

This Opinion is not a  
Precedent of the TTAB

Mailed: May 10, 2013

**UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board**

---

*In re Bernie Graham*

---

Application No. 85255894  
Filed: March 2, 2011

---

Paul D. Bangor, Jr., Thorp Reed & Armstrong LLP, for applicant.

Alice Benmaman, Trademark Examining Attorney, Law Office 116, Michael W. Baird, Managing Attorney.

---

**Before Bucher, Mermelstein, and Wellington, Administrative Trademark Judges.**

**Opinion by Mermelstein, Administrative Trademark Judge:**

Bernie Graham, an individual, filed an application for registration of PADPIVOT (in standard characters) to be used on goods identified as a “[s]tand specially adapted for holding tablet computers, PC tablets, pad computers, digital book readers and electronic book readers,” alleging a *bona fide* intent to use the mark in commerce. Registration has been finally refused on the ground that the mark, when used in connection with the identified goods, is merely descriptive of them. Trademark Act § 2(e)(1); 15 U.S.C. § 1052(e)(1).

We affirm the refusal to register.

**I. Applicable Law**

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the services with which

Application No. 85255894

it is used. *See, e.g., In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009–10 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the issue is whether someone who knows what the goods are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316–17 (TTAB 2002); *In re Patent & Trademark Servs. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998). “On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive.” *E.g., In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003); *In re Shutts*, 217 USPQ 363, 364–65 (TTAB 1983).

## II. Discussion

Applicant identifies its goods as a “stand specially adapted for holding ... pad computers....”<sup>1</sup> The examining attorney submitted evidence showing that “pivot” is defined as “a fixed point or pin that something turns or balances upon.” MACMILLAN DICTIONARY (online) *pivot* (<http://macmillandictionary.com/dictionary/american/>

---

<sup>1</sup> We need not consider the rest of the identification of goods.

Application No. 85255894

pivot (accessed June 9, 2011)). Applicant does not dispute this definition. The examining attorney also submitted evidence defining “pad” as “an iPad-like tablet computer.” COMPUTER DESKTOP ENCYCLOPEDIA, *pad* (THE FREE DICTIONARY BY FARLEX <http://encyclopedia2.thefreedictionary.com/pad> (accessed Jan. 9, 2012)). The examining attorney concludes that both “pad” and “pivot” are descriptive of applicant’s goods, and that the combination of those terms is likewise descriptive of a “stand specially adapted for holding ... pad computers....” Final Ofc. Action (Jan. 9, 2012).

Applicant’s first (and presumably best) argument is that the examining attorney ignored “highly probative evidence that Applicant’s PADPIVOT mark is not merely descriptive,” namely, an “email received from a head purchaser of Best-Buy to the Applicant that requested all [PADPIVOT] product ... be re-labeled to add ‘portable tablet stand.’” Applicant did not submit this email for the record, but applicant’s quotation of it does not bear out the argument:

“. . . will be delivered on or prior to \* \* \* and the rest will be [sic] filter through the remainder of the week. Also we were just asked by the merchant team to add a sticker to call out that is this a stand [sic]. So our intention is to re-label the first 3K in store. **We are getting labels printed to replace the bottom Rocketfish label with one that would call out ‘Portable Tablet Stand’.** Once I have a date I will let you know, but we would like all products updated with the ‘new’ label.”

Response to Ofc. Action (Dec. 9, 2011) (emphasis and alterations as in original).

From this email, applicant concludes that

the mark PADPIVOT at this time has been found to be insufficient to describe the nature of the device so as to entice sales. Reasonable consumers without knowledge of the PADPIVOT mark and goods were unable to understand what the goods were with the PADPIVOT mark applied directly thereto without additional language that would qualify as “merely descriptive” to provide such information to consumers.

App. Br. at 4.

We disagree. First, the only reason applicant’s wholesale purchaser gave for requesting a label change was “to call out that this is a stand.” The buyer did not say that “reasonable consumers ... were unable to understand what the goods were,” only that it wanted to emphasize on the label that the goods function as a stand. But in any event, applicant’s argument relies on an incorrect standard for descriptiveness. We are not concerned with whether “consumers without knowledge of the PADPIVOT mark and goods” would be able to “understand what the goods [are].” To the contrary, the descriptiveness of a mark is not to be judged in a vacuum; the proper question is what the mark would mean to a consumer who *does* know what the goods are. *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002) (“[I]t is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used or intended to be used, and the impact that it is likely to make on the average purchaser of such goods or services.”).

Moreover, whether the descriptiveness of the mark would “entice sales” is irrele-

Application No. 85255894

vant. A mark is merely descriptive of the identified goods if it immediately “conveys information regarding a function, or purpose, or use of the goods.” *DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Abcor Dev. Corp.*, 200 USPQ at 217 ). A descriptive term need not tell the purchaser everything about the goods or even be sufficient by itself to identify what the goods are, so long as it conveys significant information about them. *Interpayment Svcs. Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1466 (TTAB 2003); *In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1924 (TTAB 2002). And while the information conveyed by the mark must be of *some* significance — *i.e.*, not trivial — the examining attorney need not show that the information would affect a purchaser’s buying decision. Accordingly, we do not view this email communication (as quoted by applicant) to be persuasive.

Applicant next argues that “[w]hile Applicant’s goods have a ball and socket joint, the common definition of Pad is insufficient to describe the goods or a use thereof. It is a word with multiple meanings but, in all the meanings, at this time none imply the Applicant’s ‘use’ or ‘purpose.’” App. Br. at 4. Applicant quotes a lengthy definition of “pad” from Merriam-Webster’s on-line dictionary in which none of the definitions are relevant to applicant’s goods, and cites an on-line dictionary of computer jargon which “does not list ‘PAD’ as a recognized computer term. *Id.* at 5–6. Applicant suggests that the computer devices its goods are made to work with are better described as “tablets,” “notebooks,” or “readers.” *Id.*

The problem with applicant’s argument is that applicant himself uses “pad” de-

Application No. 85255894

scriptively in his application, identifying his goods as a “stand ... for holding ... *pad* computers....”<sup>2</sup> Application (March 2, 2011) (emphasis added). It is true that the identification of goods also refers to “tablet computers, PC tablets, ... digital book readers and electronic book readers,” but the availability of these terms does not diminish the descriptiveness of “pad” as a type of computer which can be held by applicant’s stand. See *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009) (“There is no requirement that the Office prove actual competitor use or need; it is well established that even if an applicant is the only user of a merely descriptive term, this does not justify registration of that term.” (citations omitted)).

Despite applicant’s lack of success in finding a relevant definition for “pad,” the examining attorney submitted an excerpt from an on-line dictionary defining a “pad” as “an iPad-like tablet computer.” The fact that other dictionaries do not include similar definitions is not necessarily fatal. A mark can be descriptive even if it does not appear in any dictionary at all. *In re Orleans Wines, Ltd.*, 196 USPQ 516, 517 (TTAB 1977). And in a field in which jargon changes as quickly as that of personal computing devices, it is not unusual to find words in descriptive use well before they are found in mainstream dictionaries (or any dictionary at all). We find the examining attorney’s evidence sufficient to establish *prima facie* that “pad” is descriptive as applied to applicant’s goods, and that applicant’s evidence is

---

<sup>2</sup> Although applicant later amended the identification of goods pursuant to the examining attorney’s requirement, the application as originally filed included the reference to “pad computers.” The examining attorney did not question applicant’s use of “pad” in the identification of goods.

Application No. 85255894

insufficient to rebut that evidence. Thus we think it clear that applicant's customers—who are owners of pad computers, tablet computers, electronic book readers, and the like—would clearly understand the significance of the term “pad” when used in connection with a stand for such devices.

Applicant does not dispute the meaning of “pivot” or its meaning in the context of the identified goods. *See* App. Br. at 4 (“While applicant's goods have a ball and socket joint....”). The examining attorney's dictionary evidence shows that “pivot” is defined as “a fixed point or pin that something turns or balances upon.” The examining attorney submitted a picture of applicant's goods from its website:



Final Ofc. Action (Jan. 9, 2012).<sup>3</sup>

---

<sup>3</sup> The picture in the record was split over two pages; we have pieced it together for clarity.

This picture clearly shows a pad computer being held by an arm, which is attached to a stand by a ball-and-socket joint. Such a joint would allow the *pad* to *pivot* on the stand to most positions or angles the user might need. We find that relevant purchasers would easily understand the descriptive relevance of the term “pivot” to such goods.

Finally, we conclude that the combination of PAD and PIVOT in applicant’s mark does not remove the result from the realm of descriptiveness. Although the words are concatenated, they are easily recognized as the words “pad” and “pivot.” *See, e.g., Carlson*, 91 USPQ2d at 1200 (URBANHOUSING merely descriptive (citing *In re Cox Enters. Inc.*, 82 USPQ2d 1040, 1043 (TTAB 2007) (THEATL equivalent to THE ATL and descriptive); *In re Planalytics Inc.*, 70 USPQ2d 1453 (TTAB 2004) (GASBUYER merely descriptive)). The words PAD and PIVOT do not together form a new, non-descriptive meaning, nor do they create a double-entendre, or have any unusual or surprising connotation when juxtaposed as in the applied-for mark. Potential purchasers would immediately recognize, without further conjecture, that a stand for pad computers sold under the term PADPIVOT is simply a pivot for a pad computer, *i.e.*, a feature, function, characteristic, or use of the identified goods.<sup>4</sup>

---

<sup>4</sup> Applicant also argues that the examining attorney’s request in her first Office action for information pursuant to Trademark Rule 2.61(a) about applicant’s goods is evidence that his mark is not descriptive. Applicant is incorrect. The examining attorney’s requirement for information was not inconsistent with her refusal of registration either at the time of the first office action or now. A Rule 2.61(a) request is routinely issued when the examining attorney is unfamiliar with the goods. The subject application was filed on an intent-to-use basis, so the examining attorney had no specimens to refer to, and in addition to refusing registration under Trademark Act § 2(e)(1), she also issued a requirement for an amend-



### **III. Conclusion**

We have carefully considered all of the evidence and argument of record. We conclude that PADPIVOT is merely descriptive of the identified goods, and that registration must accordingly be refused pursuant to Trademark Act § 2(e)(1).

**Decision:** The refusal to register is AFFIRMED and registration to applicant is refused.

---

ment to the identification of goods. A request for information was simply a prudent approach to examination in the event the goods were not what she had—correctly, it appears—assumed them to be. Applicant’s position is apparently that if the mark is descriptive, the examining attorney would have no need for further information, but as noted above, a mark need only describe one aspect of the goods in order to be descriptive. Information provided pursuant to such a request assists in the thorough examination of applications and sometimes leads to the withdrawal of a refusal.