

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: August 19, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Goldberg

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Serial No. 85365401

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Roger J. Bernstein of the Roger J. Bernstein Law Firm,
for Elliott Goldberg.

Robert Clark, Trademark Examining Attorney, Law Office 101,
Ronald R. Sussman, Managing Attorney.

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Before Bucher, Lykos and Greenbaum,
Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Elliott Goldberg (“applicant”), a U.S. citizen and resident of Scarsdale, NY, seeks registration on the Principal Register of the mark **THE DONUT** (*in standard character format*) for “therapeutic hot and cold therapy packs,” in International Class 10.¹

¹ Application Serial No. 85365401 was filed on July 7, 2011, based upon an allegation of applicant’s *bona fide* intention to use the mark in commerce.

The examining attorney has refused registration on the ground that the term is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

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

I. The Applicable Law

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the products it identifies. *See, e.g., In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the goods or services for which registration is sought and the context in which the term is used. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the question is whether someone who knows what the services or products are will understand the mark immediately to convey information about them. *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003).

II. Arguments

The examining attorney contends that when the term “Donut” is used in conjunction with applicant’s goods, it immediately conveys information about a significant characteristic of these “donut-shaped packs”; that each case must be decided on its own facts despite applicant’s repeated claims of inconsistent standards applied to analogous marks within the same industry; and that past treatment of the word “Donut” in marks in several third-party registrations supports his refusal herein.

By contrast, applicant argues that this term as used in connection with the identified goods is suggestive, not descriptive; that the examining attorney has based this refusal on a “mistaken factual premise” that the involved product is shaped like a ring or a torus, when in fact applicant’s product is a sleeve that is closer to the shape of a cylinder; that the examining attorney has failed to meet his burden properly to show that “The Donut” is merely descriptive when applied to the identified goods; that by refusing this mark, the examining attorney is applying clearly inconsistent standards to competitors in the physical therapy products field; and that the Office should resolve substantial doubts in this case in applicant’s favor and publish the mark for opposition.

III. The Evidence of Record

Applicant identified his goods as “therapeutic hot and cold therapy packs,” and this application continues to be an intent-to-use application. With the

initial Office action, the examining attorney quite appropriately asked applicant under the authority of 37 C.F.R. § 2.61(b) to submit additional information about the involved goods, specifically mentioning “fact sheets, instruction manuals, brochures, and/or advertisements.”

Hence, from representational packaging produced by applicant, we see that his therapy pack is a plastic roll-on sleeve placed around a limb. The device uses a chemical gel to give the patient the desired heating or cooling. In the case of *SKU 11-1530*, the therapy pack is designed to fit a finger (*e.g.*, see packaging at right).



In fact, applicant’s materials show five product sizes ranging from the one above for a finger to one that fits a thigh. Any limb (arm, leg or finger) is inserted into its appropriately-size sleeve, which is then rolled up the limb to the proper location. In the case of the device for the hand, wrist, arm or elbow, applicant submitted portions of an instruction manual showing with successive pictures what the compression sleeve looks like when it is being rolled up the sleeve.



In support of the refusal to register, the examining attorney has supplied for the record the following dictionary entry for “donut”:

donut

Definition of DONUT

Variant of DOUGHNUT

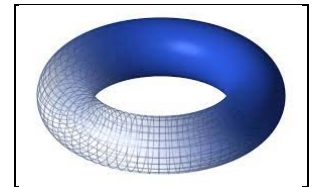
dough-nut *noun*

Definition of DOUGHNUT

1 : a small usually ring-shaped cake fried in fat

2 : something (as a mathematical torus) that resembles a doughnut especially in shape ²

In the field of solid geometry, the most often pictured torus is a surface possessing a single “hole.” Indeed, as suggested with the second definition of “doughnut” above, the usual single-holed “ring” torus embedded in three-dimensional space is shaped like a donut, displaying in the very center a donut hole. Consistent with applicant’s detailed definitions of “torus” and his related arguments, a donut-shaped, single-holed “ring” torus is a surface of revolution generated by revolving a circle in three-dimensional space about an axis coplanar with the circle.



The examining attorney provided examples of third-party trademark registrations where the word “Donut” is disclaimed within composite marks registered in connection with, for example, a set of silicone bake ware molds designed to make cakes in the shape of a giant doughnut, and in connection with cushions in International Class 20. Applicant, in turn, provided examples of third-party registrations where he argued competitors have registered similarly suggestive terms for related goods.

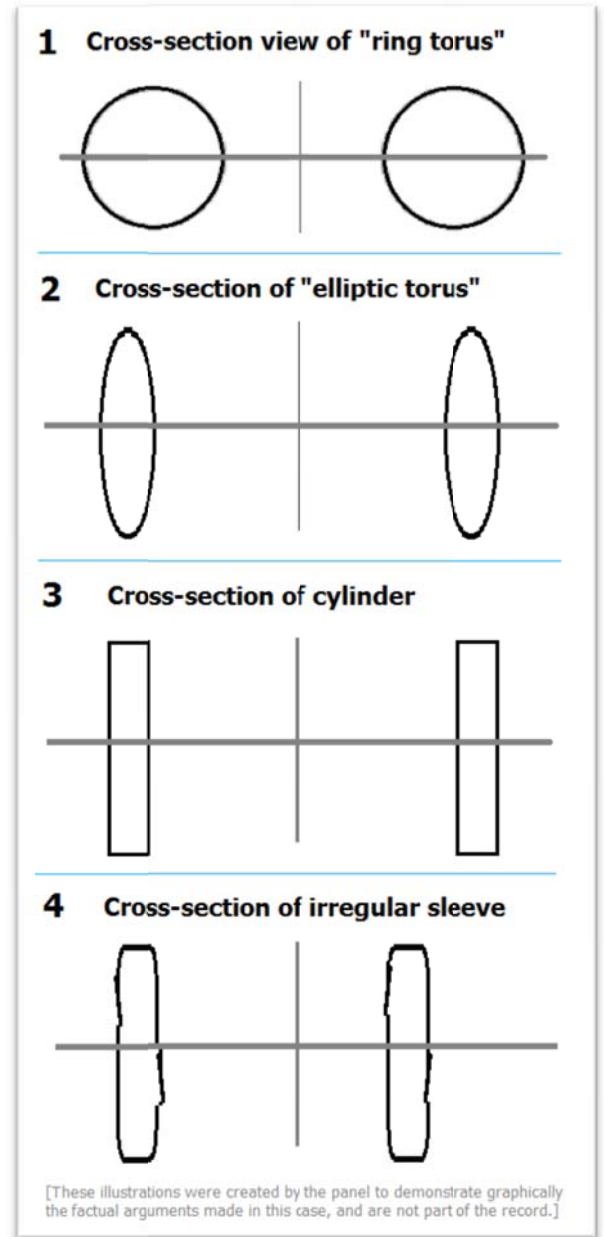
² MERRIAM-WEBSTER’S COLLEGIATE DICTIONARY, drawn from <http://www.merriam-webster.com/dictionary/donut>

IV. Analysis

As seen in the examples gathered by the examining attorney, toroidal objects include everyday items like doughnuts, spare tires, bagels, O-rings and a variety of other manufactured products. Hence, the word “doughnut” (or “donut”) might well describe goods having the shape of a single-holed “ring” torus. However, with wares whose shapes involve cross-sections where the revolving surfaces move from (1) circular to (2) elliptical (creating an elliptic torus) or even to (3) rectangular (creating a cylinder), or finally, (4) with an irregularly-shaped item – where the surfaces are not round, smooth or even equidistant from a central axis – terms like donut-shaped, bagel-shaped or “ring

torus” seem to us to move from being merely descriptive of the shape of the involved goods to being nothing more than suggestive of them.

Accordingly, we agree with applicant that the word “donut” does not immediately convey information about these therapy packs, and is deemed to be



suggestive. Based on this record, we disagree with the position of the examining attorney, and see no reason why competitors would need to use the word “donut” to describe a competing compression sleeve.

In conclusion, we find that the examining attorney has failed to meet his burden of making out a *prima facie* case that applicant’s mark, **THE DONUT**, is merely descriptive of the goods for which registration is sought.

Decision: The refusal to register applicant’s mark, **THE DONUT**, under Section 2(e)(1) of the Lanham Act is hereby reversed.