

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: February 25, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Western Industries, Inc.
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Serial No. 85076800
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Michael J. Gratz, Boyle Fredrickson, S.C. for Western Industries, Inc.

Josette M. Beverly, Trademark Examining Attorney, Law Office 112 (John Lincoski, Managing Attorney).
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Before Bucher, Shaw and Kuczma, Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Western Industries, Inc. (“applicant”) filed an intent-to-use trademark application to register the following mark in standard character format:¹

Premium. Reliable.
Performance.

for the following goods identified in the application:

Cooking ovens; Cooking ranges; Electric cooktops; Electric food warmers; Electric stoves; Electric towel warmers; Extractor hoods for kitchens; Gas stoves; Plate warmers.

¹ Application Serial No. 85076800 was filed on July 2, 2010, based upon applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

The Trademark Examining Attorney issued a final refusal to register the applied-for mark pursuant to Section 2(e)(1) of the Trademark Act of 1946, 15 U.S.C. § 1052(e)(1), on the ground that the mark is merely descriptive of the goods. Applicant appealed the final refusal and requested reconsideration, which was denied. The appeal is fully briefed. For the reasons set forth below, the refusal to register is affirmed.

Descriptiveness

A term is deemed to be merely descriptive of goods, within the meaning of Trademark Act § 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 Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 813-814, 200 USPQ 215, 217-218 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods. *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2051 (TTAB 2012); *In re H.U.D.D.L.E.*, 216 USPQ 358, 359 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338, 339 (TTAB 1973).

Applicant's applied-for mark was refused registration on the grounds that the individual components as well as the composite slogan are descriptive and that the slogan is laudatory. In support of the refusal, the examining attorney submitted the following definitions:

Premium:²

(noun)

1. cost of insurance: the sum of money paid, usually at regular intervals, for an insurance policy. . .
2. additional sum . . .

(adjective)

1. high-quality: higher than normal, especially in price
2. unusually high: higher than normal, especially in price

<http://encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?refid=1861737244>

Reliable:³

(adjective)

1. dependable: able to be trusted to do what is expected or has been promised . . .
2. likely to be accurate: able to be trusted to be accurate or to provide a correct result

<http://encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?refid=1861700303>

Performance:⁴

(noun)

- 1 a: the execution of an action
b: something accomplished . . .
- 2 : the fulfillment of a claim, promise, or request: implementation

² See attachment to October 8, 2010 Office Action.

³ See attachment to October 8, 2010 Office Action.

⁴ See attachments to October 8, 2010 Office Action and April 4, 2011 Final Office Action.

3 a: the action of representing a character in a play

b: a public presentation or exhibition <a benefit performance>

4 a: the ability to perform: efficiency

b: the manner in which a mechanism performs, engine performance

<http://www.merriam-webster.com/dictionary/performance>

(noun)

1. artistic presentation . . .

2. manner of functioning: the manner in which something or somebody functions, operates or behaves; *a high performance car*

3. working effectiveness: the way in which somebody does a job judged by its effectiveness (often used before a noun); *performance-related pay*

<http://encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?refid=1861724999>

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods for which registration is sought, the context in which it is being used on or in connection with those goods, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use. *See In re Chamber of Commerce of the United States*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 964, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re Omaha Nat'l Corp.*, 819 F.2d 1117, 1119, 2 USPQ2d 1859, 1861 (Fed. Cir. 1987); and *Abcor Dev.*, 588 F.2d at 814, 200 USPQ at 218. That a term may have other meanings in different contexts is not controlling. *In re Franklin County Historical Society*, 104 USPQ2d 1085,

1087 (TTAB 2012) and *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). 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, 1316-1317 (TTAB 2002); *see also In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); and *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

In light of the foregoing definitions of “premium,” “reliable” and “performance,” it is apparent that these words are used in a laudatory manner to describe applicant’s cooking appliances. “Premium” describes the quality of the goods; “Reliable” indicates that the goods are dependable; “Performance” describes the efficiency of the goods. These words laud the quality of the goods and as such, are merely descriptive of them.

Laudatory terms that attribute quality or excellence to goods are considered merely descriptive. Thus, laudatory terms, phrases and slogans are nondistinctive and unregistrable without proof of distinctiveness. *See In re Nett Designs, Inc.*, 236 F.3d 1339, 1341, 57 USPQ2d 1564, 1565 (Fed. Cir. 2001); *In re Boston Beer Co. L. P.*, 198 F.3d 1370, 1373, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999); *In re The Place, Inc.*, 76 USPQ2d 1467 (TTAB 2005); *In re Dos Padres, Inc.*, 49 USPQ2d 1860, 1861 (TTAB 1998); *In re Ervin*, 1 USPQ2d 1665, 1667 (TTAB 1986). Here, the record is silent with respect to the acquired distinctiveness of the applied-for mark.

Applicant correctly contends that when determining descriptiveness, the mark must be considered in its entirety.⁵ A mark, such as applicant's applied-for mark, that is composed of a combination of merely descriptive terms is registrable if the combination creates a unitary mark with a unique incongruous or otherwise nondescriptive meaning in relation to the goods. *See, e.g., In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (CCPA 1968).

Applicant argues its applied-for mark is not a combination that results in a composite mark that is descriptive. According to applicant, the applied-for mark is not merely a listing of three adjectives that retain their descriptive meaning. Rather, it signifies a level of performance with "the term 'performance' chang[ing] to become a noun" which is then modified by the adjectives "premium" and "reliable." As a noun, the word "performance" is not capable of being descriptive of the goods, and therefore, applicant concludes that the applied-for mark as a whole is not descriptive.⁶

As shown by the dictionary definitions, the individual words in the applied-for mark are descriptive of applicant's goods and the combination of the words does not alter their meanings or otherwise convert the composite into a nondescriptive mark. Regardless of whether the word "performance" functions as a noun or an adjective, there is nothing in the context of the applied-for mark that changes its descriptive meaning with respect to applicant's goods.

⁵ Applicant's Appeal Brief pp. 4, 8.

⁶ Applicant's Appeal Brief pp. 8-9.

The fact that the three words in applicant's applied-for mark are followed by periods does not alter the meaning of the individual words or their composite. Punctuation does not ordinarily change a descriptive term into a nondescriptive term and we see no reason why the inclusion of the periods in applicant's applied-for mark detracts from its descriptiveness. *See, e.g., DuoproSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 1252-1254, 103 USPQ2d 1753, 1756-1758 (Fed. Cir. 2012) (finding SNAP!, with a broken exclamation point, merely descriptive of medical syringes using snap-off plungers); *In re Litehouse, Inc.*, 82 USPQ2d 1471, 1474 (TTAB 2007) (CAESAR! CAESAR! merely descriptive of salad dressing); *In re Vanilla Gorilla, L.P.*, 80 USPQ2d 1637, 1639 (TTAB 2006) (finding that the presence of a hyphen in the mark "3-0's" does not negate mere descriptiveness of mark for automobile wheel rims); *In re Promo Ink*, 78 USPQ2d 1301, 1305 (TTAB 2006) (finding that the exclamation mark in the mark PARTY AT A DISCOUNT! "simply emphasize[d] the descriptive nature of the mark" for advertising services in the field of private party venues); and *In re Brock Residence Inns, Inc.*, 222 USPQ 920, 922 (TTAB 1984) (FOR A DAY, A WEEK, A MONTH OR MORE! merely descriptive of hotel services). In fact, the periods in the applied-for mark reinforce the significance of each individual word. Accordingly, when combined, the words contained in the applied-for mark do not form a unique incongruous meaning rather, they retain their descriptive laudatory meanings.

The internet evidence also shows that the words contained in applicant's applied-for mark are laudatory terms that are commonly employed by others in the

cooking appliance industry to describe desirable qualities of their appliances. For example (emphasis added):⁷

- Ovens – Why pay a **premium** for high end brands?

. . . there is no doubt that ovens are essential so surely it would be better to invest in one which will last longer and be more **reliable** . . . **Premium** brands often offer a selection of products . . . **Premium** ovens are from brands such as . . . **premium** ovens are **premium** for a reason . . .

http://webcache.googleusercontent.com/search?q=cache:2Qh6s51TE4QJ:www.articlealley.com/article_787465_27.html+premium+and+reliable+ovens&cd=2&hl=en&ct=clnk&gl=us&source=www.google.com 04/04/2011 08:23:29 AM

- Bosch Appliances

Bosch built-in ovens . . . will very likely meet your expectations for a **premium**-brand appliance. Bosch ovens are high quality and **reliable** . . .

<http://webcache.googleusercontent.com/search?q=cache:qxzF8c3Yi8wJ:www.elgotkitchens.com/bosch.php+premium+and+reliable+ovens&cd=28&hl=en&ct=clnk&gl=us&source=www.google.com> 04/04/2011 08:51:31 AM

- Bosch Ovens – design excellence

. . . Bosch appliances not only delivers on its promise of **performance** . . . offers smart, enduring and **reliable** technology . . . The childproof lock function is a most **reliable** safety feature . . . **Premium** single ovens also include . . .

<http://webcache.googleusercontent.com/search?q=cache:urlQceI3COoJ:www.bosch-oven.org/+premium+and+reliable+ovens+and+performance&cd=49&hl=en&ct=clnk&gl=us&source=www.google.com> 04/04/2011 09:00:39 AM

- Dacor

Upgrade With Distinction: Introducing the Distinctive Wall Oven

⁷ See attachments to April 2, 2011 Final Office Action. Inasmuch as the identification of applicant's goods includes ovens and heating devices utilized in cooking, gas stoves, electric food and plate warmers and electric towel warmers, the evidence referring to industrial ovens and heaters, and laboratory ovens, was not considered.

. . . you need a **reliable** wall oven that . . . Combining professional style with all of the **premium performance** features

<http://webcache.googleusercontent.com/search?q=cache:PzHnGYWyx0AJ:www.dacor.com/WorkArea/linkit.aspx%3FLinkIdentifier%3Did%26ItemID%3D16829+premium+and+reliable+ovens&cd=26&hl=en&ct=clnk&gl=us&source=www.google.com>
04/04/2011 08:53:24 AM

- Sweets Network Kitchen Aid

. . . KitchenAid appliances continue our traditions of elegant styling, **reliable performance** . . . A KitchenAid warranty is synonymous with long-lasting, worry-free **performance** . . .

<http://webcache.googleusercontent.com/search?q=cache:RB9W0GNvddsJ:products.construction.com/Manufacturer/KitchenAid-Inc--NST15315/overview+PREMIUM+RELIABLE+PERFORMANCE+and+ovens&cd=20&hl=en&ct=clnk&gl=us&source=www.google.com>
04/04/2011 09:29:59 AM

- Appliancecist

. . . central burner and two large ovens promise many years of high **performance** and **reliable** cooking. . . Dacor has recently introduced the new dual fuel range . . . offers the perfect balance of stylish design and **premium performance** . . . The new KitchenAid range cookers . . . includes high **performance** cooktops . . . **Premium** features in the new collection . . . The latest contemporary range cooker from Caple . . . Offering the utmost in **performance** . . . Glem GPC122IX is the freestanding stainless steel range with clean straight lines and high **performance** features . . . Belling . . . British designed and manufactured, the contemporary styled, high **performance** dual fuel range . . .

<http://webcache.googleusercontent.com/search?q=cache:HoP3RzkN7tsJ:www.appliancecist.com/ranges/%3Fstart%3D30+premium+and+reliable+ovens+and+performance&cd=18&hl=en&ct=clnk&gl=us&source=www.google.com>
04/04/2011 08:57:26 AM

As illustrated above, the words “premium,” “reliable,” and “performance” are used by third parties to describe qualities of cooking appliances. Thus, the relevant purchasing public would understand the mark to describe applicant’s products as high-quality, reliable products that efficiently perform the desired functions of cooking appliances.

Applicant also contends that its applied-for mark evokes a new and unique commercial impression resulting from both its visual and auditory symmetry. As argued by applicant, visually, the term is composed of three words each followed by a period; the first and last words include alliteration with the letter “P;” the middle word begins with the letter “R” which is similar to the letter “P.” As to the auditory symmetry, the three words in the term each begin with a combination of the letters “P” “R” and “E,” producing a similar sound in the words PREmium, RELiable and PERformance; the three words have three or fewer syllables to provide the term with consistent cadence or rhythm; because the first and last words begin with the letter “P” there is auditory balance.⁸

As noted by the examining attorney, applicant’s argument that the visual and auditory elements create a new and unique commercial impression is not a compelling argument.⁹ The third-party websites discussed above show that purchasers of similar products will be familiar with the use of the same three words comprising applicant’s applied-for mark in describing the features of such products.

While applicant correctly notes that slogan marks are registrable, it failed to demonstrate that its applied-for mark has any incongruous meaning or double entendre such as found in the slogan marks held registrable in *Colonial Stores*, 394 F.2d at 553, 157 USPQ 385 (SUGAR & SPICE mark evoked an image of the familiar nursery rhyme); and *In re Wilderness Group, Inc.*, 189 USPQ 44, 46 (TTAB 1975) (LET YOUR HIPS SHOULDER THE LOAD for hiking and camping

⁸ Applicant’s Appeal Brief pp. 9-10.

⁹ Examining Attorney’s Appeal Brief p. 8.

equipment expresses idea in catchy manner and constitutes double entendre). Applicant's reliance on *In re National Training Center of Lie Detection, Inc.*, 226 USPQ 798, 800 (TTAB 1985) in support of the registrability of its mark is not well placed as the descriptiveness of the slogan in that case was not even at issue (laudatory phrase DEDICATED TO ACHIEVING THE HIGHEST LEVEL OF PROFESSIONALISM functions as a mark in light of lack of evidence to the contrary; "this [is not] a case where applicant seeks to register explanatory matter so highly informational or descriptive or undistinguishing in nature").

Whether viewed individually or taken as a whole, the term "Premium. Reliable. Performance." is laudatory and descriptive of qualities, features or characteristics of the goods. Telling evidence of the descriptiveness of the applied-for mark comes from applicant's own website, www.westernpremium.com, which states ". . . being a boutique appliance brand that truly offers **premium reliable performance** . . . we truly offer innovation and **premium reliable performance** prior to launch (emphasis original). Thus, applicant itself utilizes the term in a descriptive manner in promoting its products. Applicant's own use of the term in a descriptive manner is strong evidence that the term is descriptive. See e.g., *In re Gould Paper Corp.*, 834 F.2d 1017, 1019, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987) ("[applicant's] own submissions provided the most damaging evidence that its alleged mark is generic"); and *In re Educational Communications, Inc.*, 231 USPQ 787, 790 (TTAB 1986) ("applicant's own highly descriptive usages of the components of its asserted mark ... is strong evidence of its generic nature").

Relying on recently-issued third-party registrations for marks consisting of three words followed by respective periods, applicant argues that its applied-for mark is no more laudatory than the marks contained in the cited registrations and is therefore registrable.¹⁰ We find such evidence does not overcome the descriptiveness of the applied-for term. Each case is to be decided on own facts and the Board is not bound by prior decision involving different records. The question of whether a mark is merely descriptive is determined based on evidence of record at time each registration is sought. *Nett Designs*, 57 USPQ2d at 1566 and *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001).

In view of the evidence of descriptiveness, the fact that third-party registrations exist for marks that are allegedly similar in nature to applicant's applied-for mark is not persuasive. Not only does applicant admit that the applied-for mark is laudatory,¹¹ applicant itself uses the applied-for mark in a descriptive manner. Moreover, the fact that third-party registrations exist for allegedly similar marks does not dictate the destiny of applicant's application. Even if there have been inconsistencies in how examining attorneys treated slogan marks in other applications, as applicant suggests, that alone does not raise a doubt as to the

¹⁰ At the time of filing its Reply Brief, applicant simultaneously sought remand of its application in order to make certain third-party registrations of record. In the Board's Order of May 1, 2012, applicant's request for remand was granted with respect to those nine registrations which issued subsequent to the date that the application was forwarded to the examining attorney for preparation of her appeal brief. Because the examining attorney had already submitted her brief at the time remand was granted, the examining attorney was given an opportunity to file, and did so file, a supplemental brief addressing the third-party registrations, and applicant was allowed to file a supplemental reply brief.

¹¹ See Applicant's Appeal Brief p. 12 and October 4, 2011 Request for Reconsideration.

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merely descriptive nature of the slogan now before us. Applicant's applied-for mark does not become registrable simply because other arguably similar marks are registered. *In re Scholastic Testing Service, Inc.*, 196 USPQ 517, 519 (TTAB 1977).

Conclusion

Applicant's applied-for slogan mark is descriptive of the quality of applicant's goods. Whether the components are analyzed individually or as a whole, the slogan is merely descriptive of the quality, reliability and performance of applicant's cooking appliances. Thus, the mark is not registrable as a trademark on the Principal Register without evidence of acquired distinctiveness.

Decision: The refusal to register the mark under Section 2(e)(1) of the Trademark Act is affirmed.