

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

Mailed: July 23, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Dipyourcar.com LLC
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Serial No. 86165003
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Matthew H. Swyers of The Trademark Company for Dipyourcar.com LLC.

Deirdre G. Robertson, Trademark Examining Attorney, Law Office 111,
Robert L. Lorenzo, Managing Attorney.

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Before Kuhlke, Cataldo and Lykos, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Dipyourcar.com (Applicant) seeks registration on the Principal Register of the standard character mark DIP PEARLS for “Paint additive made of recycled material to add texture, color, or reflection; Textured additives for paint,” in International Class 2.¹

¹ Application Serial No. 86165003, filed on January 14, 2014, based upon Applicant’s allegation of first use and first use in commerce on January 10, 2014 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

The Trademark Examining Attorney has refused registration of Applicant's mark on the ground that DIP PEARLS is merely descriptive of Applicant's goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

When the refusal was made final, Applicant appealed. The Examining Attorney and Applicant filed briefs. We affirm the refusal to register.

Mere Descriptiveness

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 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.")). *See also In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015). 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 of 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 Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (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, 1010 (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 Tech., Inc.*, 103 UPQ2d 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 & Larson LLP*, 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 if the composite has a bizarre or incongruous meaning as applied to the goods or services. *See generally In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968). *See also In re Shutts*, 217 USPQ 363, 364-65 (TTAB 1983).

Evidence and Argument

The Examining Attorney asserts that “the applied-for mark, when considered in relation to the applied-for goods, immediately and directly conveys the meaning that the goods are pearl paint additives used with car dip paints.” Ex. Att. Br., 6 TTABVUE 7.

In support of her position, the Examining Attorney submitted web pages from several third-party websites and Applicant's website using the words DIP and PEARL(S) to describe a type of automotive paint application (dip or dipping) and paint additives (pearls) applied to cars by dipping. A few examples highlighted by the Examining Attorney are set forth below:

The Car Dip Kit website shown below includes the following text:

Water transfer printing, also called hydrographics or car, dash and automotive dipping, is the process that transfers an image or pattern to a 3D surface. ... Automotive manufacturers use dipping to print wood grain patterns, and many other patterns, on all kinds of auto parts. ... Perfect for the first time car dipper, the entry level kit contains everything you will need to dip items in your own home. ... Need to dip larger or more items? The Elite kit comes with everything you will need to dip a bigger, or larger amount of items. ... Our kit was designed to make automotive dipping problem free. ... this means that your dipped product will be resistant to the elements as well as fading and chipping for years to come.



The Autoaspire website shown below advertising, *inter alia*, “wraps, dipping and dips and tinting” includes the following text:

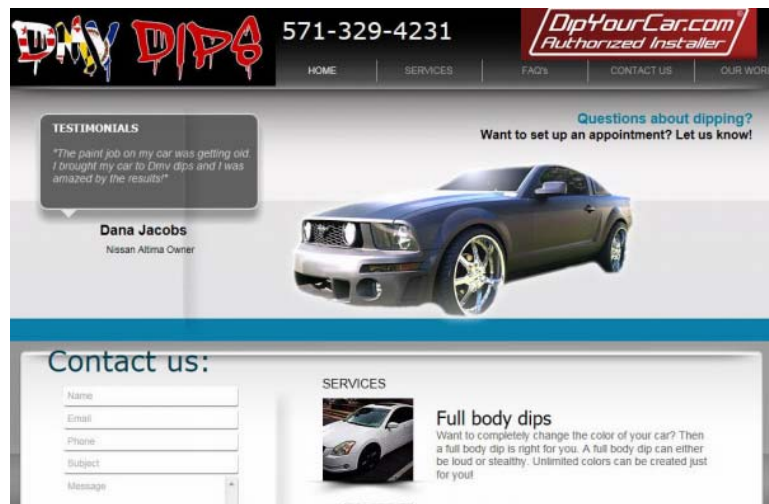
² MYDIPKIT website (<http://cardipkit.com>), May 30, 2014, Office Action, TSDR pp. 2-9.

From dipping rims and wheels, to full body dipping, wrapping, and window tinting. We use the best material and professional techniques in our products and application. ... There's this notion that plasti-dip has to be only flat black. ... We have a number of services to meet your needs. One of our most affordable services is Plasti-dipping. "Dipping" is an inexpensive way to get an exclusive look for your car dips.



The website also provides the pricing for different types of dips, e.g., spot dip, area dip, pro dip and premium dip.³

The DMV Dips website shown below also offers "full body dips" explaining that "[a] full body dip can either be loud or stealthy."



³ Autoaspire website (<http://autoaspire.com>), *Id.* at 5-7.

⁴ DMV Dips website (www.dmvdips.com), *Id.* at 16. This third party appears to be Applicant's authorized dealer.

The WikiHow website shown below includes the following text explaining pearls:



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The Paint with Pearl website shown below explains that “Pearls add not only depth but a brilliant color changing effect when exposed to certain light. Our pearl paints, candy paints, and metal flakes work equally well in automotive paint, powder coats, fiberglass gel coat, concrete sealer ...”



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The DuPont website shown below describes “pearls” as a type of paint additive:

⁵ WikiHow website (www.wikihow.com), *Id.* at 26.

⁶ Paint with Pearl website (www.paintwithpearl.com), *Id.* at 18-19.

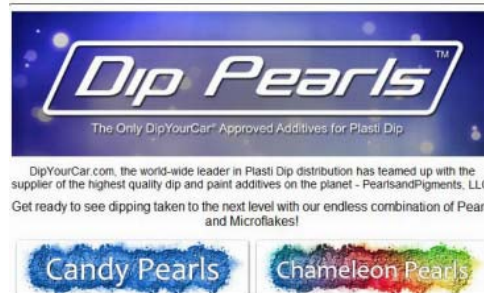


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The excerpts shown below are from Applicant's website:



Dip Pearls (Pearls, Flakes and Additives)



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⁷ DuPont website (<http://pc.dupont.com>), *Id.* at 44.

⁸ Applicant's website (www.dipyourcar.com), February 11, 2014 Office action, TSDR p. 2.

⁹ *Id.* at 15.



Sample Sizes are easy!

Every one of our Pearls and Micro Flakes are available in both 25 gram bags, and 5 gram Sample bags. Mix and match as many or as little as you want!

Suggested amounts of Pearls and Flakes

Additive	Grams per gallon
Candy Pearls	50
Chameleon Pearls	75
Micro Flakes	25
Holographic Micro Flakes	25
Color Shifting Micro Flakes	25

*We do not recommend using more than the suggested amount of Micro Flakes

[FAQ/How to Use Dip Pearls](#)

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Noting that several third-party websites offer car dip kits and/or car dipping services, the Examining Attorney asserts that DIP is merely descriptive “because it merely indicates how the applicant’s paint additives are applied to automobiles. Specifically, automotive ‘dipping’ is a particular type of aftermarket automotive paint application.” Ex. Att. Br., 6 TTABVUE 5.

Pointing to the record, she contends that PEARLS “is descriptive because it merely indicates the particular type of applicant’s paint additives. Specifically, aftermarket automotive paint additives called ‘pearls’ are a particular category of additive that adds luster to automotive paint finishes.” Ex. Att. Br., 6 TTABVUE 6.

As to the proposed mark in its entirety, she argues that “[t]he term ‘PEARLS,’ when combined with the term ‘DIP,’ clearly indicates that [sic] the type of the additive.” Ex. Att. Br., 6 TTABVUE 9. She continues that “[e]ven if the additives were offered in the shape of pearls, the term ‘PEARLS’ is still merely descriptive.

¹⁰ *Id.* at 16.

The term would describe both the type and form of the additive. The evidence ... shows that the paint additive ‘pearls’ come in ‘pearls’ and ‘flakes.’” *Id.*

In support of its position that its proposed mark DIP PEARLS is not merely descriptive of its goods, Applicant submitted the following dictionary definitions:

Pearl: noun 1. a smooth, rounded bead formed within the shells of certain mollusks and composed of the mineral ... 2. Something resembling this, as various synthetic substances for use in costume jewelry 3. Something similar in form as a dew drop or capsule of medicine 4. Something precious or choice, the finest example of anything, pearls of wisdom 5. A very pale gray approaching white but commonly with a bluish tinge.¹¹

Dip: verb 1. To plunge .. temporarily into a liquid, so as to moisten it, dye it or cause it to take up some of the liquid 2. To raise or take up by a bailing, scooping, or ladling action 3. to lower and raise 4. To immerse in a solution to destroy germs, parasites, or the like 5. To make by repeatedly plunging a wick into melted tallow or wax.¹²

Applicant also submitted several third-party use-based registrations that include the terms DIP or PEARL.

Applicant argues that “[w]hile DIP speaks for itself when used in connection with automotive paint, the terms together ‘DIP PEARLS’ does not immediately direct the consumer to a paint additive used to create light and texture in an automobile’s paint. Thus, even if a consumer utilized their imagination, they would still not know immediately what types of goods are provided and what its functions are.” App. Br. p. 6, 4 TTABVUE 7.

¹¹ (www.dictionary.com), May 16, 2015 Response, TSDR p. 14.

¹² *Id.* at 15.

Applicant contends that “[w]hile goods used in connection with the mark in question are automotive paints, the terms placed together can conjure up numerous other images, and there is no instantaneous connection between the ‘DIP PEARLS’ and paint additives. While some consumers may assume the use of the term ‘PEARLS’ indicates tiny additives in the paint in the shape of pearls, others may assume ‘PEARLS’ simply refers to the color of the paint, such as ‘PEARL WHITE.’ Further, still, some consumers may assume the additives are actual precious stones (pearls) that are crushed and mixed into the paint.” App. Br. p. 5, 4 TTABVUE 6.

The Examining Attorney responds that “consumers are unlikely to assume in the context of Applicant’s goods that it would refer to the color “pearl white” because of the connotation of the composite mark, *i.e.*, coupling PEARLS with DIP the connotation is a type of additive not a color. As to the possible meaning of crushed precious stones she responds that there is no evidence to support such consumer perception; rather the record supports the consumer perception that they are a type of paint additive. Ex. Att. Br. p. 8, 6 TTABVUE 9.

Applicant points to the third-party registrations and argues “it would be inconsistent for the office to assert that Applicant’s mark is merely descriptive of Applicant’s goods where the above-referenced marks containing the terms ‘DIP’ and ‘PEARLS’ have been permitted to register on the Principal Register and thus not found to be merely descriptive.” App. Br. p. 7, 4 TTABVUE 8.

We find that the third-party registrations do not support Applicant’s position. First, as is well established, we must make our decision in each case on its own

merits “[e]ven if some prior registrations had some characteristics similar to” the current application, “the PTO’s allowance of such prior registrations does not bind the Board” *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Moreover, many of the registrations upon which applicant relies are registered on the Supplemental Register (Reg. No. 4389865 for the mark RUBBER DIP for “a liquid air dry coating applicable to tools and other articles made of wood, metal, glass, rope, fabric and plastic to protect against chemicals, ultraviolet light, abrasion, penetration, moisture, rust and corrosion”) or under Section 2(f) based on acquired distinctiveness (Reg. No. 2108560 for the mark DIP SEAL for “clear and colored transparent hot metal plastics sealer coatings for application to hand and machine tools to protect against corrosion, impact, abrasion, and chemical action”), are unitary marks where the terms are coupled with arguably distinctive matter (Reg. No. 4179313 for the mark STRAND OF PEARLS for “interior and exterior paint”) and/or are marks for dissimilar goods rendering those examples irrelevant to the question before us (Reg. No. 1234065 for the mark DIP-AN-EGG for “egg dyes”).

Finally, Applicant contends that it is unlikely that any competitor would need this phrase given other options such as Jewel, Drenching Bead and Immersion Drop and there is no evidence of competitor use of this term. *Id.* at 10. While the presence of third-party use could be probative on the question of competitive need, the absence thereof is not dispositive. Although Applicant may be the first and presently the only user of the term for such goods, this fact does not obviate a mere descriptiveness refusal. *In re Nat’l Shooting Sports Found., Inc.*, 219 USPQ 1018,

1020 (TTAB 1983). Moreover, it is not clear these terms are exact synonyms for DIP PEARLS.

Analysis

The record shows that in connection with car painting the term “DIP” means type of aftermarket automotive paint application. In addition, in connection with paint additives the term PEARL(S) means a type of paint additive. The combination of these terms simply describes the type of PEARL paint additives, *i.e.*, those used for dip. There is nothing incongruous or unique to cause the consumer to exercise any imagination when presented with the combination DIP PEARLS when purchasing paint additives.

By contrast, there is nothing in the record to support a finding that the combination does not retain the same descriptive meaning when used in connection with paint additives. We conclude that the combination DIP PEARLS does not present a unique or incongruous term such that the combination removes the merely descriptive significance from the terms.

Applicant’s arguments regarding the other meanings of the words DIP and PEARL do not take into account the perception of the consumer as to meaning in the context of Applicant’s goods, *i.e.*, what meaning is relevant to paint additives. In addition, the fact that the word PEARL may have a different merely descriptive meaning in another context, is not controlling on the question of descriptiveness. *In re RiseSmart Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012); *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984). In our analysis of the proposed term, DIP PEARLS,

we must consider “the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use.” *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219. Applicant’s broad identification encompasses pearl paint additives for use in dipping. Applicant’s website makes clear that a significant feature of its paint additives, *i.e.*, pearls, is that they are designed for use with dip, a type of automotive paint application. *See Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219. *See also In re Bayer Aktiengesellschaft*, 82 USPQ2d at 1832 (Internet evidence may be considered for purposes of evaluating a trademark).

Where the combination of descriptive terms creates a unitary mark with a unique, incongruous or otherwise non-descriptive meaning in relation to the goods, the mark is registrable. *Colonial Stores, Inc.*, 157 USPQ at 384. Applicant’s use of the term DIP PEARLS does not evoke other meanings such that “the merely descriptive significance of the term[s] is lost in the mark as a whole.” *RiseSmart Inc.*, 104 USPQ2d at 1934 (quoting *In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983)). *See also In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002) and *In re Cryomedical Sciences Inc.*, 32 USPQ2d 1377, 1379 (TTAB 1994). In the context of these goods, “Paint additive made of recycled material to add texture, color, or reflection; Textured additives for paint,” the meaning of DIP PEARLS is clear; there is no incongruity or double entendre.

We find that DIP PEARLS immediately describes a significant feature of the goods, namely a type of paint additive for use with the automotive paint application called dip.

Decision: The refusal to register Applicant's mark DIP PEARLS as merely descriptive under Section 2(e)(1) is affirmed.