

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

In re One Nation Enterprises

Serial No. 86260948
filed April 23, 2014

Derek A. Simpson, Law Offices of Derek A. Simpson, for Applicant.

Simon Teng, Trademark Examining Attorney, Law Office 105, Susan Hayash, Managing Attorney.

Before Mermelstein, Kuczma, and Greenbaum, Administrative Trademark Judges.

Opinion by Mermelstein, Administrative Trademark Judge:

Alleging use of its mark in commerce under Section 1(a) of the Trademark Act, 15

U.S.C. § 1051(a), One Nation Enterprises applied to register



for use on

Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Athletic uniforms; Combative sports uniforms; Compression garments for athletic or other non-medical use, namely, shorts; Fight shorts for mixed martial arts or grappling; Headgear, namely, hats, caps; Martial arts uniforms; Martial arts uniforms, namely, gis; Wearable garments and clothing, namely, shirts; Women's clothing, namely, shirts, dresses, skirts,

blouses.

As stated in the application, “[t]he mark consists of the stylized cursive words ‘**JIUJITEIRO**,’” and “[t]he English translation of ‘**JIUJITEIRO**’ in the mark is a ‘practitioner of Brazilian jiu-jitsu.’” The Examining Attorney has not accepted Applicant’s offer of a disclaimer of **JIUJITEIRO** apart from the mark as shown.

The Examining Attorney issued a final refusal to register under Trademark Act § 2(e)(1), on the ground that the mark is primarily merely descriptive of the identified goods, and Applicant appealed. We reverse.

I. Issues

This application comes before us having been refused registration on the ground of descriptiveness. But we need not dwell on that issue, for Applicant has essentially admitted that **JIUJITEIRO** is descriptive with respect to the identified goods by proffering a disclaimer of that term apart from the mark as shown. *App. Br.* 14 TTABVue 7 (referring to the descriptiveness of the literal element of the mark as a “moot point”); *Resp. to Ofc. Action* (June 1, 2015) (“Applicant no longer seeks to persuade [the] Examining [A]ttorney to withdraw the 2(e)(1) objection. . . . Applicant has, therefore, amended its application to disclaim . . . **JIUJITEIRO**.”). The Examining Attorney refused to accept Applicant’s disclaimer, pointing out that Applicant may not disclaim the entire mark. *Final Ofc. Action* (June 16, 2015).

The Examining Attorney is correct that a mark may not be disclaimed in its entirety, *Dena Corp. v. Belvedere Int’l Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991), and that usually, a mark consisting solely of descriptive words is properly refused registration under § 2(e)(1), even if the applied-for mark includes minor or

insignificant non-descriptive characteristics, such as routine stylization of descriptive wording. *Id.*, 21 USPQ2d at 1051 (“Such a mark, in effect, has no ‘unregistrable component’ because the dominant feature of the mark extends a nonregistrable meaning to the whole. The entire mark becomes nonregistrable.”). Conversely, if the stylization in which Applicant’s mark appears is distinctive,¹ the mark would be “otherwise registrable,” and may be registered on the Principal Register with a disclaimer of its literal element:

[T]he issue before us is whether the stylization of the lettering in which **SADORU** appears^[2] creates a separate and inherently distinctive commercial impression apart from the word itself, such that the mark as a whole is not merely descriptive. Although an entire mark cannot be disclaimed and also registered, nevertheless where the literal components of a mark are combined in a distinctive design or display it is possible to disclaim those literal components and still have a mark which is registrable as a whole. *In re Jackson Hole Ski Corp.*, 190 USPQ 175, 176 (TTAB 1976).

In re Sadoru Grp. Ltd., 105 USPQ2d 1484 1485–86 (TTAB 2012).

II. Distinctiveness of Applicant’s Mark

The determination of whether a particular stylization is inherently distinctive is necessarily somewhat subjective, and depends on the particular nature of the mark at issue. While prior decisions regarding different marks are not determinative, both Applicant and the Examining Attorney have cited several cases, and we find they

¹ While it is possible for a non-distinctive stylization to acquire distinctiveness, *see* Trade-mark Act § 2(f), Applicant makes no such claim in this case.

² In *Sadoru Grp.*, the applicant sought to register the word SADORU (Japanese for saddle) in the following stylization:

The logo consists of the word "SADORU" in a bold, black, sans-serif font. The letters are thick and blocky, with a slightly irregular, hand-drawn appearance. The 'S' and 'D' are particularly prominent due to their size and weight.

Serial No. 86260948

provide some useful perspective.

In support of its appeal, Applicant cites *In re Jackson Hole Ski Corp.*, and *In re Clutter Control Inc.*, 231 USPQ 588 (TTAB 1986). In *Jackson Hole*, the mark **JACKSON HOLE** in the following stylization:



for providing skiing resort facilities, was found registrable on the Principal Register with a disclaimer of **JACKSON HOLE**. The Board agreed with the applicant that the juxtaposition of the words with their enlarged initial letters JH arranged in the manner of a monogram were “sufficiently distinctive to create a commercial impression separate and apart from the disclaimed words ‘**JACKSON HOLE.**’” *Jackson Hole*, 190 USPQ at 176. The Board reversed the refusal, allowing the mark to be registered with a disclaimer of the literal elements.

In *Clutter Control*, the Board considered the registrability of the mark **CONSTRUCT-A CLOSET**, in the following stylization:



for components used to construct personal storage systems. Although the Board held the wording descriptive, the mark was found registrable with a disclaimer of **CONSTRUCT-A-CLOSET**, because “the tube-like rendition of the letter ‘C’ in the words ‘construct’ and ‘closet’ ma[d]e a striking commercial impression, separate and apart from the word portion of applicant’s mark.” *Clutter Control*, 231 USPQ 589–90.

Arguing the contrary, the Examining Attorney cites *In re Sambado & Son Inc.*, 45 USPQ2d 1312 (TTAB 1997), and *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224

(TTAB 1987). *E.A. Br.* 17 TTABVue 6–7. In *Sambado*, the Board refused registration on the Supplemental Register of the designation **FRUTTA FRESCA** displayed as follows:

Frutta Fresca

for fresh deciduous fruits, with **FRUTTA** disclaimed. The Board found **FRUTTA FRESCA** (“fresh fruit” in English) to be generic for the identified goods, and therefore incapable of identifying and distinguishing the applicant’s goods in commerce. “Moreover, applicant’s presentation of the term is not so unique or unusual as to create a distinctive commercial impression apart from the words.” *Sambado*, 45 USPQ2d at 1315. The applied-for designation would not have been registrable even if the entire mark had been disclaimed. *Id.*

In *Bonni Keller*, the Board considered the registrability of **LA LINGERIE** stylized as follows:

La Lingerie

on the Supplemental Register for clothing, namely undergarments and retail store services in the field of clothing, with **LINGERIE** (the English translation of the mark) disclaimed. The Board found the literal element incapable of distinguishing the goods and services, and that the stylization of the mark was not sufficient to render the generic wording registrable:

In order for a term otherwise unregistrable to be capable of distinguishing an applicant’s goods, the presentation of the term must be sufficiently distinctive so as to create a commercial impression separate and apart from the unregistrable components whereby it is possible to disclaim those unregistrable components and still have a mark which is

registrable as a whole. See *In re Carolyn's Candies, Inc.*, 206 USPQ 356 (TTAB 1980).^[3] Recognizing that the determination of whether the stylization of an otherwise unregistrable designation is sufficiently distinctive in character to “rescue” the designation as a whole is a necessarily subjective one, it is our view that the presentation of applicant’s mark simply does not possess the degree of stylization necessary to warrant allowance on the Supplemental Register. We believe that the *Carolyn Candies, Jackson Hole* and *In re Wella Corp.*, 565 F.2d 143, 196 USPQ 7 (CCPA 1977),^[4] cases . . . relied on by applicant, all involved styles of display of words more fanciful, eye catching and imaginative than that involved herein. We find the presentation of applicant’s **LA LINGERIE** to be rather ordinary and nondistinctive in appearance and closer in style to the display of the **BODY SOAP** designation in the case of *In re Cosmetic Factory, Inc.*, 220 USPQ 1103 (TTAB 1983).^[5]

Bonni Keller, 6 USPQ2d at 1227 (citations revised).

We agree with the Examining Attorney that the *Jackson Hole* and *Clutter Control*

³ In *Carolyn's Candies*, the Board found the mark **YOGURT BAR** stylized as:

YOGURT 

for candy bars, to be registrable on the Supplemental Register with a disclaimer of **YOGURT BAR**.

⁴ In *Wella*, the Court of Customs and Patent Appeals found the mark **BALSAM**, displayed as follows:

balsam

registrable on the Supplemental Register for hair conditioner and hair shampoo, with a disclaimer of **BALSAM**.

⁵ In *Cosmetic Factory*, the Board found the designation **BODY SOAP** in the following stylization:

Body Soap

for body shampoo in liquid form to be unregistrable on the Supplemental Register.

cases do not strongly support Applicant's position. In both cases, the marks were found registrable because of the particular arrangement of the words, and in *Clutter Control*, the use of letters as design elements, neither of which is the case with Applicant's mark. But by the same token, *Sambado* and *Bonni Keller*⁶ offer but weak support for the Examining Attorney's position. The marks in both cases were displayed in ordinary, easily readable typefaces. The prospective purchaser coming across either mark would see little or nothing but the generic words themselves.

By contrast, Applicant's mark

The image shows the word "Jiu-Jiteiro" written in a highly stylized, cursive script. The letters are connected and flow together, with some letters having long, sweeping tails. The overall appearance is that of a handwritten signature or a calligraphic mark rather than a standard printed font.

is not displayed in a font. Rather, it bears the appearance of an idiosyncratic handwritten cursive script. The literal element, the descriptive word **JIUJITEIRO**, is not easily discernable on first impression. While marks in many cursive scripts would surely fall closer to the marks in *Sambado* and *Bonni Keller* in distinctiveness (or the lack of it), the fact that many cursive scripts are easily readable and indistinctive does not mean that all must be so. We think that in this case the stylization of Applicant's mark is sufficient to create a distinctive commercial impression apart from the literal element of the mark, and sufficient to justify registration notwithstanding the

⁶ Applicant maintains that *Sambado* and *Bonni Keller* are inapposite because the question in both was whether the marks were registrable on the Supplemental Register notwithstanding their generic wording. We agree that the situation in this case not identical, although it is analogous.

descriptiveness of the disclaimed term. The stylization of Applicant's mark is in essence a recognizable and distinctive design in its own right, regardless of the literal meaning conveyed by the word so displayed.

III. Conclusion

We agree with the Examining Attorney "that whether a mark's stylization reaches the minimum threshold of creating a distinctive element is dependent on the individual mark." *E.A. Br. 17 TTABVue 7* (citing *Sadoru Grp.*, 105 USPQ2d at 1489). Having carefully considered all the evidence and argument of record, it is our opinion that in this case, Applicant has crossed that threshold. We find Applicant's mark registrable with a disclaimer of the literal element of the mark.⁷

Decision: Applicant's disclaimer of **JIUJITEIRO** will be entered and the refusal to register on the ground of mere descriptiveness is reversed.

⁷ Because we reverse, we need not consider Applicant's request for amendment to the Supplemental Register. *App. Br. 14 TTABVue 14* (requesting leave to amend if the refusal to register is affirmed). But had we affirmed, such leave would have been denied. Trademark Rule § 2.142(g) ("An application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer . . . or upon order of the Director, but a petition to the Director to reopen an application will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated."). Had Applicant wished to argue registrability on the Supplemental Register in the alternative, it should have raised that issue prior to appeal, or upon remand for good cause requested prior to final decision.