

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: June 4, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Mistler

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Serial No. 85700737

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David C. Jenkins of Eckert Seamans Cherin & Mellott for William Thomas Mistler.

Timothy J. Finnegan, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).

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Before Quinn, Cataldo and Bergsman,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

William Thomas Mistler filed, on August 10, 2012, an intent-to-use Application under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), to register on the Principal Register the mark O-RING CONDOM (“CONDOM” disclaimed) (in standard characters) for “condoms” in International Class 10.

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 used in connection with Applicant’s goods, is merely descriptive thereof.

When the refusal was made final, Applicant appealed. Applicant and the Examining Attorney filed briefs.

Applicant states that its earlier-filed intent-to-use application to register the same mark for the same goods, Serial No. 77629085, was published and received a notice of allowance; there was no refusal to register the mark on the ground of mere descriptiveness. Applicant states, however, that it was unable to bring the product to market before the final deadline for filing a statement of use and, accordingly, it filed the present Application. According to Applicant, an “O-ring” is a hollow circular element that defines a passage, whereas a condom is a sheath-like element that prevents passage; Applicant claims that the two terms comprising its mark describe two items that are the antithesis of each other. Thus, Applicant maintains, the combination of the two terms results in an incongruent mark. Further, Applicant’s printed luminescent ring is a printed circle, not an O-ring, which is a gasket. Applicant argues that the Examining Attorney has improperly conflated a printed ring with an O-ring. Applicant introduced dictionary definitions of the terms “ring,” “condom,” “O-ring,” and “sheath.”

The Examining Attorney maintains that the individual words in the mark are merely descriptive, and that their combination does not create an incongruous mark that is not merely descriptive. According to the Examining Attorney, Applicant’s goods are “condoms with ‘o’ shaped rings.” (Brief, unnumbered p. 3). The Examining Attorney also points to Applicant’s patent covering the goods, which states in part “the condom includes a ring-like roll having multiple layers of the medial section of the body being wound about the first end rib.” The Examining

Attorney relied upon dictionary definitions, Applicant's patent, and a portion of Applicant's website.

A term is merely descriptive of goods within the meaning of Section 2(e)(1) if it forthwith conveys an immediate idea of a quality, characteristic, feature, function, or purpose of the goods. *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 Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods in order to be considered merely descriptive; it is enough that the term describes one significant attribute or function of the goods. *See In re H.U.D.D.L.E.*, 216 USPQ 358, 359 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338, 339 (TTAB 1973).

We must determine whether a term is merely descriptive not in the abstract, but in relation to the goods identified in the application and the possible significance that the term would have to the average purchaser of the goods. *In re ICE Futures U.S. Inc.*, 85 USPQ2d 1664, 1665-66 (TTAB 2008); *In re Polo International Inc.*, 51 USPQ2d 1061, 1062 (TTAB 1999); *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." *DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed.

Cir. 2012) (quoting *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)). The burden is initially on the Office to make a *prima facie* showing that the mark is merely descriptive from the vantage point of purchasers of applicant's goods. *In re Box Solutions*, 79 USPQ2d 1953, 1955 (TTAB 2006).

The Examining Attorney made the following definitions of record: "O-ring" meaning "a flat ring made of rubber or plastic, used as a gasket" (<education.yahoo.com/reference/dictionary>); and "condom" meaning "a sheathlike covering of thin rubber worn on the penis or in the vagina during sexual intercourse to prevent conception or infection" (<collinsdictionary.com>).

Applicant introduced the following definitions of "O-ring": "a ring (as of synthetic rubber) used as a gasket" (<m-w.com>); "a rubber ring used in machinery as a seal against oil, air, etc." (<collinsdictionary>); "a gasket consisting of a flat ring of rubber or plastic; used to seal a joint against high pressure" (<vocabulary.com>). This final entry also lists the definition of "gasket" as "[a] seal consisting of a ring for packing pistons or sealing a pipe joint."¹ Applicant also submitted a dictionary definition of "condom": "a sheath commonly of rubber worn over the penis (as to prevent conception or venereal infection during coitus)." (<m-w.com>).

¹ As indicated above, the record includes definitions obtained from the online version of *Collins* dictionary (<collinsdictionary.com>). The *Collins* dictionary, while in the English language, is published in Glasgow, Scotland and the above definitions pertain to varieties of "Worldwide" English, notwithstanding that the website also provides an option for "American" English definitions. In the future, when the *Collins* online dictionary is used, the "American English" option should be employed.

The record includes a copy of Applicant's Patent No. 7,673,632, issued March 9, 2010, covering "a condom having an indicia indicating the proper orientation for use." (Response, 12/20/12). The "Summary of the Invention" reads as follows:

The present invention discloses a condom having an indicia disposed on the lower side of the roll when the condom is in the rolled configuration. Preferably, the indicia is a fluorescent marking disposed on the inner side of the condom disposed at a location so that, when the condom is in the rolled configuration, the indicia is visible from the lower side only. More preferably, the indicia is a ring-shaped marking extending about the inner side of the tubular body. In this configuration, a user holding the condom can easily determine which is the upper side of the roll and which is the lower side of the roll. The user may then quickly orient the condom with the lower side facing toward the penis and unroll the condom in the proper direction.

An excerpt of Applicant's website (<o-ringcondom.com>) is of record. The following information is set forth:

Studies show that a significant percentage of condoms are initially applied incorrectly. Most health professionals and regulatory agencies, such as the U.S. FDA, tell us that if the condom is first applied the wrong way, the condom must be discarded to avoid increasing the risk of spreading sexually transmitted infections.

This has been a universal problem, until now.

Introducing the O-RING Condom. O-Ring Condoms are designed for exceptionally quick and easy application. O-Ring Condoms feature a patented luminescent ring on the underneath side of the rolled condom, which can be seen in the daytime and nighttime. When the luminescent ring is facing down towards the body, the condom is ready to unroll.

The dictionary evidence shows the term “O-ring” consistently defined as a gasket or rubber ring used as a seal in connection with machinery. Although we readily recognize that applicant’s condom utilizes a luminescent rubber ring to inform users of the proper orientation of the condom, the ring is not, by any definition of record, an “O-ring.” The Examining Attorney has produced no evidence to the contrary. Further, there is no evidence that competitors have a need to use the term “O-ring” to describe their condoms. It is the record evidence that controls our determination of whether an applied-for mark is merely descriptive, and the evidence falls short in this case.

Decision: The refusal to register is reversed.