

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Oral Hearing: July 22, 2008

Mailed: September 29, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re True Value Company

Serial No. 78840966

Serial No. 78840980

Christopher J. Schulte, of Merchant & Gould P.C., for True Value Company.

Katy Halmen, Trademark Examining Attorney, Law Office 109 (Dan Vavonese, Managing Attorney).¹

Before Rogers, Walsh and Ritchie de Larena, Administrative Trademark Judges.

Opinion by Ritchie de Larena, Administrative Trademark Judge:

True Value Company, applicant herein, filed two applications seeking to register "MASTER ELECTRICIAN" on the Principal Register for goods identified as follows:

1. "Electric power strips; extension cords and electrical wires; timers; wiring devices, namely, reels for electric wire, wire diameter measuring devices; electric light dimmers; audio, video and

¹ Examining attorney Richard White presented the oral argument for the Office.

Serial No. 78840966

Serial No. 78840980

telephone accessories, namely interface circuits for video cameras, video circuit boards; electrical power supplies; antennae and accessories, namely, antenna parameter measuring apparatus and electronic combiners for connecting antennas and receivers," in International Class 9.²

2. a) "Cord storage, namely, non-metal electrical cord reels," in International Class 9.

b) "Lighting fixtures, namely, under cabinet and fluorescent lighting; lamp parts, namely, lamp shades, lamp bases, chimneys for oil lamps, filaments for electric lamps, lamp reflectors; portable task lights, namely, pen lights, flashlights; lighting fixtures, namely, work lights and security lighting," in International Class 11.³

The trademark examining attorney issued a final refusal in both applications on the ground that the mark is merely descriptive of the identified goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1). Applicant appealed the final refusals. Both applicant and the examining attorney filed briefs. Applicant and the examining attorney took part in an oral hearing in these cases on July 22, 2008. The Board scheduled these two cases along with several of applicant's pending *ex parte* appeals that contain the term "MASTER" in the marks for a single

² Serial No. 78840966, filed on March 20, 2006, based on Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), alleging a bona fide intent to use the mark in commerce.

Serial No. 78840966

Serial No. 78840980

hearing. In this decision, we have limited our focus to the two *ex parte* appeals in which applicant seeks to register the mark "MASTER ELECTRICIAN." These two appeals involve common questions of law and fact, and are appropriate for consolidation. Upon careful consideration of the evidence of record and the arguments of counsel, we reverse the refusal to register in both applications.

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). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. *See In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

³ Serial No. 78840980, filed on March 20, 2006, based on Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), alleging a bona fide intent to use the mark in commerce.

Serial No. 78840966

Serial No. 78840980

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 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). On the other hand, if a mark requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods or services, then the mark is suggestive. *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003).

Serial No. 78840966

Serial No. 78840980

We consider a composite mark in its entirety. The composite is registrable even if its individual terms are descriptive, so long as the unitary mark has a separate, non-descriptive meaning. *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (holding SUGAR & SPICE not merely descriptive of bakery products). Thus we consider whether the words "MASTER ELECTRICIAN" have a descriptive meaning as a unitary phrase. The examining attorney argues that the term "MASTER ELECTRICIAN" merely describes "a particular consumer group" with "a particular license and high level of skill and knowledge in the field of electrical work." The examining attorney further submitted evidence to show that master electricians use the goods set forth in the recitals of these two applications. A sampling of the examining attorney's evidence includes the following excerpts:

"The second method I mentioned was to have the generator installed by a master electrician. The electrician can wire the generator into house circuits in a way that - as John mentions - automatically switches the circuitry so that the generator power travels in household circuits but is blocked from leaving the house, where it can do damage."⁴

"Our team of Master Electricians is trained and equipped to provide superior service that will meet or exceed the National Electrical Code . . . We provide the

⁴ Evidence submitted by the examining attorney in the final office action in Application No. 78840966, citing *The Atlanta Journal-Constitution*, October 31, 2004.

Serial No. 78840966

Serial No. 78840980

following electrical services: . . . 240 wiring for dryers, ranges and air conditioners; new circuit wiring and outlets; computer wiring . . . custom lighting controls/dimmers . . . Telephone and Cable Repairs . . . Home Theaters."⁵

"Call our experts for lighting installation and specialty wiring needs. Electric Services; Recessed Lighting . . . Outdoor Lighting . . . Custom Lighting Designs . . . From residential work on older homes to remodels or service, we do it all. No job is too big or too small for our master electricians."⁶

To support her argument that applicant's "MASTER ELECTRICIAN" mark is merely descriptive of the identified goods in the two applications, the examining attorney cites *In re Camel Manufacturing Co., Inc.*, 222 USPQ 1031 (TTAB 1984). The Board in that case held the mark "MOUNTAIN CAMPER" to be merely descriptive under Section 2(e)(1) of "retail and mail order services in the field of outdoor equipment and apparel." However, the Board did not base its decision in that case merely on the existence of "mountain campers" as a possible class of consumer of applicant's goods. Rather, the Board clearly noted that "we embrace the holding that a mark is merely descriptive if it describes the type of individuals to whom an

⁵ Evidence submitted by the examining attorney in the denial of request for reconsideration in Application No. 78840966, citing Internet printout from www.lehighvalleyelectric.com.

⁶ Evidence submitted by the examining attorney in the denial of request for reconsideration in Application No. 78840980, citing Internet printout from www.johnnyelectric.com.

Serial No. 78840966

Serial No. 78840980

appreciable number or all of a party's goods or services are directed." *Id.*

Applicant has shown that not to be the case here. Applicant has pointed to numerous articles that tout applicant's goods as being targeted to "do-it-yourself" homeowners. A sampling of applicant's evidence includes the following excerpts:

"In 1994, Bryant became the general manager of the True Value Home Center, a True Value operation opened by his family to better serve the needs of do-it-yourself homeowners." *Sierra Star* July 21, 2006.

"After listening to customer focus groups for months, True Value is targeting not bargain-hunters or advice-seekers but the 'do-it-yourself' enthusiasts who already account for an estimated 43 percent of its sales." *Associated Press Online* March 27, 2006.

"ei software Inc. works with a variety of home-improvement suppliers - Pittsburgh Paints, Raynor Garage Doors, True Value Co. - to provide visualization tools for the do-it-yourself type." *Newsday* March 30, 2006.

"Products, tools, and DIY sheets are at Mitre 10, True Value, Stratco, Home Depot . . ." *Nationwide News Pty. Limited* June 20, 2004.

"Its products are sold in 20,000 retail locations nationwide, including Home Depot, Lowes, True Value, and Ace Hardware. 'They're mostly DIY products,' Broderick said, 'and 85 percent of what we distribute goes home in DIYer's cars.'" *National Home Center News* October 8, 2001.

"I was referred by the local True Value Hardware, a do-it-yourself gold mine in its own right." *The Seattle Times* August 8, 1999.

Accordingly, applicant argues that the term "MASTER ELECTRICIAN" does not describe applicant's intended

Serial No. 78840966

Serial No. 78840980

consumers, or at least not "an appreciable number" of them as required by the Board in *In re Camel Manufacturing Co., Inc., supra*, 222 USPQ 1031. Rather, applicant argues, the mark is suggestive of the professional quality that a do-it-yourself homeowner can obtain from applicant's products. Applicant relies on several prior Board rulings that distinguish between goods targeted to professionals, and goods targeted to a general consumer who wishes to have professional-style results. See *In re Chesebrough-Pond's Inc.*, 163 USPQ 244 (TTAB 1969). The Board in *Chesebrough-Pond's* reversed the examining attorney's requirement of a disclaimer of the term "MANICURIST" in the mark "MANICURIST BY CUTEX" for "nail polish." As the Board explained, finding the nail polish in its typical channels of trade, consumers would not expect that the product is intended only for professional manicurists. Rather, they would hope that by using the product they may obtain a professional result. *Id.* The same conclusion was reached in the non-citable case relied upon by applicant, *In re Omega Research, Inc.*, Serial No. 74/546,080 (TTAB 1997).⁷ There, the Board reversed a 2(e)(1) refusal to register the mark

⁷ We do not base our decision in these cases on this non-citable case, but discuss it merely as an example of similar Board rulings and because applicant has relied on it in briefing these cases.

Serial No. 78840966

Serial No. 78840980

"WALL STREET ANALYST" for "computer software to assist in making investment decisions." The Board reasoned that while a professional "wall street analyst" could use the applicant's product, it was intended for do-it-yourself investors who wished for professional results.

Accordingly, as in *Chesebrough-Pond's*, the mark in *Omega* was held not "merely descriptive" but suggestive.

The examining attorney argues that *Omega Research* is not analogous to the present case, asserting that the examining attorney there, unlike here, had failed to demonstrate a nexus between the user identified in the mark and the services identified in the application. It is true that the examining attorney here has provided ample evidence of the existence of a group of possible consumers known as "master electricians," and of the possibility that they may use applicant's identified goods. However, as in *Chesebrough-Pond's*, that is not the critical point in these cases. The question, rather, is whether an "appreciable number or all" of applicant's goods are directed towards master electricians. See *In re Camel Manufacturing Co., Inc., supra*, 222 USPQ 1031. Applicant has submitted probative evidence that they are not. Furthermore, there is nothing in the identifications of goods in these applications which limits the class of consumers to master

Serial No. 78840966

Serial No. 78840980

electricians, nor is there anything inherent in the nature of the listed items which would limit their use to master electricians. Rather, the goods appear to be goods which "do-it yourselfers" or others who are not master electricians could and would purchase. These potential purchasers would likely constitute the overwhelming majority of purchasers, and these purchasers would likely perceive the suggestive meaning of the mark posited by applicant.

Furthermore, we note that unlike a Section 2(d) analysis, any doubts regarding the application of Section 2(e)(1) are to be resolved in favor of the applicant. *In re Conductive Services, Inc.*, 220 USPQ 84, 86 (TTAB 1983) (observing, "[w]e recognize that the suggestive/descriptive dichotomy can require the drawing of fine lines and often involves a good measure of subjective judgment."). Accordingly, we find that applicant's "MASTER ELECTRICIAN" mark is suggestive, and we reverse the Section 2(e)(1) refusals of these two applications.

Decision: We reverse the refusals to register in Application Nos. 78840966 and 78840980.