

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: February 15, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re CauseForce, Inc.

Serial No. 78624761

Serial No. 78625097

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Before Quinn, Hairston and Wellington,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

CauseForce, Inc. filed applications to register the
mark THE UNDERWEAR AFFAIR (in typed character format) and
the mark appearing to the right
on the Principal Register for
services ultimately identified
as: "charitable fundraising,
namely, organizing athletic
events to generate funds for



research on, and treatment of, cancers below the waist" in International Class 36.¹

The trademark examining attorney refused registration of THE UNDERWEAR AFFAIR (in standard character format) under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark is merely descriptive of applicant's services. The examining attorney refused registration of the mark THE UNDERWEAR AFFAIR (in stylized letters) with an underwear design based on applicant's failure to comply with the requirement under Section 6 of the Trademark Act to disclaim the phrase "THE UNDERWEAR AFFAIR" apart from the mark because the phrase is merely descriptive of applicant's services. Although the grounds for refusal are different, the issue is the same, namely, whether or not the mark (and phrase) "THE UNDERWEAR AFFAIR" is merely descriptive of the recited services.

After the refusals were made final, applicant filed requests for reconsideration and appealed. The examining attorney denied the requests for reconsideration. Applicant and the examining attorney filed briefs on the issue under appeal. Because the applications are owned by

¹ Application Serial Nos. 78624761 and 78625097 were filed May 6, 2005, based upon applicant's assertion of its bona fide intent to use the marks in commerce in connection with the recited services.

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the same applicant, were reviewed by the same examining attorney, and involve common issues of fact and law, we have consolidated the appeals. Both refusals are reversed.

The examining attorney contends that THE UNDERWEAR AFFAIR is "merely descriptive because it is a combination of merely descriptive terms that immediately describes a feature of the applicant's services, that is, that the services include, or is, an affair in which underwear is featured or worn." Brief, p. 7.² Specifically, he argues that the word "affair" encompasses applicant's charitable fundraising athletic events; that "participants in [applicant's] charitable fundraising affair are encouraged to wear underwear as their sole piece of outerwear attire"; that "applicant's website shows many images of people wearing underwear as the sole piece of clothing, displays images of underwear, and consistently emphasizes the underwear theme throughout the website"; and that, therefore, the term "underwear" is also "merely descriptive because the word tells the customer that the wearing of underwear as the sole piece of clothing is encouraged and takes place." Brief, p. 5.

² Unless otherwise specified, references are to briefs filed in application Serial No. 78624761.

In support of his position, the examining attorney submitted copies of definitions, of which we take judicial notice, from *The American Heritage Dictionary of the English Language* (4th ed. 2000) of the terms "underwear" and "affair"; copies of printouts from four different third-party websites using the term "affair" in connection with fundraising events; and copies of printouts from applicant's website.

Applicant contends that THE UNDERWEAR AFFAIR is, at most, suggestive of "one of the ways that [applicant's] organizers attempt to draw attention to the need for research funds for cancers that occur below the waist (and entice entrants to a fun, costumed event, and donors to support such an event)." Brief, p. 4. In particular, applicant acknowledges that some of the attendees of its fundraising events are encouraged to wear underwear, but not as the term is defined, but in the manner of a costume. Brief, p. 3. And, "[t]hese costumes impart a message about the use of funds donated," i.e., for research on cancers below the waist. *Id.*

The examining attorney bears the burden of showing that a mark is merely descriptive of the identified goods or services. See *In re Merrill, Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 21567, 4 USPQ2d 1141, 1143 (Fed. Cir.

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1987). A term is considered to be merely descriptive of goods and/or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods and/or services.

Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052; see also *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

It is not necessary, in order to find that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods and/or services for which registration is sought. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

However, upon encountering the goods or services under the mark, should a multistage reasoning process or resort to imagination be required in order to determine the

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attributes or characteristics of the product or services, the mark is suggestive rather than merely descriptive. See *In re Abcor Development Corp.*, *supra.*; *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633 (TTAB 1999); and *In re Atavio*, 25 USPQ2d 1361, 1362 (TTAB 1992). Often there is fine line separating suggestiveness from mere descriptiveness, and determining which side of the line a mark falls on frequently involves a good measure of subjective judgment. To the extent that there is any doubt in resolving this decision, such doubt is resolved in applicant's favor. *In re Atavio*, 25 USPQ2d 1361, 1363 (TTAB 1992).

There is a good deal of incongruity between the phrase THE UNDERWEAR AFFAIR and applicant's charitable fundraising services, namely, organizing athletic events to generate funds for research on, and treatment of, cancers below the waist, inasmuch as people are not accustomed to wearing and/or seeing others in their underwear at charitable fundraising events. The rhyming of the words "underwear" and "affair" further highlights the fanciful nature of the phrase THE UNDERWEAR AFFAIR. There is no evidence that underwear is commonly used as a theme or costume at charitable fundraising events, other than applicant's use, such that we may conclude that the phrase would be

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perceived as merely describing a feature of applicant's services. As a result of the incongruity, when viewing THE UNDERWEAR AFFAIR in connection with applicant's services, a certain level of imagination is needed before one construes this phrase as describing a charitable fundraiser where underwear is being worn by as a costume by participants.

Accordingly, we conclude that the examining attorney has not established that the mark (and phrase) THE UNDERWEAR AFFAIR, when applied to applicant's services is merely descriptive; that some mental processing is required in order for recipients of and prospective customers for applicant's services to understand the significance of the mark (and phrase) as it pertains to applicant's services.

Decision: The refusals under Sections 2(e)(1) and 6 of the Act are reversed.