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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Zakrytoe Aktsionernoe Obschestvo "Zavod Ema"

Serial No. 79055467

Maria M. Eliseeva of Houston Eliseeva for Zakrytoe
Aktsionernoe Obschestvo "Zavod Ema."

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(Dan Vavonese, Managing Attorney).

Before Quinn, Wolfson and Lykos, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Zakrytoe Aktsionernoe Obschestvo "Zavod Ema" filed an
application to register the mark shown below



for "lamps; standard lamps; ceiling lights."¹ The application includes the following translation: "The transliteration of the non-Latin characters in the mark is: EMAled." The application also includes the following description of the mark:

Color is not claimed as a feature of the mark. The logotype of the designation applied for presents an artificial word consisting of two components, the first part "Ema" is an abbreviation of the initial letters from the word combination "ElektroMeditsinskaya Apparatura" ("ElectroMedical Apparatus") executed in Russian typeface letters; the second part "led" is an artificial word formation composed of the letters of the word combination "svetiL'niki mEDitsinskiye" executed in transliteration using letters of the Latin alphabet; the second part of the logo "led" is displaced with regard to the first one by the height of the lowercase letter; the graphic element of the designation applied for is represented by an image of the letter "l" in the form of a stylized source of light.

The trademark examining attorney has refused registration based on applicant's failure to comply with the requirement to disclaim the acronym "LED" apart from the mark. According to the examining attorney, the "LED"

¹ Application Serial No. 79055467, filed February 8, 2008, under Section 66(a) of the Trademark Act, 15 U.S.C. §1141f, based on International Registration No. 0968742, issued February 8, 2008.

portion of the mark, meaning "light emitting diode," is merely descriptive of a feature of applicant's goods.

When the refusal was made final, applicant appealed. Applicant and the examining attorney² filed briefs.

Applicant argues that the examining attorney, in requiring a disclaimer of "LED," impermissibly has dissected the mark. Applicant contends that its mark is an integral unitary mark comprising two arbitrary components:

One abbreviation typed in Russian (Cyrillic) is "ЭМА" - the abbreviated name of Applicant (a loose translation into English is Electro-Medical Apparati).

The second portion of that fanciful integral mark is an arbitrary abbreviation «ЛЕД» of the Russian phrase "СВЕТИЛЬНИКИ МЕДИЦИНСКИЕ", which translates into English as "medical lightings". This second Russian abbreviation ЛЕД is arbitrary and that combination of letters ЛЕД has nothing to do with light or light sources. The abbreviation ЛЕД does not stand for a light emitting diode in the Russian language.

To create a fanciful arbitrary mark, Applicant left the first Russian abbreviation in the Cyrillic lettering and transliterated the second

² The examining attorney, in his brief, requests the Board to take judicial notice of two additional online dictionary definitions. Because the examining attorney has not shown that this evidence falls within the judicial notice guidelines (that is, the electronic versions are available in a printed format, or the references are the electronic equivalent of a print reference work or the references have regular fixed editions), the request is denied.

abbreviation into Roman lettering as LED, to come up with a one-word mark ЭМАLED. (The Russian letter "Л" corresponds to the English "l" and the Russian letter "Д" corresponds to the English "D"). The mark is pronounced as "emaa-led" - long [a] after "m" and "led" as in "led by a leader", for example. The mark is not pronounced as "ema-el-ee-dee".

(Brief, pp. 2-3). Applicant further argues that

the slightly raised portion of its unitary mark is not "raised" to make an impression of a non-integral mark, but to emphasize the stylized letter "l" to make it look like a light source that could be used in medical operating rooms. This is not a capitalized letter. If it were capitalized, then it would have been of the same height as capital letter "D" in the drawing of the mark, and, as follows from the drawing, it is not of the same height, but rather twice as high. It is known that the lighting used in operating rooms is always elevated relatively high to the operating table.

Applicant's fanciful mark intends to convey an impression that a medical lighting fixture with letter "l" has a long vertical portion of the letter, which makes it possible to stylize it as a stem-neck portion of a lighting fixture. (Brief, p. 3).

Applicant asserts that it uses the "word" ЭМАLED as an integral brand name for its products as shown on its website.

The examining attorney maintains that "LED" is merely descriptive as applied to applicant's lighting products

and, thus, must be disclaimed. The examining attorney further contends that the "LED" portion of applicant's mark is raised and separated from the "EMA" portion of the mark and is presented in a manner in which "LED" stands separate and apart from the rest of the mark. The examining attorney also points to the fact that the "LED" portion is in larger type font, and that the initial letter "L" in "LED" is capitalized, both factors contributing to the likely perception that the mark is not unitary. The examining attorney also draws attention to the way applicant's mark is actually used on its website, with the mark presented in two colors, namely EMA is in blue, while LED and the design element above the "L" are in yellow. In support of the disclaimer requirement, the examining attorney introduced dictionary definitions of "LED."

In deciding this appeal, we confront two issues, namely 1) whether LED is merely descriptive so that a disclaimer is appropriate; and 2) whether the mark is unitary, thereby negating the requirement for a disclaimer.

The examining attorney bears the burden of showing that a term is merely descriptive of the relevant goods and/or services. *In re Merrill, Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). We hasten to add in this case, however, that

applicant has not argued against the examining attorney's finding that "LED" is merely descriptive. Rather, applicant focuses on its argument that the mark is unitary, and that, therefore, a disclaimer is not appropriate. For the sake of completeness, however, we will address the descriptiveness issue.

The examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Section 6 of the Trademark Act, 15 U.S.C. §1056. This section of the statute was amended in 1962 to allow the exercise of greater discretion by examining attorneys in determining whether a disclaimer is necessary. See TMEP §1213.01(a) (7th ed. 2010). Merely descriptive or generic terms are unregistrable under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), and therefore are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); and *In re Box Solutions Corp.*, 79 USPQ2d 1953 (TTAB 2006).

A mark 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. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828 (TTAB 2007); and *In re Abcor Development*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A mark 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; rather, it is sufficient that the mark describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a mark 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 the goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services because of the manner of its use. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). 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).

An abbreviation, initialism or acronym of a merely descriptive or generic term is also merely descriptive or generic if it is readily understood by the relevant purchasers to be "substantially synonymous" with the merely descriptive or generic wording it represents or stands for. See, e.g., *In re BetaBatt Inc.*, 89 USPQ2d 1152 (TTAB 2008); and *In re Finisar Corp.*, 78 USPQ2d 1618 (TTAB 2006).

The letters "LED" comprise an acronym for "light-emitting diode." American Heritage Abbreviations Dictionary (3d ed. 2005). This acronym is also defined as:

Short for light-emitting diode. An electronic semiconductor device that emits light when an electric current passes through it. They are considerably more efficient than incandescent bulbs, and rarely burn out. LEDs are used in many applications such as flat screen video displays, and increasingly as general sources of light.

The American Heritage Science Dictionary (2002).

Given that applicant's goods are identified as "lamps; standard lamps; and ceiling lights," the acronym "LED" is merely descriptive when applied to such goods. See *In re Princeton Tectonics, Inc.*, 95 USPQ2d 1509, 1512 (TTAB 2010). Even in Russian, according to applicant, this portion is an abbreviation of a Russian phrase "which translates into English as 'medical lightings.'" (Brief,

p. 3). The "LED" portion of applicant's mark immediately informs prospective consumers that applicant's goods feature light-emitting diodes. No imagination or thought is required to discern this feature of applicant's goods.

Accordingly, unless applicant's mark is considered to be unitary, a disclaimer of the merely descriptive designation "LED" is required. We thus turn to consider whether or not applicant's mark is unitary.

The visual presentation of applicant's mark is such that the mark will not be perceived as forming a unitary whole. See TMEP §1213.05(f) (7th ed. 2010). That is to say, the elements of applicant's mark, "OMA" and "LED," are not so merged together that they cannot be divided and regarded as separable elements. In analyzing this issue, we must consider a number of factors to determine whether matter is part of a single or unitary mark: whether it is physically connected by other design features; the relative location of the respective elements; and the meaning of the terminology as used in connection with the goods. *Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991).

Generally, when a design element replaces a letter in a word that is descriptive, this combination of word and design element does not create a unitary mark if the word

remains recognizable; in such circumstances, a disclaimer is required. *In re Clutter Control, Inc.*, 231 USPQ 588 (TTAB 1986). Even in the case of marks with a distinctive design that replaces a letter, a disclaimer is required when the wording is merely descriptive. See examples at TMEP §1213.05(g)(i) (7th ed. 2010). As highlighted by the examining attorney, the "LED" portion is raised and separated from the "OMA" portion of the mark, and is presented in a manner in which "LED" stands separate and apart from the rest of the mark. The "LED" portion is in larger type font, and the initial letter "L" in "LED" is capitalized; both factors contribute to the likely perception that the mark is not unitary. Further, in the present case, the presentation of "LED" in applicant's mark, both in combination with "OMA" and the design feature of the letter "L," does not result in a nondescriptive significance of the designation "LED."

As indicated in TMEP §1213.05 (7th ed. 2010): "If one cannot spell out exactly why a mark is unitary, then the mark is probably not unitary and nondistinctive elements within the mark must be disclaimed." In the present case, we find that applicant's argument, to the effect that its mark is unitary, is strained; however, we find the

examining attorney's remarks, in explaining why the mark is not unitary, to be articulate and convincing.

Applicant's website shows that its applied-for mark is prominently displayed in the same manner that is shown in the special form drawing. Though applicant is not claiming color, its mark, as actually used, is presented in two colors, namely "3MA" is in blue, while "LED" and the design element above the "L" are in yellow. Thus, the mark, as actually used, clearly will not be perceived as unitary by consumers.

Applicant submitted, for the first time with its appeal brief, copies of third-party registrations of unitary marks comprising, in part, "LED" for lighting products, wherein there is no disclaimer of "LED." The examining attorney, in his brief, properly objected to the untimely submission of this evidence. See Trademark Rule 2.142(d) (record must be complete prior to appeal). Notwithstanding the objection, the examining attorney went on to indicate that, even if considered, the evidence is not probative.

The examining attorney's objection is sustained, and the copies of the third-party registrations do not form part of the record on appeal. We should add, however, that we agree with the examining attorney's assessment that the

third-party registrations are not helpful to applicant's position. If applicant had applied for its mark in a single word in standard character form, ƉMALED, similar to the marks shown in the registrations, then, according to the examining attorney, no disclaimer would be required. However, inasmuch as the special form of applicant's mark depicts the "LED" portion in larger typeface above and apart from the "ƉMA" portion, the "LED" portion is a separable element of the mark that requires a disclaimer. In any event, "[e]ven if prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court." *In re Nett Designs Inc.*, 236 F.3d 139, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

In sum, we find that applicant's mark, depicted in special form, is not unitary. We further find that "LED" is merely descriptive when applied to applicant's goods and, therefore, a disclaimer is required.

Decision: The refusal to register is affirmed. However, if applicant submits the required disclaimer within 30 days of the mailing date of this decision, the decision will be set aside, and the application passed to publication. Trademark Rule 2.142(g).