

This Opinion is not a
Precedent of the TTAB

Mailed: June 22, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Penny Johnson
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Serial No. 86017471
—

Luke Brean of BreanLaw, LLC,
for Penny Johnson,

Karen Severson, Trademark Examining Attorney, Law Office 117,
Hellen M. Bryan-Johnson, Managing Attorney.

—
Before Bergsman, Lykos and Kuczma,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Penny Johnson (“Applicant”) seeks registration on the Principal Register of the
mark, in stylized text, shown below:

Grocery Gear

for “Reusable grocery bags” in International Class 18.¹

The Trademark Examining Attorney 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 proposed mark merely describes a feature or purpose of Applicant’s goods.

When the refusal was made final, Applicant appealed and requested reconsideration. After the request for reconsideration was denied, the appeal was resumed. Applicant and the Examining Attorney have filed briefs. After careful consideration of the evidence in the record and of the arguments of counsel, we affirm the refusal to register.

I. Evidentiary Issue

Before proceeding to the merits of the refusal, we address an evidentiary matter. Applicant submitted exhibits attached to its appeal brief. Resubmission of materials already of record is duplicative and unnecessary. Furthermore, any materials not previously made of record during prosecution of the application are untimely if submitted for the first time at briefing. *See* Trademark Trial and Appeal Board Manual of Procedure (June 2014) § 1203.02(e) and authorities cited therein. In view of the foregoing, no consideration is given to the exhibits filed with the Brief for Applicant.

¹ Application Serial No. 86017471 was filed on July 23, 2013, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

II. Applicable Law

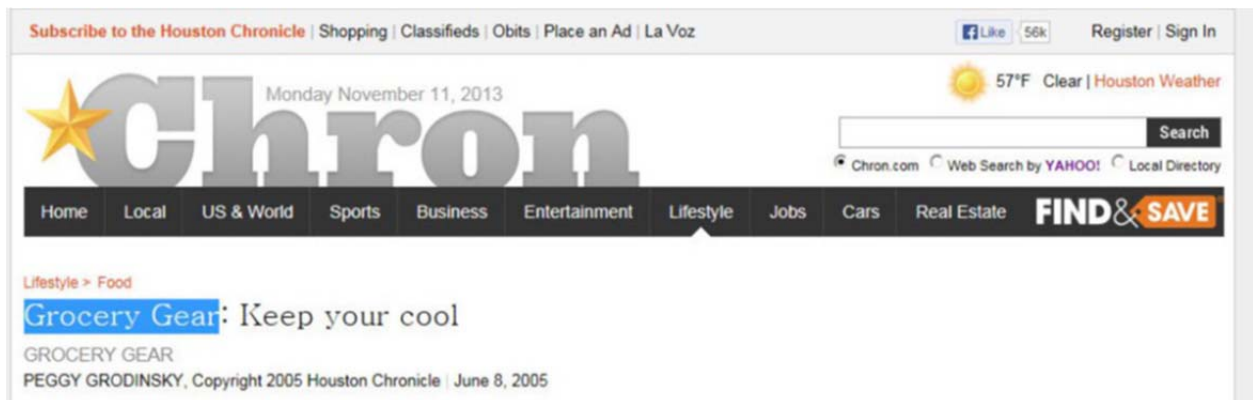
A term is merely descriptive within the meaning of § 2(e)(1) if it immediately conveys knowledge of a quality, characteristic, function, feature, purpose or use of the goods with which it is used. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) and *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive must be determined not in the abstract, but in relation to the goods for which registration is sought, the context in which the term is used, and the possible significance that the term is likely to have to the average prospective purchaser encountering the goods in the marketplace. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Phoseon Technology Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012).

Because GROCERY GEAR is a composite mark, we examine the meaning of each component individually, and then determine whether the mark as a whole is merely descriptive. *See DuoProSS Meditech Corp. v. Inviro Medical Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1758 (Fed. Cir. 2012).

In support of the descriptiveness refusal, the Examining Attorney submitted evidence including dictionary definitions and third-party webpages showing use of the wording GROCERY GEAR, GROCERY and GEAR, used descriptively in connection with reusable grocery bags used for carrying grocery items. The definition for “grocery” is “food sold by a grocer: food bought at a store;” and “gear”

is defined as “equipment, paraphernalia.”² Moreover, “grocery” appears in the identification of goods, i.e., “reusable grocery bags,” further supporting the descriptiveness of that term.

The internet evidence, while not abundant, shows use of the terms “fabulous grocery gear” in connection with reusable grocery bags³, and “Grocery Gear: Keep your cool” for a collapsible cooler used to carry groceries as shown below:⁴



Although such evidence by itself is not compelling, it supports the descriptive meanings of the terms identified by the dictionary definitions.

In addition, the Examining Attorney introduced six third-party registrations, three including the term GROCERY and three including the term GEAR, which each disclaimed either GROCERY or GEAR when used in connection with reusable

² See dictionary definitions attached to November 12, 2013 Office Action: <http://www.merriam-webster.com/dictionary/grocery>; <http://www.merriam-webster.com/dictionary/gear?show=0&t=1384254292>.

³ www.fabgreen.com/2007/02/19/fabulous-grocery-gear-2/ showing use of “fabulous grocery gear” in connection with reusable grocery bags attached to November 12, 2013 Office Action.

⁴ www.chron.com/life/food/article/Grocery-Gear-Keep-your-cool-1935099.php displaying copy of article entitled: “Grocery Gear: Keep your cool” that discusses a collapsible cooler used to carry groceries published online by the Houston Chronicle, attached to November 12, 2013 Office Action.

and/or textile shopping bags in International Class 18.⁵ Third-party registrations featuring goods the same as or similar to Applicant's goods are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on acquired distinctiveness, or registered on the Supplemental Register. *See Institut National des Appellations D'Origine v. Vintners International Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006). Such third-party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods. *Sweats Fashions, Inc. v. Pannill Knitting Co., Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987); *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172, 1174 (TTAB 1987).

The descriptive meanings of the individual terms GROCERY and GEAR with respect to Applicant's goods are established by the foregoing evidence. However, combinations of merely descriptive terms are registrable if their combination results in a new and different commercial impression and/or the term created imparts a unique, incongruous or otherwise non-descriptive separate meaning as used in

⁵ Attached to October 6, 2014 Request for Reconsideration Denied: Reg. No. 2944542 MAXPEdition HARD-USE GEAR, Reg. No. 4096303 FORCEPROTECTOR GEAR, Reg. No. 4566208 FULL SERVICE GEAR, Reg. No. 3385192 OAKVILLE GROCERY, Reg. No. 4178247 JERMIKKO STATUS BAG GROCERY, SHOPPING & ALL PURPOSE BAG DESIGNED TO SHOW YOUR STATUS. Reg. No. 3469085 for GROCERY POD was in force when the Examiner submitted it, but was cancelled on February 20, 2015, for failure to file an affidavit of continuing use pursuant to Trademark Act § 8. Because it is well-established that an expired or cancelled registration is evidence of nothing but the fact that it once issued, it is no longer of value in support of descriptiveness. *Sunnen Prods. Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987).

connection with the goods. *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382, 384 (CCPA 1968); *In re Positec Group Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013). Generally, if each component retains its descriptive significance in relation to the goods, as is the case with respect to Applicant's applied-for mark, the combination results in a composite that is itself descriptive. *See DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, 103 USPQ2d 1753 (SNAP SIMPLY SAFER merely descriptive for medical devices); *also see, In re Petroglyph Games Inc.*, 91 USPQ2d 1332, 1341 (TTAB 2009) (BATTLECAM merely descriptive for computer game software); *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (THE BREATHABLE MATTRESS held merely descriptive of beds, mattresses, box springs, and pillows where BREATHABLE retained its ordinary dictionary meaning when combined with MATTRESS and the resulting combination was used descriptively in the relevant industry); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (GROUP SALES BOX OFFICE is merely descriptive of theater ticket sales services because it combines the two common descriptive terms most applicable to applicant's services which remains a common descriptive compound expression).

Based on the definitions of the terms used in the applied-for mark, the fact that Applicant itself has described its goods as "reusable grocery bags,"⁶ and the manner in which Applicant promotes its goods, *i.e.*, "pack & transport grocery system," consumers would understand that the applied-for mark describes the purpose

⁶ See App. Brf. at p. 4 (7 TTABVue 5).

and/or a feature of the goods, namely, that they are bags intended to carry items from a grocery store. Thus, when used in combination, the combined terms do not evoke any new or unique commercial impressions. Because the terms retain their merely descriptive significance in relation to the goods, the combination results in a composite that is itself merely descriptive. *See In re Phoseon Technology*, 103 USPQ2d at 1823. A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358, 359 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338, 339 (TTAB 1973).

In support of the registrability of the applied-for mark, Applicant argues that the absence of evidence of descriptive usage of GROCERY GEAR by others constitutes strong evidence that the applied-for mark is not descriptive.⁷ It is well established that simply because an applicant may have been the first or only user of a merely descriptive designation does not necessarily render it incongruous or distinctive if the only significance conveyed by the term is merely descriptive, as is the case here. *See In re Phoseon Technology*, 103 USPQ2d at 1826; *In re Alpha Analytics Investment Group LLC*, 62 USPQ2d 1852, 1856 (TTAB 2002). Moreover, some of the evidence showed descriptive use of the term “Grocery Gear”⁸ by third parties.

⁷ App. Brf. p. 5 (7 TTABVue 6).

⁸ See www.fabgreen.com/2007/02/19/fabulous-grocery-gear-2/ and www.chron.com/life/food/article/Grocery-Gear-Keep-your-cool-1935099.php attached to November 12, 2013 Office Action.

As to the alleged incongruity of the applied-for mark urged by Applicant, Applicant does not explain the incongruity and we see none. The applied-for mark combines the merely descriptive term GROCERY with the merely descriptive term GEAR. This combination of terms simply informs that Applicant's goods are bags for carrying groceries. Thus, there is nothing incongruous about the applied-for mark when viewed as a whole. The design and display of the terms GROCERY and GEAR in the mark do nothing that detracts from the descriptiveness of the applied-for GROCERY GEAR mark. Thus, no imagination, thought or perception is needed to understand the nature of the identified goods.

Applicant notes that when deciding the issue of descriptiveness, it is the Board's policy to resolve doubts in favor of the applicant and allow the mark to be published. *See In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981); *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).⁹ Here, however, there is no such doubt about the descriptiveness of the applied-for mark.

III. Conclusion

Based on the foregoing, the evidence shows that the components of the applied-for mark are descriptive and retain their descriptive meaning when combined such that the overall composite is descriptive. The Examining Attorney has met the USPTO's burden to establish that Applicant's applied-for mark is merely descriptive. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007).

⁹ Applicant's Appeal Brief at p. 6 (7 TTABVUE 7).

The applied-for mark is a combination of descriptive terms that immediately conveys a feature of the purpose of Applicant's goods, namely, equipment, (*i.e.*, bags) used to carry items purchased at a grocery store. We have no doubt that both the individual components and the composite result of the applied-for mark are descriptive of Applicant's goods and do not create a unique, incongruous or non-descriptive meaning in relation thereto.

Grocery Gear

Decision: The refusal to register Applicant's mark: under
§ 2(e)(1) of the Trademark Act is affirmed.