

<p><b>This Opinion is Not a Precedent of the TTAB</b></p>
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Mailed: March 22, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Charcoal Box USA, L.L.C.*

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Serial Nos. 86532794 and 86533646<sup>1</sup>

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for Charcoal Box USA, L.L.C.

David E. Tooley, Jr., Trademark Examining Attorney, Law Office 112,  
Angela Bishop Wilson, Managing Attorney.

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Before Cataldo, Adlin and Gorowitz,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Charcoal Box USA, L.L.C. ("Applicant") seeks registration on the Principal Register  
of THE BOX (in standard characters)<sup>2</sup> and

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<sup>1</sup> Because the issues presented in both appeals are the same and the arguments and evidence advanced by Applicant and the Examining Attorney are nearly identical in each case, we hereby *sua sponte* consolidate these appeals. All references to the briefs and evidentiary record cite to application Serial No. 86532794 unless otherwise noted.

<sup>2</sup> Application Serial No. 86532794 was filed on February 12, 2015, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.



both for

“charcoal; charcoal packaged in charcoal starter” in  
International Class 4.

The Trademark Examining Attorney has refused registration of Applicant’s proposed marks under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the wording THE BOX merely describes a function, feature or characteristic of the identified goods. Since the mark in application Serial No. 86533646 includes a design element, to overcome the refusal, the Examining Attorney required a disclaimer of the descriptive wording THE BOX pursuant to Trademark Act § 6(a), 15 U.S.C. § 1056(a).<sup>4</sup> Applicant did not comply with this requirement.

When the refusal was made final in each case, Applicant appealed and requested reconsideration. After the Examining Attorney denied the requests for reconsideration, the appeals resumed. We affirm the refusals to register.

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<sup>3</sup> Application Serial No.86533646 was filed on February 12, 2015, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. “Color is not claimed as a feature of the mark.”

<sup>4</sup> The question of whether the wording THE BOX in either mark has acquired distinctiveness under Section 2(f) of the Trademark Act or is capable of distinguishing Applicant’s goods on the Supplemental Register, is not before us.

“A term 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 U.S.*, 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)). *See also In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015). Whether a mark is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Bayer*, 82 USPQ2d at 1831. A term need not immediately convey an idea of each and every specific feature of the goods in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of them. *See In re Gyulay*, 3 USPQ2d at 1010; *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). This requires consideration of the context in which the mark is used or intended to be used in connection with those goods, and the possible significance that the mark would have to the average purchaser of the goods in the relevant marketplace. *See In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Bayer*, 82 USPQ2d at 1831.

In other words, 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 Medical Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); *In re Patent & Trademark Servs. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998). “On the other

hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive.” *Coach Servs. Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1616 (TTAB 2010) (quoting *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978)), *vacated-in-part on other grounds*, 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012).

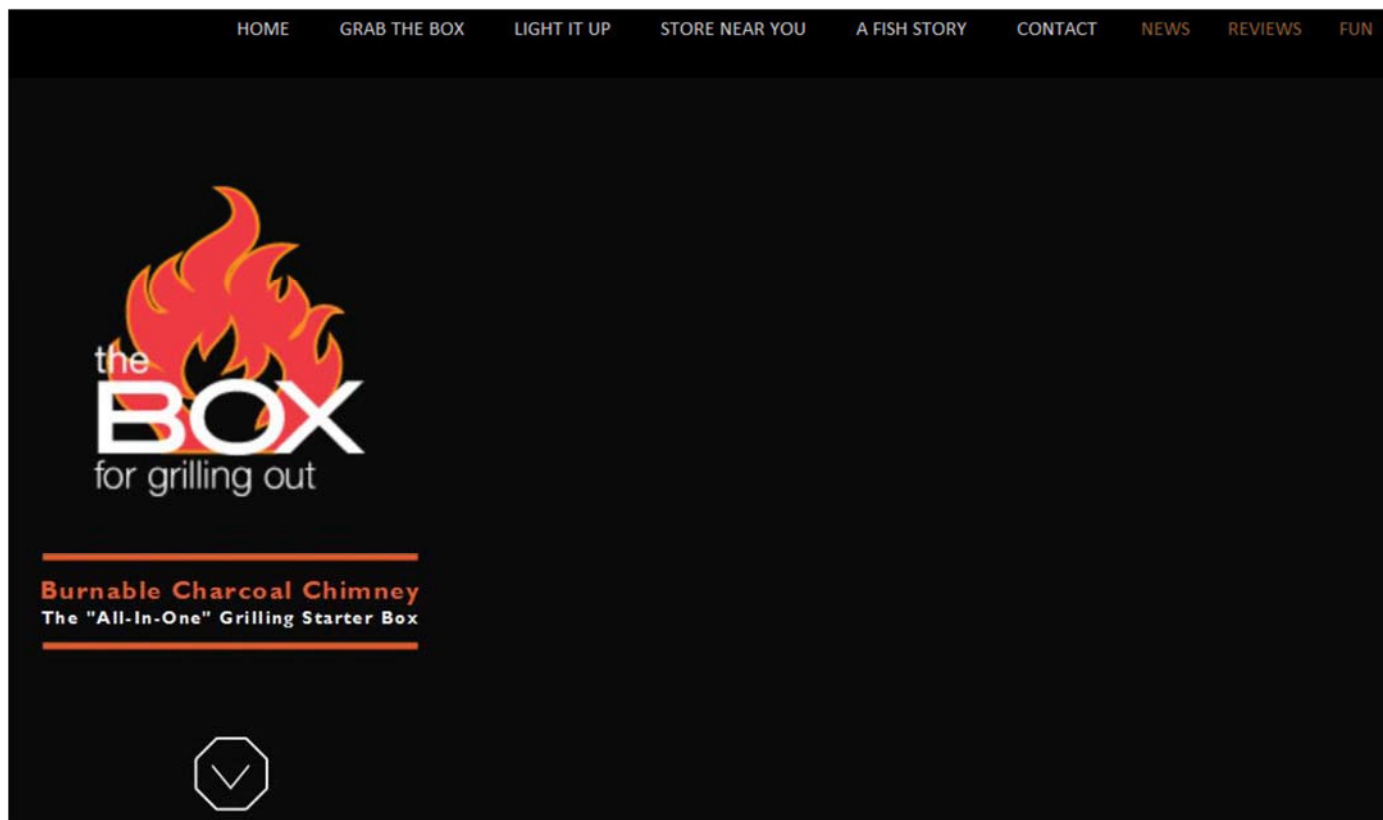
With regard to application Serial No. 86533646, an examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6(a), 15 U.S.C. § 1056(a). Merely descriptive terms are unregistrable, under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1) and, therefore, are subject to disclaimer if the mark is otherwise registrable. 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 National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977).

In support of the refusal to register, the Examining Attorney made of record with his May 24, 2015 first Office action, screenshots from Applicant’s Internet website, excerpted below.<sup>5</sup>

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<sup>5</sup> P. 4-9. (Charcoalbox.com.)

Serial Nos. 86532794 and 86533646





Fishing Trip

### The Time I Invented the BOX

It began like most stories. We'd been drinking. And fishing. Of course we'd been drinking and fishing. It goes without saying. But now its been said, anyway.

There we were with some very fine crappie waiting to be grilled and someone had forgotten the charcoal chimney. OK, Porter had forgotten the chimney. I had the charcoal, he hadn't held up his end as usual. That's when it hit me. I took the old fried chicken bucket from the trunk, punched some holes in the bottom, tore up the newspaper we were going to wrap the extra fish with and stuck it under the bucket of now loaded charcoal. Sparked it all with my grandfather's depression era Zippo.

Now the holes are what made it work. Without going into the aerodynamics and physics of hot air rising, let's just say the charcoal looked like it should after about two beers.

There are some people who want exact times down to the minute. It takes two beers before you can put fish on a charcoal grill to cook, with a little butter of course.

When we got back and started telling this fish story everybody wanted to know what happened to the bucket. So I showed them with a milk carton what happens when you light a bucket of charcoal. The same thing after about two beers.

So here's the BOX. Who knew you could patent a box? Light it up. Have two beers, or whatever counts as two beers worth of fishing stories or fun in your part of the country. Then throw your food on the perfectly ashed-over coals. Don't blame us if your story doesn't end with you inventing the easiest way to grill. Get yourself some better beer and take that time to make some better stories.

Roger

# Contact

Press: [press@charcoalbox.com](mailto:press@charcoalbox.com)

Sales: [sales@charcoalbox.com](mailto:sales@charcoalbox.com)

Customer Satisfaction: [satisfaction@charcoalbox.com](mailto:satisfaction@charcoalbox.com)

Phone: (616)502-4928

To become a distributor [[Click Here to Apply!](#)]



FOR QUICK RESPONSE YOU CAN USE THE FORM BELOW.

Post

## It Starts with a Match...



## Easy Directions

1. Open Top
2. Remove bag of starter paper set on lower grill
3. Place the BOX with the charcoal inside over the bag on the grill
4. Light the starting paper through the lower side vents (where it says - Light Here)
5. About 18-20 minutes later you're ready to grill when the briquettes are ashed over.

Based upon this evidence, we find that THE BOX merely describes a central feature or characteristic of Applicant's "charcoal; charcoal packaged in charcoal starter," namely, that it describes the charcoal starter, which is a vented box that users light on fire in order to ignite the charcoal for grilling purposes. Applicant's own website describes its goods as follows: "The 'All-In-One' Grilling Starter Box."<sup>6</sup> "Grab the BOX and Go..."<sup>7</sup>

Loaded with 40 oz. of premium charcoal briquettes. Perfect for burgers, hot dogs, brats, and fish for four. No need to haul 20 lbs. dirty, messy bags or cans of lighter fluid with you. All you need is a match and a BOX.<sup>8</sup>

The directions provided on Applicant's website, displayed above, clearly show a box of charcoal and starter paper placed on a grill and lighted on fire. According to the directions, the user opens the top of the box, removes the bag of starter paper and places it below the box filled with charcoal briquettes. The user then lights the starter paper through the side vents, which ignites the charcoal briquettes inside the box. Thus, Applicant's goods are not simply contained in a box and then poured into a charcoal grill. Rather, the box itself is an integral feature of the charcoal starter, and serves as the chimney for the charcoal while it heats. In addition, the testimonial from the product's inventor states: "So here's the BOX. Who knew you could patent a box?"<sup>9</sup>

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<sup>6</sup> May 24, 2015 first Office action at 4.

<sup>7</sup> *Id.* at 5.

<sup>8</sup> *Id.*

<sup>9</sup> *Id.* at 8.

The presence of the word THE in the designation THE BOX fails to negate the mere descriptiveness of BOX, or transform the designation as a whole into a unitary, inherently distinctive mark. As the Board has repeatedly found, the word “the” is generally perceived, as it is in this case, as merely the common article that it is, without trademark significance. *See, e.g., In re G.D. Searle & Co.*, 149 USPQ 619 (CCPA 1966), *aff’g* 143 USPQ 220 (TTAB 1964) (THE PILL); *In re King Coil Licensing Co.*, 79 USPQ2d 1048, 1051 n.6 (TTAB 2006) (THE BREATHABLE MATTRESS); *In re Weather Channel, Inc.*, 229 USPQ 854, 856 (TTAB 1985) (THE WEATHER CHANNEL); *Conde Nast Publications Inc. v. The Redbook Publishing Co.*, 217 USPQ 356, 357 (TTAB 1983) (THE MAGAZINE FOR YOUNG WOMEN).

Based upon the evidence of record, we find the Examining Attorney has established, *prima facie*, that THE BOX merely describes a central feature of Applicant’s goods. *See, e.g., In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1220 (Board relied in part on evidence obtained from applicant’s own web site to find the mark NATIONAL CHAMBER merely descriptive of various chamber of commerce services).

Applicant contends that

Many items are packaged within boxes. The majority of charcoal companies package charcoal in paper bags, not boxes. Applicant has attached multiple pictures of charcoal packaged in bags. ... Applicant has also attached pictures of instant light charcoal packaged in bags, not boxes.<sup>10</sup>

A representative example of charcoal packaged in a bag is included below.<sup>11</sup>

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<sup>10</sup> Applicant’s November 19, 2015 response to Office action at 5.

<sup>11</sup> *Id.* at 7-12.



Applicant contends that THE BOX is at least suggestive for Applicant's goods. Applicant provides charcoal and charcoal packaged in a charcoal starter. The packaging does not describe Applicant's goods as a large number of goods may be packaged within a box.<sup>12</sup>

However, that a majority of grilling charcoal is packaged in bags does not lessen the mere descriptiveness of THE BOX as applied to Applicant's goods contained in a box. Even if Applicant was the first and/or at one time the only user of the term THE BOX in connection with its charcoal and charcoal packaged in starters, it is well settled that this does not entitle Applicant to the registration thereof where, as here, the term has been shown to immediately convey only a merely descriptive significance in the context of Applicant's goods. *See, e.g., In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018, 1020 (TTAB 1983); *In re Mark A. Gould, M.D.*, 173 USPQ 243, 245 (TTAB 1972).

To the extent Applicant argues that while the term THE BOX may be descriptive of Applicant's packaging, it does not describe a characteristic or feature of Applicant's actual products as identified in its application – "charcoal; charcoal packaged in charcoal starter," – Applicant is incorrect. In *J. Kohnstam, Ltd. v. Louis Marx & Co.*,

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<sup>12</sup> *Id.* at 5.

280 F.2d 437, 126 USPQ 362, 363-4 (CCPA 1960), the term MATCHBOX SERIES was found merely descriptive for model toy vehicles sold in boxes having the size and appearance of matchboxes. As the court explained:

It is clear that the word-mark sought to be registered was adopted by reason of the deliberate simulation, by the packaging for the goods, of matchboxes and this is further emphasized by some of the advertising which includes such statements as “Individually packed in small multicolor Matchboxes (2 1/4¢ long),” “Matchbox Display,” and “Best of all, they're packed in these small 2 1/4¢ matchboxes.” Taking full advantage of the advertising possibilities in the word, appellant promotes the line as “The Matchless ‘Matchbox’ Series” “for hours of ‘matchless’ fun.” It gave away as a promotion a “Ronson” lighter engraved “MATCHLESS AS ‘MATCHBOX’ SERIES.”

...

“Matchbox” is, of course, a common English word defined by Webster's Dictionary as “A box for holding matches.” A matchbox is still a matchbox if the matches are removed and a toy is put in their place. We think the word is just as descriptive of a box which is made to look as much like a matchbox as is feasible so that the toys packaged in it can appropriately be designated as a “Matchbox Series” of toys.

As further evidence of descriptiveness, in the toy merchandising field specifically, opposers' evidence shows that for nearly 5 years, from 1939 into 1943, when the war put an end to it, it marketed a “Match Box Construction Set” which was in the size and shape of a safety-match box with a metal drawer and a paper sleeve, also described as “The Vest Pocket Builder—100 Toys in One.”

In other words, “while it may be literally true” that BOX does not describe charcoal or charcoal starter, “it does not hold with respect to” charcoal and starter sold in a box. “[T]he form in which” Applicant puts its charcoal products on the market “is aptly described” as box charcoal or charcoal in a box. *See id.* at 364.

We also find instructive *In re Serv-A-Portion Inc.*, 1 USPQ2d 1915, 1916 n.4 (TTAB 1986), in which the Board, in upholding a requirement for a disclaimer of the term “SQUEEZE N' SERV” as being merely descriptive of goods identified as “ketchup,”

noted that “whether it is the package itself, or the ketchup, or both which is (are) squeezed, is immaterial” inasmuch as “it is understood that this kind of food is necessarily sold in packages” and “hence the package is as much a part of the goods as the ketchup.” A consumer would not be able to purchase Applicant’s charcoal, or for that matter any brand of charcoal, unless it is sold in a container of some sort – whether it is the traditional method of selling charcoal by the bag or Applicant’s more recently developed methodology of box packaging that doubles as a charcoal chimney. In this case, the goods and packaging are necessarily and intentionally intertwined, and it is therefore entirely appropriate to consider whether the term THE BOX describes a feature of the packaging for the goods. *Cf. In re Metcal Inc.*, 1 USPQ2d 1334 (TTAB 1986) (holding SOLDER STRAP merely descriptive of self-regulating heaters in the form of flexible bands or straps); *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982) (holding TOOBS merely descriptive of bathroom and kitchen fixtures in the shape of tubes).

We also emphasize that the Examining Attorney is not required to prove that others have used the mark at issue or that they need to use it; the correct test is whether the mark 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). *See also In re Walker Mfg. Co.*, 359 F.2d 474, 149 USPQ 528, 530 (CCPA 1966) (“The question . . . is not whether the Board or others may or would utilize ‘CHAMBERED PIPE’ to describe applicant’s goods, but whether this designation does, in fact, describe such goods.”). In any event, competitors offering

charcoal in boxes would have a need to use the term “box” in connection therewith, further supporting the Examining Attorney’s refusal. *See In re Boston Beer Co. L.P.*, 47 USPQ2d 1914, 1920-21 (TTAB 1998), *aff’d*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) and *In re Abcor Development*, 200 USPQ at 217 (“The major reasons for not protecting [merely descriptive] marks are ... 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.”).

Applicant further argues that “despite packing charcoal within a bag, the USPTO previously allowed [third-party] registration of BBQ BAG as U.S. Registration No. 1,556,451” for “charcoal briquettes.”<sup>13</sup> Applicant also points to third-party registrations for marks including the word “box” used in connection with a wide variety of goods and services unrelated to its “charcoal; charcoal packaged in charcoal starter.”<sup>14</sup> Applicant submitted copies of 16 registrations issued on the Principal Register, of which the following are an illustrative sample:

Reg. No. 4776127 for the mark THEEBOX (standard characters) for “media players with a space for storing small items, sold as a unit;”

Reg. No. 4471692 for the mark THE BOX (standard characters) for “Electronic equipment, namely, microphone preamps, audio equalizers, audio compressors for processing audio signals, and audio mixing consoles, namely, audio mixer consoles;”

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<sup>13</sup> 4 TTABVUE 30-36, 336. Section 8 affidavit accepted; renewed.

<sup>14</sup> *Id.* at 74-314. We note that two of the submitted registrations, Reg. Nos. 2925271 and 3557645, are cancelled and therefore have little, if any, probative value. *See Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“[A] cancelled registration does not provide constructive notice of anything”).

Reg. No. 4407879 for the mark THE BOX (standard characters) for “printed publications, namely, magazines in the fields of health, nutrition, diet, fitness, and exercise;” and “providing on-line magazines in the fields of fitness and exercise; providing information in the fields of fitness and exercise via a web site; providing on-line magazines in the fields of health, nutrition, and diet;”

Reg. No. 3349320 for the mark THE BOX (standard characters) for “radio broadcasting services;” “entertainment services in the nature of radio programs in the fields of music, dance, news, sports, talk shows, and topics of general interest;”

Reg. No. 3519182 for the mark BOTA BOX (standard characters, BOX disclaimed) for “wines;”

Reg. No. 2791248 for the mark BLACK BOX (typed form) for “wine;”

Reg. No. 4976201 for the mark HEALTHY BOX (standard characters, HEALTHY disclaimed) “processed vegetables and fruits;” and

Reg. No. 4940089 for the mark PINKBOX (standard characters) for “retail services provided through automated vending machine kiosks featuring adult toys and novelties.”

These registrations are not conclusive on the question of the mere descriptiveness of THE BOX inasmuch as each case must stand on its own merits. *See 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 [applicant’s] application, the PTO’s allowance of such prior registrations does not bind the board or this court.”); *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977). Furthermore, we are not privy to the records of the applications underlying these registrations and cannot discern the refusals of registration, arguments or evidence that were advanced therein. Also, each of these third-party registrations identifies goods or services that

are unrelated to the goods at issue herein, or denotes a mark other than THE BOX, at issue herein.

Applicant also argues that

Applicant's packaging for THE BOX Burnable Charcoal Chimney requires more than simply a box. Applicant's packaging requires more material to provide the support and spacing for placement of the paper at the bottom of the packaging underneath the charcoal. Furthermore, Applicant's packaging increases the cost of manufacturing over a simple box due to this support in the bottom in which the holes are placed. Applicant's packaging requires increased material and increased labor costs required to assemble the packaging.<sup>15</sup>

However, there is no question that Applicant's goods utilize a box, both as packaging and burnable charcoal chimney. The mere fact that Applicant's goods may require additional cost and material to produce in order for the box itself to serve both as packaging and a burnable chimney does not detract from the mere descriptiveness of the term THE BOX as applied to "charcoal; charcoal packaged in charcoal starter." It is the meaning of the term in question rather than the functionality of Applicant's product that matters.

Finally, Applicant argues that "box" has numerous definitions, and that it "is unaware of any dictionary or other definition that defines box relating to charcoal."<sup>16</sup> However, Applicant cites to no authority for its apparent position that the term "box" must possess a definition specifically related to charcoal in order for THE BOX to merely describe charcoal packaged in a box that also functions as a burnable charcoal chimney. Further, the Board does not dispute that "box" is subject to numerous

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<sup>15</sup> 4 TTABVUE 333.

<sup>16</sup> *Id.*; *Id.* at 37-63.

definitions. However, descriptiveness is considered in relation to the relevant goods recited in the involved application, not in the abstract or in relation to other products or services. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). “That a term may have other meanings in different contexts is not controlling.” *In re Franklin Cnty. Historical Soc’y*, 104 USPQ2d 1085, 1087 (TTAB 2012) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)). Upon encountering Applicant’s proposed mark THE BOX, consumers will immediately understand that it refers to the packaging of Applicant’s “charcoal; charcoal packaged in charcoal starter.”

**Decision:** As to application, Serial No. 86532794, the refusal to register Applicant’s proposed mark THE BOX is affirmed.

As to application Serial No. 86533646, the refusal to register Applicant’s proposed

mark  in the absence of a disclaimer of the wording THE BOX is affirmed. However, this decision will be set aside as to application Serial No. 86533646 if, within two months of the mailing date of this order, applicant submits to the Board a proper disclaimer of THE BOX. *See* Trademark Rule 2.142(g). The standardized disclaimer format is as follows: No claim is made to the exclusive right to use the word THE BOX apart from the mark as shown.