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This Opinion is Not Citable As Precedent of the TTAB
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re TruServ Corporation

Serial No. 78068851

Christopher J. Schulte and Kristine M. Boylan of Meagher & Geer for TruServ Corporation.

Elizabeth J. Winter, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Hanak, Holtzman and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

TruServ Corporation [applicant] has applied to register, on the Principal Register, the term WOOD CARE CENTER, as a mark for the following Class 35 services: "Retail hardware store services featuring wood care and related products, namely, paints, stains, protectants, sealants and finishes, and paint and stain accessories including brushes and rollers for the treatment of home remodeling and building materials."

The examining attorney has refused registration on the grounds that the proposed mark is merely descriptive of the identified services and that applicant's evidence of acquired distinctiveness is insufficient. See Trademark Act Sections 2(e)(1) and 2(f), 15 U.S.C. §§ 1052(e)(1) and 1052(f). When the refusal of registration was made final, applicant filed a notice of appeal and a request for reconsideration. After the Board acknowledged the appeal, the examining attorney considered, and denied, the request for reconsideration.

In this appeal, both applicant and the examining attorney have filed briefs, but applicant did not request an oral hearing. We affirm the refusal of registration.

The USPTO bears the burden of setting forth a prima facie case in support of a descriptiveness refusal. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). To establish a prima facie case for refusal, the examining attorney is not required to prove that the public would actually view a proposed mark as descriptive, but must establish a reasonable predicate for the refusal, based on substantial evidence, i.e., more than a scintilla of evidence. In re Pacer Technology, 338 F.3d 1348, 67 USPQ2d 1629 (Fed. Cir. 2003). When the examining attorney sets forth a prima facie case, the applicant cannot simply

criticize the absence of additional evidence supporting the refusal, but must come forward with evidence supporting its argument for registration. Gyulay, *supra*.

To carry her burden of proof, the examining attorney relies on dictionary definitions of "wood," "care" and "center"; applicant's prior registration of WOODCARE CENTER on the Supplemental Register for goods identified as "informational brochures about wood, wood care and wood related products, paper display signage and posters relating to wood, wood care and wood related products"¹; two Principal Register registrations of marks, not owned by applicant, which include the term WOODCARE and a disclaimer of the same²; numerous excerpts from the NEXIS database of articles; numerous web pages retrieved from the Internet; and records retrieved from the USPTO's system for searching registered and pending marks, such records including

¹ Registration no. 2454281 issued May 22, 2001 to TruServ Corporation.

² Registration no. 2187500 for the mark WOODCARE PLUS, for services identified as "restoration, refinishing and repair of fine millwork and cabinetry, including wood, veneer, and laminate surfaces; alteration and relocation of cabinetry, ongoing maintenance of millwork and cabinetry," issued September 8, 1998 to L.C.M. Associates, Inc. and includes a disclaimer of WOODCARE.

Registration no. 2297718 for an emblem including the words CABOT and PREMIUM WOODCARE SINCE 1877, for goods in two classes, including a variety of paints, stains, coatings, sealers, cleaners and the like for various building materials, including wood and wood-based siding, issued December 7, 1999 to Samuel Cabot, Incorporated and includes a disclaimer of PREMIUM WOODCARE and SINCE 1877.

information on five registered marks for various retail store services, with each mark including the term CENTER and a disclaimer of that term.³

The NEXIS excerpts show that "wood care" is a widely used term in conjunction with the care, refurbishing and protection of a wide variety of products made of wood, including indoor wood flooring and furniture and outdoor wood decking or furniture. The excerpts are replete with references to wood care products, wood care services provided by various entities, wood care experts, wood care kits, wood care tips wood care guides and the like. Likewise, the numerous web pages retrieved by the examining attorney from the Internet show much the same, in terms of usage of "wood care." One article headlined "Great Ideas" in the "Home" section of the South Bend Tribune includes the statement "For free brochures about household cleaning and wood care, call [800] 486-7627 or go to Murphy's Wood Care Center at www.murphyoilsoap.com." Similarly, the web page for FurnishMagazine.com includes a list of links to online resources focusing on "Wood Furniture Care and

³ The registration for NAPA AUTOCARE CENTER and design includes a disclaimer of CENTER; the registration for NAPA AUTOCARE COLLISION CENTER and design includes a disclaimer of COLLISION CENTER; the registration for ORECK HOME CARE CENTER includes a disclaimer of HOME CARE CENTER; the registration for ORECK FLOOR CARE CENTERS includes a disclaimer of FLOOR CARE CENTERS; and the

Restoration Help..." and there is a link to "Murphy's Wood Care Center," a site summarized by the following statement "The experts from Murphy's Oil Soap explain how to protect your wood from dust, wax, and water."

Applicant's contributions to the record speak only to the alternative question whether WOOD CARE CENTER has acquired distinctiveness as a mark for applicant's retail hardware store services featuring wood care and related products. We discuss the two declarations offered in support of the alternative argument for registration *infra*.

It is, of course, well settled that the question whether a term is merely descriptive is determined not in the abstract but, rather, in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser or user of the goods or services. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979) and In re Recovery, 196 USPQ 830, 831 (TTAB 1977).

On the record created by the examining attorney, we have no doubt that "wood care" is a highly descriptive term

registration for AMERICAN HEALTH CARE CENTER includes a disclaimer of HEALTH CARE CENTER.

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when used in conjunction with retail hardware store services featuring, inter alia, wood care products. In addition, we find that a retail hardware store featuring a collection of specialized products is aptly described by the word "center," a word with many definitions, one of which is "a store or establishment devoted to a particular subject or hobby, carrying supplies, materials, tools, and books as well as offering guidance and advice: a garden center; a nutrition center."⁴

Considered as a whole, WOOD CARE CENTER immediately informs prospective customers for retail hardware store services featuring, inter alia, wood care products, that a store, or section thereof, so designated, will contain wood care products and related items. There would be no need for these customers to have to engage in any mental reasoning whatsoever to reach this conclusion. See Vision Center v. Opticks, Inc., 596 F.2d 111, 202 USPQ 333 (5th Cir. 1979), cert. denied, 444 U.S. 1016 (1980) ("[I]t simply does not require an effort of the imagination to decide that a 'vision center' is a place that one can get glasses."). We are not persuaded otherwise by applicant's

⁴ The Random House Dictionary of the English Language 335 (2nd ed. 1987). The Board may take judicial notice of dictionary definitions. See University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

argument that WOOD CARE CENTER only "gives a vague impression that it relates to *some thing* which relates to wood" (emphasis by applicant). Nor are we persuaded by applicant's argument that the products it sells only "color or protect wood surfaces." As the examining attorney's evidence shows, caring for wood and protecting wood are virtually synonymous concepts.

A proposed mark is considered merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately conveys information about an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-218 (CCPA 1978); see also In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. In re Venture Lending Associates, 226 USPQ 285 (TTAB 1985). Thus, it is not necessary, in this instance, that a prospective customer of applicant's services be immediately apprised of the full panoply of products available from applicant's hardware store featuring wood care and related products.

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It is sufficient that such a customer will immediately know the nature and type of products available, even without knowing the particular products.

Finally, we have no doubt about our conclusion that WOOD CARE CENTER is descriptive for the identified services. Thus, we need not, as applicant urges, resolve doubt in its favor and publish the designation for opposition, where "competitors or others will have the opportunity to pose an opposition."

We turn then, to applicant's alternative argument that WOOD CARE CENTER has acquired a secondary meaning and now serves as a mark for applicant's services. To begin, WOOD CARE CENTER is highly descriptive and, therefore, requires a stronger showing of acquired distinctiveness before it can be registered. In re K-T Zoe Furniture Inc., 16 F.3d 390, 29 USPQ2d 1787, 1788-899 (Fed. Cir. 1994) (Court affirmed Board's finding that the words "The Sofa & Chair Company" were not generic, but were aptly descriptive of "custom manufacturing of furniture upholstered with fabrics furnished or pre-selected by customers," and held that the degree of acquired distinctiveness that must be shown varies with the degree of descriptiveness of the term). Put simply, the more descriptive the term, the more evidence of secondary meaning must be shown for a term to

attain registration. Yamaha Int'l Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988) ("[L]ogically that standard becomes more difficult as the mark's descriptiveness increases.").

In the case at hand, applicant's evidence of acquired distinctiveness consists of two declarations and a photograph showing the section of one of its stores wherein the sign WOOD CARE CENTER appears. As for the photograph, we note that it features WOOD CARE CENTER in two places, one of which is under the term WOODSMAN. In neither display does WOOD CARE CENTER bear a "tm" or other designation indicating it is claimed as a mark; nor is the designation used with some other generic description of the collection of featured products, so as to differentiate WOOD CARE CENTER. In short, we find that applicant's prospective customers would, viewing such signage, immediately perceive the signage as indicating the nature of the contents of this section of the store and nothing more. The signs cannot be considered "look for" advertising or anything that would promote recognition of WOOD CARE CENTER as a mark rather than as a descriptive store aisle or store section designation.

As for applicant's declarations, the first is by applicant's "Paint Products, Store Fixtures and Décor

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Manager," David Vermilya. In his declaration, Mr. Vermilya states that applicant is a hardware cooperative and its 6,000 member stores make 12 billion dollars in retail sales each year. Mr. Vermilya also states that 247 stores have established a WOOD CARE CENTER; that these stores accounted for WOOD CARE CENTER revenue of \$6,768,000 in 1999, \$6,481,000 in 2000, and \$7,000,000 in 2001; that applicant does not track per store sales of WOOD CARE CENTER products "but a conservative estimate of sales of these products" would amount to \$239,223 per store in 1999, \$229,079 in 2000, and \$247,424 in 2001. Doing the math ourselves, we come out with per store revenue figures for each of the three years of \$27,401 for 1999, \$26,239 for 2000, and \$28,340 for 2001.

Mr. Vermilya also notes the 247 stores have spent \$569,650 on WOOD CARE CENTER "signage materials." We figure this to be approximately \$2,306 per store. It is unclear whether the per store cost covers signs alone or the shelving and display materials which show the signs and products.

A second and more recent declaration, from Tracy Polyak, a paralegal in applicant's Legal Department, has been used to introduce what is said to be a spreadsheet

listing 454 stores that feature a WOOD CARE CENTER. The attachment, however, is virtually unintelligible.

Even if we assume that applicant has, in fact, boosted the number of stores featuring a WOOD CARE CENTER from 247 to 454, neither declarant attests to any advertising or promotion of the involved designation. We are not convinced that a few years worth of use, even if we assume it has been continuous and substantially exclusive⁵, by a fraction of applicant's 6,000 member stores establishes that WOOD CARE CENTER has taken on a secondary meaning as a mark. Nor do we find per store expenditures of approximately \$2,300 on display materials and annual per store revenue from sales of displayed products of approximately \$26,000 to \$28,000 to establish acquired distinctiveness.⁶

Applicant has failed to meet its burden of establishing that WOOD CARE CENTER has acquired distinctiveness as a mark for the identified services. "There is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the

⁵ Mr. Vermilya attests to "continuous and substantial use" since January of 1999, but does not claim the use to be "substantially exclusive" to applicant.

⁶ Mr. Vermilya has an alternative theory by which he estimates "that millions of consumers around the nation have been exposed

applicant." In re Hollywood Brands, Inc., 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954). See also, In re Leatherman Tool Group Inc., 32 USPQ2d 1443, 1450 (TTAB 1994) ("Absent, therefore, anything to link applicant's gross sales of over \$20 million and advertising expenditures of \$200,000, which were generated and spent in connection with its marketing of in excess of one million tools during a nearly ten-year period, with use in contexts which would condition customers to react to or recognize the designation 'POCKET SURVIVAL TOOL' as an indication of source rather than as a description of a category of product, there is no convincing basis for finding that such designation functions other than as a generic name").

Decision: The refusal of registration is affirmed, both under Section 2(e)(1), because WOOD CARE CENTER is descriptive, and under Section 2(f), because applicant has failed to prove by a preponderance of the evidence that WOOD CARE CENTER has acquired distinctiveness.

to the mark." Vermilya dec. paragraph 7. However, the math is clearly faulty and his conclusion is therefore doubtful at best.