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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Werner Media Partners, LLC

Serial No. 85083690

Loren Donald Pearson of Assouline & Berlowe for Werner Media Partners, LLC.

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Before Quinn, Wellington and Shaw,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Werner Media Partners, LLC filed, on July 13, 2010, an intent-to-use application under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), to register the mark Ortho-Pedic (in special form) for "sleep products, namely, beds, mattresses, wood bedsteads, mattress toppers, pillows; mattress support systems in the nature of mattress foundations, bed frames, and bed headboards; viscoelastic foam mattresses, viscoelastic foam mattress toppers, non-therapeutic pet beds, and non-therapeutic

viscoelastic foam pet beds" (in International Class 20).¹ The application includes the following statements: "The mark consists of the stylized wording 'Ortho-Pedic' in the color aquamarine. The color aquamarine is claimed as a feature of the mark."

The trademark examining attorney 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 applied to applicant's goods, is merely descriptive thereof.

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

Before turning to the merits of the refusal, we first direct our attention to a procedural matter. The examining attorney indicated, in initially refusing registration on the ground of mere descriptiveness, that the proposed mark appeared to be generic and, thus, an amendment to claim acquired distinctiveness or to the Supplemental Register was not possible.² No formal refusal on the ground of genericness was

¹ The examining attorney issued, on May 25, 2011, an examiner's amendment involving the identification of goods "to correct obvious typographical errors by the applicant." A review of the amended identification reveals, however, that the examiner's amendment itself included a typographical error: "non-therapeutic viscoelastic foam bet [sic] beds." This error was perpetuated by both applicant and the examining attorney in the remainder of their filings. We have corrected this obvious mistake by replacing "bet" with "pet" in this decision.

² In this connection, we also note that applicant's application is based on an intention to use, which precludes registration on the Supplemental Register unless an amendment to allege use is filed, and also restricts registration under Section 2(f) to limited circumstances.

ever raised; the examining attorney, in her final refusal, merely reiterated her advisory statement. Applicant, in its brief, noted the examining attorney's statement, and correctly proceeded to only address the issue of mere descriptiveness. The examining attorney, in her brief, correctly stated that the sole issue on appeal is mere descriptiveness and mentioned, only in passing when recounting the prosecution history, her earlier advisory statement that the mark appeared to be generic. In its reply brief, however, applicant asserts for the first time that genericness exists as a second issue on appeal, and goes on to address the merits of whether or not its proposed mark is generic. Applicant concludes its reply brief as follows:

"Should the Board not reverse the rejection under Section 2(e), the Board is asked to reverse the Examining Attorney's provisional rejection that the mark is generic, and remand the case for further prosecution to afford Applicant with the opportunity to submit an amendment to allege use and an amendment to register the mark on the supplement register."

(Reply Brief, p. 3).

So as to be clear, the only issue on appeal for our consideration is mere descriptiveness under Section 2(e)(1). The examining attorney's remark that the proposed mark appeared to be generic was only an advisory statement, and did not raise

a second ground of refusal. TMEP § 1209.02(a) (8th ed. 2011) provides, in pertinent part, as follows:

A designation that is merely descriptive must be refused registration under Section 2(e)(1). The examining attorney must not initially issue a refusal in an application for registration on the Principal Register on the ground that a mark is a generic name for the goods or services, unless the applicant asserts that the mark has acquired distinctiveness under § 2(f) in the application itself. Even if it appears that the mark is generic, the proper basis for the initial refusal is § 2(e)(1) descriptiveness. If there is strong evidence that the proposed mark is generic, a statement that the subject matter appears to be a generic name for the goods or services should be included in conjunction with the refusal on the ground that the matter is merely descriptive.

If, in response to a first-action refusal under § 2(e)(1), the applicant merely argues that the mark is registrable on the Principal Register without claiming acquired distinctiveness or amending to the Supplemental Register, the examining attorney must issue a final refusal under § 2(e)(1), on the ground that the proposed mark is merely descriptive, if he or she is not persuaded by applicant's arguments.

Further, applicant's request for a remand is denied. A remand at this late juncture to allow applicant to amend its application is not permissible. Trademark Rule 2.142(g). See TBMP § 1218 (3rd ed. 2012); and TMEP § 816.05 (8th ed. 2011). If applicant wished to preserve its option to seek registration

under Section 2(f) or on the Supplemental Register during prosecution, it could have taken alternative positions accordingly. See TMEP §§ 816.04 and 1212.02(c) (8th ed. 2011); and TBMP § 1215 (3rd ed. 2012).

We now turn to the merits of the Section 2(e)(1) refusal grounded on mere descriptiveness. Applicant argues that its proposed mark is not merely descriptive "because the accompanying design features (i.e. aquamarine color and use of a hyphen) of the asserted mark create a unique and distinctive impression on purchasers separate and apart from the impression made by the word portions of the mark." (Brief, p. 1). Applicant points out that the examining attorney's evidence is devoid of any third-party uses of "Ortho-Pedic" with a hyphen or in an aquamarine colored font for bedding products.

The examining attorney maintains that the proposed mark merely describes bedding and mattresses designed to relieve orthopedic disorders. In support of the refusal, the examining attorney introduced dictionary definitions, pages from applicant's website, and excerpts of third-party websites.

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 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 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, 1316-17 (TTAB 2002).

The record includes dictionary definitions of the word "orthopedic": "relating to or marked by disorders of the bones, joints, ligaments, or muscles; marked by or affected with a

skeletal deformity, disorder, or injury." (msn Encarta; and merriam-webster.com).

An "orthopedic pillow" has been identified as "a pillow designed to correct body positioning in bed or while lying in any other surface. Its design conforms to orthopedic guidelines to ensure the right placement and support of one or more specific parts of the body to provide safe and healthy rest to the sleeper." (wikipedia.com). An "orthopedic mattress" has been identified as "a mattress designed to give additional back support." (wikipedia.com).

Also of record are pages retrieved from applicant's website wherein applicant touts the orthopedic advantages of its products in the following ways: "All of our products are designed with the highest concerns for health...your entire body is cradled and comforted from head to toe"; and "[e]ach mattress in our collection varies in density and foam height for a customized feel that benefits those who suffer from illnesses that cause sleeplessness (Fibromyalgia, Arthritis, Back Pain and Discomfort)." Applicant's website also indicates that applicant's products are sold to a broad range of customers, including those in the health care markets.

The remainder of the record comprises third-party websites showing extensive use of "orthopedic" in a highly descriptive/generic manner in connection with sleep products

such as pillows, beds and mattresses. These uses include the following representative sample: "orthopedic pillows"; "orthopedic mattresses"; "orthopedic foam bed"; "orthopedic foam bed mattress"; and "orthopedic foam dog bed."

Based on the evidence of record, we find that the proposed mark Ortho-Pedic in special form is merely (if not highly) descriptive of a significant characteristic or feature of applicant's pillows, beds and mattresses. Absolutely no imagination is required by a purchaser or user to discern that the proposed mark, when applied to the goods, describes such products designed to address orthopedic infirmities such as arthritis and back pain.

We are not persuaded in the least by applicant's principal argument that the presence of a hyphen in its proposed mark, and the mark's aquamarine color, converts the highly descriptive term "orthopedic" into the distinctive mark Ortho-Pedic.

The use of a common punctuation mark, as in the case of a hyphen in the proposed mark, is not sufficient to negate the mere descriptiveness of a term. *In re Vanilla Gorilla, L.P.*, 80 USPQ2d 1637 (TTAB 2006) (finding that the presence of a hyphen in the mark "3-0's" does not negate mere descriptiveness of the mark for automobile wheel rims). Further, the degree of stylization of applicant's mark is so minimal as to be virtually

nonexistent. Lastly, the use of the color aquamarine hardly suffices to somehow magically transform a merely descriptive term into one that is inherently distinctive. This color likely would be seen as only ornamental, and there is no argument, let alone evidence, showing that this color would be seen as having a source-indicating function. Simply put, applicant's presentation of its proposed mark in special form is not so unique or unusual as to create a distinctive commercial impression apart from the commonly used and understood word "orthopedic." See *In re Sambado & Son Inc.*, 45 USPQ2d 1312 (TTAB 1997).

We conclude that applicant's proposed mark Ortho-Pedic in special form for bedding and mattress products is merely descriptive of such products that are designed to comfort or control orthopedic disorders.

Decision: The refusal to register is affirmed.