

This Opinion Is Not a
Precedent of the TTAB

Mailed: June 30, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Corporate Green, LLC

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Application Serial No. 87519612

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R. Bennett Ford, Jr., of Roy Kiesel Ford Doody & Thurmon
for Corporate Green, LLC.

Mark Sparacino, Trademark Examining Attorney, Law Office 103,
Stacy Wahlberg, Managing Attorney.

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Before Rogers, Chief Administrative Trademark Judge, Taylor and Bergsman
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Corporate Green, LLC (Applicant) seeks registration on the Principal Register of
the mark BIG BARK, in standard character form, for “tree care services,” in
International Class 44.¹

¹ Serial No. 87519612 filed July 7, 2017, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on Applicant’s claim of a bona fide intent to use the mark in commerce.

On January 26, 2018, Applicant filed an Amendment to Allege use claiming first use of its BIG BARK mark anywhere and in commerce as of February 27, 2018.

The Examining Attorney issued a final requirement for Applicant to disclaim the exclusive right to use the word “Bark.” According to the Examining Attorney, Applicant must disclaim the exclusive right to use the word “Bark” because “it merely describes a purpose of applicant’s applied-for services.”² While “Applicant concedes that BARK is descriptive of tree care services,” Applicant contends that a disclaimer is unnecessary because BIG BARK is a unitary term.³

I. Preliminary Issue

Applicant’s reply brief is 16 pages. Trademark Rule 2.142(b)(2), 37 C.F.R. § 2.142(b)(2), provides that a reply brief shall not exceed ten pages. Because Applicant’s reply brief exceeds the page limitation, we will not consider it. *See In re Thomas*, 79 USPQ2d 1021, 1023 (TTAB 2006) (Board refused to consider applicant’s 29-page main brief).

II. Disclaimer Requirement

A. Applicable Law

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) (“The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.”). Merely descriptive terms are unregistrable, under Trademark Act Section 2(e)(1), 15 U.S.C. § 1051(e)(1), and, therefore, are subject to disclaimer if the mark is otherwise registrable. Failure to

² Examining Attorney’s Brief (9 TTABVUE 4).

³ Applicant’s Brief, p. 2 (7 TTABVUE 3).

comply with a disclaimer requirement is grounds for refusal of registration. *See In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) (“FirstTier” for banking services is merely descriptive and unregistrable without a disclaimer of the exclusive right to use the term “First Tier”); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46, 47 (CCPA 1975) (“it follows that if the words SOLID STATE [in the mark RICO SOLID STATE], which it appears appellant has declined to disclaim, are descriptive of appellant’s goods within the prohibition of *section 2(e)(1)*, then the Commissioner did not err in conditionally refusing registration.”); *In re Ginc UK Ltd.*, 90 USPQ2d 1472 (TTAB 2007) (ZOGGS TOGGS for clothing is unregistrable without a disclaimer of the exclusive right to use the word “Toggs”); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1954 (TTAB 2006).

B. Whether BIG BARK is a unitary term.

In the present appeal, we have no doubt that “Bark” is merely descriptive as applied to “tree care services,” and, as noted above, Applicant does not dispute that the word “Bark” is merely descriptive. Instead, Applicant contends that BIG BARK is a unitary term and, thus, does not require a disclaimer. *See TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1213.05 (2018)* (“If the matter that comprises the mark or relevant portion of the mark is unitary, no disclaimer of an element, whether descriptive, generic or otherwise, is required.”).

As explained by the Federal Circuit in *Dena Corp. v. Belvedere Int'l, Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991), a mark that is unitary

has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the

mark has a distinct meaning of its own independent of the meaning of its constituent elements. In other words, a unitary mark must create a single and distinct commercial impression. This test for unitariness requires the Board to determine “how the average purchaser would encounter the mark under normal marketing of such goods and also...what the reaction of the average purchaser would be to this display of the mark.” [*In re*] *Magic Muffler* [*Servs., Inc.*], 184 USPQ [125] at 126 [(TTAB 1974)].

In *Magic Muffler*, 184 USPQ at 126, the Board explained that we use Applicant’s specimen to gauge the reaction of the average purchaser to the display of the mark.

It is apparent that, in order to determine whether what applicant seeks to register constitutes a single composite or unitary mark, one must look to the specimens filed with an application because they show the mark as used on or in connection with the goods and therefore how the average purchaser would encounter the mark under normal marketing of such goods and also suggest what the reaction of the average purchaser would be to this display of the mark.

Turning to a consideration of how Applicant displays its mark, we reproduce below Applicant’s specimen of use filed in support of its Amendment to Allege Use.



Applicant uses “Big” as an adjective modifying “Bark.” The composite term BIG BARK does not have a well-known or common meaning in connection with trees or tree care services. While “Bark” “is essentially the skin of the tree” that protects it from insects and diseases,⁴ the Examining Attorney did not submit any evidence showing the term “Big Bark” has any meaning or is used in connection with trees or tree care services.⁵ Thus, the combination of “Big” and “Bark” forming the composite mark BIG BARK has a distinct meaning of its own independent of the meaning of its constituent elements; that is, BIG BARK engenders a commercial impression separate and apart from the word “Bark.”

Contrary to the Examining Attorney’s arguments, the term BIG BARK is an incongruous term because the combination of “Big” and “Bark” is illogical, out of place, or unexpected.⁶ In particular, the meaning of “Bark” (i.e., the skin of a tree) combined with “Big” (an adjective meaning large) forms a composite that is not associated with skin or bark, and thus creates an incongruity. Here, the term BIG BARK creates a single unitary phrase that is an imaginary thing. Thus, BIG BARK is an incongruous term.

⁴ October 4, 2017 Office Action (TSDR 4).

Citations to the examination record are to the Trademark Status and Document Retrieval System (TSDR) by page number in the downloadable .pdf format.

⁵ The Examining Attorney agrees that BIG BARK is not a commonly used term. Examining Attorney’s Brief (9 TTABVUE 9) (“the very minimal amount of evidence found by applicant is in fact itself evidence that BIG BARK is not a commonly used term that the public would recognize.”).

⁶ Examining Attorney’s Brief (9 TTABVUE 11).

As displayed in Applicant's specimen, Applicant's clients and prospective clients encounter the mark BIG BARK as it appears on Applicant's truck and other advertising and such use will trigger their reaction to the mark so displayed. As such, Applicant's clients and prospective clients will refer to Applicant's services as BIG BARK tree services, not "Big" tree services or "Bark" tree services.

We find the mark BIG BARK, in its entirety, has a suggestive significance wholly distinct from the merely descriptive significance of the term "Bark." That is, the merely descriptive significance of the term "Bark" is lost in the mark as a whole. Applicant's clients or prospective clients will not go through the mental process of breaking the mark BIG BARK into its component elements but will rather regard it as a unitary term. The alliteration created by the repeated common first letter further reinforces the likelihood that prospective purchasers of Applicant's services will look to the terms as a composite, and not rely on one or the other term as dominant.

The analysis of the mark in this appeal is similar to the analysis we employed in *In re Kraft*, 218 USPQ 571, 573 (TTAB 1983), where the Board found LIGHT 'N LIVELY for reduced calorie mayonnaise unitary based not only on the "alliterative liting cadence" of the wording but also on the fact that the mark as a whole "has a suggestive significance which is distinctly different from the merely descriptive significance of the term 'LIGHT' per se" and that "the merely descriptive significance of the term 'LIGHT' is lost in the mark as a whole."

The Examining Attorney argues that Applicant's refusal to disclaim the exclusive right to use the word "Bark" indicates that Applicant "believes it should be able to

prevent others from using BARK in connection with tree care services for repairing “bark.”⁷ However, Applicant’s mark is BIG BARK, not “Bark” standing alone, and the presumptions afforded a registration under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), pertain to the mark as a whole rather than to its component parts. Therefore, the registration of BIG BARK cannot serve to preclude others from making fair use of the term “Bark” in describing their tree care services. *See In re Hampshire-Designers, Inc.*, 199 USPQ 383, 384 (TTAB 1978).

Finally, the Examining Attorney contends that the USPTO has already determined that BIG BARK is not unitary because the USPTO registered Registration No. 4772372 for the mark BIG BARK for “ale; beer,” in International Class 32, where registrant disclaimed the exclusive right to use the word “Bark.”⁸ This registration does not rebut our finding that BIG BARK is a unitary term because we must decide each case on its own merits. *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (citing *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417,424 (Fed. Cir. 1985)). The previous requirement by a different Examining Attorney of a disclaimer of BARK in a BIG BARK mark for different goods does not bind us in the case at hand. *Nett Designs*, 57 USPQ2d at 1566 (“this court finds little persuasive value in the registrations that Nett Designs submitted to the examiner or the list of registrations that Nett Designs attempted to submit to the Board.”).

⁷ Examining Attorney’s Brief (9 TTABVUE 13).

⁸ Examining Attorney’s Brief (9 TTABVUE 12-13) and the referenced registration made of record in the November 9, 2018 Denial of the Request for Reconsideration (TSDR 4-6).

In this appeal, the term “Big” in Applicant’s mark BIG BARK clearly modifies the word “Bark” to create a unitary phrase that, in its entirety, only suggests a feature of Applicant’s services. Therefore, Applicant need not disclaim the exclusive right to use the word “Bark.” *See Hampshire-Designers, Inc.*, 199 USPQ 383 (“DESIGNERS” need not be disclaimed from “DESIGNERS PLUS+” for sweaters); *In re Diamond Walnut Growers, Inc.*, 183 USPQ 63 (TTAB 1974) (“CRUST” need not be disclaimed from “NUT CRUST BAKE” for seasoned coating mix).

Decision: We reverse the refusal to register Applicant’s mark BIG BARK based on the requirement that Applicant disclaim the exclusive right to use the word “Bark.”