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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Van Patton Industries Inc.*

Serial No. 75/375,188

Basil E. Demeur of Knechtel, Demeur & Samlan for Van Patton Industries Inc.

Fred Mandir, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before *Cissel, Hohein and Hairston*, Administrative Trademark Judges.

Opinion by *Hohein*, Administrative Trademark Judge:

Van Patton Industries Inc. has filed an application to register the term "THE INHIBITOR" for "capsules containing corrosion inhibiting chemicals for use in the protection of metallic objects for general public use."¹

¹ Ser. No. 75/375,188, filed on October 17, 1997, which alleges a bona fide intention to use such term in commerce.

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that, when used in connection with applicant's goods, the term "THE INHIBITOR" is merely descriptive of them.

Applicant has appealed. Briefs have been filed, but an oral hearing was not held. We affirm the refusal to register.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible

significance that the term would have to the average purchaser of the goods or services because of the manner of its use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Consequently, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

Applicant, by way of background information about its goods, notes in its initial brief that:

Applicant's mark THE INHIBITOR is applied to capsules containing corrosion inhibiting chemicals to protect metallic objects for general public use. The capsules are designed with an industrial strength rust prevention system The capsules contain VCI ["Volatile Corrosion Inhibitor"] vapors that are actuated when the capsule is rotated to open vents within the capsule and, thereby, expose the VCI vapors to protect the objects.

In addition, the advertising literature made of record by applicant states, with respect to the goods, that:

eliminate rust and corrosion
Protect all your valuable metal equipment from rust and corrosion. Extend the life of your valuable equipment and avoid the ongoing expense of constantly replacing rusted or corroded equipment. The Inhibitor is light, easy to use, inexpensive and it works!

how does the inhibitor work?
The chemical compound used in The Inhibitor System is called VCI (Volatile Corrosion Inhibitor). The VCI slowly vaporizes into

an enclosed area, placing an invisible barrier over a wide variety of metal surfaces. These vapors not only provide a great barrier, but they are capable of penetrating into the smallest cracks or crevices, rendering moisture and oxygen incapable of starting the corrosion process. The Inhibitor's VCI has a proven track record of protecting a variety of metals such as Iron, Steel, Brass, Bronze, Copper and many others.

....

development of the inhibitor
Volatile corrosion inhibition (VCI) has previously been available only to the industrial manufacturing industry. Jeff Sorensen, inventor of The Inhibitor, has 10 years experience working with what he believes is the world's top VCI manufacturer - Cromwell Phoenix - and realized how useful this industrial grade rust prevention system would be to sportsmen, boaters, travellers [sic] and homeowners alike. He created The Inhibitor System to bring these unique capabilities ... to consumers in a form that is light, easy to use and relatively inexpensive.

Applicant's advertising literature also contains such testimonials about its goods as "That product keeps those guns from rusting and saves us a lot of work in the course of the [hunting] season"; "The Inhibitor is the best rust preventative product I've ever seen"; and "I think The Inhibitor is the best rust preventative product I've ever used or sold--that is why I invented it."

Referring, inter alia, to a number of dictionary definitions of the term "inhibitor," applicant argues that,

regardless of whether an imagination test, competitors' need test or competitors' use test is utilized to distinguish between a suggestive mark and a merely descriptive one, the term "THE INHIBITOR" is not merely descriptive of its goods.

Specifically, besides noting that the Examining Attorney relies upon dictionary definitions of the term "inhibitor," which The American Heritage Dictionary of the English Language (3rd ed. 1992) defines as meaning "[o]ne that inhibits, as a substance that retards or stops a chemical reaction," and which Hawley's Condensed Chemical Dictionary (12th ed. 1993) lists as connoting "(1) A compound (usually organic) that retards or stops an undesired chemical reaction, such as corrosion, oxidation, or polymerization. Such substances are sometimes called negative catalysts,"² applicant points out that such term "is defined several other ways as follows" in that:

(a) Hawley's Condensed Chemical Dictionary (12th ed. 1993) further lists "inhibitor" as connoting "(2) A biological

² Although the latter definition, unlike the former, was offered for the first time with the Examining Attorney's appeal brief and is therefore technically untimely under Trademark Rule 2.142(d), we have nevertheless considered such evidence inasmuch as it is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852, 860 (TTAB 1981) at n. 7. Likewise, while not previously made of record, we have considered the additional definitions offered by applicant in its reply brief.

antagonist used to retard growth of pests and insects and in medicine";

(b) Webster's Revised Unabridged Dictionary (1996) sets forth the term as signifying "[t]hat which causes inhibitory action; esp., an inhibitory nerve";

(c) WordNet (1997) identifies the term as denoting "a substance that retards or stops an activity"; and

(d) CancerWEB's On-line Medical Dictionary (1997-98) defines it as meaning "[a] molecule which represses or prevents another molecule from engaging in a reaction."

Notwithstanding, however, that some of the above definitions which it cites are plainly inapposite to its goods,³ applicant insists that, "[w]ith at least five definitions of 'Inhibitor', a consumer will not immediately perceive an ingredient, quality, or characteristic of Applicant's capsule." Instead, according to applicant:

Applicant's mark requires sufficient imagination, thought, and perception to reach a conclusion as to the nature of the goods and, therefore, Applicant's mark is not merely descriptive under the imagination test. As Applicant's mark requires imagination to associate the mark with the product, the mark is not likely to be needed by competitors to describe their products. Applicant's mark is also not used by competitors as a descriptive reference on similar products and, therefore, Applicant's

³ For example, in light of the background information and literature furnished by applicant, it is obvious that applicant's encapsulated corrosion inhibiting chemicals are not biological antagonists nor are they inhibitory nerves.

mark is neither a natural nor obvious manner to describe the goods. Thus, as applied to the three tests set forth by the ... Board, Applicant's mark THE INHIBITOR is not merely descriptive of capsules containing corrosion inhibiting chemicals for use in protection of metallic objects for general public use.

The Examining Attorney, on the other hand, contends that under the pertinent definitions of the term "inhibitor," such term clearly "encompasses applicant's goods, which are corrosion inhibitors." Accurately noting that, in particular, applicant has acknowledged in its initial brief that "[t]he literal meaning of 'Inhibitor' is a substance that retards or stops a chemical reaction," such as the formation of rust or corrosion on metal, the Examining Attorney maintains that:

The proposed mark[,] "THE INHIBITOR," is merely descriptive as applied to applicant's goods because corrosion inhibitors are a type of inhibitor. It is not necessary that a term describe all of the purposes, functions, characteristics or features of the goods to be merely descriptive. It is enough if the term describes one attribute of the goods. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). The proposed mark "THE INHIBITOR" identifies the single most important characteristic of applicant's goods, that they are in fact inhibitors.

....

In the present case, it is our view that, when used on or in connection with applicant's "capsules containing corrosion inhibiting chemicals for use in the protection of metallic objects for general public use," the term "THE INHIBITOR"

immediately describes, without conjecture or speculation, a significant purpose, function or use of such goods, namely, that they act as an inhibitor to protect metallic objects from corrosion or rust. As the relevant definitions noted above confirm, an "inhibitor," in the context of applicant's goods, is any chemical substance or compound that "retards or stops a chemical reaction," such as iron oxidation (rust), "retards or stops an activity," such as rusting, or "retards or stops an undesired chemical reaction, such as corrosion." Likewise, we judicially notice that Webster's Third New International Dictionary (1993) defines "inhibitor" in pertinent part as "one that inhibits: as **a** (1) : a substance for reducing corrosion or rust formation" Applicant's arguments to the contrary, as the Examining Attorney rightly points out, "center around the contention that consumers would not be able to guess what applicant's goods are, or guess that applicant's capsules contain corrosion inhibitors." However, as is plain from applicant's advertising literature and the testimonials contained therein for its products, consumers will indeed know that applicant's goods are corrosion inhibitors, irrespective of the fact that such chemicals are sold in capsules. Thus, to customers for its goods, there is nothing in the term "THE INHIBITOR" which would be ambiguous, incongruous or susceptible, perhaps, to another plausible meaning.

Moreover, the fact that that there is an absence of evidence on this record as to whether any of applicant's competitors utilize the terminology "inhibitor" or "the inhibitor" in reference to encapsulated or other possible forms of corrosion inhibiting chemicals for use in the protection of metallic objects does not mean that the term "THE INHIBITOR" is at best suggestive rather than merely descriptive of such goods. The fact that applicant may be the first and only user of such term in connection with its products, or so it would appear from the claims in its advertising literature, does not justify registration when, as the pertinent dictionary excerpts make clear, the term "THE INHIBITOR" merely describes goods which function as corrosion inhibitors for metallic objects. See, e.g., In re International Game Technology Inc., 1 USPQ2d 1587, 1589 (TTAB 1986); In re National Shooting Sports Foundation, Inc., 219 USPQ 1018, 1020 (TTAB 1983); and In re Pharmaceutical Innovations, Inc., 217 USPQ 365, 367 (TTAB 1983).⁴

⁴ While applicant does not raise the argument, it should in any event be pointed out that the simple addition of the article "the" to the word "inhibitor" does not create trademark significance for the term "THE INHIBITOR." See, e.g., Conde Nast Publications Inc. v. Redbook Publishing Co., 217 USPQ 356, 357 (TTAB 1983) ["THE MAGAZINE FOR YOUNG WOMEN" held unregistrable for magazines directed to young women]; In re Computer Store, Inc., 211 USPQ 72, 74-75 (TTAB 1981) ["THE COMPUTER STORE" found unregistrable for computers and computer book outlet services); and S. S. Kresge Co. v. United Factory Outlet, Inc., 209 USPQ 924, 928 (D. Mass. 1980) ["THE MART" held unregistrable for retail discount stores]. In particular, as analogously stated by the Board in finding the term "THE PILL" unregistrable for oral contraceptive pills (footnote omitted):

Accordingly, because the term "THE INHIBITOR" conveys forthwith a significant purpose, function or use of applicant's "capsules containing corrosion inhibiting chemicals for use in the protection of metallic objects for general public use," it is merely descriptive of such goods within the meaning of the statute.

Decision: The refusal under Section 2(e)(1) is affirmed.

R. F. Cissel

G. D. Hohein

The use of the article "THE" in association with a name or word such as "PILL" is a common or usual method adopted to refer to an object or person previously identified or to refer to something or someone assertedly unique; and it is frequently employed to shorten or eliminate unnecessary use of repetitious or descriptive wording. And considering that applicant's "ENOVID" product was the only one of its kind then on the market for commercial sale, the use of the designation "THE PILL" in association therewith was essentially as a term of reference and not necessarily as an indication of origin. If we were to give any weight to applicant's arguments concerning the "unique" effect created by the utilization of the article "THE" in association with the mark "PILL" ..., it would seem to follow that an automobile manufacturer could register the designation "THE AUTOMOBILE" or an appliance manufacturer the phrase "THE REFRIGERATOR". Manifestly, the utilization of the article "the" ... cannot convert a simple notation comprising ordinary words of the English language used in their ordinary sense into a registrable trademark.

In re G. D. Searle & Co., 143 USPQ 220, 222-23, *aff'd*, 360 F.2d 650, 149 USPQ 619 (CCPA 1966).

Ser. No. 75/375,188

Judges,
Board

P. T. Hairston
Administrative Trademark
Trademark Trial and Appeal