

This Opinion Is Not a
Precedent of the TTAB

Mailed: December 15, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Petglobe USA Inc.

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Application Serial No. 88640998

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Michael J. Sullivan of the Law Office of Michael J. Sullivan
for Petglobe USA Inc.

Allison Holtz, Trademark Examining Attorney, Law Office 111,
Chris Doninger, Managing Attorney.

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Before Thurmon, Deputy Chief Administrative Trademark Judge,
Bergsman and Heasley, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Petglobe USA Inc. (Applicant) seeks registration on the Principal Register of the mark SPIDER WOOD, in standard character form, for “Decorative ornaments in the nature of natural sculptures of wood for use in terrariums, animal habitats, bird cages, floral arrangements, and interiorscape installations,” in International Class 20.¹

¹ Serial No. 88640998 filed October 3, 2019, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming 2008 as its dates of first use of the mark anywhere and in commerce.

The Examining Attorney refused to register Applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that SPIDER WOOD for is merely descriptive for the identified goods. According to the Examining Attorney, SPIDER WOOD is a type of tangled, decorative wood.² The Examining Attorney submits the evidence listed below in support of the descriptiveness refusal:³

- Bantam.Earth website (bantam.earth/spider-wood/) appears to be a blog providing information about vivariums.⁴ Bantam.Earth provides the information reproduced below:

SPIDER WOOD (AZALEA ROOTS)

Spider Wood has been a relatively new type of driftwood used in aquascaping recently. With the amount of character this wood exhibits along with its colorful nature, one glance at it in a vivarium and you'd know why. The two most common questions we get asked about this driftwood is: What is it exactly and is it right for my setup? This article will provide those answers and much more as we go in-depth about the hardscaping wood.

What is Spider Wood?

Spider Wood is a type of driftwood that is becoming very popular in the aquarium niche. The wood is acquired from

² Examining Attorney's Brief (8 TTABVUE 6).

³ Citations to the examination record refer to the USPTO Trademark Status and Document Retrieval system (TSDR) by page number in the downloadable .pdf format.

⁴ A vivarium is "a place, such as a laboratory, where live animals or plants are kept under conditions simulating their natural environment, as for research." Dictionary.com based on the RANDOM HOUSE UNABRIDGED DICTIONARY (2020) (accessed December 12, 2020). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

the root section of various species within the genus *Rhododendron*. These perennial plants are a type of shrub that grows shallow roots through and sometimes above the soil. This shrub root garnishes its nickname “Spider Wood” from the unusual formation of its branches often resembling a dead spider.

Spider Wood is considered a softwood due to the fact that it remains evergreen during its lifetime. ...⁵

- Flip Aquatics (flipaquatics.com) advertises the sale of Spider Wood.⁶

Spider Wood

PRODUCT DESCRIPTION

Spider wood is a very unique type of wood used in the aquarium hobby. The wood has lots of extensions giving it a tree like appearance. Spider wood is often a popular choice when aquascaping due to the amount of plants that can be attached to the branches.

Spider wood is different than most driftwood in the fact that it has been dried out to be lightweight for shipping purposes.

- Buce Plant website (buceplant.com) advertises the sale of SPIDERWOOD.⁷

SPIDERWOOD

The wildest wood of your aquascaping dreams. Spiderwood is ... our favorite type of driftwood here at Buce Plant HQ. It's so easy to use, any way you arrange it can turn into a natural masterpiece. The tangles and twists of every piece are enough to make any aquascaper's wet dreams a reality.

⁵ January 14, 2020 Office Action (TSDR 5-6).

⁶ *Id.* at TSDR 14.

⁷ *Id.* at TSDR 17.

- Amazon.com advertises the sale of Aquarium Spider Wood (8-12 inches) by Aquarium Plants Discounts.⁸ “Customers who viewed this item also viewed ...”⁹



- Petco.com advertises the sale of Imagitarium Spider Wood, Medium by Imagitarium.¹⁰ “Customers Also Viewed” Galapagos Spider Wood.¹¹

Description

The Imagitarium Spider Wood allows you to branch out and achieve a more natural setting for your aquatic pals. This organic wood harbors the growth of health bacteria so your fish can just keep swimming in a nourishing environment.¹²

- ZOO MED website (zoomed.com) advertises the sale of Spider Wood.¹³

Spider Wood



⁸ June 16, 2020 Office Action (TSDR 7).

⁹ *Id.* at TSDR 8.

¹⁰ *Id.* at TSDR 15.

¹¹ *Id.* at TSDR 15-16.

¹² *Id.* at TSDR 16.

¹³ *Id.* at TSDR 18-19.

Perfect for Aquariums and Terrariums

- Spider-like limbs, great for climbing lizards and snake[s]

In the absence of acquired distinctiveness, Section 2(e)(1) of the Trademark Act precludes registration of a mark on the Principal Register that, when used in connection with an applicant's goods, is merely descriptive of them. 15 U.S.C. § 1052(e)(1). "A mark is merely descriptive if it immediately conveys information concerning a feature, quality, or characteristic of the goods or services for which registration is sought." *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1373 (Fed. Cir. 2018) (quoting *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017)).

We "must consider the mark as a whole and do so **in the context of the goods or services at issue.**" *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (emphasis added); *In re Calphalon Corp.*, 122 USPQ2d 1153, 1162 (TTAB 2017). "Whether consumers could guess what the product is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). Rather, "the question is whether someone who knows what the goods and services are will understand the mark to convey information about them." *DuoProSS*, 103 USPQ2d at 1757 (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)).

This applies to compound marks as well.

In considering a mark as a whole, the Board may weigh the individual components of the mark to determine the overall impression or the descriptiveness of the mark and its

various components. ... [I]f ... two portions individually are merely descriptive of an aspect of appellant's goods [or services], the PTO must also determine whether the mark as a whole, i.e., the combination of the individual parts, conveys any distinctive source-identifying impression contrary to the descriptiveness of the individual parts.

In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004).

The issue before us is whether the mark SPIDER WOOD as a whole is merely descriptive in relation to the identified goods. The evidence shows that SPIDER WOOD is a type of driftwood used in aquariums to create a natural setting.

Applicant contends that SPIDER WOOD is suggestive, not merely descriptive, because “the product is a tangled mass of wood roots used in animal habitats” that “does not have any other clear connection to spiders.”¹⁴

Because there is no clear and immediate reason why the product is referred to as “Spider Wood,” a consumer familiar with both the mark and the product might just as easily guess that the reason for the use of Applicant's Mark is because pet spiders prefer habitats containing this terrarium product. As there are other plausible reasons for labeling the product “Spider Wood,” there is no clear description provided by the term “Spider Wood” and instead the consumer's imagination is required to understand why Applicant's Mark is used with respect to the listed goods. As there is no clear description and imagination is required, Applicant's Mark is not merely descriptive and is instead suggestive.¹⁵

Applicant's argument that SPIDER WOOD is suggestive because there is no clear connection to spiders is incorrect. SPIDER WOOD used in connection with “natural sculptures of wood for use in terrariums, animal habitats, bird cages, floral

¹⁴ Applicant's Brief, p. 5 (6 TTABVUE 6).

¹⁵ *Id.*

arrangements, and interiorscape installations” has a meaning and commercial impression separate and distinct from its component parts similar to basswood,¹⁶ sapwood,¹⁷ or heartwood.¹⁸ In other words, SPIDER WOOD creates a single and distinct commercial impression because this is how the relevant consumers encounter SPIDER WOOD under normal marketing conditions as demonstrated by the Examining Attorney’s evidence. Applicant’s argument that “the addition of the word SPIDER’ before ‘WOOD’ makes the composite term ‘SPIDER WOOD’ a suggestive mark” ignores the evidence of record.¹⁹ Owners of terrariums, animal habitats, and birdcages in the market for “decorative ornaments in the nature of natural sculptures of wood” who encounter the term SPIDER WOOD will immediately know that it is a type of driftwood without having to resort to a multi-step reasoning process, thought, or cogitation.

Applicant contends that the numerous third-party registrations consisting of the word “Spider” or consisting of the word “Wood” demonstrate that SPIDER WOOD is suggestive. According to Applicant, “[t]he fact that the marks ... were registered without a Section 2(e)(1) refusal therefore strongly implies that such marks are suggestive and that any similar mark, such as Applicant’s Mark, would also be

¹⁶ “Basswood” is “any tree of the genus *Tilia*, especially *T. Americana*, the American linden, having drooping branches and large, tooted, ovate leaves” and “the wood of a linden.” Dictionary.com based on the RANDOM HOUSE UNABRIDGED DICTIONARY (2020) (accessed December 14, 2020).

¹⁷ “Sapwood” is “the softer part of the wood between the inner bark and the heartwood.” *Id.*

¹⁸ “Heartwood” is “the hard central wood of the trunk of an exogenous tree; duramen.” *Id.*

¹⁹ Applicant’s Brief, p. 9 (6 TTABVUE 10).

suggestive.”²⁰ The problems with Applicant’s contention are three-fold. First, because none of the third-party registrations is for SPIDER WOOD, or a variation thereof, the third-party registrations are of limited probative value. Second, because only two of the third-party registrations are for products that are remotely close to “decorative ornaments in the nature of natural sculptures of wood,” the third-party registrations are of limited probative value. Finally, “[e]ven if some prior registrations had some characteristics similar to [Applicant’s] application, the PTO’s allowance of such registrations does not bind the Board.” See *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

The record in this case contains many prior registrations of marks including the term ULTIMATE. These prior registrations do not conclusively rebut the Board's finding that ULTIMATE is descriptive in the context of this mark. As discussed above, the term ULTIMATE may tilt toward suggestiveness or descriptiveness depending on context and any other factor affecting public perception. The Board must decide each case on its own merits. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1127, 227 USPQ 417, 424 (Fed.Cir.1985).

Nett Designs, 57 USPQ2d at 1566. Without copies of the prosecution histories of the third-party registrations, we presume there was no evidence that registrants or third

²⁰ Applicant’s Brief, p. 7 (6 TTABVUE 8). Applicant submitted 33 third-party registrations incorporating the word “Spider” for a wide variety of products none of which is for “decorative ornaments in the nature of natural sculptures of wood.” May 19, 2020 Response to Office Action (TSDR 18-75). In addition, Applicant submitted 44 third-party registrations incorporating the word “Wood” for a wide variety of products none of which is for “decorative ornaments in the nature of natural sculptures of wood.” July 10, 2020 Request for Reconsideration (TSDR 87-186). However, Registration No. 1407713 for the mark CLEARWOOD is for a “decorative moulding made of wood or plastic” (TSDR 155); and Registration No. 5982132 for the mark WEDDED WOOD is for “works of art made of wood.” (TSDR 183).

parties used those marks descriptively unlike the evidence shows in this case. The bigger problem with the third-party registration evidence, however, is that, at most, it tells us registrants have used and registered the words “spider” and “wood,” which is neither surprising nor relevant.

Finally, Applicant’s owner and Chief Executive Officer submitted a declaration attesting that he believes he “developed” the mark SPIDER WOOD, and was the first to use the mark SPIDER WOOD, and that “any other industry usage of the SPIDER WOOD trademark for the same goods is an infringement of [Applicant’s] established unregistered trademark rights in this trademark.”²¹ The fact that an applicant may be the first user of a merely descriptive designation does not justify registration if the only significance conveyed by the term is merely descriptive. *See In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1514 (TTAB 2016); *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.*, 543 U.S. 111, 122, 72 USPQ2d 1833, 1838 (2004) (trademark law does not countenance someone obtaining “a complete monopoly on use of a descriptive term simply by grabbing it first”) (citation omitted).

We find that SPIDER WOOD for “decorative ornaments in the nature of natural sculptures of wood for use in terrariums, animal habitats, bird cages, floral arrangements, and interiorscape installations” is merely descriptive.

Decision: The Section 2(e)(1) refusal to register Applicant’s mark SPIDER WOOD is affirmed.

²¹ Hashemian Decl. ¶¶3-5 (July 10, 2020 Request for Reconsideration (TSDR 187)).