This Opinion is Not a Precedent of the TTAB

Mailed: May 12, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Contour Hardening, Inc.

Serial No. 85569491

James M. Durlacher of Woodard Emhardt Moriarty McNett & Henry LLP, for Contour Hardening, Inc.

Jenny Park, Trademark Examining Attorney, Law Office 104, Chris Doninger, Managing Attorney.

Before Quinn, Bergsman and Greenbaum, Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

Contour Hardening, Inc. ("Applicant") seeks registration on the Principal Register of the mark EV500 (in standard characters) for

> Promoting competition events of others involving electric vehicles in International Class 35, and
>
> Organizing and conducting sporting events, namely, competition racing events involving electric vehicles in International Class 41.[1]

[1] Application Serial No. 85569491 was filed on March 14, 2012, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

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), on the ground that the mark is merely descriptive of the identified services.

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 affirm the refusal to register.

I. Evidentiary Issue

We note that Applicant attached approximately 15 pages of evidence to its appeal brief.[2] It appears that much (and possibly all) of it is duplicative of Applicant's previously submitted evidence. Rather than engaging in a time-consuming comparison of the attachments to the brief and the previously-filed material, because any material that was not previously submitted is not properly of record (see Trademark Rule 2.142(d)), we have only considered the previously-filed material. *See In re Greenliant Systems Ltd.*, 97 USPQ2d 1078, 1080 (TTAB 2010).

II. Applicable Law

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). *See also In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (*quoting Estate*

[2] Applicant's briefs have been filed in single space. Applicant is advised that briefs must be double spaced. *See* Trademark Rule 2.126(a)(1); Trademark Rule 2.142(b)(2).

of P.D. Beckwith, Inc. v. Comm'r, 252 U.S. 538, 543 (1920) ("A mark is merely descriptive if it 'consist[s] merely of words descriptive of the qualities, ingredients or characteristics of' the goods or services related to the mark.")). The determination of whether a mark is merely descriptive must be made "in relation to the goods [or services] for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser or the goods because of the manner of its use or intended use." *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (*citing In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant ingredient, quality, characteristic, function, feature, purpose or use of the goods or services. *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

The question is not whether someone presented only with the mark could guess the products or services listed in the description of goods or services. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012), *quoting In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002). *See also In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB

1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Where a mark consists of multiple words, the mere combination of descriptive words does not necessarily create a nondescriptive word or phrase. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988). If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. *Oppedahl*, 71 USPQ2d at 1371. However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a nondescriptive meaning, or a double entendre with one meaning being non-descriptive, or if the composite has an incongruous meaning as applied to the goods or services. *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE for "bakery products"); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE for "a snow removal hand tool having a handle with a snow-removing head at one end, the head being of solid uninterrupted construction without prongs").

Last, as Applicant correctly points out, a mark comprising more than one element must be considered as a whole and should not be dissected; however, as the Examining Attorney aptly notes, we may consider the significance of each element separately in the course of evaluating the mark as a whole. *See DuoProSS*, 103 USPQ2d at 1756-57 (reversing the Board's denial of cancellation for Snap! for medical devices as not merely descriptive, but noting that "[t]he Board to be sure,

can ascertain the meaning and weight of each of the components that makes up the mark.").

III. Evidence and Argument

The Examining Attorney asserts that "EV" is an abbreviation for "electric vehicles," and "500" denotes the number of miles in the electric vehicle competition that Applicant intends to promote for others and to organize and conduct in its own behalf, as well as the number of miles an electric vehicle can or aspires to travel on a single charge, without refueling/recharging. The Examining Attorney relies on dictionary definitions and third-party uses of the term "EV" as an abbreviation for "electric vehicles," Applicant's own use of the term EV500 in connection with an exhibition (advertised as a race) sponsored by Applicant in which two electric vehicles traveled 500 miles on the famed Indianapolis Motor Speedway, articles/blogs reporting the exhibition, and third-party uses of the number "500" in connection with 500 mile races such as the Indy 500, and as a benchmark for electric vehicles to travel on one charge. Consequently, according to the Examining Attorney, when used in connection with Applicant's promotion, organizing and conducting competitions involving electric vehicles, the proposed mark EV500 merely indicates that Applicant's services will feature a 500 mile race involving electric vehicles.

Applicant does not dispute that "EV" is a recognized abbreviation for "electric vehicles." However, Applicant contends that the number "500" as used in Applicant's mark EV500, is arbitrary, and has no significance with respect to the

services identified in the application. Applicant made an affirmative statement to this effect in response to the Examining Attorney's inquiry as to the meaning or significance of the number "500" in the mark ("This topic refers to the 'numbering in the Mark' and whether the specific numbering 'in the Mark' has any significance. The answer to this question is 'No.'").[3]

Applicant argues at length in its brief that to its knowledge, there has not yet been a 500 mile competition for electric vehicles, and that due to "technical limitations for electric vehicles in terms of their speed, range and charging time," they are "unlikely candidates for any type of competition going for 500 miles or longer."[4] Applicant also argues that "if '500' means anything, other than simply being an arbitrary term, it could refer to other features or characteristic of a race, such as 500-volt electric vehicles, or 500 laps."[5]

As an initial point, we note that Applicant owns a registration on the Supplemental Register for the mark EV500 for "organizing, promoting, and conducting exhibitions for business purposes related to electric vehicles" in International Class 35.[6] It is well-settled as a legal matter that a mark owner's acceptance of registration on the Supplemental Register constitutes an admission that the mark is descriptive at the time of registration, *see, e.g., In re Clorox Co.*,

[3] January 23, 2014 Response to Office Action.

[4] App. Br. p. 6, 7 TTABVUE 7. Citations to Applicant's and the Examining Attorney's briefs in this opinion also include citations to the TTABVUE docket entry number, and the electronic page number where the argument appears. TTABVUE is the Board's electronic docketing system.

[5] App. Br. p. 4, 7 TTABVUE 5 (emphasis in original).

[6] Registration No. 4207970 registered on September 11, 2012.

578 F.2d 305, 198 USPQ 337, 340 (CCPA 1978); *In re Consolidated Foods Corp.*, 200 USPQ 477, 478 n.2 (TTAB 1978) ("Registration of the same mark on the Supplemental Register … is an admission of descriptiveness."). Although the services identified in this registration are not exactly the same as the services in the instant application, they are closely related. We keep this in mind as we consider whether EV500 also is merely descriptive for the services identified in the application.

There is no question that the number "500" has significance in the vehicle racing industry. Applicant acknowledges that the number "500" could represent the number of laps raced or, as in the case of the "Indianapolis 500" and the "Daytona 500," the number of miles traveled around the track. In addition, the evidence from <visitindy.com> and "en.wikipedia.org> names the "Indy 500" as the most famous race covering a distance of 500 miles.[7]

Applicant attempts to qualify its acknowledgement that the number "500" has significance in the vehicle racing industry by pointing to a third-party registration for the mark LITTLE 500 for "entertainment services, namely sponsoring an annual bicycle race and other competitive entertainment events including a golf tournament, 5K run and 10K walk" in International Class 41,[8] and arguing that "this all depends on the person who is answering the question. For example, a student competing in the "Little 500" at Indiana University likely thinks of "500" as

[7] June 25, 2012 Office Action.

[8] Applicant attached to the August 15, 2014 Request for Reconsideration a copy of the registration and a portion of the application file, including the Office Action withdrawing the requirement that the applicant disclaim "500" apart from the mark as shown.

representing nothing more than 200 laps around a cinder track."[9] In addition to lacking support, this argument is not relevant to our analysis which, as we discussed above, requires us to determine whether "500" has meaning or significance with respect to Applicant's identified services. *See, e.g., DuoProSS*, 103 USPQ2d at 1757.

The record also establishes that the number "500" has significance with respect to electric vehicles in that one of the acknowledged problems with such vehicles is their current inability to drive long distances without needing to be recharged. According to an article from Forbes Magazine <forbes.com> entitled "Electric Car Breaks 500 Mile Barrier," "Most of these cars cannot exceed 100 miles and could benefit from [ ] technology to boost drivable distances, though Coda Automotive's electric offering boasts 125-mile range and the Volt -- a traditional hybrid -- can go over 350."[10]

Several other articles of record explain that makers of electric vehicles and their batteries are trying to extend the life of each charge so that the electric vehicles can drive longer distances before requiring a recharge. According to these articles, the number "500" represents the mileage goal for such vehicles, and at least one manufacturer has achieved it: the Forbes Magazine article mentioned above states that a consortium of Danish car builders has created an electric car that can travel 500 miles without refueling. Others believe it is possible to reach this goal. According to a Volkswagen engineering director in California, reported on the

[9] January 23, 2014 Response to Office Action.

[10] February 19, 2014 Office Action.

Autocar website <autocar.co.uk> in an article entitled "VW: 500-mile EVs by 2020," electric vehicles will have a range of more than 500 miles by the year 2020. Similarly, a web article from the Green Car Reports website <greencarreports.com> entitled "Do We Really Need 500-Mile Electric Car Batteries?" discusses a rechargeable lithium-air battery that could let an electric car travel 500 miles on a single charge.[11]

Electric vehicles face another problem – the amount of time it takes to recharge the batteries. Applicant has promoted its own mobile charging system as a solution to this recognized problem, and, as noted above, now owns Registration No. 4207970 on the Supplemental Register for the mark EV500 for "organizing, promoting, and conducting exhibitions for business purposes related to electric vehicles." During the course of prosecution of that application, Applicant submitted a specimen which states that "we're going to be driving an electric vehicle on a circuit for 500 miles, the famed Indianapolis Motor Speedway Oval -- In One Day -- to show how the range of almost any EV can be extended dramatically by using Real Power's Mobile EV charging and rescue truck."[12]

According to videos posted on the <GTChannel.com> and <technologicvehicles.com> websites regarding Applicant's EV500 exhibition, the electronic vehicles traveled 500 miles in 12 hours.[13] In addition, the Examining Attorney submitted a web article entitled "Indy 500 in an Electric Vehicle?" by

[11] *Id.*

[12] *Id.*

[13] September 5, 2014 Denial of Request for Reconsideration.

Carter Jung <blog.roadandtrack.com>, which discusses the same 500 mile demonstration, and states that Applicant's EV500 event "offers a glimpse into the future where EV range angst can be quelled with short charge cycles."[14]

Applicant argues that the identified services do not "include any express or implied reference to any type of 500 miles nor to 500 of anything."[15] However, this is not the test as to whether the proposed mark EV500 is merely descriptive of the identified services. Even if the identified services do not expressly state that EV500 will be used in connection with 500 mile races for electric vehicles, there is ample record evidence to support a finding that a 500 mile race for electric vehicles is possible in the future, and that electric vehicle and battery makers are trying to manufacture electric vehicles that can drive 500 miles on one charge. Moreover, as the Examining Attorney notes, Applicant has not limited the scope of the identified services to exclude competitions of 500 miles; the identification of services therefore encompasses 500 mile races for electric vehicles, even if there has not yet been such a competition.

We also add that regardless of whether Applicant's previous exhibition involving two electronic cars traveling 500 miles on the Indianapolis Motor Speedway was an exhibition and technically not a competitive race, a point that Applicant argues extensively in its brief, the associated specimen clearly promoted the exhibition as a race, and it has been reported to the public as such. The public therefore has already been exposed to one 500 mile exhibition billed as a race involving electric

[14] June 25, 2012 Office Action.

[15] App. Br. p. 4, 7 TTABVUE 5.

vehicles, and would understand that EV500 describes electric vehicle events involving 500 miles. Further, given the popularity of famous races like the Indianapolis 500 and the Daytona 500, and the record evidence demonstrating that the number "500" in the context of electric vehicles is the range of miles the vehicle can or aspires to travel without recharging, the public likely will understand the term "500" in the context of vehicle races to refer to the mileage of the race, and EV500 to refer to electric vehicle races involving 500 miles.

Applicant does not contend that any of the alternate meanings of "500" is a double entendre, as was Sugar & Spice for bakery goods in *Colonial Stores*, or that EV500 is otherwise incongruous, nor can we make such findings based on the evidence of record, all of which points to a 500 mile race for electric vehicles as the main feature of Applicant's services. Further, to the extent EV500 present different meanings, they are all merely descriptive of the services in the application, in that all of the asserted meanings refer to miles, laps or volts.

Each of the terms comprising Applicant's proposed mark is individually descriptive, and the combination of these terms does not evoke a new and unique commercial impression. Rather, each component of the composite marks retains its merely descriptive significance in relation to Applicant's identified services, thus resulting in composites that are themselves merely descriptive. *See In re Petroglyph Games*, 91 USPQ2d 1332 (TTAB 2009) (BATTLECAM merely descriptive for computer game software); *In re Carlson*, 91 USPQ2d 1198 (TTAB 2009) (URBANHOUZING merely descriptive of real estate brokerage, real estate

consultation, and real estate listing services). No imagination is required by a prospective purchaser or user to discern that Applicant is or will be promoting, organizing and conducting 500 mile races for electric vehicles. Accordingly, the proposed mark, EV500, when considered as a whole, is merely descriptive of Applicant's services.

Decision: The refusal to register Applicant's mark EV500 is affirmed.