

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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March 5, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re McCrane, Inc.

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Serial No. 85276221

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Edward S. Wright for McCrane, Inc.

Ronald McMorro, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

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Before Wellington, Shaw, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

McCrane, Inc. has applied to register on the Principal Register the mark SOF in standard character form for goods identified as “Exercise weights,” in International Class 28. The trademark examining attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that applicant’s mark merely describes the goods. When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs.

The examining attorney contends that SOF is a misspelling of the word “soft,” which describes a type of exercise weight that is coated or covered with a soft

material. The examining attorney has made of record evidence in the form of internet advertisements for exercise weights of this type, indicating that the purpose of the soft coating is to afford the user a more comfortable grip, or to avoid scratching or otherwise damaging floors and other surfaces that may come into contact with the weights. The evidence shows goods called “soft dumbbells” offered by companies called American Fitness.net; Carnegie Fitness; T&G International Sourcing Co., Ltd.; Xenios USA; and Only-Cricket.com; “soft weights” offered by Isokinetics, Inc. and Fitness Wholesale; kettlebells offered by Sports Authority that have “a soft outer shell that won’t scratch floors”; Nautilus brand “Pilates soft weight balls” offered by Bowflex; and Bally brand “soft grip weights” offered by Kmart.¹

Applicant argues that SOF is not, in fact, the phonetic equivalent of the word “soft,” because it lacks the sound of the final letter T. Applicant argues that the cases relied upon by the examining attorney related to marks that were the exact phonetic equivalents of descriptive terms. Applicant also points to registrations on the Principal Register for marks that include the designations SOFT and SOF to demonstrate that the Trademark Office has treated such marks as non-descriptive in the past.

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

¹ Evidence submitted with examining attorney’s Office action of November 7, 2011. *See also* similar materials submitted with the examining attorney’s final office action of April 26, 2011.

used." *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). It is well established that a slight misspelling of a word will not turn a descriptive word into a non-descriptive mark if it will be perceived by consumers as the equivalent of the descriptive term. *In re ING Direct Bancorp*, 100 USPQ2d 1681, 1690 (TTAB 2011) (PERSON2PERSON PAYMENT generic); *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009) (URBANHOUSING merely descriptive); *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1475 (TTAB 2007) (TOGGS generic); *In re Hubbard Milling Co.*, 6 USPQ2d 1239 (TTAB 1987) (MINERAL-LYX generic).

Clearly, the spelling of a descriptive term may be so extensively altered that the resulting mark would not be perceived as the equivalent of the original descriptive word, but merely suggestive of it. However, even extensively altered descriptive terms may be found merely descriptive. *Andrew J. McPartland, Inc. v. Montgomery Ward & Co.*, 76 USPQ 97 (CCPA 1947), *cert. denied*, 333 U.S. 875, 77 USPQ 676 (1948) (KWIX-TART merely descriptive). The courts have also found misspelled words to be merely descriptive where the pronunciation of the resulting designation was not exactly the same as the descriptive term from which it was derived. *American Druggists' Syndicate v. United States Industrial Alcohol Co.*, 2 F.2d 942 (D.C. Cir. 1924) (AL-KOL); *Elizabeth Arden Sales Corp. v. Faberge, Inc.*, 134 USPQ 186 (CCPA 1962) (EXTRORDINAIRE); *Car-Freshner Corp. v. Auto Aid Mfg. Corp.*, 461 F.Supp. 1055 (N.D.N.Y. 1978) (CAR-FRESHNER); *In re Keebler Co.*, 479 F.2d 1405, 178 USPQ 155 (CCPA 1973) (RICH 'N CHIPS).

The question before the Board is whether SOF is merely descriptive because of its resemblance to the word “soft.” The policy underlying the rule that misspelled words may be found merely descriptive is set forth in the Restatement of Unfair Competition as follows:

The misspelling or corruption of an otherwise descriptive word will not ordinarily alter the descriptive character of the designation. In many instances the contrivance will not overcome the ordinary meaning of the term, and prospective purchasers will thus continue to understand the designation in a purely descriptive sense. ... Recognition of exclusive rights in variants and corruptions of descriptive words also imposes a risk of liability on subsequent users of the original words. [Cross-reference omitted.] Thus, unless the alteration is sufficient to avoid encumbering use of the original word, the variation remains descriptive.

RESTATEMENT (THIRD) OF UNFAIR COMPETITION (2012), § 14, Comment a.

The predecessor of our primary reviewing court noted that in the “attempt[] to register a ‘mark’ which is a mere misspelling or contraction of a descriptive term,” there is an inherent “evil,” which is “the possibility of harassment by the registrant of the descriptive term, by means of threats of infringement suits and the like, of others in the field who use the descriptive term to describe their products...” *Armour and Co. v. Organon, Inc.*, 245 F.2d 495, 114 USPQ 334, 337 (CCPA 1957). Examples of the “harassment” against which *Armour* warned can be seen in *American Aloe Corporation v. Aloe Creme Laboratories, Inc.*, 159 USPQ 560 (N.D. Ill. 1968) and *Aloe Creme Laboratories, Inc. v. Milsan, Inc.*, 165 USPQ 37 (5th Cir. 1970), two cases in which a plaintiff claiming rights in the trademark ALO

unsuccessfully alleged infringement by users of marks that included the descriptive word ALOE.

The Supreme Court has expressed the same concern, *i.e.*, that a business should not be allowed to appropriate a term whose “primary meaning” is one that “others may employ with equal truth, and with equal right, for the same purpose.” *Standard Paint Company v. Trinidad Asphalt Manufacturing Company*, 220 U.S. 446, 454 (1911). In finding the mark RUBEROID to be merely descriptive, the Court stated:

The word [“rubberoid”], therefore, is descriptive, not indicative of the origin or the ownership of the goods; and, being of that quality, we cannot admit that it loses such quality and becomes arbitrary by being misspelled [as RUBEROID]. Bad orthography has not yet become so rare or so easily detected as to make a word the arbitrary sign of something else than its conventional meaning....

Id. at 455.

Commenting upon *Standard Paint*, the Restatement explains, “Application of the rule turns on both the distinctiveness of the altered form and the extent to which the remaining visual or aural similarities with the word as correctly spelled create a risk of infringement for others using the original term.” RESTATEMENT, Reporter’s Note to § 14, Comment a. Similarly, the Second Circuit explained that a business may not appropriate a mark if the use of other marks that include the related descriptive term would be deemed to infringe it: “A ‘descriptive’ mark is bad... because...the protection of the mark would trench upon common speech.... If a true description in English speech is an infringement, the mark is wholly bad.” *Oakland Chemical Co. v. Bookman*, 22 F.2d 930, 931 (2d Cir. 1927).

We find that registration of applicant's mark SOF would go against the policies expressed above. We must consider the degree of descriptiveness of a designation in relation to the specific goods on which it will be used. *Remington Products, Inc. v. N. Am Philips Corp.*, 892 F.2d 1576, 1580, 13 USPQ2d 1444, 1448 (Fed. Cir. 1990). In the context of exercise weights, potential consumers are likely to perceive SOF as a "misspelling or corruption" of the word "soft," because "soft weights" and "soft dumbbells" are known commodities in the marketplace. In appearance and sound, SOF is not highly distinct from the word "soft." Visually, SOF differs from "soft" only by the lack of the final letter T. It may be true that SOF is not an exact phonetic equivalent of "soft," but it is a close approximation, and in actual speech the final T of the word "soft" may sometimes be elided. That SOF may be perceived as a variant of "soft" is strongly suggested by the trademark registrations of record relating to marks that include the designation SOF for goods that are soft or cushioned: SOF TEE (for a soft vinyl golf tee) and SOF-STX (for padded martial arts training weapons);² SOF · CARE (for an inflated cushion); SOF SPORT and SOF SOLE (for impact-absorbing insoles); SOF GEL (for gel-filled shoe inserts).³ These registrations are not evidence that the marks are in use; but they do show the proclivity of those who applied for them to associate the designation SOF with things that are soft or cushioned. Overall, we find that in the context of applicant's goods, SOF is highly likely to be perceived as a misspelling or variation of "soft."

² Submitted with applicant's response of October 26, 2011.

³ Submitted with examining attorney's Office action of November 7, 2011.

Considering the visual and phonetic similarities between applicant's mark and the descriptive word "soft," we find that if the mark were registered there would be "a risk of infringement for others using the original term." That is, applicant could colorably allege that trademarks consisting of or including the designation SOFT infringe upon applicant's trademark rights.⁴ In other words, the difference between SOF and "soft" is not "sufficient to avoid encumbering use of the original word." Restatement, § 14, Comment a. This is the undesired outcome against which the cases discussed above warn, and against which Section 2(e)(1) of the Trademark Act protects. Accordingly, we find that applicant's mark is merely descriptive within the meaning of Section 2(e)(1), 15 U.S.C. §1052(e)(1).

Decision: The refusal to register is affirmed.

⁴ We do not suggest that applicant has engaged in such conduct, or plans to. Our purpose is merely to point out the untoward effects that could ensue if the requested registration were to issue.