

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
December 8, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Invue Security Products Inc.

Serial No. 77006342

Jonathan P. Spence of Adams Intellectual Property Law, PA,
for Invue Security Products Inc.¹

Michael W. Baird, Managing Attorney, Law Office 116.

Before Seeherman, Mermelstein, and Ritchie, Administrative
Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Invue Security Products Inc., applicant herein, seeks
registration on the Principal Register of the mark "PUCK,"
in standard character format, for goods ultimately
identified as "theft deterrent devices and anti-shoplifting
devices, namely, electronic article surveillance tags

¹ Applicant changed its attorney after the case was fully
briefed. The attorney listed herein is the new attorney of
record, as designated by applicant.

embodying electronic microcircuits," in International Class 9.² The trademark examining attorney refused registration on the ground that applicant's mark is merely descriptive of the identified goods under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1). Applicant appealed the final refusal. Both applicant and the examining attorney filed briefs. After careful consideration of all of the arguments and evidence of record, we affirm the refusal to register.

A term is deemed to be merely descriptive of goods or services, 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); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term

² Serial No. 77006342, filed on September 25, 2006, under Trademark Act Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), alleging a bona fide intent to use in commerce.

would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Moreover, it is settled that "[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 understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); *See also In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985).

The word "puck" is defined as "a hard rubber disk used in ice hockey."³ The examining attorney argues that "PUCK" in relation to applicant's identified goods would be perceived by consumers as indicating a feature of the goods, namely, that they are offered in the general size and shape of a hockey puck. To support this argument, the

³ American Heritage Dictionary of the English Language (4th ed. 2000). The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd* 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

examining attorney submitted evidence of Internet articles and advertisements showing security devices similar to applicant's -- including some offered by applicant on its own website -- with illustrations of the devices in the general size and shape of a hockey puck.

One competitor's website referred to the size of a similar security device as being in the "range from the size of a grain of rice to a hockey puck." *Aurora Bar Code Technologies: Radio Frequency Identification (RFID) Systems*, www.aurorabarcode.com/rfid.htm 10/26/07 printout. Another article referred to a similar device as being the "size of a hockey puck." "RFID Technology is Important for Wisconsin Companies," *Wisconsin Technology Network*, 10/12/05.

Applicant argues that its proposed mark is suggestive, rather than merely descriptive, of a hockey puck, since consumers may believe that "PUCK" refers to a device that is "strong and durable like a hockey puck" rather than being shaped like one. (Applicant's Brief at 10). It is clear to us from the record, however, that similar devices, including applicant's own "Non-Alarming Puck," "Power Puck" and "Camera Puck" security devices, are offered in the general size and shape of a hockey puck, and that consumers would therefore require no imagination to arrive at the

belief that applicant's proposed mark refers to a feature of its product.

It is well-established that a proposed mark describing a shape or size may be considered merely descriptive of a feature of the identified goods. *J. Kohnstam, Ltd. v. Louis Marx & Co.*, 124 USPQ 362, 364 (CCPA 1960). As the court there noted: "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." See also *In re H.U.D.D.L.E.*, 216 USPQ 358, 359 (TTAB 1982) (TOOBS, as phonetic equivalent of "tubes" was merely descriptive of household items shaped like tubes, even though not actually serving as tubes).

Furthermore, as the examining attorney noted, the primary purposes for refusing registration of a merely descriptive mark are "(1) to 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*, 200 USPQ at 217. It would be difficult for competitors to describe this apparently common feature of their own security devices (*i.e.*, that it is offered in the general size and shape of a hockey puck) if we were to allow applicant to register "PUCK." Indeed, the examining attorney submitted evidence of a design patent on a similar product stating, "what is claimed is: the ornamental design for a security puck, as shown and described." *Patent No. D416778, issued November 23, 1999 for "Security Puck."* This indicates to us that others in the industry may use the term not only descriptively but perhaps even generically.

In sum, although any doubt on a 2(e)(1) refusal must be resolved in favor of the applicant, it is clear that a consumer would understand "PUCK" used in connection with applicant's goods as conveying information about them. See *In re Tower Tech Inc.*, 64 USPQ2d at 1316-17; see also *In re Conductive Services, Inc.*, 220 USPQ 84, 86 (TTAB 1983). Therefore we find that the mark is merely descriptive of the identified goods. Accordingly, we affirm the refusal to register.

Decision: The refusal to register under Trademark Act Section 2(e)(1) is affirmed.