

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Hearing:
July 8, 2004

Mailed: October 26, 2004
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Luppen Holdings, Inc.

Serial No. 75372720

Frances R. Gorowitz of O'Melveny & Myers LLP for Luppen Holdings, Inc.

Esther A. Belenker, Trademark Examining Attorney, Law Office 111 (Craig Taylor, Managing Attorney).

Before Hanak, Hairston and Bucher, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Luppen Holdings, Inc. has applied to register PERSONAL POST OFFICE as a trademark for "hand-held metal scales for weighing letters and small packages."¹ Registration was refused by the Trademark Examining Attorney on the following grounds: (1) Section 2(e)(1) of the Trademark Act on the ground that PERSONAL POST OFFICE is merely

¹ Application Serial No. 75372720, filed October 14, 1997, and asserting first use and first use in commerce as early as July 15, 1992.

descriptive of the identified goods; (2) Section 2(a) of the Trademark Act on the ground that PERSONAL POST OFFICE falsely suggests a connection with the U.S. Postal Service; and (3) Section 2(d) of the Trademark Act on the ground that PERSONAL POST OFFICE for the identified goods, so resembles the marks UNITED STATES POST OFFICE², UNITED STATES POST OFFICE EXPRESS³, UNITED STATES POST OFFICE and eagle design⁴, and UNITED STATES POST OFFICE EXPRESS and eagle design⁵, for "mail services, namely, sorting, handling, and receiving packages and letters; retail store services featuring stamps, philatelic products, stationery, and other mailing materials, novelty items, and other related merchandise; postal services, namely, packaging articles for transportation, letter and parcel delivery and rental of mailboxes", all registered to the U.S. Postal Service, as to be likely to cause confusion or mistake or to deceive.

² Registration No. 2295192 issued November 30, 1999; with a Section 2(f) claim as to UNITED STATES POST OFFICE.

³ Registration No. 2295422 issued November 30, 1999; with a Section 2(f) claim as to UNITED STATES POST OFFICE.

⁴ Registration No. 2295423 issued November 30, 1999; with a Section 2(f) claim as to UNITED STATES POST OFFICE.

⁵ Registration No. 2295478 issued November 30, 1999; with a Section 2(f) claim as to UNITED STATES POST OFFICE.

When the refusals were made final, applicant filed this appeal. Briefs have been filed and an oral hearing was held on July 8, 2004.

Refusal based on Section 2(e)(1)

We turn first to the refusal to register based on mere descriptiveness. In support of the refusal, the Examining Attorney has submitted the following definitions of the words "personal" and "post office" from The American Heritage Dictionary of the English Language, Third Edition 1992, (electronic version):

personal: relating to a person's movable property; personal possessions.

post office: 1. The public department responsible for the transportation and delivery of the mails. Also called postal service. 3. A local office where mail is received, sorted, and delivered, and where stamps and other postal materials are sold.

In addition, the Examining Attorney submitted copies of sixty-five third-party registrations for various goods and services wherein the word PERSONAL has been disclaimed. The Examining Attorney maintains that these registrations demonstrate that the U.S. Patent and Trademark Office has traditionally considered the word "personal" to be descriptive of goods and services for individual use. Further, the Examining Attorney made of record excerpts of articles from the NEXIS database which refer to the fact

that parcels, packages and other mail is weighed at post offices. Based on the above evidence, the Examining Attorney argues that PERSONAL POST OFFICE is merely descriptive of the identified goods. The Examining Attorney argues that the word "personal" is descriptive of the identified goods because applicant's scales are small in size and designed for home or small office use. Further, according to the Examining Attorney, the words "post office" are descriptive of the identified goods because the use of scales to weigh letters and packages is a typical function of the U.S. Post Office.

Thus, the Examining Attorney argues that PERSONAL POST OFFICE immediately conveys that the identified goods are of a "personal nature" and "provide a Post Office function." Office action mailed February 13, 2000.

Applicant, on the other hand, argues that its mark PERSONAL POST OFFICE is at most suggestive of applicant's hand-held metal scales. Applicant argues that neither PERSONAL nor POST OFFICE is descriptive of applicant's scales. Applicant argues that the definitions submitted by the Examining Attorney are not applicable to applicant's goods.

Further, applicant takes issue with the Examining Attorney's contention that the Office has traditionally

considered the word "personal" to be descriptive of goods for home or small office use. In this regard, applicant submitted copies of sixty registrations of marks that contain the word "personal" with no disclaimer thereof.

Further, applicant submitted the declaration of John A. Hawkins, a professor of linguistics at the University of Southern California. It is Mr. Hawkins' opinion that "the phrase PERSONAL POST OFFICE is not generic, and nor is it descriptive of hand-held letter scales. It is instead either suggestive or arbitrary." Hawkins declaration, p. 3.

A mark is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]." *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976). (emphasis added). See also: *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). Moreover, in order to be descriptive, the mark must immediately convey information as to the ingredients, qualities or characteristics of the goods or services with a "degree or particularity." *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199, 1204-1205 (TTAB 1981); *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949, 982 (TTAB 1981): *In re TMS Corp.*

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of the Americas, 200 USPQ57, 59 (TTAB 1978); and In re Diet Tabs, Inc., 231 USPQ 587, 588 (TTAB 1986).

If, however, when the goods or services are encountered under a mark, a multistage reasoning process, or resort to imagination, is required in order to determine the attributes or characteristics of the product or services, the mark is suggestive rather than merely descriptive. See: In re Abcor Development Corp., supra at 216; and In re Atavio, 25 USPQ2d 1361, 1362 ((TTAB 1992). To the extent that there is any doubt in drawing the line of demarcation between a suggestive mark and a merely descriptive mark, such doubt is resolved in applicant's favor. In re Atavio, supra at 1363.

We agree with applicant that the mark PERSONAL POST OFFICE, as used on hand-held metal scales for weighing letters and small packages, is not merely descriptive. Several steps are required to move from the combined term PERSONAL POST OFFICE to an understanding of the nature of applicant's goods. The combination of PERSONAL and POST OFFICE results in an incongruous term. A prospective purchaser must use a multistage reasoning process to understand the nature of applicant's goods, i.e., the scales are small in size and are for personal use; the scales are a "substitute" for weighing letters and packages

at a post office; thus the scales are in the nature of a "personal post office."

Therefore, we conclude that the Examining Attorney has not established that the term PERSONAL POST OFFICE, when applied to applicant's goods is merely descriptive; that some mental processing or cogitation is required in order for prospective purchasers of applicant's hand-held metal scales to understand the significance of the term PERSONAL POST OFFICE as it pertains to applicant's goods.

Refusal based on Section 2(a)

We turn next to the refusal to register under Section 2(a) of the Trademark Act on the ground that the mark PERSONAL POST OFFICE falsely suggests a connection with the U.S. Postal Service. The Examining Attorney argues that the mark PERSONAL POST OFFICE is a close approximation of "United States Post Office" which the U.S. Postal Service uses to identify its places of business and services; that consumers will recognize that applicant's mark PERSONAL POST OFFICE is very similar to "United States Post Office"; that applicant is not connected in any way to the U.S. Postal Service; and that the United States Postal Service, operating through various Post Offices, is so famous that consumers would presume a connection. The Examining Attorney relies on statements made by the National

Arbitration Forum in proceedings involving various domain names that contain "post office." (e.g., United States Postal Service v. Consumer Information Organization and United States Postal Service v. Reflex Publishing). The Forum has stated that "there are over 38,000 places of official Postal businesses located throughout the United States, all known as POST OFFICE" and that "[t]he Postal Service has gained widespread public recognition of both its POST OFFICE and PRIORITY MAIL marks and the services offered under those marks. These marks have become a distinctive designation of the source of its products and services and have become uniquely associated with the Postal Service."

Applicant, on the other hand, argues that PERSONAL POST OFFICE does not falsely suggest a connection with the U.S. Postal Service, particularly because the term "post office" does not uniquely identify the U.S. Postal Service. Applicant submitted a printout of a website whose address is www.postoffice.com and calls itself "The World-Wide Post Office Portal." The website links users to the official "post office" sites in sixty-two countries. Applicant also submitted printouts from the "post office" websites of a number of countries. In addition, applicant submitted copies of printouts from the websites of summer camps which

use the term "post office" to identify the facility used to internally process mail. Also, applicant submitted copies of six third-party registrations containing the term "POST OFFICE" for various goods and services; none of the registrations is owned by the U.S. Postal Service.

In order to be properly refused registration pursuant to Section 2(a) of the Act, the mark (or part thereof) "must point uniquely" to persons, living or dead, institutions, beliefs, or national symbols. The University of Notre Dame v. J.C. Food Imports, 703 F.2d, 217 USPQ 505, 509 (Fed. Cir. 1983).

In this case, applicant has submitted substantial evidence that clearly establishes that entities not connected with the U.S. Postal Service have made use of the term "Post Office." Thus, it cannot be said that POST OFFICE points uniquely to the U.S. Postal Service. With respect to the statements made by the National Arbitration Forum, the Board is not bound by such statements.

Refusal based on Section 2(d)

We turn next to the refusal based on Section 2(d) of the Trademark Act. Applicant's mark is PERSONAL POST OFFICE and the cited marks are UNITED STATES POST OFFICE, UNITED STATES POST OFFICE EXPRESS, UNITED STATES POST OFFICE and eagle design, and UNITED STATES POST OFFICE

EXPRESS and eagle design. We find that when the marks are considered in their entirety, they are not so similar that their use in connection with the goods of applicant and the services set forth in the cited registrations would be likely to cause confusion. Although applicant's and registrant's marks contain the term "Post Office," this term is highly descriptive or generic of registrant's services, so its inclusion in applicant's and registrant's marks is not a basis for finding the marks in their entirety to be similar. The remaining parts of applicant's and registrant's mark are different and when these different components are combined with the term POST OFFICE, the marks in their entirety are not so similar that they would be likely to cause confusion when used in connection with the respective goods and services.

With respect to the goods and services, applicant's services are hand-held metal scales for weighing letters and small packages. The services in the cited registrations are: mail services, namely, sorting, handling, and receiving packages and letters; retail store services featuring stamps, philatelic products, stationery, and other mailing materials, novelty items, and other related merchandise; postal services, namely, packaging articles for transportation, letter and parcel delivery and

rental of mailboxes. The Examining Attorney argues that it is common knowledge that the U.S. Postal Service sells at its locations stationery, mouse pads, T-shirts and other items. According to the Examining Attorney, consumers would believe that the U.S. Postal Service is also offering for sale hand-held metal scales.

We are not persuaded by the Examining Attorney's argument. We recognize that the U.S. Postal Service sells stationery, mailing materials, and promotional type items. However, hand-held metal scales are very different from these kinds of items and there is no evidence that hand-held metal scales are related in any meaningful way to the services in the cited registrations, namely, mail services, retail store services, and postal services. Further, the record is devoid of evidence that hand-held metal scales are within the U.S. Postal Service's natural area of expansion.

Decision: The refusals to register under Sections 2(e)(1); 2(a); and 2(d) are reversed.