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PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Colakel

Serial No. 85206022

Matthew H. Swyers, Esq. for Kemal Colakel

Eugenia K. Martin, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Wolfson, Lykos and Gorowitz, Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

On December 27, 2010, Kemal Colakel (“applicant”) applied to register the mark (depicted below):

towel & towel

based on his intent to use the mark for goods in International Class 24, namely, “Bath towels; Beach towels; Children's towels; Compressed towels; Curtains and towels; Face towels; Face towels of textiles; Football towels; Golf towels; Hand

towels; Hand towels of textile; Hand-towels made of textile fabrics; Hooded towels; Household linen, including face towels; Japanese cotton towels (tenugui); Kitchen towels; Large bath towels; Moisture absorbent microfiber textile fabrics for use in the manufacture of athletic apparel, namely, shirts, pants, shorts, jackets, bags, towels and athletic uniforms; Quilts of towels; Tea towels; Terry towels; Towel sets; Towel sheet; Towelling coverlets; Towels; Towels made of textile materials; Towels that may be worn as a dress or similar garment; Turkish towel.”

The application includes the following disclaimer: No claim is made to the exclusive right to use TOWEL apart from the mark as shown.¹

The Trademark Examining Attorney has refused registration of applicant’s mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), having determined that the applied-for mark merely describes the identified goods.

When the refusal was made final, applicant appealed and filed a request for reconsideration. After the examining attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

Evidentiary Issue

The examining attorney has objected to the introduction of a list of third-party registrations that applicant submitted with its appeal brief. The objection is

¹ The application also includes a statement explaining that the ampersand (“&”) appearing in the mark “means or signifies AND in the relevant trade or industry or as applied to the goods/services listed in the application.”

sustained. Because the record must be complete prior to appeal, the listing has not been considered. Trademark Rule 2.142(d); TBMP § 1208.02.²

Applicable Law

Trademark Act § 2(e)(1) prohibits registration of a mark which is merely descriptive of the applicant's goods or services. A term 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 Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). *See also, In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828 (TTAB 2007); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods and/or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods and/or services for which registration is sought. *See In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).

Discussion

Applicant admits that the word "towel" in the mark "is a self explanatory word that identifies the goods(s),"³ and that "the term 'TOWEL' speaks for itself."

² We hasten to add that consideration of the list would not have changed the result in this proceeding.

Brief at 6. Applicant argues, however, that when the word “towel” is repeated and the two instances joined by an ampersand, the resultant mark is not merely descriptive. Instead, a unique mark is allegedly created that suggests to customers they “will be able to find, choose, compare and make a purchase of many towel goods. It suggests a family of products that are being sold based on their relationship to one another.” In other words, applicant contends that by repeating the word “towel,” the proposed mark allegedly evokes the impression of a variety of different types of towels, “sit[ting] next to the another [sic] towel, almost any given time, any place on earth.” *Response to Office Action* (dated September 27, 2011).

In contrast, the examining attorney contends that “[b]ecause the goods are towels, the word ‘towel’ is descriptive of the goods.” *Examining Attorney’s Appeal Brief* at 5. She argues that the mark is merely descriptive because it simply repeats the descriptive word “towel” without creating a new or different meaning or commercial impression of the word. “A consumer presented with the mark TOWEL & TOWEL in relation to applicant’s goods, towels, would clearly understand the meaning of the mark in this case, as the mark would be used on a [sic] different types of towels.” *Id.* at 8.

“It is settled that a mark’s mere repetition of a merely descriptive word does not negate the mere descriptiveness of the mark as a whole.” *In re Litehouse, Inc.*, 82 USPQ2d 1471, 1474 (TTAB 2007) (holding CAESAR!CAESAR! merely descriptive for salad dressing). A mark comprised of a repeated descriptive term is itself merely descriptive unless a new or different commercial impression results

³ Response to Office Action (dated September 27, 2011).

from the repetition. *In re Tires, Tires, Tires, Inc.*, 94 USPQ2d 1153, 1155 (TTAB 2009) (holding TIRES TIRES TIRES generic for retail tire store services). *See also, In re Disc Jockeys, Inc.*, 23 USPQ2d 1715, 1716 (TTAB 1992) (holding DJDJ merely descriptive for disc jockey services for parties); and TMEP §1209.03(t). “[T]he critical factor is that the two or more words serve to modify each other and enhance the meaning of the composite, which is something that does not occur merely by repeating a word.” *Tires, Tires, Tires*, 94 USPQ2d at 1156.

Here, no new or different commercial impression is formed by the simple repetition of the descriptive word “towel,” nor has the meaning of the term “towel” been altered by the repetition. The first instance of the word “towel” does not modify the second word “towel,” nor does the repetition of the words “towel & towel” enhance the meaning of the phrase. Likewise, the use of an ampersand instead of the word “and” (or merely a space between the words) has not created a composite, unitary mark whose meaning has been somehow enhanced or made incongruous thereby. *See In re Seaman & Associates Inc.*, 1 USPQ2d 1657, 1659 (TTAB 1986) (“We do not believe that addition of the ampersand between the terms ‘product acceptance’ and ‘research’ results in a designation which in its entirety is incongruous or in any other way less descriptive than the terms taken alone.”). *See also In re Harcourt Brace Jovanovich, Inc.*, 222 USPQ 820 (TTAB 1984) (LAW & BUSINESS held unregistrable on the Supplemental Register).

Applicant alleges that the mark “has never been used in commerce/trade before.” That the mark has never been used before is irrelevant. “There is no valid

reason to require an examining attorney to demonstrate that a designation composed solely of a repeating word has been used by others, when the examining attorney has demonstrated that the repeated term is generic and that the repetition does not result in a designation with a different meaning.” *Tires, Tires, Tires*, 94 USPQ2d at 1155. The same reasoning applies in this case.

Applicant also argues that the particular stylization of the wording towel & towel has created a unique and registrable mark. In order for the stylization of the words in a mark to enable registration of the mark as a whole, the stylization must be sufficiently distinctive so as to “create an impression on purchasers separate and apart from the impression made by the words themselves.” *In re Am. Academy of Facial Plastic & Reconstructive Surgery*, 64 USPQ2d 1748, 1753 (TTAB 2002). We agree with the examining attorney that in this case, “there is nothing in the simple font which creates an impression ‘separate and apart’ from the impression made by the words TOWEL & TOWEL.” *Examining Attorney’s Appeal Brief* at 8. See, e.g., *In re Sadoru Group, Ltd.*, 105 USPQ2d 1484, 1485 (TTAB 2012) (finding that the stylization of the mark **SADORU** for motorcycle seats did not create a separate and inherently distinctive commercial impression); and *In re Guilford Mills Inc.*, 33 USPQ2d 1042, 1044 (TTAB 1994) (holding the mark **microdenier** for microfiber fabrics “insufficiently stylized to create an inherently distinctive display that is registrable, without more, on the Principal Register.”).

Finally, applicant argues that its proposed mark can “conjure up numerous other images.” *Brief* at 6. Applicant suggests that the mark can reference a retail store that sells “bath products and other home goods” and that “even if a consumer utilized their imagination” they would not immediately know that such a retail store sold towels or that the mark refers to towels. *Id.* Although towels are typically considered “home goods” and would likely be sold in such retail stores, suffice it to say that we do not consider the mark in a vacuum, but rather in relation to the goods that are listed in the identification of goods of the applicant’s application. Someone who knows that applicant’s goods are towels, towel fabric, and goods made from such fabric will immediately understand the mark TOWEL & TOWEL to convey information about these goods. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012).

We find that neither the mere repetition of the word “towel” in applicant’s mark, the presence of the ampersand in the mark, the combination of both these features, nor the stylization of the mark, suffice to negate the mere descriptiveness of the mark as a whole as applied to the goods.

Decision: The refusal to register applicant’s towel & towel mark as merely descriptive under Trademark Act § 2(e)(1) is affirmed.