

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Chestek

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Serial No 85072195

Pamela S. Chestek, Esq., *pro se*.

Laura Kovalsky, Trademark Examining Attorney, Law Office 110,
(Chris A.F. Pedersen, Managing Attorney).

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Before Quinn, Bucher and Hightower,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Pamela S. Chestek filed, on June 25, 2010, an application to register the term **Property, intangible** (in standard characters) for “on-line journals, namely, blogs featuring information on intellectual property law” in International Class 41. Applicant alleges first use anywhere and first use in commerce on June 26, 2008.

The trademark examining attorney originally refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that applicant’s mark, when used in connection with the services, is merely descriptive thereof.

In response to the refusal, applicant contended that the mark is inherently distinctive but claimed, in the alternative, that the mark has acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f). *See* TMEP § 1212.02(c) (Oct. 2012); and TBMP § 1215 (3d ed. 2012). The examining attorney continued the mere descriptiveness refusal under Section 2(e)(1), but also indicated that applicant's evidence was sufficient to show the mark had acquired distinctiveness and, accordingly, was registrable under the provisions of Section 2(f).

Accordingly, as applicant acknowledges in her own words, "the present appeal is on the sole issue of whether the applied-for mark is inherently distinctive. Applicant will accept registration under Section 2(f) if she is unsuccessful in reversing the refusal under Section 2(e)(1)." (Appeal Brief, p. 1).

Applicant argues that the term "Property, intangible" has no defined meaning, differing from the phrase "intangible property"; according to applicant, "[w]ord order matters." (Appeal Brief, p. 2). In this regard, applicant asserts that the reverse word order and the addition of a comma are sufficient features to change the commercial impression of the phrase, contending that such changes can transform a unitary phrase into an arbitrary, if not unintelligible designation. Applicant proffers the examples "corpus, habeas," "market, gray," "use, fair," "amendment, first" and "planning, estate." Moreover, applicant points to the absence of any evidence showing that the unitary phrase "intangible property" is ever reversed to "property intangible," with or without a comma. Thus, applicant urges that her mark is just suggestive because it comprises an unnatural, incongruous combination. At bottom, the mark comprises a unitary phrase

(“intangible property”) rearranged in an unexpected manner (“Property, intangible”): “[A]pplicant placed the word ‘property’ first and, by separating it from the following word with a comma, asks the reader to pause so that the reader would first react to the meaning of the word ‘property’...the word ‘property’ draws the reader’s attention to the tangible and conveyable aspects of property before inviting the reader to enter the world of the challenges in applying these principles in an ‘intangible’ context.” (Appeal Brief, pp. 6-7). In this connection, applicant relies on a Second Circuit case and two unpublished Board decisions wherein a reversal of word order resulted in findings that the terms were not merely descriptive. According to applicant, the target audience of her services comprises intellectual property attorneys and, when responding to applicant’s request for a declaration on the question of acquired distinctiveness, they stated that the mark sought to be registered has no merely descriptive meaning to them. Lastly, applicant urges that any doubt on the issue of mere descriptiveness must be resolved in her favor. In support of her position, applicant submitted copies of two unpublished Board opinions,¹ a dictionary definition of the word “property,” statements from fellow intellectual property attorneys, and information related to searches for applicant’s

¹ Although parties are not prohibited from citing non-precedential cases, the Board does not encourage this practice. *Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1875 n.5 (TTAB 2011). *See In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1151 n.7 (TTAB 2011) (“While practitioners may cite to [non-precedential] decisions, they are not binding on the Board. TBMP § 101.03 (3d ed. 2011). Since they have no precedential effect, the Board will generally not discuss them in other decisions.”). *See also* TBMP 1203.02(f) (3d ed. 2012). In view thereof, we see no need to discuss the two unpublished cases in this opinion. We would add, however, that our research also revealed no fewer than six non-precedential cases wherein the Board affirmed a Section 2(e)(1) refusal of a transposed term.

blog using Google's search engine (showing that "property intangible" is the third highest search query driving traffic from the search engine to applicant's blog).

The examining attorney maintains that the term sought to be registered immediately informs readers of applicant's blog that the featured subject matter of the blog is intangible property. The reversal of word order and addition of a comma do not diminish the merely descriptive nature of the term "Property, intangible." To highlight the point, the examining attorney relies upon the public's exposure and understanding of the "item, type of" and "last name, first name" formats commonly used in other contexts. In support of the refusal, the examining attorney introduced dictionary definitions of "intangible property" and "intellectual property,"² excerpts of third-party websites, and excerpts of a variety of publications.

A mark is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828 (TTAB 2007); and *In re Abcor Development*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A mark need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; rather, it is sufficient that the mark describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a

² The request to take judicial notice of the latter definition is granted. *See Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

mark is merely descriptive is determined not in the abstract, but 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 the goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services because of the manner of its use. *In re Chamber of Commerce of the USA*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). It is settled that “[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them.” *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002).

It is beyond dispute that the term “intangible property” is commonly used and has a well understood meaning in the legal field. As shown by the dictionary definitions of record, the term encompasses property that has value but cannot be seen or touched, and that such property includes patents, trademarks and copyrights, all forms of intellectual property, which is the featured subject of applicant’s blog. Applicant readily acknowledges that the target audience for her blog is intellectual property attorneys (Appeal Brief, p. 7); we obviously presume that these individuals are acutely aware that intellectual property is a type of intangible property. *See In re Cox Enterprises Inc.*, 82 USPQ2d 1040, 1042 (TTAB 2007), *citing In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) (Descriptiveness must be determined from the perspective of the relevant class or classes of actual or prospective purchasers for applicant’s goods).

When these knowledgeable customers encounter applicant's proposed mark, the transposition of the term "intangible property" to "Property, intangible" would not evoke a new and unique commercial impression that is inherently distinctive. Rather, relevant consumers would readily understand that the transposed term still immediately conveys direct information about the subject matter of the blog. A mere change in word order in this case does not automatically result in a mark that is inherently distinctive. That is to say, merely reversing the word order of "intangible property" to "Property, intangible" in an "item, type of" format does not give the term the modicum of distinctiveness to make it inherently distinctive. No imagination or multistage reasoning process is required by intellectual property attorneys, the group that applicant claims is her target audience, to discern that applicant's blog features information about a type of intangible property, more specifically, intellectual property. *See In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778 (Fed. Cir. 2003). The proposed mark merely describes the subject matter of the blog, and someone who knows what those services are will readily understand the proposed mark to convey information about them.

The transposition of the commonly used and recognized term "intangible property" does not change the overall commercial impression, that is, the transposed mark "Property, intangible," in an "item, type of" format, does not create any incongruity; rather, the term creates the same or highly similar commercial impression as "intangible property." *See In re Dairimetics, Ltd.*, 169 USPQ 572, 573 (TTAB 1971) (Board affirmed refusal of registration on the Supplemental Register of **ROSE MILK** for body creams based on finding that **ROSE MILK** is synonymous

with “Milk of Roses,” a descriptive name for a rose-scented cosmetic preparation); and *In re Vasco Metals Corp.*, 154 USPQ 191, 192-93 (TTAB 1967) (“The mere transposition of words is generally insufficient to create trademark rights in an otherwise recognizable common descriptive term or designation. However, we cannot preclude the possibility that, under appropriate circumstances and conditions, an inverted term such as that involved herein may possess the capacity to distinguish the applicant’s goods.” Registration permitted on the Supplemental Register of **DIE GROUND** for tool steel bars, although the evidence showed that “ground die steel” was a common descriptive name for a particular type of steel, in view of persuasiveness of ten affidavits from purchasers of steel who state that they associate **DIE GROUND** only with applicant.).

In the analogous context of likelihood of confusion under Section 2(d), 15 U.S.C. § 1052(d), where the primary difference between the marks is the transposition of the elements that compose the marks, and where this transposition does not change the overall commercial impression, the similarity between the marks may be a basis on which to find a likelihood of confusion. *Cf., e.g., In re Wine Soc’y of Am. Inc.*, 12 USPQ2d 1139 (TTAB 1989) (**THE WINE SOCIETY OF AMERICA** and **AMERICAN WINE SOCIETY**); *In re Nationwide Indus., Inc.*, 6 USPQ2d 1882 (TTAB 1988) (**RUST BUSTER** and **BUST RUST**); and *In re Gen. Tire & Rubber Co.*, 213 USPQ 870 (TTAB 1982) (**SPRINT STEEL RADIAL** and **RADIAL SPRINT**). Further, the use of punctuation generally is not enough to create a different commercial impression. *See DuoProSS Meditech Corp. v. Inviro Medical Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (**SNAP!** and design is merely descriptive for “medical devices,

namely, cannulae; medical, hypodermic, aspiration and injection needles; medical, hypodermic, aspiration and injection syringes”); and *In re Vanilla Gorilla L.P.*, 80 USPQ2d 1637, 1639-40 (TTAB 2006). In the present case, the proposed transposition to form “Property, intangible” evokes substantially the same if not identical meaning and commercial impression as “intangible property.”

Our view that intellectual property attorneys will equate “Property, intangible” with “intangible property” is buttressed by the examining attorney’s evidence showing reverse word order uses such as “item, type of” (e.g., “Instruments, musical”) for tangible goods in catalogs, and “last name, first name” (e.g., “Smith, Aaron) in phone directory listings. Although we recognize the obvious differences in context from the present use, the examples show that reverse order uses (with a comma) have some public exposure. Given such usage, we find that the present circumstances are different from the cases relied upon by applicant and, thus, find them to be distinguishable from the present case on their facts.

Applicant’s argument based on the absence of any evidence showing even a single use of “Property, intangible,” despite the vast resources available to the examining attorney, such as Internet search sites and publications, is not persuasive. As often stated, the fact that applicant may be the first and only user of a merely descriptive designation does not justify registration if the only significance conveyed by the term is merely descriptive. *See In re Nat’l Shooting Sports Found., Inc.*, 219 USPQ 1018 (TTAB 1983). Further, that a term is “malformed” or otherwise is not found in a dictionary is not controlling on the question of registrability if the examining attorney can show that the term has a recognized

meaning, as is the case herein. *See Cummins Engine Co., Inc. v. Continental Motors Corp.*, 359 F.2d 892, 149 USPQ 559, 561 (CCPA 1966); *Flexitized, Inc. et al. v. National Flexitized Corp. et al.*, 335 F.2d 774, 142 USPQ 334, 338 (2d Cir. 1964), *cert. denied*, 144 USPQ 780 (1965); and *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977) (**BREADSPRED** held merely descriptive of jellies and jams).

We also are not persuaded by the declarations of intellectual property attorneys that were submitted in support of applicant's claim of acquired distinctiveness. Indeed, while all of the declarants state that the applied-for term serves as a source indicator, and some make the conclusory statement that the term is inherently distinctive, only one actually asserts that "imagination is required to reach a conclusion as to the nature of the services [applicant is] providing under the name."

Lastly, applicant's Google evidence and argument based thereon is more probative in showing acquired distinctiveness than it is in establishing inherent distinctiveness.

Decision: The refusal to register on the ground of mere descriptiveness is affirmed. The application will proceed under Section 2(f).

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Bucher, Administrative Trademark Judge, dissenting:

Because I disagree with the majority that the refusal to register in this case is appropriate, I respectfully dissent. And yes, I am cognizant of the fact there is very little at stake in this determination inasmuch as Ms. Chestek is assured of having her mark published for opposition irrespective of how we hold on Section 2(e)(1).

Under our precedent, a mark is suggestive if, when the goods or services are encountered under the mark, a multi-stage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. *See, e.g., Abcor Development Corp.*, 200 USPQ at 218; and *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1349 (TTAB 1984). As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992) and *In re TMS Corp. of the Americas*, 200 USPQ 57, 58 (TTAB 1978). The distinction, furthermore, is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. *See In re George Weston Ltd.*, 228 USPQ 57, 58 (TTAB 1985).

In any case, we must focus on the composite mark, **Property, Intangible**, in its entirety, and exactly as presented. *In re Wisconsin Tissue Mills*, 173 USPQ 319, 320 (TTAB 1972) (**POLYTISSUE** is not merely descriptive of combination paper and plastic table covers). In this context, applicant argues that even if the unitary phrase, “Intangible Property,” is deemed to be highly descriptive of the contents of her blog, the combination **Property, Intangible** creates a distinct commercial impression. I agree.

The examining attorney bears the burden of showing that a mark is merely descriptive of the identified goods or services. I find that the examining attorney has failed to cite to any reported cases that are on-point. Logically, this designation

is not analogous to phone book listings of “Last name, first name.” It is not analogous to “Item, type of.” It is not analogous to the mere insertion of surprising punctuation. It is not analogous to reported cases of a simple reversed order word, nor is it a case of a misspelled term.

Rather, with a reversal of the word order and the insertion of a comma, one experiences a sudden pause, a mental hiccup. Rolling this designation across one’s tongue creates a momentary aural awkwardness bordering on the poetic. **Property, Intangible** breaks apart a unitary term, and when reassembled in this new form, it creates an incongruity that requires a multi-stage reasoning process or imagination in order for readers of applicant’s blog to be able, perhaps, to ascribe any particular significance to the phrase when used in connection with applicant’s services. In the case at bar, this manipulation of the presentation results in a mark that is no more than suggestive of applicant’s services. *See Aluminum Fabricating Co. v. Season All Window Corp.*, 259 F.2d 314, 119 USPQ 61 (2nd Cir. 1958) (SEASON ALL, unlike the term ALL-SEASON, is not merely descriptive of aluminum storm windows and doors).

Moreover, the well-understood meaning of “intangible” as “elusive” provides for applicant a playful double entendre. Readers of the **Property, Intangible** blog often struggle along with the author over complex intellectual *property* ownership disputes of a most *elusive* nature. This alternate connotation sets in motion sufficient mental gymnastics for me to conclude that this mark is suggestive – not merely descriptive. Accordingly, when one is asked to place this coined term at the

appropriate spot along the continuum of distinctiveness, I would contend that this degree of creativity alone should prove sufficient to move this mark onto the suggestive/distinctive side of the thin line of demarcation. The declarations of intellectual property attorneys indicate that readers of applicant's blog perceive the composite mark as an inherently distinctive source indicator, and they would never use the term "Property, intangible" to refer to the subject matter of this blog. Certainly, to the extent that this specific formulation creates a doubt about whether Section 2(e)(1) should serve as a bar in this case, or contrariwise, whether the mark, at worst, may be suggestive of the named services, it is our wont to resolve such doubt in favor of the publication of applicant's mark for opposition. *See, e.g., In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981) and *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

An unstated fear of the majority may be that a reversal herein would open the floodgates to all kinds of simple marks having only the formulation, for example, of "Item, type of" used in connection with industrial supplies, as characterized by the examining attorney. However, unless the hypothetical future applicant can articulate a double entendre or demonstrate an apparent incongruity in the combination of the words, a reversal in this case would not create a slippery slope requiring the publication (or issue) by examining attorneys of all such future marks.

Accordingly, I would reverse the examining attorney's refusal to register the mark **Property, Intangible** under Section 2(e)(1) of the Lanham Act.