

**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 Schroeder & Tremayne, Inc.

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Serial No. 85157275

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Mark Sableman and Jennifer A. Visintine of Thompson Coburn  
LLP for Schroeder & Tremayne, Inc.

Aretha C. Somerville, Trademark Examining Attorney, Law  
Office 107 (J. Leslie Bishop, Managing Attorney).

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Before Seeherman, Shaw and Adlin, Administrative Trademark  
Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Schroeder & Tremayne, Inc. has appealed from the final  
refusal of the trademark examining attorney to register THE  
ORIGINAL and design, as shown below, for "cleaning mitts of  
cloth and cleaning cloths; dish drying mats made of fabric  
and foam; gloves for household purposes, namely, dish

drying gloves" in Class 21, and "kitchen towels and dish cloths," in Class 24.<sup>1</sup>



The application has had a somewhat unusual history. In the first Office action, the examining attorney required a disclaimer of THE ORIGINAL, which applicant provided. The application was then approved for publication, but was never published. Instead, the examining attorney issued an Office action refusing registration pursuant to Section 2(e)(1) of the Trademark Act, on the ground that the mark is merely descriptive because the wording THE ORIGINAL describes that applicant's goods are the first of their kind or not derivative of other goods. Noting that applicant had disclaimed exclusive rights to these words, the examining attorney explained that the stylization and the design is not sufficiently striking, unique or distinctive so as to create a commercial impression

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<sup>1</sup> Application Serial No. 85157275, filed October 20, 2010. The application in Class 21 is based on Section 1(a) of the Trademark Act, and asserts first use and first use in commerce at least as early as August 31, 2009; the application in Class 24 is based on Section 1(b) (intent-to-use).

separate and apart from the unregistrable components of the mark.

At that point, applicant proceeded in the alternative, first arguing that its mark was inherently distinctive, and that THE ORIGINAL was only suggestive as to the goods identified in the application, and therefore did not need to be disclaimed. However, applicant also agreed to disclaim THE ORIGINAL if this was necessary to obtain a registration on the Principal Register.

The examining attorney was not persuaded by applicant's arguments or evidence, and issued a final Office action. This appeal followed.

We begin with a procedural point. With its appeal brief applicant submitted a number of pages of evidence that had not been previously made of record. The record in the application should be complete prior to the filing of an appeal, and the Board will ordinarily not consider additional evidence filed with the Board after the appeal is filed. See Trademark Rule 2.142(d). Although the examining attorney has not specifically objected to consideration of this evidence, neither did she discuss the evidence in her brief. Therefore, we cannot deem her to have stipulated it into the record. See TBMP § 1207.03 (Board may consider evidence submitted after appeal if the

nonoffering party: 1) does not object to the new evidence, and 2) discusses the new evidence or otherwise affirmatively treats it as being of record). See also TBMP § 1203.02(e).

Applicant has also cited certain articles in its brief, from internet websites such as [www.businessnewsdaily.com](http://www.businessnewsdaily.com) and <http://blog.hubspot.com>. These articles were never made of record and neither the quotes from them nor applicant's assessment of the statements in the articles have been given any consideration.<sup>2</sup>

We now turn to the substantive issue on appeal, whether the mark is merely descriptive. The examining attorney argues that the mark is laudatorily descriptive because it describes a quality of the goods.

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(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 Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). Laudatory marks

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<sup>2</sup> Even if the quotes and statements were considered, they would have no effect on our decision.

that describe the alleged merit of the goods or services are considered to be descriptive because they simply describe the characteristics or quality of the goods or services in a condensed form. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 (TTAB 1998). Whether a term 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 term would have to the average purchaser of the goods or services because of the manner of its use; that a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

Both applicant and the examining attorney have submitted third-party registrations to support their respective positions. Those submitted by applicant are for marks containing or consisting of the word ORIGINAL, in which there is no disclaimer of ORIGINAL nor resort to Section 2(f), while the registrations submitted by the examining attorney have disclaimers of this word. For example, applicant relies on, inter alia, the following registrations:



for Himalayan crystal salt;<sup>3</sup>



for clothing;<sup>4</sup> and

ORIGINAL SIX for, inter alia, action figures.<sup>5</sup>

The examining attorney relies on, inter alia, the following registrations:

PPB THE ORIGINAL COLLECTIBLE, with THE ORIGINAL COLLECTIBLE disclaimed, for, inter alia, bathroom towels;<sup>6</sup>



THE ORIGINAL  
MICROFIBER TOWEL  
COMPANY SINCE  
1990

with THE ORIGINAL MICORFIBER  
TOWEL COMPANY SINCE 1990 disclaimed, for, inter  
alia, towels; and



with THE ORIGINAL and BLANKET  
disclaimed, for, inter alia, bed blankets.<sup>7</sup>

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<sup>3</sup> Reg. No. 3042424.

<sup>4</sup> Reg. No. 1354253.

<sup>5</sup> Reg. No. 2773891.

<sup>6</sup> Reg. No. 3187421.

Although some of the registrations submitted by applicant can be distinguished because the word ORIGINAL appears as part of a unitary mark and therefore would not be subject to a disclaimer, or the descriptive meaning of the word is subsumed in the incongruous meaning of the mark as a whole, the fact is that the various third-party registrations do not reflect a consistent Office policy as to when ORIGINAL is considered merely descriptive and when it is not. Therefore, although the Office strives for consistency, in this "battle of the registrations," there is little persuasive value in the registrations submitted by either applicant or the examining attorney.<sup>8</sup> See *In re Nett Designs Inc.*, 57 USPQ2d at 1566.

We therefore turn to the dictionary definitions and precedent to determine whether THE ORIGINAL has a laudatorily descriptive meaning.<sup>9</sup>

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<sup>7</sup> Reg. No. 3383147.

<sup>8</sup> Nor do the third-party registrations for marks which applicant contends have similar meanings to ORIGINAL, e.g., MODEL, STANDARDS, PATTERN and NOVEL, have any real probative value, because these terms and marks are different from ORIGINAL.

<sup>9</sup> Applicant has cited to certain dictionary and thesaurus pages in its brief where presumably definitions or synonyms of "original" can be found. However, applicant never submitted the definitions themselves, let alone copies of the relevant pages. Although the Board may take judicial notice of dictionaries and other reference works, see *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), in general, when parties wish the Board to take judicial notice of information, they supply a copy of the reference material that they want the Board to consider. We point out that the

The examining attorney has submitted several definitions of "original" from Dictionary.com, including "new; fresh; inventive; novel: *an original way of advertising.*"<sup>10</sup> We also note, from that same internet source, the definition from Collins English Dictionary, 10<sup>th</sup> ed. (2009), "the first and genuine form of something, from which others are derived."

We find, based on these definitions, that THE ORIGINAL in applicant's mark directly conveys the laudatory information that applicant's goods are new, fresh, novel or the first and genuine form of the goods. We understand applicant's argument that it does not claim to be the original maker of kitchen towels and dish cloths, which it says "have certainly existed and been used for as long as kitchens and woven goods have existed." Brief, p. 6. However, it is not necessary that purchasers perceive the mark as describing the originator of the goods in general for ORIGINAL to be found merely descriptive. ORIGINAL is a term that also describes that a product has a new characteristic. See *General Foods Corp. v. Ralston Purina Co.*, 220 USPQ 990, 933 (TTAB 1984), *aff'd unpub'd*, No. 84-

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dictionary definitions we have considered, as discussed infra, appear to generally include the "concepts of meaning" that applicant argues in its brief.

<sup>10</sup> www.dictionary.com, Dictionary.com Unabridged, based on the Random House Dictionary, © 2013.



1345 (Fed. Cir. Dec. 18, 1984), which found that ORIGINAL BLEND was merely descriptive of cat food. Certainly there would be no question that cat food products had been made and sold prior to the applicant's claimed use of the mark in 1970. The Board stated that ORIGINAL is "generally used to indicate that a product or a particular variety or style of a product is the first-of-its kind," and that "[t]here is no doubt that one reason for its widespread use is that, in the English language, at least, ORIGINAL has the character of 'puffery'... " and that "if a manufacturer wishes to say to purchasers in a plain and simple way that the product, variety or type is the first-of-its kind, there are not very many words other than ORIGINAL from which to choose." See also, *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999).

Although the *General Foods* case discussed the descriptiveness of the word ORIGINAL, there is nothing about the addition of THE in the present mark that would change the laudatory descriptive meaning of the mark for the identified goods. The additional word THE merely emphasizes that the goods are the first-of-their-kind. Thus, we find that THE ORIGINAL is a laudatorily descriptive term for the identified goods.

Applicant argues in the alternative that, even if THE ORIGINAL is merely descriptive, the mark as a whole can be registered with a disclaimer of THE ORIGINAL because it has a distinctive stylization and design. Although an entire mark cannot be disclaimed and also registered, where the literal components of a mark are combined in a distinctive design or display it is possible to disclaim those literal components and still have a mark which is registrable as a whole. *In re Jackson Hole Ski Corp.*, 190 USPQ 175, 176 (TTAB 1976). The question, then, is whether, if applicant disclaims exclusive rights to the term THE ORIGINAL, the design element and the stylized script in which the words are written are sufficient to create an impression separate and apart from the impression made by the words themselves. *In re Guilford Mills Inc.*, 33 USPQ2d 1042, 1043 (TTAB 1994).

As has been frequently recognized, whether or not the disclaimed literal components of a designation sought to be registered are displayed in an inherently distinctive fashion is necessarily a subjective matter which must be determined based on a viewer's first impression. *In re Grande Cheese Co.*, 2 USPQ2d 1447, 1449 (TTAB 1986); *In re Jackson Hole Ski Corp.*, 190 USPQ at 176.

In *In re Sadoru Group Ltd.*, 105 USPQ2d 1484 (TTAB 2012), the Board undertook an extensive analysis of the cases involving stylized marks having potentially descriptive or generic wording, so we see no need to depict the marks here. The marks can be found at pages 1486 through 1488 of that opinion.

We find that the stylization and design elements of applicant's mark are not sufficient to create a separate and inherently distinctive commercial impression apart from the term itself. The background design for the words THE ORIGINAL is an oval surrounded by a rectangle. Common geometric shapes such as ovals, rectangles, circles, triangles, diamonds and stars, when used as backgrounds for the display of word or letter marks, are generally not regarded as trademarks for the goods to which they are applied absent evidence of distinctiveness of the design alone. *In re Anton/Bauer Inc.*, 7 USPQ2d 1380, 1381 (TTAB 1988). Even applicant has recognized that ovals are common background shapes for trademarks. Reply brief, p. 4. Further, the stylized script in which THE ORIGINAL appears is a rather ordinary font, and the "tildes" on either side of the words are not significant either. In short, the background geometric shapes and the stylization of THE

ORIGINAL are not distinctive enough to create a separate commercial impression.

Rather, in viewing applicant's mark in the context of the marks discussed in prior Board opinions, we consider applicant's mark to be far more similar to the marks in which the stylization/design element was found not to create an inherently distinctive display.

Accordingly, we find that applicant's mark as a whole is merely descriptive, and the design/stylization does not create a separate and inherently distinctive commercial impression apart from the term THE ORIGINAL, such that the mark is registrable with a disclaimer of these words.

Decision: The refusal of registration is affirmed.