

This Opinion is Not a  
Precedent of the TTAB

Mailed: August 23, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Pico Pro Inc.*

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Serial No. 86672373

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Matthew H. Swyers of The Trademark Company PLLC  
for Pico Pro Inc.

Seth A. Rappaport, Trademark Examining Attorney, Law Office 103,  
Dayna Browne, Managing Attorney.

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Before Mermelstein, Lykos and Gorowitz,  
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On June 24, 2015, Pico Pro Inc. (“Applicant”) filed an application to register the mark displayed below on the Principal Register for “consulting services in the field of architectural design” in International Class 42.<sup>1</sup>

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<sup>1</sup> Application Serial No. 86672373, filed under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging May 10, 2015 as the date of first use anywhere and in commerce.

The description of the mark is as follows: “The mark consists of the stylized word ‘PRO’ featured with a capital letter ‘P’ and lowercase letters ‘R’ and ‘O.’ A large shaded circle is featured to the bottom right of the letter ‘O’ representing a period.” Color is not claimed as a feature of the mark.

The Trademark Examining Attorney has refused registration of the mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the mark is merely descriptive of Applicant’s identified services.

Applicant has appealed and both Applicant and the Examining Attorney have filed briefs. For the reasons set forth below, we affirm the refusal to register.

*Whether the Mark is Merely Descriptive?*

Section 2(e)(1) of the Trademark Act precludes registration of a mark which, when used in connection with the goods or services of the applicant, is merely descriptive of them. 15 U.S.C. § 1052(e)(1).<sup>2</sup> Citing to a 1985 Trademark Trial and Appeal Board

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<sup>2</sup> “No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it .... (e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them. ...”

(“Board”) decision,<sup>3</sup> Applicant in its appeal brief maintains that the Board has adopted a three-part test to determine whether a mark is descriptive or suggestive:

- (1) The degree of imagination necessary to understand the product;
- (2) A competitor’s need to use the same terms; and
- (3) Competitors’ current use of same or similar terms.

While these various tests for determining the difference between descriptive and suggestive terms have been used by an array of Federal courts,<sup>4</sup> the correct test as set forth by our primary reviewing court, the Court of Appeals of the Federal Circuit, is articulated as follows: “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 used.” *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). The Board has repeatedly stated that “the [only] test for descriptiveness is whether a term ‘immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used,’” and this is the test we have applied here. *Anheuser-Busch Inc. v. Holt*, 92 USPQ2d 1101, 1104 n.8 (TTAB 2009) (citing *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009)).

The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract.

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<sup>3</sup> *No Nonsense Fashions, Inc. v. Consolidated Food Corp.*, 226 USPQ 502 (TTAB 1985).

<sup>4</sup> See 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 11:66-11.71 (4<sup>th</sup> ed. 2015).

*In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Bayer*, 82 USPQ2d at 1831. 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 the mark would have to the purchasers of the goods or services in the marketplace. *In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Bayer*, 82 USPQ2d at 1831; *In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987). Evidence that a term is merely descriptive to the relevant purchasing public “may be obtained from any competent source, such as dictionaries, newspapers, or surveys.” *In re Bayer*, 82 USPQ2d at 1831 (quoting *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986)).

Having said this, we now turn to a review of the evidence of record. In support of the refusal, the Examining Attorney submitted dictionary entries for the word “pro” which include the following:

**A professional, especially in sports.**

**An expert in a field of endeavor.<sup>5</sup>**

The record further shows that “pro” is an abbreviation for “professional” which may be defined as:

**Engaging in a given activity as a source of livelihood or as a career.**

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<sup>5</sup> *The American Heritage Dictionary of the English Language* at [www.ahdictionary.com](http://www.ahdictionary.com) (October 7, 2015 Office Action).

**Having or showing great skill; expert.**

**A person following a profession, especially a learned profession.<sup>6</sup>**

Based on these definitions, Applicant's mark immediately conveys to the consumer that Applicant offers professional "consulting services in the field of architectural design," and thus the mark is merely descriptive. The additional period following "pro" does not alter our determination. As a general proposition, adding punctuation marks to a descriptive term will not ordinarily change the term into a non-descriptive one. *See, e.g., In re Samuel Moore & Co.*, 195 USPQ 237, 240 (TTAB 1977) (holding SUPERHOSE! merely descriptive of hydraulic hose). We see no reason to deviate from this practice here since the period makes no difference in consumer perception of the mark.

Our determination is bolstered by the evidence showing that it is not uncommon for third parties to use the term "professional," a spelled out version of "pro," to describe the nature or quality of their architectural design services. We highlight the following:

"Moseley Architects provides comprehensive professional architectural, engineering, and interior design solutions to clients seeking responsive and reliable facility planning and design services, as well as specialized expertise. ... Our architects, engineers, interior designers, and other professionals work collaboratively within a unified multi-disciplinary studio setting."

"Aspect Architecture offers customized and professional architectural and design services to meet the needs of their clients. We promise

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<sup>6</sup> *The Free Dictionary by Farlex* at [www.thefreedictionary.com](http://www.thefreedictionary.com) (January 21, 2016 Final Office Action).

industry-leading and cost-effective service to satisfy your demands and accomplish your dreams.”

UIC provides architectural design services: “Our skilled professional teams will partner with you to design project elements that are right for the purpose and place.”

See January 21, 2016 Final Office Action (web site excerpts from Google search “professional architectural design services.”). Accordingly, Applicant’s proposed mark is merely descriptive of the identified services.

*Whether the stylization renders the mark inherently distinctive?*

Applicant argues that the stylization of its mark renders it inherently distinctive,<sup>7</sup> pointing to “two tones, a specific font, and a large ball in distinct shading in lieu of a typically sized period of this font and size.” Applicant’s Brief, p. 13; 6 TTABVUE 14. In support thereof, Applicant notes that its applied-for mark is not in standard character format but rather is a design mark, relying upon the description of the mark in the application.

It is well settled that when words which are merely descriptive, and hence unregistrable, are presented in an inherently distinctive design, the design may render the mark as a whole registrable, provided that the words are disclaimed under Section 6 of the Trademark Act, 15 U.S.C. § 1056(a). See *In re Venturi, Inc.*, 197 USPQ 714 (TTAB 1977); *In re Jackson Hole Ski Corp.*, 190 USPQ 175 (TTAB 1976). The proper inquiry is whether the stylization of the lettering creates “a separate and

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<sup>7</sup> To be clear, Applicant has not claimed in the alternative that its particular display of merely descriptive matter has acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f).

inherently distinctive commercial impression apart from the word itself, such that the mark as a whole is not merely descriptive.” *In re Sadoru Group, Ltd.*, 105 USPQ2d 1484, 1485 (TTAB 2012).

We acknowledge that the determination regarding whether stylization is sufficient to carry a mark is “in the eyes of the beholder,” *In re Jackson Hole Ski Corp.*, 190 USPQ at 176, and “a necessarily subjective one.” *In re Bonni Keller Collections, Ltd.*, 6 USPQ2d 1224, 1227 (TTAB 1987). In our view, neither the very plain presentation of the mark in block letters nor the addition of the period in the form of a “large ball” suffice to create a “separate and inherently distinctive commercial impression” apart from the word “pro.” That is to say, the appearance of the mark is “relatively ordinary.” *Id.* As summarized in *In re Sadoru Group Ltd.*, *supra*, the following marks were found to be insufficiently stylized and therefore not inherently distinctive:



*See In re Guilford Mills, Inc.*, 33 USPQ2d 1042 (TTAB 1994); *In re Project Five, Inc.*, 209 USPQ 423 (TTAB 1980). That being said, “ultimately the decision we make in

this case must be based on the particular facts and record herein.” *In re Saduro Group, Ltd.*, 105 USPQ2d at 1490 (citing *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001)).

In view of the foregoing, we do not find Applicant’s proposed mark as a whole to be inherently distinctive and therefore registrable on the Principal Register with a disclaimer of “Pro.”

**Decision:** The descriptiveness refusal under Section 2(e)(1) of the Trademark Act is affirmed.