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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85366699
Applicant	The Sherwin-Williams Company
Applied for Mark	METAL DIRECT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

APPLICANT:	THE SHERWIN-WILLIAMS COMPANY
FILING DATE:	July 8, 2011
SERIAL NO.:	85/366,699
FOR THE MARK:	METAL DIRECT
INTERNATIONAL CLASS(ES):	002
EXAMINING ATTORNEY:	Hannah M. Fisher
LAW OFFICE:	111
ATTORNEY DOCKET NO.:	16082A

APPLICANT'S BRIEF ON APPEAL

TABLE OF CONTENTS

TABLE OF AUTHORITIES

CASES:

OTHER AUTHORITIES:

I. STATEMENT OF FACTS

The application that is the subject of this appeal was filed on July 8, 2011 and was assigned Serial No. 85/366,699 by the U.S. Patent and Trademark Office.

In the first Office Action sent via electronic mail on September 28, 2011, the Examining Attorney refused registration of the subject mark under Section 2(e)(1) alleging that the subject mark merely describes a feature of Applicant's goods.

Applicant entered a response to the first Office Action on March 28, 2012 arguing against the rejection under Section 2(e).

The Examining Attorney issued a final refusal Office Action on April 22, 2012 repeating the rejections under Section 2(e)(1) that the mark is merely descriptive of a feature of the goods.

On October 19, 2012, Applicant filed a Notice of Appeal.

II. ISSUE ON APPEAL

ISSUE: **IS THE MARK "METAL DIRECT" MERELY DESCRIPTIVE AS APPLIED TO PAINT?**

CONCLUSION: **NO, THE MARK "METAL DIRECT" IS NOT MERELY DESCRIPTIVE OF PAINT.**

III. REMARKS

In the Final Refusal Action of April 22, 2012, the Examining Attorney refused registration under Trademark Act Section 2(e)(1), arguing that Applicant's proposed mark "METAL DIRECT" "merely describes a significant characteristic of the goods." For the reasons detailed below, the term "METAL DIRECT" when used in connection with "paint" does not immediately describe, without conjecture or speculation, a significant characteristic or feature of Applicant's goods. Rather, the mark "METAL DIRECT" is at most only suggestive of the goods of this application. Therefore, Applicant believes that the subject mark should be passed to publication.

A term is considered to be merely descriptive of goods 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 or services. *See* In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-218 (CCPA 1978). 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. *See* In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

If, however, such goods or services are encountered under a mark and a multi-stage reasoning process, or resort to imagination, cogitation or perception, is required in order to determine what attributes or characteristics about the product or service the mark indicates, the mark is suggestive rather than merely descriptive. *See* In re Abcor Development Corp., 588 F.2d at 218 and In re Atavio, 25 USPQ 2d 1361, 1362 (TTAB 1992). As has often been noted, there is often a thin line of

demarcation between a suggestive term and a merely descriptive one. *See* In re Colonial Refining & Chemical Co., 196 USPQ 46, 47 (TTAB 1977). To distinguish between descriptive and suggestive marks one must focus on "how immediate and direct the thought process from the mark to the particular product." AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 349 (9th Cir. 1979). If there is any doubt as to whether a mark is merely descriptive, it is the policy of the Board to resolve such doubt in the Applicant's favor by allowing publication of the mark for opposition. *See* In re Atavio, 25 USPQ2d at 1363; In re Morton-Norwich Products, Inc., 209 USPQ 791 (TTAB 1981); and In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972).

The TTAB has employed a three-pronged test to determine the descriptiveness of a mark. A mark is descriptive if it:

A) conveys to the consumers an immediate idea of the ingredients, qualities or characteristics of the goods;

B) has been used so frequently by others that consumers are unlikely to perceive the term when used in the manner of a trademark as indicating source or origin; or

C) deprives competitors of an apt description of their goods.

No Nonsense Fashions, Inc. v. Consolidated Foods Corp., 226 USPQ 502,507 (TTAB 1985). These three tests are also referred to as (1) the degree of imagination test, (2) the competitors' use test, and (3) the competitors' need test. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:66 N.1 (4th ed. 2003). In contrast, a mark is suggestive if consumers must pause and think to appreciate how a mark relates to the nature of the goods in question. TMEP § 1209.01(a). The burden is on the Examining Attorney to prove descriptiveness, and "any doubt on the question of mere descriptiveness is resolved in favor of publication." In re LRC Prods. Ltd., 223 USPQ 1250, 1252 (TTAB 1984).

The following analysis under the Board's three-prong test shows that the METAL DIRECT mark is suggestive and not merely descriptive of Applicant's goods.

A. Under the Degree of Imagination Test, Applicant's Mark is Suggestive

To be deemed merely descriptive, it is not sufficient that a mark merely convey some information about the goods it identifies. Both descriptive and suggestive marks do that. Descriptiveness requires that the mark immediately convey some particular and clear idea about the subject of the goods. *See e.g.,* In re Hutchinson Tech., 7 USPQ2d 1490, 1492 (Fed. Cir. 1988) ("A mark is merely descriptive of a product if it would immediately convey to one seeing or hearing it the thought of [Applicant's] product." In re Bed & Breakfast Registry, 229 USPQ 818 (Fed. Cir. 1987)); In re House Store, Ltd., 221 USPQ 92 (TTAB 1983).

In concluding that METAL DIRECT is descriptive, the Examining Attorney concluded that "the terminology merely describes a significant characteristic of the goods, that they can be applied to metal surfaces without prior coatings." In so concluding, the Examining Attorney makes two erroneous assumptions: (1) that a consumer already knows that the associated product is paint and (2) that the only logical message that a consumer may take away from the METAL DIRECT mark is that the associated products are applied directly to metal surfaces. This information, however, is not directly conveyed by the mark itself. A consumer who is interested in obtaining paints and coatings would first have to conclude that the combined terms "METAL" and "DIRECT" refer to a paint product before being able to deduce a characteristic that the mark may describe. In addition, while the Examining Attorney strains to equate the mark "METAL DIRECT" to the phrase "direct to metal," there is no evidence that the two will automatically be interpreted to mean exactly the same thing. The two words, "metal" and "direct," when combined in the order of Applicant's mark, do not have any discernible meaning and the incongruous combination of the words that make up the

overall trademark serve to suggest a characteristic of the product. As a result, some imagination is required to understand the relationship between Applicant's METAL DIRECT mark and the products on which it is used. *See* TMEP § 1209.03(d); In re Shutts, 217 USPQ 363 (TTAB 1983) (holding that SNO-RAKE was not merely descriptive for a snow removal hand tool). As the Board explained in In re Shutts, "The concept of mere descriptiveness, it seems to us, must relate to general and readily recognizable word formulations and meanings, either in a popular or technical usage context, and should not penalize coinage of hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and 'mental pause'." 217 USPQ at 364.

Moreover, the evidence proffered by the Examining Attorney does not prove that the mark describes a characteristic of the goods. While the record illustrates that "direct to metal" is a commonly used descriptive phrase for a way of applying paint, it does not show the term "metal direct" being used in the same fashion.

Because of the mental steps required to make a connection between the trademark METAL DIRECT and the associated goods, the mark is not merely descriptive, but rather a suggestive designation for the goods.

B. Under the Competitors' Use Test, Applicant's Mark is Suggestive

The Examining Attorney has the burden of proving that Applicant's mark is merely descriptive of the goods it identifies. *See* TMEP § 1209.02 (noting that an Examining Attorney must support a refusal to register on descriptiveness grounds with appropriate evidence); s*ee also e.g.*, In re Ohmite Manuf. Co., 134 USPQ 30 (TTAB 1962) (reversing refusal to register the mark "V.T." because the Examining Attorney provided "no evidence of any sort" demonstrating public recognition of "V.T." as an abridgment of "variable transformers"; In re WSI Corp., 1 USPQ 2d

1571, 1571-72 (TTAB 1986) (reversing refusal to register the mark SUPERSAT because the Examining Attorney failed to provide "some showing" of purchaser recognition that the abbreviation "SAT" referred to "satellite" rather than any other term beginning with the letters "SAT"). The TTAB considers a mark merely descriptive of the goods if the evidence in the record establishes that competitors use the mark to describe the same type of goods. *See* In re Eng'g Sys. Corp., 2 USPQ 2d 1075 (TTAB 1986). The rationale is that, if the mark has frequently been used by competitors to refer to the same goods for which the Applicant seeks registration, then consumers will likely consider the mark to merely describe the goods in questions, rather than indicate the source thereof.

The record contains no evidence that the term METAL DIRECT has been used at all by competitors or that consumers will fail to perceive the term as indicating the source of Applicant's goods. The third-party evidence provided by the Examining Attorney consists of copies of web pages gathered from the Internet which show that the term "direct to metal" is commonly used in connection with coatings products. The Examining Attorney then concludes that "Applicant's "metal direct" is not significantly different in sound, appearance, or meaning from "direct to metal". Instead, applicant's wording merely is an abbreviated version of the common phrase." First, the tests for determining descriptiveness of a trademark do not involve comparing the mark in terms of sound and appearance to common phrases. With respect to the meaning of the mark, the evidence of record does not show that the mark METAL DIRECT is understood by consumers to mean the same thing as "direct to metal." In addition, the evidence does not show that competitors are using what the Examining Attorney calls the "abbreviated version." If Applicant's mark was an abbreviated version that was understood to have the same meaning as the phrase "direct to metal," then evidence should be available to show that the terms are interchangeable. Evidence showing that a different phrase is

commonly used to describe products is not sufficient to meet the Examining Attorney's burden of proving that the METAL DIRECT mark is merely descriptive.

The fact that competitors are not using the term "metal direct" to describe similar products strongly supports a finding that the mark is not descriptive. *See* In re Dollar-A-Day Rent-A-Car Sys., Inc. 173 USPQ 435 (TTAB 1972) (absence of evidence of descriptive use by others constitutes a strong argument in favor of non-descriptiveness).

C. Under the Competitors' Need Test, Applicant's Mark is Suggestive

The Examining Attorney has not shown that competitors need to use the mark METAL DIRECT to describe any type of paint products or that the registration of the term METAL DIRECT would not deprive competitors of an apt description for paint products. In Sperry Rand Corp. v. Sunbeam Corp., 170 USPQ 37 (CCPA 1971), the court found that the term LEKTRONIC for electric shavers was not needed by competitors, who were free to use the term "electronic" without interference from the owner of the LEKTRONIC mark. As applied in this case, there is no indication that anyone would need to use the term METAL DIRECT to describe goods of a similar nature. Applicant's registration would carry with it a presumption of exclusive right, not to any use of the words, but to use of the combined words in a trademark sense, i.e., as an indication of origin. *See* Pacific Industries, Inc. v. Minnesota Mining and Manufacturing Co., 165 USPQ 631 (CCPA 1970) at 632.

IV. CONCLUSION

In light of the foregoing, Applicant's mark METAL DIRECT is not merely descriptive of paint. The incongruous meaning of the term METAL DIRECT requires the purchasing public to use some degree of imagination to discern the exact nature of the associated products. In addition, the public does not use and does not need to use the term METAL DIRECT to describe similar goods.

As a result, the mark METAL DIRECT is not descriptive, and is, at least, suggestive of Applicant's goods. Since the Trademark Examining Attorney has indicated that a search of the Office records indicated that there is no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), Applicant respectfully submits that the Trademark Examining Attorney's refusal to register METAL DIRECT should be withdrawn and this mark be published for opposition.

Respectfully submitted,

THE SHERWIN-WILLIAMS COMPANY

Dated: December 20, 2012

By: 

Eryn Ace Fuhrer

Attorney for Applicant