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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Weldkit, Inc.

Serial No. 78521325

Kit M. Stetina of Stetina Brunda Garred & Brucker for
Weldkit, Inc.

Robert Clark, Trademark Examining Attorney, Law Office 101
(Ronald R. Sussman, Managing Attorney).

Before Quinn, Bucher and Grendel, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Weldkit, Inc. filed an application to register the
mark WELDKIT for "suspension systems for automobiles" in
International Class 12.¹

The examining attorney refused registration under
Section 2(e)(1) of the Trademark Act on the ground that
applicant's mark, as applied to applicant's goods, is
merely descriptive thereof.

¹ Application Serial No. 78521325, filed November 22, 2004,
alleging a bona fide intention to use the mark in commerce.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.

The examining attorney's position is that the term sought to be registered "immediately and logically conveys that applicant provides suspension systems for automobiles that include a kit for welding." (Brief, unnumbered p. 8). In support of the refusal, the examining attorney submitted dictionary definitions of the terms "weld" and "kit"; and portions of five third-party websites retrieved from the Internet.

Applicant argues that its applied-for mark is just suggestive in that WELDKIT "does not communicate a clear understanding of the characteristics of [applicant's] goods." (Brief, p. 4). According to applicant, the proposed mark is simply too broad to describe the goods with immediacy and particularity. Further, applicant states, its goods are "bolt-on" suspension systems that do not require welding. Applicant asserts that its mark is taken from its corporate name, Weldkit, Inc., and that this name is derived from the founder's surname, "Weld." In responding to the examining attorney's evidence, applicant contends that three of the websites have nothing to do with automobile suspension systems. Applicant further points out that another of the websites, while involving

instructions for welding a suspension, does not specifically use the terms "weld kit," "welding kit" or "kit for welding." The final website, according to applicant, does not use "weld kit" to specifically describe the suspension system.

The term "weld" is defined as "to join (metals) by applying heat, sometimes with pressure and sometimes with an intermediate or filler metal having a high melting point." The term "kit" is defined as "a set of articles or implements used for a specific purpose; a container for such a set." The American Heritage Dictionary of the English Language (3d ed. 1992).

Three of the Internet websites introduced by the examining attorney refer to "weld kits." As pointed out by applicant, however, this evidence is not probative to show mere descriptiveness for automobile suspension systems. The articles respectively involve fiberglass vinyl ester butt weld kits, aircraft plastic repair weld kits, and fiberglass hole repair kits. These references, directed to various welding applications, have nothing to do with automobile suspension systems.

The record includes a portion of another website, this one involving what appears to be automobile suspensions. (www.hnmotorsports.com) The website includes the following

language: "Tig weld shown is not standard with this mig weld kit. Please contact us for pricing on the tig welded option." In the absence of further explanation or context, we are unsure as to the significance of "tig weld" and "mig weld kit" to suspension systems. Given our uncertainty, we do not find this evidence particularly helpful in resolving the descriptiveness question.

Lastly, there is an excerpt from a website addressing an "Axle Welding Procedure." The excerpt essentially comprises a set of instructions for welding an axle in a suspension system. Although the terms "weld" and "welding" appear in the excerpt, there is no use of the term "weld kit" or variations thereof.

A term is merely descriptive "if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods." In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). The examining attorney bears the burden of showing that a mark is merely descriptive of the relevant goods. In re Merrill, Lynch, Pierce, Fenner, and Smith Inc., 82 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

We find that the present record falls short of establishing the mere descriptiveness of WELDKIT for automobile suspension systems. Although the individual

words comprising applicant's mark have meanings, the combination does not convey an immediate quality about the goods with any degree of particularity. *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199, 1204-05 (TTAB 1981).

In reaching our conclusion we obviously considered the two instances that show the use of welding procedures in connection with suspension systems. We are at a loss, however, to ascertain, with any degree of certainty, whether welding is an isolated procedure or a common practice in the automobile suspension field. There is nothing in the record to show that something called a "weld kit" is commonly used in connection with suspensions, or even that welding of suspensions is a common industry practice. The evidence likewise does not show that the term "weld kit" is used to market automobile suspension systems. In sum, the sparse record does not establish that "weld kit" is in common use for automobile suspension systems such that we could conclude that WELDKIT is merely descriptive. In *re Stroh Brewery Co.*, 34 USPQ2d 1796, 1797 (TTAB 1994) [the fact that a term may be descriptive of certain goods is not determinative of whether it is descriptive of other goods, even if the goods are closely related].

The Board has noted on a number of prior occasions that there is a thin line of demarcation between a suggestive and a merely descriptive designation. This case boils down to a failure of proof, and we find that the mark sought to be registered does not fall in the merely descriptive category.² To the extent that the Examining Attorney's arguments cast doubt on our finding, such doubts are to be resolved in applicant's favor. See, e.g., *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992); *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981); and *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

Decision: The refusal to register is reversed.

Bucher, Administrative Trademark Judge, dissenting:

Although the Office has provided scant evidence in support of this refusal, I respectfully dissent.

Applicant intends to market "kits" having suspension components for land vehicles. The record demonstrates that there is a market for suspension lift kits designed for

² When this mark proceeds to publication, a competitor in the automobile suspension field is free to file an opposition grounded on mere descriptiveness. Such an opposer is in a much better position to introduce probative evidence on mere descriptiveness than is the examining attorney. It is quite possible that on a fully developed record, a different result may be reached.

performance vehicles, like Ford trucks.³ Applicant even argues that the word "kit" in applicant's mark may be perceived by some as representing a "kitten"! This is among applicant's arguments that I cannot take seriously.

As noted by the majority, at least two websites in the record show that these aftermarket components may require welding. Whether one joins the metals using "metal inert gas" or "tungsten inert gas" welding, to the relevant consumer, the term "weld kit" will immediately convey information about the nature of these suspension components. On the other hand, to the extent these goods will be used in connection with "bolt-on" kits, as applicant argues, the mark should be refused under Section 2(e)(1) of the Act as being deceptively misdescriptive. Either way, it benefits applicant not at all that the surname of applicant's principal is "Weld."

Accordingly, I would affirm this refusal to register.

³ See <http://www.hnmmotorsports.com/>