

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: February 2, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Star-Brite Distributing, Inc.

Serial No. 86344788

John Christopher of Christopher & Weisberg, P.A. for Star-Brite Distributing, Inc.

Vivian Micznik First, Trademark Examining Attorney, Law Office 114 (K. Margaret Le, Managing Attorney).

Before Quinn, Kuczma and Adlin, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Star-Brite Distributing, Inc. (“Applicant”) seeks a Principal Register registration for the proposed mark CARBON ELIMINATOR, in standard characters and with CARBON disclaimed, for a “non-chemical enzyme fuel additive.”¹ The Examining Attorney refused registration on the ground that Applicant’s proposed mark is merely descriptive of the identified goods under Section 2(e)(1) of the Act.

¹ Application Serial Nos. 86344788, filed July 22, 2104 based on an intent to use the proposed mark in commerce under Section 1(b) of the Trademark Act, and later amended to allege first use dates of January 19, 2015.

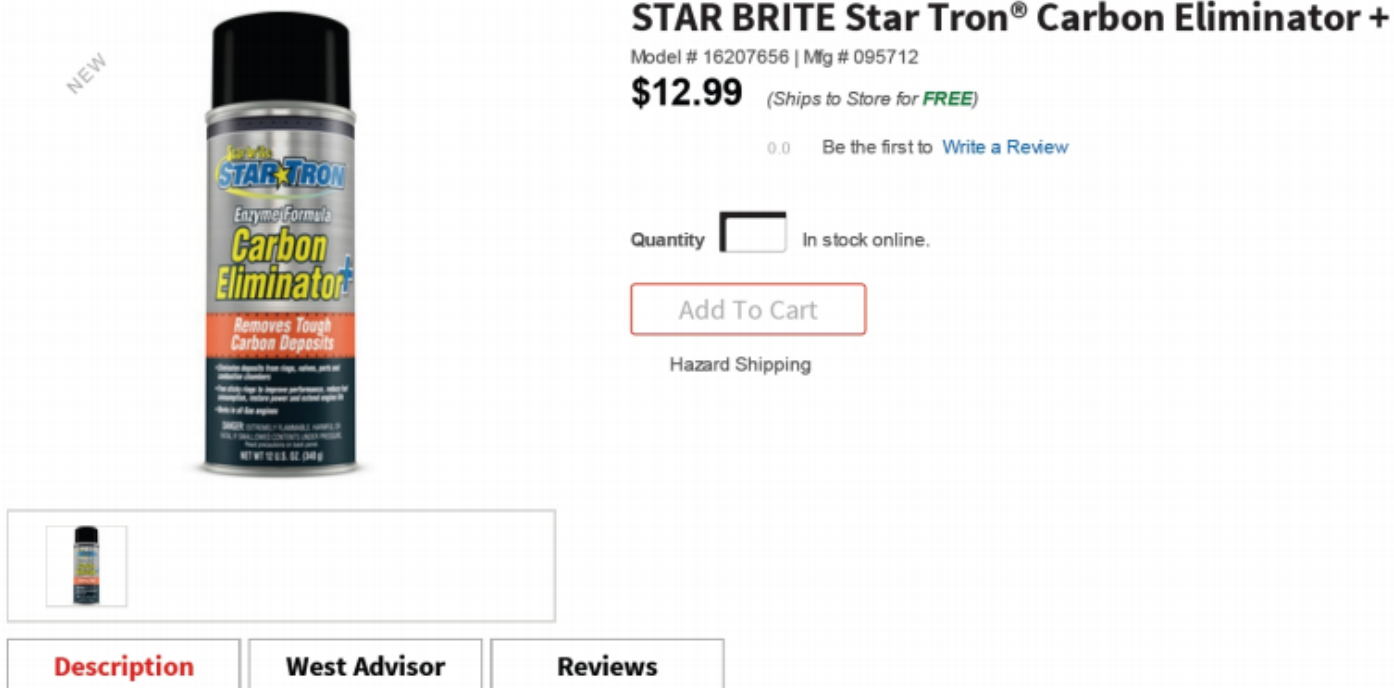
After the refusal became final, Applicant appealed and Applicant and the Examining Attorney filed briefs.

A mark is deemed to be merely descriptive, within the meaning of Section 2(e)(1), if it immediately conveys knowledge of a quality, feature, function, characteristic or purpose of the goods for which it is used. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (quoting *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009)); and *In re Abcor Development*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A mark need not immediately convey an idea of each and every specific feature of the goods in order to be considered merely descriptive; rather, it is sufficient that the mark describes one significant attribute, function or property of the goods. *In re Chamber of Commerce of the United States of America*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a mark is merely descriptive is determined not in the abstract, but in relation to the goods for which registration is sought, the context in which it is being used on or in connection with the goods, and the possible significance that the mark would have to the average purchaser of the goods because of the manner of its use. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). It is settled that “[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the

mark to convey information about them.” *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002).

When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods, the combination results in a composite that is itself merely descriptive. *See e.g., In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004) (PATENTS.COM merely descriptive of computer software for managing a database of records that could include patents, and for tracking the status of the records by means of the Internet); *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332 (TTAB 2009) (BATTLECAM merely descriptive for computer game software); *In re Carlson*, 91 USPQ2d 1198 (TTAB 2009) (URBANHOUSING merely descriptive of real estate brokerage, real estate consultation and real estate listing services); *In re Tower Tech*, 64 USPQ2d at 1314 (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).

Here, the Examining Attorney relies on a dictionary definition which indicates that “eliminate” means “to remove or take out, get rid of.”² Office Action of March 26, 2015. She also relies on Applicant’s specimen of use:



Product Description

Formulated with the latest in deposit control compounds, plus a proprietary enzyme package specifically developed to remove even the toughest deposits. Formula uses enzyme technology to remove carbon, gum and varnish deposits. Carbon Eliminator provides quick DIY removal of engine deposits with its easy-to-use 12-ounce spray. For use in all gasoline and diesel engines, just spray directly into carburetor or air intake. 12oz.

Id. As shown in the specimen, the packaging for Applicant’s product states that CARBON ELIMINATOR “removes tough carbon deposits,” and the product’s description indicates that CARBON ELIMINATOR “uses enzyme technology to remove carbon, gum and varnish deposits.”

² <http://www.collinsdictionary.com/dictionary/english/eliminator>. This definition indicates that one of the word’s “derived forms” is “eliminator,” a noun.

This evidence and the record as a whole establish that CARBON ELIMINATOR is merely descriptive of the product's purpose. In fact, by disclaiming "CARBON" apart from the mark as shown, Applicant has conceded that this term is merely descriptive. *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.* 89 USPQ2d 1844, 1851 (TTAB 2008). And it is obvious that "ELIMINATOR" is also merely descriptive, because according to the product's packaging and the product description in Applicant's specimen of use, CARBON ELIMINATOR "removes," i.e. "eliminates," deposits, including "carbon deposits." It is settled that "[e]vidence of the context in which a mark is used on labels, packages, or in advertising material directed to the goods is probative of the reaction of prospective purchasers to the mark." *In re Abcor Development*, 200 USPQ at 218; *In re Promo Ink*, 78 USPQ2d 1301, 1303 (TTAB 2006); *see also In re Hunter Fan Co.*, 78 USPQ2d 1474, 1476 (TTAB 2006) ("applicant's own use of the term ERGONOMIC ... highlights the descriptive nature of this term ...").

When the terms "carbon" and "eliminator" are combined "the mark as a whole, i.e., the combination of the individual parts," does not convey "any distinctive source-identifying impression contrary to the descriptiveness of the individual parts." *In re Oppedahl & Larson*, 71 USPQ2d at 1372. To the contrary, from "the perspective of a prospective purchaser or user" of Applicant's fuel additive, "because ... the combination of the terms does not result in a composite that alters the meaning of [any] of the elements ... refusal on the ground of descriptiveness is appropriate." *In re Petroglyph Games*, 91 USPQ2d at 1341. Indeed, as Applicant's

specimen and product packaging make clear, Applicant's enzyme fuel additive eliminates carbon engine deposits.

Applicant's arguments to the contrary are unpersuasive. While Applicant asserts in its brief that "carbon" does not describe any feature or function of a "non-chemical enzyme fuel additive," Applicant's Appeal Brief at 4, this contention is belied by the specimen of use, which specifically states that the product's function is to "remove carbon ... deposits." It is not relevant that the removal of carbon deposits is accomplished through an enzyme acting "as a catalyst to bring about a specific biochemical reaction," *id.* at 5, because CARBON ELIMINATOR is descriptive of the purpose and result of that biochemical reaction. Indeed, it is settled that where marks describe the intended purpose of the goods in connection with which they are used, they are merely descriptive. *In re W.A. Sheaffer Pen Co.*, 158 F.2d 390, 72 USPQ 129, 130 (CCPA 1946) (finding FINELINE merely descriptive of pencils, because "appellant's pencil, and the lead therein, when used for its intended purpose, does produce and include a line which by relative standards of comparison is properly described or characterized as 'fine'" and the "mark, if registered, might hamper others in the free use of the words 'fine' and 'line'"); *In re Wells Fargo & Co.*, 231 USPQ 95 (TTAB 1986) (finding EXPRESSSERVICE merely descriptive of banking and trust services); *In re MBAssociates*, 180 USPQ at 339 (finding STUN-GUN merely descriptive of "a weapon or gun designed to be used to stun or make a person senseless or unconscious when the need arises").

Applicant's argument that CARBON ELIMINATOR is a double entendre because consumers will or could believe it "is a product that reduces carbon dioxide engine emissions associated with hydrocarbon fuel burning engines," Applicant's Appeal Brief at 6, is unavailing. The term is "carbon eliminator," not "carbon dioxide eliminator," and in any event, as Applicant itself points out, if all meanings of the alleged "double entendre" are merely descriptive in relation to the goods, then the mark is merely descriptive. *Id.* at 5 (citing TMEP § 1213.05(c)); *In re RiseSmart, Inc.*, 104 USPQ2d 1931, 1934 (TTAB 2012).

Finally, Applicant's reliance on third-party registrations for allegedly similar terms is misplaced. "Although the United States Patent and Trademark Office strives for consistency, each application must be examined on its own merits. Neither the Trademark Examining Attorney nor the Board is bound to approve for registration an Applicant's mark based solely upon the registration of other assertedly similar marks for other goods or services having unique evidentiary records." *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014); *see also, In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("The Board must decide each case on its own merits ... Even if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court.").

While Applicant is correct that we must resolve doubt in its favor, here we have no doubt. On this record, it is clear that consumers familiar with Applicant's goods would immediately understand, upon seeing Applicant's proposed mark, that the

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fuel additive removes carbon deposits. Furthermore, Applicant's competitors who also offer products which remove deposits should, like Applicant, have the opportunity to use the term "carbon eliminator" or variations thereof to explain the purpose of their products. *See, In re Boston Beer Co. L.P.*, 47 USPQ2d 1914, 1920-21 (TTAB 1998), *aff'd*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999); *In re Abcor Development*, 200 USPQ at 217 ("The major reasons for not protecting [merely descriptive] marks are ... to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.").

Decision: The refusal to register Applicant's proposed mark under Section 2(e)(1) of the Trademark Act is affirmed.