

This Opinion is not a
Precedent of the TTAB

Mailed: September 29, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Eveready Battery Company, Inc.
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Serial No. 86268913
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Thomas A. Polcyn of Thompson Coburn LLP,
for Eveready Battery Company, Inc.

Esther Queen, Trademark Examining Attorney, Law Office 111,
Robert L. Lorenzo, Managing Attorney.

—
Before Bucher, Zervas and Heasley,
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Eveready Battery Company, Inc. (“Applicant”) seeks registration on the Principal Register of the mark BANANA BOAT (in standard characters) for “Air fragranc[ing] [sic] preparations; Room fragrances” in International Class 3.¹

¹ Application Serial No. 86268913 was filed on May 1, 2014, 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 refused registration of Applicant's mark on the ground that the wording "Banana" must be disclaimed because it "merely describes the scent of the goods." See 15 U.S.C. §§ 1052(e)(1) and 1056(a).

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

I. Applicable Law

Merely descriptive terms are unregistrable, under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), and, therefore, are subject to disclaimer if the mark is otherwise registrable. Thus, an Examining Attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6(a), 15 U.S.C. § 1056(a). Failure to comply with a disclaimer requirement is grounds for refusal of registration. *See In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (CCPA 1975); *In re Ginc UK Ltd.*, 90 USPQ2d 1472 (TTAB 2007).

Thus, a term must be disclaimed apart from the mark as shown if it is deemed to be merely descriptive of the subject goods or services. A term is deemed to be merely descriptive within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *See, e.g., In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978).

The Examining Attorney has submitted the following evidence in support of the disclaimer requirement:

- a. A dictionary definition of “banana” as a type of tropical fruit.²
- b. Internet evidence to show that “banana” is a scent:
 - Nature’s Garden Wholesale Candle & Soap Supplies, offering banana fragrance oil.³
 - Amazon, offering Banana Room Spray by Eclectic Lady.⁴
 - 1803 Candles, offering banana walnut cake linen & room spray.⁵
 - Jane Bernard Aromatics Sensational Gifts, offering coconut and banana room spray.⁶
 - Barn Candle Company, offering room spray featuring ”ripe banana.”⁷
 - Jazz Candles, offering room sprays featuring a banana blend.⁸
 - Sassafras Hill, offering room sprays featuring bananas.⁹

² <http://dictionary.reference.com/browse/banana?s=t> (accessed on July 25, 2014). Priority Action dated July 25, 2014.

³ [http://www.naturesgardencandles.com/candlemaking-soap-supplies/item/618/-banana-\(true\)--fragrance-oil-.html](http://www.naturesgardencandles.com/candlemaking-soap-supplies/item/618/-banana-(true)--fragrance-oil-.html) (accessed on July 25, 2014). Priority Action dated July 25, 2014.

⁴ <http://www.amazon.com/Banana-Room-Spray-8-ounces/dp/B00KKLTT20> (accessed on July 25, 2014). Priority Action dated July 25, 2014.

⁵ <http://1803candles.com/banana-walnut-cake-linen-room-spray.html> (accessed on December 31, 2014). Office Action dated January 7, 2015.

⁶ <http://www.scentsationalgifts.com/browseproducts/Asquith---Somerset-Coconut-and-Bananafor-Home-Fragrance.html> (accessed on December 31, 2014). Office Action dated January 7, 2015.

⁷ <http://www.barncandles.com/store/p/370-Banana-Cream-Pie-Barn-Room-Spray.aspx?> (accessed on December 31, 2014). Office Action dated January 7, 2015.

⁸ <http://jazzcandles.com/product/ROOMSPRAYS/%20/TDM-RP> (accessed on December 31, 2014). Attachment to the Office Action dated January 7, 2015.

⁹ <http://www.sassafrashill.com/store/WsDefault.asp?One=833> (accessed on December 31, 2014). Attachment to the Office Action dated January 7, 2015.

- Scentsy, offering BananaBerry Room Spray.¹⁰
- The Candleberry Co., offering a candle featuring a dominant nutty banana scent.¹¹

Applicant argues that it is not using BANANA to describe the scent of the goods, but is using BANANA BOAT as a unitary phrase:

Applicant has been using its well-known trademark BANANA BOAT as a source indicator for almost 40 years. In addition, the term “banana boat” refers to a type of boat. Thus, consumers will perceive BANANA BOAT as a unitary mark, not a combination of two separate and independent components.¹²

In addition, Applicant argues:

Here, the mark is unitary by virtue of its incongruity. Consumers would not be likely to conclude that BANANA BOAT describes a banana scented BOAT, and indeed inflatable recreational boats sometimes referred to as “banana boats” are not known for having any particular scent. If anything, “banana” is a reference to the shape of such boats, which of course has nothing to do with Applicant’s mark.¹³

Further, Applicant disputes the probative value of the Examining Attorney’s Internet evidence, stating that the uses clearly are referring to “the scent of the fruit BANANA,”¹⁴ while Applicant is not using the term to refer to a scent. In addition, Applicant submitted with its response to the First Office Action a copy of the following registrations where BANANA was not disclaimed, arguing that they

¹⁰ <http://scentbars.com/products/bananaberryscentsy-room-spray> (accessed on December 31, 2014). Attachment to the Office Action dated January 7, 2015.

¹¹ http://www.candleberry.com/scents/view-scent?name=Nanner_Nut_Bread#Nanner-Nut-Bread-26-oz-Jar-Candle (accessed on December 31, 2014). Attachment to the Office Action dated January 7, 2015.

¹² Applicant's Brief at 8, 4 TTABVUE 9.

¹³ Applicant's Brief at 8, 4 TTABVUE 9.

¹⁴ Applicant's Brief at 4, 4 TTABVUE 5.

support its position that the term BANANA in Applicant's mark is not merely descriptive of its goods:

1. BANANA REPUBLIC; Reg. No. 2048367 for toilet water, shower gel, moisturizing body lotion, soap; aromatic candles;
2. BANANA REPUBLIC MODERN; Reg. No. 2459986 for cologne;
3. BANANA NUT BREAD; Reg. No. 2319762 for hair products, namely, shampoos; and bath products, namely gels, and bubble bath; and
4. BANANA MOON; Reg. No. 3534514 for toilet water, perfumes, perfumed soaps, essential oils, shaving preparations, deodorants for body care, cosmetic sun-tanning preparations, hair lotions, body creams, room spray.¹⁵

After carefully reviewing the evidence and the parties' arguments, we find that the term BANANA in the mark is merely descriptive of a feature of Applicant's goods, namely, the scent of the preparations and room fragrances. The Examining Attorney's evidence clearly demonstrates that "banana" is a scent that is marketed in room sprays. Applicant's countering evidence is not persuasive; Applicant has only provided a handful of registrations which do not contain a disclaimer of BANANA and the subject marks may have been considered unitary terms.¹⁶ Further, Applicant has not provided any evidence demonstrating that its mark is

¹⁵ Applicant also submitted a registration for ELECTRIC BANANA; Reg. No. 2925265 for cosmetics, hair dyes, hair colors. Because the subject goods for this registration do not concern goods having an aroma, this registration has limited probative value.

¹⁶ Besides, as the Examining Attorney points out, prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the Board. *See In re Midwest Gaming & Entm't LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). Each case is decided on its own facts, and each mark stands on its own merits. *See AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (CCPA 1973).

famous or well-known, and there is no dictionary definition of “banana boat” in the record (and we have not located one from an American English dictionary) to support the meaning Applicant attributes to “banana boat.” Applicant’s additional point that the term BANANA in the mark, when combined with BOAT, is not being used to refer to a scent, is not well taken; Applicant’s identification of goods allows for banana scented preparations and fragrances, and, because the mark is not unitary, consumers would likely consider the term to refer to a banana scent.

Thus, we find that the evidence does not support Applicant’s contention that the mark is a unitary term and the word “banana” in the mark is not merely descriptive. Rather, we find the term “banana” in Applicant’s mark to be merely descriptive. We have no doubts as to our conclusion, and hence do not need to resolve any doubt in Applicant favor, as Applicant urges us to do at pp. 9-10 of its Brief.¹⁷

Decision: The requirement for a disclaimer of the term “Banana” is affirmed and registration to Applicant is refused. However, in the event that Applicant submits the required disclaimer within **thirty days** from the mailing date of this decision, the refusal to register will be set aside and the application will proceed to publication. See Trademark Rule 2.142(g).

¹⁷ 4 TTABVue 10-11.