to see that when the proof of use is filed, and will have the opportunity ... to evaluate whether such marketing warrants a rejection on the grounds of descriptiveness" (*id.*); and that the refusal amounts to mere speculation.

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<sup>2</sup> The examining attorney requested in his brief that we take judicial notice of another dictionary definition of "bench." We decline to do so because the proposed evidence is merely repetitive of the definitions already of record.

We agree with applicant that the examining attorney has failed to establish, with only the two dictionary definitions of record, that BENCH VAC is merely descriptive in connection with vacuum cleaners. The record contains no evidence regarding the types or use of vacuum cleaners such that we can conclude that the BENCH portion of the mark would be understood by relevant consumers to describe a significant aspect of applicant's vacuum cleaners, i.e., whether BENCH VAC describes an intended use or other characteristic of the goods. The burden of proving mere descriptiveness is on the examining attorney. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). We will not draw inferences about descriptiveness from information that the examining attorney contends applicant has *not* made of record.

Moreover, any doubt that we may have about whether the mark is merely descriptive we resolve in favor of applicant and publication of the mark for opposition. See *In re Rank Organization Ltd.*, 222 USPQ 324, 326 (TTAB 1984) and cases cited therein.

The refusal on the ground of descriptiveness is reversed. However, when and if the application is examined following the submission by applicant of a statement of use and specimen, the examining attorney may, if appropriate

based on the evidence in the record, refuse registration on the ground of mere descriptiveness.

*Requirement for Additional Information*

The examining attorney required additional information about the goods in his second office action. Applicant did not address this requirement in its response to that action, so the examining attorney repeated the requirement and made it an additional basis for the final refusal to register. Applicant filed its notice of appeal and, in its appeal brief, addressed the information requirement only to the extent that it stated "it has not developed marketing materials for the goods or decided how they will be marketed." (Brief, p. 2.) Applicant also accused the examining attorney of merely speculating about the nature of its goods.

In his brief, the examining attorney reiterated the requirement for "factual information that makes it clear how the goods operate, their salient features, and their prospective customers and channels of trade [or] any documentation for goods of the same type, explaining how its own product will differ." (Brief.)

Then, in its reply brief, applicant attached "materials on other goods that are comparable to the goods that the applicant now intends to sell under the proposed BENCH VAC mark." (Reply Brief, p. 1.) Because all evidence in a

proceeding must be submitted prior to appeal, we have not considered this evidence.

Trademark Rule 2.61(b), 37 CFR §2.61(b) provides "[t]he examiner may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application."

The case of *In re Page*, 51 USPQ2d 1660 (TTAB 1999), involved an intent-to-use applicant's failure to comply with the examining attorney's requirement for information as to the intended use of the mark. Noting that such a requirement constitutes grounds for refusal, the Board affirmed the refusal and stated that the request is relevant to the perception of a mark. The Board stated the following, which we find is relevant to the situation in this case:

Applicant's failure to respond completely to the examining attorneys' requests for information required the examining attorney to proceed with an incomplete understanding of how applicant's asserted mark is or will be used, and without materials which would have allowed the examining attorney to conduct a more thorough and informed evaluation of the issue of mere descriptiveness.

Applicant did not respond to the information request until its brief, where it appears to be avoiding a full response by simply stating that it has no marketing materials. During examination, the examining attorney clearly stated the type of information he was seeking and noted several ways in which applicant could comply to

explain the nature of its goods, particularly if no marketing materials were available. Beyond its statement about lacking marketing materials, applicant has provided no explanation for its failure to fully respond to the examining attorney's request for information, except to argue that the issue should, essentially, be deferred until it files its statement of use and specimen of use. If applicant truly has no information about the exact nature of its vacuum cleaner because, for example, it is still in the design stage, applicant should have so stated. On the one hand, applicant's goods are identified as "vacuum cleaners," which encompasses all types of vacuum cleaners for all types of uses. However, information about whether applicant's vacuum cleaners are intended or designed for use in a workshop environment and/or on or in connection with a workbench is quite relevant to the question of descriptiveness. If applicant had this information it should have divulged it now; as to do otherwise is likely to be a waste of USPTO time and resources, to say nothing of cost to applicant. As applicant itself notes, without any explanation from applicant about the intended nature and use of the goods, the examining attorney resorted to speculation about the exact nature of applicant's goods.



We affirm the refusal to register based on applicant's failure to fully comply with the examining attorney's request for information.

Decision: The refusal on the ground of mere descriptiveness under Section 2(e)(1) is reversed. The refusal on the ground that applicant failed to comply with the requirement for additional information is affirmed and registration to applicant is refused.