

This Opinion is Not a
Precedent of the TTAB

Mailed: December 4, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Mats & Rugs LLC
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Serial No. 87594162
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Nicholas D. Wells of Legends Law Group PLLC,
for Mats & Rugs LLC.

Sahar Nasserghodsi, Trademark Examining Attorney, Law Office 115,
Daniel Brody, Managing Attorney.

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Before Taylor, Lykos and Adlin,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Mats & Rugs LLC (“Applicant”) seeks registration on the Principal Register of the phrase OVER THE FLOOR (in in standard characters) as a mark for “bath mats; personal exercise mats; meditation mats; gymnasium exercise mats; yoga mats; door mats; floor pads and non-skid floor mats in the nature of non-slip pads for use under rugs or carpet to prevent slippage; rugs; area rugs” in International Class 27.¹


¹ Application Serial No. 87594162 was filed on September 1, 2017, based upon Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming February 28, 2017 as both the date of first use of the mark anywhere and in commerce. Applicant claims ownership of the following registrations, both registered on the Supplemental Register: Reg. No. 5278496 for the mark

The Trademark Examining Attorney has refused registration of Applicant's applied-for mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e), on the ground that the phrase OVER THE FLOOR merely describes a characteristic, function or purpose of the identified goods.

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

I. Applicable Law

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *See In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (internal citations omitted).² *See also In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015).

OVER THE FLOOR (standard characters); and Reg. No. 5278497 for the stylized mark , both for the same goods for which Applicant presently seeks registration, both registered on August 29, 2017, and both claiming February 28, 2017 as the date of first use of the mark anywhere and in commerce.

² Applicant, citing to *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502 (TTAB 1985), additionally argues with respect to a three-part test set forth therein for determining whether a mark is suggestive rather than descriptive. App.'s Br. pp. 13-14, 4 TTABVUE 14-15. The test includes: (1) the degree of imagination necessary to understand the product; (2) a competitor's need to use the same term; and (3) the competitor's current use of the same or similar terms. We note, however, that this "test" was set out in an *inter partes* case in a discussion of whether the use of a term by third parties on their packaging detracted from the plaintiff's trademark rights. Since this decision issued in 1985, there have been numerous decisions from the Court of Appeals for the Federal Circuit, our primary reviewing court, and from the Board making clear that the 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." *See In re Fat Boys Water Sports LLC*, 118 USPQ2d

The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought. *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219. It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, rather it is sufficient if the mark describes a single ingredient, quality, characteristic, function, feature, purpose or use of the goods or services. *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (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 Aktiengesellschaft*, 488 F.2d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007), as well as “labels, packages, or in advertising material directed to the goods.” *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). It may also be obtained from websites and publications, and, in the case of a use-based application, an applicant’s own specimen of use and any explanatory text included therein. *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017); *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1565 (Fed. Cir. 2001).

1511, 1514 (TTAB 2016); *see also Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Bayer Aktiengesellschaft*, 488 F.2d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007), citing *Gyulay*, 3 USPQ2d at 1009; *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). We base our decision herein on the test for descriptiveness set forth in the post 1985 decisions and have considered Applicant’s arguments within those parameters.

Where a mark consists of multiple words, the mere combination of descriptive words does not necessarily create a nondescriptive word or phrase. *In re Phoseon Tech., Inc.*, 103 UPQ2d 1822, 1823 (TTAB 2012); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988). A mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, suggestive, or otherwise nondescriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods or services. See *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968); *In re Shutts*, 217 USPQ 363 (TTAB 1983). However, 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. *Oppedahl & Larson LLP*, 71 USPQ2d at 1371.

Finally, a mark comprising more than one element must be considered as a whole and should not be dissected; however, we may consider the significance of each element separately in the course of evaluating the mark as a whole. See *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1756-57 (Fed. Cir. 2012) (noting that “[t]he Board to be sure, can ascertain the meaning and weight of each of the components that makes up the mark.”).

II. Arguments and Evidence

Applicant contends that its applied-for mark is suggestive of its identified goods because “the ‘mental link’ between the mark OVER THE FLOOR and Applicant’s

goods as recited in the application is neither immediate nor instantaneous.” Br. p. 10.³

The Examining Attorney maintains that the phrase OVER THE FLOOR merely describes the identified goods because it immediately conveys to consumers a characteristic, purpose or function of the goods, namely, that they are used to cover or protect, and are on top of the floor. The Examining Attorney has supported this position with the following definitions:

“Over” is defined in relevant part as “above so as to cover or protect”;⁴

“Floor” is defined in relevant part as “the ground” or “the lower surface of a room, on which one may walk”;⁵

“Rug” is defined in relevant part as “a small carpet that covers part of a floor”;⁶ (emphasis added) and

“Mat” is defined in relevant part as “a small piece of carpet or other thick material which is put on the floor for protection, decoration, or comfort.” (emphasis added)⁷

We also note that the article “the” in the applied-for mark has no source-indicating significance and simply connects the other two terms in the phrase OVER THE

³ 4 TTABVUE 11. The TTABVUE and Trademark Status and Document Retrieval (“TSDR”) citations reference the docket and electronic file databases for the involved application. All citations to the TSDR database are to the downloadable .pdf version of the documents. Complete URLs may be found in the cited TSDR records.

⁴ <https://en.oxforddictionaries.com>, accessed September 26, 2017; October 3, 2017 Office Action, TSDR 5.

⁵ *Id.* at 6.

⁶ www.macmillandictionary.com accessed November 17, 2017; November 22, 2017 Office Action, TSDR 5.

⁷ www.collinsdictionary.com accessed November 17, 2017; November 22, 2017 Office Action, TSDR 6.

FLOOR. *See e.g., In re The Place, Inc.*, 76 USPQ2d 1467, 1468 (TTAB 2005) (holding THE GREATEST BAR merely descriptive for restaurant and bar services); *In re The Weather Channel, Inc.*, 229 USPQ 854, 856 (TTAB 1985) (holding THE WEATHER CHANNEL merely descriptive for weather information services and television programming relating to weather); *In re The Computer Store, Inc.*, 211 USPQ 72, 74-75 (TTAB 1981) (holding THE COMPUTER STORE merely descriptive for retail outlets featuring computers).

As identified, Applicant's goods include mats and rugs; these goods by definition cover parts of floors for various purposes such as protection, decoration and comfort. In addition, as noted by the Examining Attorney, Applicant's specimens of record include a "no-slip rug pad" the label for which states that the pad has "sturdy and sleek rug pad construction [that] prevents slips and falls" and "adds extra cushioning and comfort to your home."

It is clear that the wording "OVER THE FLOOR," as a whole, immediately describes a characteristic, purpose or function of the identified mats, floor pads and rugs, namely, that they cover, or are placed over, the floor and provide comfort, protection and/or decoration. The combination of terms is not incongruous, and no additional information is needed for the merely descriptive significance thereof to be readily apparent to prospective purchasers of rugs, mats and other floor coverings. *See, e.g., Duopross Meditech v. Inviro Medical, supra*, (SNAP SIMPLY SAFER merely descriptive for "medical devices, namely, cannulae; medical, hypodermic, aspiration and injection needles; medical, hypodermic, aspiration and injection syringes"); *In re*

King Koil Licensing Co. Inc., 79 USPQ2d 1048 (TTAB 2006) (THE BREATHABLE MATTRESS held merely descriptive of “beds, mattresses, box springs and pillows,” based on dictionary definitions of “breathable” and “mattress,” and excerpts of web pages that refer to “breathable mattresses” and “breathable bedding”); *In re Putman Publ'g Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE merely descriptive of news and information service for the food processing industry); *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) (SCREEN FAX PHONE merely descriptive of “facsimile terminals employing electrophoretic displays”).⁸

⁸ In making our finding, we have not relied upon the Examining Attorney’s assertion that Applicant’s prior Supplemental Register registrations for the identical mark for identical goods is probative evidence on the issue of descriptiveness in this case. Our position is primarily rooted in the Examining Attorney’s failure to put Applicant on notice that she intended to rely on the Supplemental Register registrations in support of her position on the issue of descriptiveness. As the Board explained in *In re Future Ads LLC*, 103 USPQ2d 1571 (TTAB 2012):

Although it is well-settled as a legal matter that a mark owner’s acceptance of registration on the Supplemental Register constitutes an admission that the mark is descriptive at the time of registration, *see, e.g., In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 340 (CCPA 1978); *In re Consolidated Foods Corp.*, 200 USPQ 477, 478 n.2 (TTAB 1978) (“Registration of the same mark on the Supplemental Register ... is an admission of descriptiveness”), it is troubling that the examining attorney never put applicant on notice that the examining attorney was treating the Supplemental Registration as evidence in support of her position, or that applicant had options to address the prima facie evidence of the Supplemental Registration (*i.e.*, to file evidence of acquired distinctiveness under Section 2(f) or submit rebuttal evidence).

Nonetheless, we recognize that Applicant filed the present application only three days after its listed prior Supplemental Register registrations registered and, as such, it is unlikely that Applicant would have been able to show acquired distinctiveness in such a limited time frame.

Applicant's arguments to the contrary do not persuade us otherwise. First, Applicant maintains that its goods do not "cover" the floor; that is, they do not hide it." Nor are they principally used to "protect" the floor. App. Br. p. 11.⁹ Rather, Applicant asserts, "the principal intent ... [is to] provide an aesthetic element to the space in which it is placed, ... [and] greater comfort for feet on a hard or cold surface." *Id.*¹⁰ That Applicant's goods are intended to be multi-functional does not detract from their protective function, or, more to the point, where they are placed in relation to flooring, even if protection is not the featured function. "A mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services." *Oppedahl & Larson*, 71 USPQ2d at 1371 (citations omitted). Nonetheless, the record supports that Applicant's mats, rugs and other goods are placed over, or on top of floors.

Applicant also asserts that its goods are not placed OVER THE FLOOR, but ON THE FLOOR, and that the phrase OVER THE FLOOR is not in common usage or needed by competitors to describe goods placed "on the floor." That the phrase OVER THE FLOOR is not in common parlance is not controlling. That Applicant may be the first and only user of a merely descriptive designation does not justify registration if the only significance conveyed by the term is merely descriptive. *See Fat Boys Water Sports* 118 USPQ2d at 1514; *In re Nat'l Shooting Sports Found., Inc.*, 219 USPQ 1018, 1020 (TTAB 1983); *see also KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*,

⁹ 4 TTABVUE 12.

¹⁰ *Id.*

543 U.S. 111, 122 (2004) (trademark law does not countenance someone obtaining “a complete monopoly on use of a descriptive term simply by grabbing it first”) (citation omitted). As the dictionary definitions make clear, the phrase OVER THE FLOOR as used in connection with Applicant’s identified goods imparts the same connotation as that conveyed by the phrase ON THE FLOOR, and thus merely describes, as explained above, the function or purpose, and placement, of the identified mats, floor pads and rugs.

Applicant also highlights numerous cases in which the applied-for mark was found to be suggestive as opposed to merely descriptive. As has been noted many times, each case must be decided on its own facts. *See In re Nett Designs* 57 USPQ2d at 1566 (“Even if some prior registrations had some characteristics similar to [applicant’s] application, the PTO’s allowance of such prior registrations does not bind the Board or this court.”); and *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987). Here, the record establishes that the phrase OVER THE FLOOR merely describes the function, manner of use or placement of Applicant’s goods.

Finally, we note Applicant’s reliance on the principle that when there is doubt on the issue of whether a mark is merely descriptive, that doubt should be resolved in favor of the applicant. In the present case, however, the record leaves us no doubt to be resolved.

III. Conclusion

After careful consideration of all of the evidence and arguments presented, including evidence and arguments not specifically discussed herein, we conclude that when applied to Applicant's goods, the phrase OVER THE FLOOR, as a whole, immediately conveys, without the need for multi-stage reasoning process, a characteristic, function, or purpose of the identified goods, namely that Applicant's "bath mats; personal exercise mats; meditation mats; gymnasium exercise mats; yoga mats; door mats; floor pads and non-skid floor mats in the nature of non-slip pads for use under rugs or carpet to prevent slippage; rugs; [and] area rugs" are used on top of and for the purpose of covering and/or protecting and/or decorating the floor.

Decision: The refusal to register the phrase OVER THE FLOOR as merely descriptive under Section 2(e)(1) is affirmed.