This Opinion is Not a Precedent of the TTAB

Mailed: January 5, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Palms Free Inc.

Serial No. 86229868

John F. Vodopia of John F. Vodopia, PC,
for Palms Free Inc.

Christopher Law, Trademark Examining Attorney, Law Office 105,
Susan Hayash, Managing Attorney.

Before Bergsman, Wolfson and Kuczma,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Palms Free Inc. ("Applicant") seeks registration on the Principal Register of the mark PALMS FREE (in standard characters) for "universal phone holders and harnesses," in International Class 9.[1]

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(e)(1) of the Trademark Act of 1946, 15 U.S.C. § 1052(e)(1), on the ground that Applicant's mark is merely descriptive: that is, the term "Palms

[1] Application Serial No. 86229868 was filed on March 24, 2014, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

Free" when used in connection with universal phone holders and harnesses directly conveys to consumers that Applicant's product has a hands-free feature that permits users to use their hands for purposes other than holding the phone.[2]

After the Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

A term is 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 Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). *See also, In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a mark or a component of a mark is merely descriptive is determined in relation to the goods or services 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 Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). A term need not immediately convey an idea of each and every specific feature of the goods or services in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of them. *See In re Gyulay*, 3 USPQ2d at 1010; *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). This requires consideration of the context in which the mark is used or intended to be used in connection with those goods or services, and the possible significance that

[2] 6 TTABVUE 5.

the mark would have to the average purchaser of the goods or services in the marketplace. *See In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re Abcor Dev. Corp.*, 200 USPQ at 218; *In re Venture Lending Assocs.*, 226 USPQ 285 (TTAB 1985). The question is not whether someone presented only with the mark could guess the products or activities listed in the description of goods or services. Rather, the question is whether someone who knows what the products or services are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002). *See also In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on the question of whether the combination of terms evokes a nondescriptive commercial impression. If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (quoting *Estate of P.D. Beckwith, Inc. v. Commissioner*, 252 U.S. 538, 543 (1920)). *See also In re Tower Tech, Inc.*, 64 USPQ2d at 1318 (SMARTTOWER merely descriptive of commercial and industrial cooling towers);

In re Sun Microsystems Inc., 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer programs for use in developing and deploying application programs); *In re Putman Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE merely descriptive of news and information services in the food processing industry). However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a non-descriptive meaning, or if the composite has an incongruous meaning as applied to the goods or services. *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE for "bakery products"); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE for "a snow removal hand tool having a handle with a snow-removing head at one end, the head being of solid uninterrupted construction without prongs"). Thus, we must consider the issue of descriptiveness by looking at the mark in its entirety.

"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." *In re Tennis in the Round, Inc.*, 199 USPQ 496, 498 (TTAB 1978). *See also, In re Shutts*, 217 USPQ at 364-65; *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980). In this regard, "incongruity is one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive from the descriptive mark." *In re Shutts*, 217 USPQ at 365. *See also In re Tennis in the Round, Inc.*, 199 USPQ at 498 (the association of applicant's mark TENNIS IN THE ROUND with the

phrase "theater-in-the-round" creates an incongruity because applicant's services do not involve a tennis court in the middle of an auditorium).

The word "Palm" is defined, *inter alia*, as "[t]he inner surface of the hand that extends from the wrist to the base of the fingers."[3]

The word "Free" is defined, *inter alia*, as "not subject to external restraint" and "not bound, fastened, or attached."[4]

When used in connection with a universal phone holder or harness, the term PALMS FREE means an unencumbered hand. There is no incongruity to that term. With respect to Applicant's intended use of the mark PALMS FREE, Applicant explains that its "applied-for mark PALMS FREE will be used with a universal phone holder and/or harness that frees the user's palms and permits them to be used for other purposes while using a phone."[5] Thus, when used in connection with a universal phone holder and/or harness, the mark PALMS FREE describes a feature of Applicant's products (*i.e.,* that using a phone will be a hands-free event).

Applicant argues to the contrary that consumers will have to use their imagination and reasoning to associate PALMS FREE with a phone holder or harness.[6]

> Users in the marketplace confronted with the mark PALMS FREE may reason that the trademark describes a device associated with a phone, or a phone that has hands

[3] Yahoo! Education website (yahoo.com) attached to the June 30, 2014 Office Action. *See also* the definitions attached to the December 12, 2014 Office Action.

[4] *Id.*

[5] 4 TTABVUE 5.

[6] 4 TTABVUE 6.

> free capability (such as for use in an automobile), but no true device will come definitively to mind so the mark cannot be said to "describe" the subject goods.
>
> Applicant respectfully asserts, therefore, that while the aggregate mark or phrase "palms free" may suggest any type of a device or apparatus that might be operated without reliance upon a user's hands, no particular device is described so the mark is not merely descriptive but suggestive and, therefore statutory under section 2(e).
>
> Put another way, Applicant agrees that a consumer could guess that a PALMS FREE device could be a phone harness or holder that allows a user to "hold" a phone without relying on the use of the user's hand to do so, but cannot agree that doing so suggests that the mark is descriptive. "Whether consumers could guess what the product is from consideration of the mark alone is not the test."[7]

Applicant is correct that the test is not whether consumers could guess what the product is after seeing the mark. However, as noted above, the issue is whether someone who knows what the products are will understand the mark to convey information about them. In this case, the products are universal phone holders and harnesses and the mark PALMS FREE describes a feature or purpose of the products by directly conveying to consumers that their hands will be unencumbered. The fact that Applicant may be the first to use this term doesn't make it distinctive. *See Sheetz of Del., Inc. v. Doctor's Assocs. Inc.*, 108 USPQ2d 1341, 1362 (TTAB 2013) ("Even if applicant was the first and/or sole user of a generic term or phrase, as it claims, that does not entitle applicant to register such a term or phrase as a mark.") (internal citations omitted).

[7] 5 TTABVUE 6-7.

Decision: The refusal to register Applicant's mark PALMS FREE is affirmed.