

This Opinion is not a
Precedent of the TTAB

Mailed: March 6, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Imaginif, Inc.
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Serial No. 86420607
—

John S. Zanghi and Rachel A. Smoot of Fay Sharpe LLP,
for Imaginif, Inc.

Paula M. Mahoney, Trademark Examining Attorney, Law Office 119,
Brett J. Golden, Managing Attorney.

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Before Quinn, Kuczma and Heasley,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Imaginif, Inc. (“Applicant”) seeks registration on the Principal Register of the
mark KRISMAS (in standard characters) for:

“Retail toy store services; online retail toy store services;
retail store services featuring holiday merchandise,
holiday ornaments, apparel, seasonal gifts, giftware, hats,
scarves and gloves; online retail store services featuring
holiday merchandise, holiday ornaments, apparel,
seasonal gifts, giftware, hats, scarves and gloves” in
International Class 35; and

“Live theatrical presentations; entertainment services,
namely, providing non-downloadable prerecorded online
theatrical presentations; television appearances by an

entertainer; photography services; digital imaging services; portrait photography; children's theatrical services, namely, presentation of live show performances; presentation of live show performances directed to children; entertainment in the nature of theater productions” in International Class 41.¹

The Trademark Examining Attorney has 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 it is merely descriptive of Applicant’s identified services.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

I. Analysis

The Lanham Act precludes registration of a term that is merely descriptive of an Applicant’s goods. 15 U.S.C. § 1052(e)(1). A mark is merely descriptive “if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *In re Chamber of Commerce of the United States of America*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1478 (TTAB 2016).

According to the Examining Attorney, Applicant’s applied-for mark KRISMAS is merely descriptive because it is the phonetic equivalent of “Christmas,” and would

¹ Application Serial No. 86420607 was filed on Oct. 10, 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, 15 U.S.C. § 1051(b).

describe a feature or characteristic of Applicant's Christmas-themed retail and entertainment services.² Applicant responds that its KRISMAS mark is suggestive, rather than descriptive. "Applicant's mark begins with a completely different letter and is missing a silent consonant 't' in the middle of the word," it observes.³ The difference in spelling between KRISMAS and "Christmas" is not merely a misspelling, it argues, but is suggestive of the secular nature of Applicant's services: "Applicant provides secular experiences and goods to those not observing the birth of Jesus Christ." Applicant has thereby created an incongruity between 'Christmas' and KRISMAS...."⁴

But a slight misspelling will not turn a descriptive word into a nondescriptive mark. *See, e.g., In re Quik-Print Copy Shops*, 616 F.2d 523, 205 USPQ 505, 507 n.9 (CCPA 1980) (QUIK-PRINT held descriptive; "There is no legally significant difference here between 'quik' and 'quick'"); *In re Carlson*, 91 USPQ2d 1198 (TTAB 2009) (holding "URBANHOUSING" phonetic spelling of "urban" and "housing," merely descriptive of real estate services); 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:31 (4th ed. 2017) (citing Restatement Third, Unfair Competition, § 14, comment a (1995) ("The misspelling or corruption of an otherwise descriptive word will not ordinarily alter the descriptive character of the designation.")). Applicant's KRISMAS mark sounds the same as "Christmas," a term that has both

² Examining Attorney's brief, 9 TTABVUE 6-7; Jan 27, 2015 Office Action p. 2; July 9, 2015 Office Action p. 3.

³ Applicant's brief p. 9, 7 TTABVUE 10.

⁴ Applicant's brief pp. 5-6, 7 TTABVUE 6-7.

religious and secular meanings. Christmas has been defined as: “a Christian holiday that is celebrated on December 25 in honor of the birth of Jesus Christ or the period of time that comes before and after this holiday.”⁵ The progression from religious to secular holiday is evinced in the *Random House Dictionary* definition of Christmas: “the annual festival of the Christian church commemorating the birth of Jesus: celebrated on December 25 and now generally observed as a legal holiday and an occasion for exchanging gifts.”⁶ The word “Krismas” has also found its way into the vernacular, defined as “Secular mid-winter holiday celebrating peren[n]ial gift giver Kris Kringle, food, family, gaudy decorations, generosity and goodwill. Essentially Christmas without the extraneous religious content. Celebrated anytime between the winter solstice and new years.”⁷

Applicant argues that it uses the term KRISMAS consistently with these definitions. As it states in its appeal brief, “Essentially, Applicant has attempted to celebrate the spirit of Christmas as invented by folklore, rather than the Christian holiday...”⁸ Its application describes retail services providing “holiday merchandise, holiday ornaments” and “seasonal gifts.”⁹ Its website describes its entertainment services: “[F]or families seeking an innovative holiday activity, Kringle’s Inventionarium® delivers a fresh yet timeless interactive experience that honors the

⁵ Merriam-Webster.com, 1/27/2015, Jan. 27, 2015 Office Action p. 4 pdf.

⁶ Dictionary.com, 8/17/2016, Aug. 17, 2016 Office Action pp. 4-5 pdf.

⁷ UrbanDictionary.com, 7/9/2015, July 9, 2015 Office Action p. 23 pdf.

⁸ Applicant’s brief p. 6, 7 TTABVUE 7.

⁹ Application Serial No. 86420607 description of services.

spirit of Christmas”:



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Applicant’s website uses KRISMAS interchangeably with “Christmas”:

¹⁰ MrKringle.com, July 9, 2015 Office Action p. 36 pdf.

Main Experiences Special Events Appearances Shop Decor Services Licensing
Book Reservations Packages Parties FAQ Locations News About Us

KRISMAS STOCKINGS

Sun, December 21, 2014 by Mr. Kringle



Krismas stockings are not just an empty sock or sock-shaped bag that's hung on Krismas Eve. Stockings are the perfect way to show your Krismas style. They're so personal and they let Mr. Kringle know which one is yours (and where to leave the best gifts). With a little help from our friends at Postively Splendid, on how to make your own Krismas Stocking with the Kringle twist, you can create your very own stocking. Fun, festive and all your own!

Merriest wishes, C. Hollyhop

#kringlesinventionasium

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On its Facebook page, Applicant advertises “Get ready to experience innovation at its merry best at Kringle’s Inventionasium, where we’re restoring the Krismas magic!”

¹¹ MrKringle.com 7/9/2015, July 9, 2015 Office Action p. 44 pdf.

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The Flats Settlers Landing Tower City Public Square Progressive Field Carnegie

230 W Huron Rd
Cleveland, Ohio

(855) 675-7464

Price Range: \$\$\$\$

<http://www.MrKringle.com/>

Greetings fellow dreamers! Get ready to experience innovation at its merry best at Kringle's Inventionasium, where we're restoring the Krismas magic!

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The public responds in kind:

¹² Facebook.com/MrKringle 7/9/2015, July 9, 2015 Office Action p. 18 pdf.



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Thus, Applicant's own use of the word "KRISMAS" implies that not only it, but the public at large would regard the term as descriptive of the Christmastime theme

¹³ Facebook.com/MrKringle 7/9/2015, July 9, 2015 Office Action pp. 8-9 pdf.

of its retail and entertainment services. *See In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) (“Evidence of the context in which a mark is used ... in advertising material ... is probative of the reaction of prospective purchasers to the mark.”). The terms “Christmas” and KRISMAS are not so incongruous that the public cannot readily and immediately use them interchangeably. “Descriptive use by the proponent ... on similar goods and services is relevant evidence of public perception.” 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:20. As the Examining Attorney observes, “Clearly, the [A]pplicant’s use refers to the holiday based on the traditional, religious Christmas holiday, as well as, offering secular items or services related to this time of year.”¹⁴

Applicant suggests that if its mark “can be perceived as having other meanings or connotations that are not descriptive, the mark is not descriptive....”¹⁵ Applicant argues that its “goods and services are not entirely clear from the mark, and consumers coming into contact with Applicant’s mark will not automatically assume or even have any clear idea what Applicant’s goods and services are.”¹⁶ It further argues that its mark is suggestive because customers must first connect KRISMAS

¹⁴ Examining Attorney’s brief, 9 TTABVUE 10.

¹⁵ Applicant’s brief p. 10, 7 TTABVUE 11. Applicant suggests, for example, that the element KRIS may refer to a Malaysian or Indonesian dagger, and the term MAS may refer to a carnival; or KRISMAS may refer to a person, such as Kris Jenner. *Id.* See Jan. 11, 2016 Response to Office Action pp. 7-17.

¹⁶ Applicant’s brief p. 7, 7 TTABVUE 8.

to a secular notion of the Christmas holiday and second connect it to Applicant's goods and services, "which are not limited to Christmas related goods and services."¹⁷

But the determination of whether a mark is merely descriptive must be made in "the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods [or services] because of the manner of its use or intended use." *Bayer Aktiengesellschaft*, 82 USPQ2d at 1831 (citing *In re Abcor Dev. Corp.*, 200 USPQ at 218). "[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 immediately understand the mark as directly conveying information about them." *In re Carlson*, 91 USPQ2d at 1200. Further, the mark "need not recite each feature of the relevant goods or services in detail to be descriptive, it need only describe a single feature or attribute." *In re Chamber of Commerce*, 102 USPQ2d at 1219 (internal punctuation omitted) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001)). As the foregoing Internet evidence indicates, the relevant consuming public—families with small children—can and do readily understand that KRISMAS, as used in context, describes the Christmastime theme of Applicant's goods and services. So the mark is descriptive, even if some of Applicant's goods and services, taken alone, might not evoke that theme, and even if the proposed mark, or its elements, might have other meanings in other contexts. See *In re RiseSmart Inc.*, 104 USPQ2d 1931,1933 (TTAB 2012) ("the fact that a term may

¹⁷ Applicant's brief p. 8, 7 TTABVUE 9.

have different meanings in other contexts is not controlling on the question of descriptiveness.”); *see generally* TMEP § 1209.03(e)(Jan. 2017).

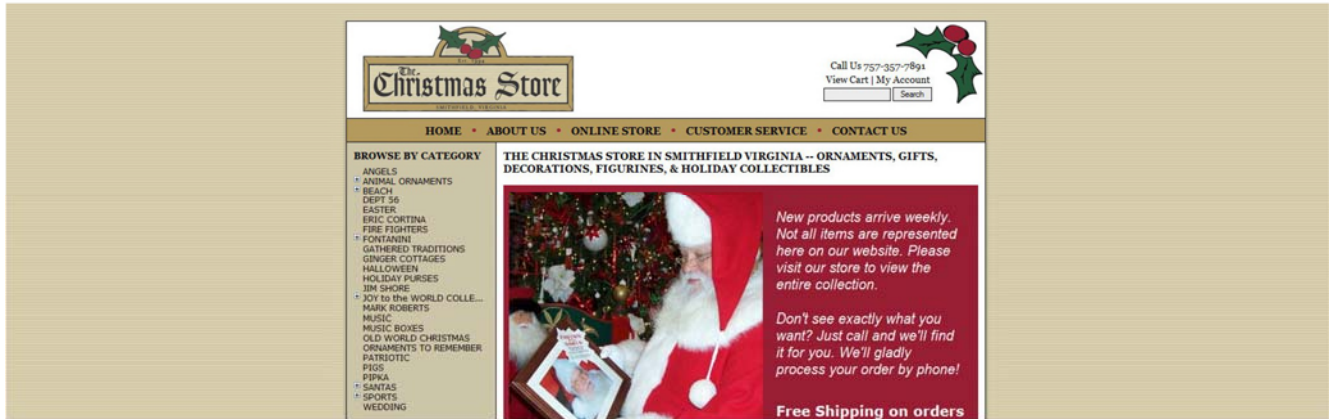
Applicant urges that we apply the three-part test enunciated in *No Nonsense Fashions, Inc. v. Consol. Foods Corp.*, 226 USPQ 502 (TTAB 1985), comprising “imagination,” “competitors’ use,” and “competitors’ need.”¹⁸ As the Board has made clear, though, the three-part *No Nonsense* test is no longer the standard:

The three-part test described in *No Nonsense Fashions* has been superseded in the Federal Circuit by the rule that we apply here.... Under the current standard, there is no requirement that the Examining Attorney prove that others have used the mark at issue or that they need to use it, although such proof would be highly relevant to an analysis under Section 2(e)(1). The correct test is whether the phrase forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods.

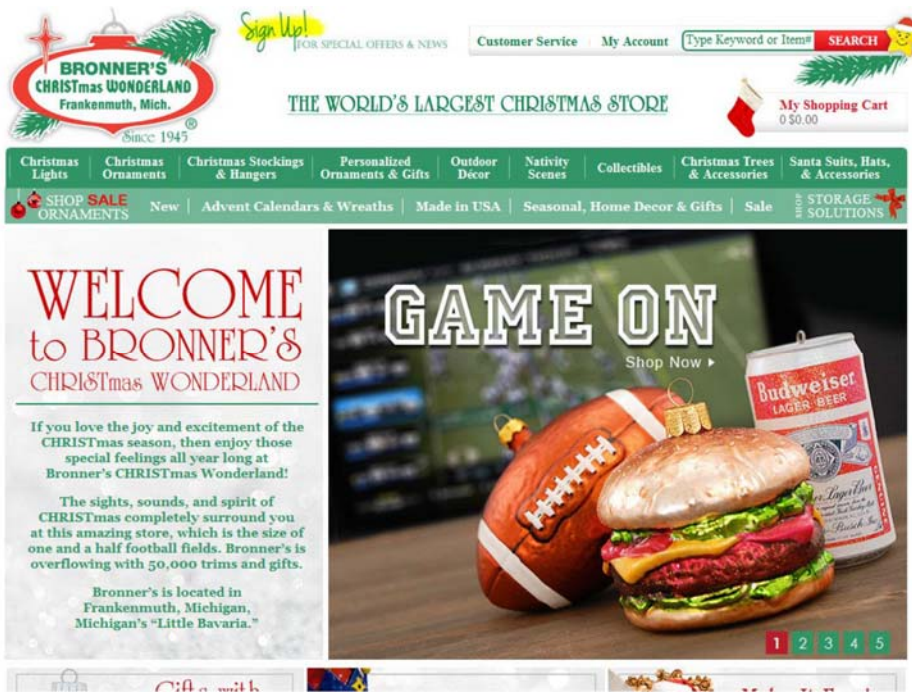
In re Fat Boys Water Sports LLC, 118 USPQ2d 1511, 1514 (TTAB 2016).

Although it is not required, the Examining Attorney has introduced evidence of other retailers using Christmas themes in their marketing, *e.g.*:

¹⁸ Applicant’s brief pp. 5-6, 7 TTABVUE 6-7.



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The Examining Attorney has also submitted advertising for Christmas-themed plays:

¹⁹ ChristmasStoreSmithfield.com, 1/27/2015, Jan 27, 2015 Office Action p. 6.

²⁰ Bronners.com, 1/27/2015, Jan 27, 2015 Office Action p. 8.

CHRISTMAS PLAYS

Sometimes the smells of pinecones and holly-berries are just the thing to set the mood for Christmas. Or perhaps holiday cookies baking in the kitchen set your heart a-flutter. The truth is, nobody can resist the smell of greasepaint when the family comes together to enjoy a great performance of a holiday play. Our Christmas Plays are proven audience pleasers ... and what better way for the year to end, and a new one to begin.

Pioneer Drama Service is pleased to offer 87 Christmas plays.

PREV • PAGE 1 OF 9 • NEXT | RESULTS PER PAGE: 10 | SORT: Popularity

Bone Soup New!
A Kwanzaa Story
Cast: Flexible cast of 8
Set/Time: Single interior and exterior set / About 40 minutes
Finally! A play that teaches the seven principles of Kwanzaa as well as some Kwanzaa traditions while being highly entertaining with its rhythmic, musical style. [More...](#)

Good News New!
Cast: 7M, 9F, plus 1 role that can be either
Set/Time: Interior diner set / About 50 minutes
Christmas is supposed to be about the good news, yet for Francine this Christmas season has been nothing but bad news. That is until a strange turn of events on Christmas Eve. [More...](#)

The Mice and the Manger New!
Cast: 4M, 4F
Set/Time: Exterior stable set / About 20 minutes
Witness the story of the Christ child's birth in a way you've never heard it before. [More...](#)

Everyone's Christmas Story
Cast: 4M, 5F, plus 9 roles that can be either, optional extras, doubling
Set/Time: Interior bedroom set / About 60 minutes
How do you tell an old story in a new way, especially when it's the most important story of all? [More...](#)

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These and other competitors must be free to use the term “Christmas” or its phonetic equivalent, KRISMAS, for goods and services that are appropriate to the season. *See Teleflora Inc. v. Florists Transworld Delivery Ass'n*, 217 USPQ 1081 (C.D. Cal. 1981) (granting summary judgment cancelling florist’s federal registration for EASTER BASKET: “Because the term Easter basket is the common descriptive name for a bouquet in a basket for Easter, it cannot be a trademark subject to monopolization by FTD under the federal trademark laws or at common law.”) *cited in In re Johanna Farms, Inc.*, 222 USPQ 607, 615 (TTAB 1984) and *In re Jenos Inc.*, 222 USPQ 1021, 1024 (TTAB 1984); 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 12:18. This furthers the purposes of Section 2(e)(1), which are: “(1) to

²¹ PioneerDrama.com/Plays-Christmas 1/27/2017, Jan 27, 2015 Office Action p. 17.

prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.” *In re Abcor Dev.*, 200 USPQ at 217.

In its request for reconsideration, Applicant provides a TESS listing of 292 active federal trademark registrations of marks that incorporate the term “Christmas” and do not disclaim “Christmas.”²² However, “the mere submission of a listing from the TESS database is insufficient to make the referenced registrations of record.” *In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006). Applicant accordingly makes of record certain TESS printouts of registrations of marks consisting of or containing “Christmas,”²³ summarized in the following table:²⁴

Reg. No.	Word Mark	Disclaimer
4813355	CHRISTMAS	NONE
4637513	CHRISTMAS WHISKEY	NONE
4077131	MERRY CHRISTMAS	NONE
3645894	THE CHRISTMAS COMPANY	“COMPANY”
2204701	MR. CHRISTMAS	NONE
4569456	CHRISTMAS BOURBON	“BOURBON”
4690316	THE CHRISTMAS PIG	“PIG” as to Classes 9, 16, 28 and 41
3887784	CHRISTMAS MILK	“MILK”
4077491	CHRISTMAS IN NEW YORK	“NEW YORK”
2977445	CHRISTMAS SAGE	“SAGE”
1398701	CHRISTMAS CHEDDAR	“CHEDDAR”
1942193	CHRISTMAS CASH	“CASH”
4372199	MERRY CHRISTMAS HONEY!	“HONEY”
4391449	CHRISTMAS TIME SPRUCE	“SPRUCE”
4585610	CHRISTMAS DAY DINNER	“DINNER”

²² Aug. 3, 2016 Request for Reconsideration pp. 8-16.

²³ TESS printouts in Aug. 3, 2016 Request for Reconsideration pp. 17-46.

²⁴ Aug. 3, 2016 Request for Reconsideration p. 5.

However, “it has been consistently held that third-party registrations are not conclusive on the question of descriptiveness. Each case must stand on its own merits and a mark which is merely descriptive should not be registered merely because other such marks appear on the register.” *In re Scholastic Testing Svc., Inc.*, 196 USPQ 517, 519 (TTAB 1977). *See In re Cordua Rests. LP*, 823 F.3d 594, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (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.”)). Unlike Applicant’s proposed mark, none of these registrations seeks to monopolize “Christmas” *per se* for Christmas-themed goods and services appropriate to the holiday. The only comparable registered mark consisting of CHRISTMAS alone, Registration No. 4813355, identifies computer game software for gaming machines. As the Examining Attorney notes, all of the other registered marks add distinguishing elements rendering them, in context, not descriptive of their identified goods or services.²⁵ As in *In re Nett Designs*, “These prior registrations do not conclusively rebut the Board's finding that [the term] is descriptive in the context of this mark. As discussed above, the term ... may tilt toward suggestiveness or descriptiveness depending on context and any other factor affecting public perception.” *Id.* at 1566.

We acknowledge that there is at times a thin line of demarcation between a suggestive mark and a merely descriptive one, and that doubt should be resolved in

²⁵ Examining Attorney’s brief, 9 TTABVUE 17-19.

favor of applicants. *In re Fat Boys Water Sports*, 118 USPQ2d at 1513. But here, for the reasons stated, there is no doubt that Applicant's mark falls on the merely descriptive side of the line. 15 U.S.C. § 1052(e)(1).

Decision: The refusal to register Applicant's mark KRISMAS is affirmed.