

**This Opinion is Not a
Precedent of the TTAB**

Mailed: March 27, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Hookah Portable Enterprises, Inc.
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Serial No. 85829768
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Matthew H. Swyers of The Trademark Company,
for Hookah Portable Enterprises, Inc.

Jessica Powers Ludeman, Trademark Examining Attorney, Law Office 104,
Chris Doninger, Managing Attorney.

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Before Taylor, Bergsman and Masiello,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Hookah Portable Enterprises, Inc. (“Applicant”) seeks registration on the
Principal Register of the stylized mark HOOKAH PORTABLE (shown below)



for “electronic hookahs; hookahs” in International Class 34.¹ The word HOOKAH
was disclaimed voluntarily in the original application.

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¹ Application Serial No. 85829768 was filed on January 23, 2013, based upon Applicant’s
allegation of first use of the mark anywhere and in commerce on October 15, 2012. The

The Trademark Examining Attorney finally refused registration on the ground that HOOKAH PORTABLE is merely descriptive of electronic hookahs and hookahs under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

Applicant appealed to this Board, and both Applicant and the Examining Attorney filed briefs. We affirm.

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. *See, e.g., In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (internal citations omitted). *See also In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004), quoting, *Estate of P.D. Beckwith, Inc. v. Commissioner*, 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.’”)² The determination of whether a mark is merely descriptive

application includes the following statements: “The mark consists of the word HOOKAH in a large stylized cursive font. Below the word HOOKAH is the word PORTABLE in smaller non-cursive font. Color is not claimed as a feature of the mark.”

² Applicant, citing to *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502 (TTAB 1985), additionally points to, and has extensively argued with regard to, a three-part test for determining whether a mark is suggestive rather than descriptive. The test includes: (1) the degree of imagination necessary to understand the product; (2) a competitor’s need to use the same term; and (3) the competitor’s current use of the same or similar terms. Br. p. 12, 4 TTABVue 13. We note, however, that this “test” was set out in an *inter partes* case in a discussion of whether the use of a term by third parties on their packaging detracted from the plaintiff’s trademark rights. Since this decision issued in 1985, there have been numerous decisions from the Court of Appeals for the Federal

must be made in relation to the goods or services for which registration is sought. *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219. The question is not whether someone presented only with the mark could guess the products listed in the description of goods. Rather, the question is whether someone who knows what the goods 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).

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, 1217, 3 USPQ2d 1009 (Fed. Cir. 1987).

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*

Circuit, our primary reviewing court, and from the Board making clear that the test for descriptiveness is whether a term “immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Bayer Aktiengesellschaft*, 488 F.2d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007), citing *In re Gyulay*, 820 F.2d 1216, 1217, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). We base our decision herein on the test for descriptiveness set forth in the post 1985 decisions and have considered Applicant’s arguments within those parameters.

Tech., Inc., 103 UPQ2d 1822, 1823 (TTAB 2012); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988). A mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, suggestive, or otherwise nondescriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods or services, see *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968); *In re Shutts*, 217 USPQ 363 (TTAB 1983), However, if each component retains its merely descriptive significance in relation to the goods, the combination results in a composite that is itself merely descriptive. *Oppedahl & Larson LLP*, 71 USPQ2d at 1371.

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 Meditech Corp. v. Inviro Med. Devices, Ltd.* 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”).

Arguments and Evidence

Applicant, while conceding that the word “hookah” in its mark HOOKAH PORTABLE is generic,³ maintains that its mark, as a whole, is suggestive of the identified goods, and that “the ‘mental link’ between the mark HOOKAH PORTABLE and Applicant’s electronic hookahs and hookahs is neither immediate nor instantaneous.” Br. p. 11.⁴

The Examining Attorney conversely maintains that Applicant’s mark is merely descriptive of the identified electronic hookahs and hookahs because it conveys an immediate idea of a characteristic of the goods (i.e., hookahs that are easy to move), that the individual terms in the mark are descriptive and, in combined form, do not create an incongruous or nondescriptive meaning. In support of her position, the Examining Attorney points to Applicant’s concession that the word HOOKAH is generic. She also has made the following evidence of record:

1. Definitions

Hookah is defined as:

an oriental tobacco pipe with a long, flexible tube that draws the smoke through water contained in a bowl⁵

Portable is defined as:

³ Br. p. 12. 4 TTABVue 13. Applicant also voluntarily disclaimed the term “Hookah” in its brief. As previously noted, Applicant’s original application included a disclaimer of “Hookah.” The second disclaimer was unnecessary.

⁴ 4 TTABVue 12.

⁵ *The New Oxford American Dictionary* 813 (2d. ed. 2005). We grant the request in the Examining Attorney’s brief and take judicial notice of this definition. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

Carried or moved with ease⁶

Capable of being carried or moved about⁷

2. *Wikipedia Entry*

The Examining Attorney made of record a Wikipedia entry for the term “Hookah” to demonstrate that a hookah is normally a large single- or multi-stemmed instrument for vaporizing and smoking flavored tobacco in which the vapor or smoke is passed through a water basin (often glass-based) before inhalation.⁸

3. *Internet evidence*

a. The Examining Attorney made of record with her first Office action, copies of web pages from the websites of Hookah & Shisha Central, Amazon and Portable Hookahs, all showing that the term “portable” is commonly used in connection with hookahs to refer to hookahs that capable of and easy to transport.⁹ Excerpts from these webpages include, for example:

Portable Hookahs

Some genius in the past few years combined the concept of the hookah and the Big Gulp and created this little beauty: The Leila Portable Hookah. This hand-held hookah can literally fit in your cup holder ...

...

⁶ *American Heritage Dictionary of the English Language*, 5th ed. (2011), retrieved at <http://www.ahdictionary.com/word/search.html?q=portable>. Attachment to Office Action dated May 12, 2013.

⁷ *Merriam-Webster's Online Dictionary*

⁸ Attachments to the final Office action dated November 9, 2013. On pages 45 and 46 of the attachments, the substantial size of the devices can be seen.

⁹ Attachments to the Office Action dated May 12, 2013.

Not every hookah can fit in your cup holder, but some are easier to transport than others.

...

Our most recently added product line is possibly the best option for all of your portable hookah needs. They go by many names” E-cigarette, portable hookah pen, portable electronic hookah, or pocket hookah – but we just prefer E-Hookah.¹⁰

The Amazon site offers for sale, for example, a “Premium Portable Hookah and 50 gram Beamer Ultra Premium Hookah molasses!,” a “Crystal Shaped Super Mini portable tobacco Hookah pipe” and a “1 Hose Portable Pocket Hookah Design AY03.”¹¹

The home page of Portable Hookahs lists in the Menu section “Portable Hookahs” and additional web pages feature various portable hookahs, including, for example:

- a. Car Genie which is described as “the most advanced portable hookah available to date”;
- b. Mya Bambino which is described as “Small and Portable”;
- c. Mya Petite which is described as the “Ultimate in portability”;
- d. Mya QT which is described as “Portable and Easy to Clean”; and
- e. Road Warrior Chrome which “can be used as a portable hookah for walks, hikes and sightseeing.”¹²

¹⁰ <http://www.hookah-shisha.com/hookahlove/13291-portable-hookas.html>.

¹¹ <http://amazon.com/Premium-Portable-Hookah-Beamer-molasses/dp/B002N2JI3S>.

¹² <http://portablehookahs.com/products-page/>.


b. The Examining Attorney attached to the final Office action copies of webpages from the websites of eBay, Hookey, Hookah & Shisha Central, and Texas Hookah, all demonstrating through a large number of products for sale on each site that “portable” hookahs are small devices designed to be used on the go. In particular, eBay and Hookah & Shisha Central each use “portable hookahs” as a category of goods.

Discussion


We find the Examining Attorney’s evidence highly persuasive. We note, first, with regard to the term “hookah,” that Applicant’s goods are identified as hookahs and also that Applicant, in its brief, conceded that the term “hookah” is generic and offered (for the second time) a disclaimer of the term. In that regard, it has long been held that the disclaimer of a term constitutes an admission of the merely descriptive nature of the term, as applied to the goods and services with which it is used, and an acknowledgment of the lack of an exclusive right therein at the time of the disclaimer. *See Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972) (when appellant disclaimed the term in applications for registrations of compound marks, it admitted the merely descriptive nature of the mark). *See also, In re Interco Inc.*, 29 USPQ2d 2037, 2038 (TTAB 1993). Further, the dictionary definition and Wikipedia entry confirm Applicant’s concession of genericness. We accordingly find that the term “hookah” identifies the recited goods.

Notwithstanding the concession and voluntary disclaimer, Applicant made of record copies of eight third-party registrations for marks that include the term HOOKAH (or variations thereof), arguing that it would be inconsistent for the Office to deny registration of its mark by concluding that the term HOOKAH is merely descriptive of the Applicant's goods where the marks in these registrations have been permitted to register on the Principal Register without disclaimers of that term.¹³ These registrations do not persuade us, however, to come to a different conclusion, nor do they obviate Applicant's concession. In those registrations, the term "hookah" is accompanied by additional arbitrary matter, is an element of a unitary design or phrase, and/or is used in connection with goods and services other than "hookahs." Moreover, and more importantly, in determining the issue of descriptiveness, prior registrations are of little value because each case must be

¹³ These registrations include:

Registration No. 3009252 for the mark HOOKAH TROPICAL FLAVORS (the word "Flavors" disclaimed) for cigars; Registration No. 3749069 for the mark HOOKAHOLIC for hookahs; Registration No. 4332774 for the mark  for electronic cigarettes; Registration No. 4396066 for the mark THE HOOK A UP for electronic cigarettes, electronic cigarette refill cartridges sold empty and hookah parts, namely, hose adaptors;

Registration No. 4108736 for the mark  for bar, café and cocktail lounge services;

Registration No. 2836353 for the mark  (the word "Lounge" disclaimed) for restaurant, carryout and catering services; and Registration No. 3657212 for the mark



for café-restaurants.

Registration No. 3445884 (cancelled) for the mark HOOKAFINA for flavored tobacco for hookah pipes is only evidence that the registration once existed.

determined on its own facts. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001) (“Even if some prior registrations had some characteristics similar to Nett Designs’ application, the PTO’s allowance of such prior registrations does not bind the Board or this court”).

As regards the term “portable,” the dictionary definition and the Internet evidence demonstrate that the term describes an attribute or characteristic of Applicant’s hookahs, namely that they are capable of being moved about. Applicant states that there are several definitions of the term portable, such as, “capable of being used on different computer systems,” “able to be endured,” “bearable,” or “capable of being transported” and, thus, no instant association to Applicant’s good will be made.¹⁴ However, as noted previously, descriptiveness is determined in relation to the goods sought to be registered. *See In re Bright-Crest, supra*. Here, the record clearly demonstrates the descriptive significance of “portable” in relation to certain hookahs, namely, that they are movable.

In view of the evidence submitted by the Examining Attorney, we find that the individual terms “Hookah” and “Portable” have descriptive significance as used in connection with the identified goods. No hesitation or thought is needed in appreciating the meaning of these two terms.

Next, we must determine whether the combination of these two descriptive terms is still descriptive, or whether it creates a term that evokes a new and unique commercial impression. As previously stated, if, when the mark is considered as a

¹⁴ Br. p. 14, 4 TTABVue15.

whole, the merely descriptive components retain their merely descriptive significance in relation to the goods, then the resulting combination is also merely descriptive. *See, e.g., In re Oppedahl & Larson*, 71 USPQ2d at 1372; *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) (SMARTTOWER held merely descriptive of commercial and industrial cooling towers).

Here, we find that the record establishes that the phrase HOOKAH PORTABLE, as a whole, is descriptive of the identified goods. When HOOKAH PORTABLE is viewed in connection with the goods listed in the application, there is nothing in the designation which is incongruous, nor is there anything which would require the gathering of further information in order for the merely descriptive significance thereof to be readily apparent to prospective purchasers of the goods. *See, e.g., In re Abcor Development Corp., Inc.*, 588 F.2d 811, 200 USPQ 215 (CCPA) (Rich, J., concurring) [GASBADGE described as a shortening of the name “gas monitoring badge”]; *Cummins Engine Co., Inc. v. Continental Motors Corp.*, 359 F.2d 892, 149 USPQ 559 (CCPA 1966) [TURBODIESEL held generically descriptive of engines having exhaust driven turbine super-chargers]. Viewing the mark as a whole, we find that the combination of the individual terms “Hookah” and “Portable” results in a term which is not unique, incongruous or otherwise nondescriptive, but rather provides more complete information about a characteristic of Applicant’s hookahs than each word alone.


Indeed, Applicant's website bolsters our finding that the phrase HOOKAH PORTABLE merely describes the mobile characteristic of Applicant's hookahs, and specifically states (emphasis in original):

Hookah Portable is offering you a new product, a new idea, and a revolutionary advance in science that is destined to change the way people hookah forever. ... Hookah Portable provides the best hookah experience for people on the go as well. You can take your portable hookah practically anywhere, everywhere and anyplace your heart desires!¹⁵

In urging reversal of the refusal, Applicant argues:

There[] would be a stronger association with what the goods may be insofar as one hears PORTABLE HOOKAH they would naturally think of [a] hookah that is portable. That is not the case if the terms are transposed. Moreover, if they are transposed and highly stylized.

In the instant case, because of the stylization of the mark in conjunction with the transposition of the terms some degree of imagination is required to associate the terms HOOKAH PORTABLE with the Applicant's goods.¹⁶

We disagree and find that the stylization of the lettering in which HOOKAH appears does not create a separate and inherently distinctive commercial impression apart from the word itself. Accordingly, it does not obviate the descriptive significance of the term. *See, e.g., In re Cordua Rests. LP*, 110 USPQ2d 1227 (TTAB 2014) (the stylization of  found insufficient to create an inherently distinctive impression apart from the term itself); *In re Sadoru Group*

¹⁵ <http://hookahportable.com/about-hp/>?, attachment to the Final Office Action dated November 9, 2013.

¹⁶ Br. p. 13, 4 TTABVue14.

Ltd., 105 USPQ2d 1484 (TTAB 2012) (the stylization of **SADORU** found insufficient to create an inherently distinctive impression apart from the term itself). We similarly find that the transposition of the terms “Hookah” and “Portable” does not add anything that would change the commercial impression of the individual terms or create any type of incongruity. *See, e.g., In re Away Chemical Corp.*, 217 USPQ 275 (TTAB 1982) (The transposition of “tablets for pans” to “pan-tablets” failed to overcome the “descriptive cast” of the mark CONDENSATE DRAIN PAN-TABLETS); *In re Vasco Metals Corp.*, 154 USPQ 191 (TTAB 1967) (the Board noted that the mere transposition of words is generally insufficient to create trademark rights in an otherwise recognizable common descriptive term). Indeed, Applicant points to and we discern no alternate meaning resulting from the reversal of terms. Instead, as displayed in the applied-for mark, the term “Portable” appears in smaller lettering, a less stylized font and below the term “Hookah,” such that it appears to modify an aspect of the more visually prominent term “Hookah.”

Applicant’s contention that it is the only user of the term likewise is unavailing. The fact that an applicant may be the first and only user of a merely descriptive or generic designation does not justify registration if the only significance conveyed by the term is merely descriptive. *See In re Nat’l Shooting Sports Found., Inc.*, 219 USPQ 1018 (TTAB 1983) (SHOOTING, HUNTING, OUTDOOR TRADE SHOW AND CONFERENCE held descriptive for conducting and arranging trade shows in the hunting, shooting, and outdoor sports products field).

Applicant also relies on numerous cases to bolster its contention that its applied-for mark is not merely descriptive of the identified goods. This reliance is misplaced. As noted, each case must be decided on its own merits. The determination of registrability of a mark in another case does not control the merits in the case now before us. *See In re Nett Designs Inc.*, 51 USPQ2d at 1566; *see also, In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001); *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001). In this case, the evidence clearly demonstrates that Applicant's applied-for mark HOOKAH PORTABLE is merely descriptive of the identified goods.

Finally, we note Applicant's reliance on the principle that when there is doubt on the issue of whether a mark is merely descriptive, that doubt should be resolved in favor of the applicant. In the present case, we have no doubt that Applicant's mark is merely descriptive.

After careful consideration of all of the evidence and arguments presented, we conclude that when applied to Applicant's goods, the designation HOOKAH PORTABLE, as a whole, immediately describes, without any kind of multi-step reasoning, a characteristic of the identified goods, namely that Applicant's electronic hookahs and hookahs are capable of being carried or, stated another way, that they are portable.

Decision: The refusal to register HOOKAH PORTABLE under Section 2(e)(1) is affirmed.