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BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Coinmach Corporation

Serial No. 75/468,157¹

Joan L. Long of Mayer, Brown, Rowe & Maw for Coinmach Corporation.

Yong Oh (Richard) Kim, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

Before Cissel, Seeherman and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On April 15, 1998, Coinmach Corporation filed an application to register the mark SUPER LAUNDRY on the Principal Register for services ultimately identified as follows:

¹ Applicant has repeatedly utilized an incorrect application serial number in its papers filed herein when referencing this application. The correct number is application Serial No. 75/468,157.

"retail distributorship featuring laundry equipment" in International Class 35; and

"construction services, namely, planning, laying out and custom construction of laundry retail stores; maintenance and repair of laundry equipment" in International Class 37.²

Citing Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), the Examining Attorney has finally refused registration for both classes of services on the ground that when applicant's mark SUPER LAUNDRY is used in connection with the services identified in the application, it is merely descriptive thereof.

When the refusal was made final, applicant appealed to this Board as to both classes. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

As a preliminary matter, we note that in its reply brief applicant argued that its mark has been in continuous use for over six years (since 1995); that prima facie evidence of acquired distinctiveness under Section 2(f) of the Trademark Act is substantially exclusive and continuous use for five years; and that "it would be ironic and

² The application is based on applicant's claimed date of first use and first use in commerce of November 22, 1995, for both classes of services.

contrary to the purpose of 2(f) to refuse registration of SUPER LAUNDRY based on a 'close call' on how distinctive the mark is, when it qualifies as a presumptively distinctive [mark] under the Act" (reply brief, unnumbered p. 5).

To clarify the record and the issue before this Board, we note that applicant has never requested registration under Section 2(f) and, in fact, applicant has not stated it has substantially exclusive use. If applicant intended the comments in its reply brief to be a request for registration under Section 2(f), it is untimely to raise such matter in the reply brief on appeal. See Trademark Rule 2.142(d). See also, TBMP §1215. The only issue before the Board is whether the phrase "SUPER LAUNDRY" is merely descriptive or inherently distinctive of the identified services.³

The test for determining whether a term or phrase is merely descriptive under Section 2(e)(1) of the Trademark Act is whether the term or phrase immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature

³ Even if applicant were able to show that its mark had acquired distinctiveness as the result of substantially exclusive and continuous use in commerce, this would have no impact on the question of whether the mark is inherently distinctive.

of the product or service on or in connection with which it is used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Associates*, 226 USPQ 285 (TTAB 1985); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). The determination of mere descriptiveness must be made, not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

Thus, the 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 as directly conveying information about them. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

The Examining Attorney argues that the word "super" refers to large size or superior quality, and the term "laundry" refers to a commercial establishment for

laundering clothes or linens; that the term "super" is laudatory, nondistinctive and unregistrable absent proof of acquired distinctiveness; that the word "laundry" is generic with respect to applicant's services, or at the very least it names the principal component or feature of both of applicant's identified services; that the phrase resulting from combining these two common English terms merely describes a significant feature of the involved services, specifically, that applicant constructs laundry retail stores, maintains and repairs laundry equipment, and provides retail distributorships featuring laundry equipment; and that the third-party registrations made of record by applicant⁴ are not persuasive of a different result.

⁴ The Examining Attorney contends that applicant made only five such registrations of record, three of which include a disclaimer of at least the word "super." Applicant contends that it cited 21 registrations in its response filed July 13, 1999, and submitted actual copies of five of those 21 registrations. In the final Office action, the Examining Attorney did not explain that a typed list is insufficient to make registrations of record, *In re Duofold, Inc.*, 184 USPQ 638 (TTAB 1974); and instead, the Examining Attorney discussed nine registrations on the merits. Therefore, the Examining Attorney waived his objection to applicant's submission of a typed list of third-party registrations. (We also note that page 7 of applicant's July 13, 1999 response, which is a full page referring to third-party registrations, was missing from the record, and presumably was missing at the time the Examining Attorney examined this application. While the Examining Attorney did not notice and/or did not request a copy of the missing page, the Board has so requested and received a copy of that page.) Thus, in addition to the five registrations for which applicant provided actual

In support of his refusal to register, the Examining Attorney submitted (i) dictionary definitions of the terms "super" and "laundry"; (ii) photocopies of several stories retrieved from the Nexis database relating to "super laundry(ies)"; and (iii) photocopies of certain pages from various websites on the Internet, again relating to "super laundry(ies)."

The definitions from The American Heritage Dictionary of the English Language (Third edition 1992) are as follows:

- (1) super (adjective) 1. Very large, great, or extreme: "yet another super Skyscraper" (Dylan Thomas). 2. Excellent; first-rate: a super party; and
- (2) laundry (noun) (plural laundries) 2.a. A commercial establishment for laundering clothes or linens.

copies, we have considered the listing of 16 registrations on pages 7-8 of applicant's response filed July 13, 1999.

Also, in applicant's request for reconsideration, filed January 5, 2001, it again presented a typed list of 15 third-party registrations, none of which include a disclaimer of the term "super" (many of which are the same as those previously discussed). This typed listing refers to Exhibits A-C, which exhibits presumably consist of actual copies of those 15 third-party registrations. These exhibits are not in the application file. The Board was unable to obtain copies thereof from applicant's attorneys, and it is unclear if the exhibits were ever actually filed with the USPTO. In any event, the actual copies of third-party registrations are not in the record and thus the exhibits themselves cannot be considered. However, the typed list of these 15 registrations provided in the body of applicant's request for reconsideration will be treated as of record because applicant presumably relied on the Examining Attorney's acceptance of a list of registrations in the prior Office action.

The following stories retrieved from the Nexis database show use of the term "super laundry(ies)" (emphasis added):

Headline: Florida Executives Plan to Revolutionize Coin Laundry Business

From garbage to videos, H. Wayne Huizenga built a multibillion-dollar empire by taking over industries once dominated by mom-and-pop operators and building them into household names. After watching the master in action, two groups of former Blockbuster Entertainment and Republic Industries executives see another opportunity to put his philosophy into action—coin laundries. They hope to pepper the country with **super laundries** called Laundromax and SpinCycle.

... The average store will be 4,500-square-feet, about twice the size of the neighborhood coin laundry with more room for everything from washers to folding stations. The big pluses are the amenities such as air conditioning, television sets, snacks and kids' games. ...

"The Miami Herald," February 5, 1998;

Sub Headline: **Super Laundries** on Way

Two former Republic Industries executives said they've raised \$7 million from private investors to start a chain of coin-laundry superstores under the Laundromax name. "The Sun-Sentinel (Fort Lauderdale, FL)," January 21, 1998; and

Headline: Obituary-Businessman Frank Okamura, 89

It is a little-known footnote to the history of Seattle, but when the Grand Union's Laundry was in its heyday, it was one of the biggest Japanese-owned businesses in the country.

... Mr. Okamura worked in the family business for more than 30 years, and had visions of building a "**super laundry**" across from the Grand Union. "The Seattle Times," October 20, 1992.

The Internet websites show the following uses of "super laundry":

"What's Up?"...Oklahoma City!
Video Rental
General Listings
...
Super Laundry & Video Rental, 3345 NW 23rd St.,..., "www.whatsupok.com" October 17, 2000; and

Speed Queen Success Story
Super Suds Laundry Solution
... At Super Suds Laundry in Denison, Texas they furnish a 1/4 cup along side every washer. ... Super Suds uses all Speed Queen MoneyMaster™ frontloading washers... The store boasts a play area for children with their own VCR and TV... **Super Laundry** is an all MoneyMaster™ Store...., "www.speedqueen.com," October 17, 2000.⁵

⁵ Applicant contends that the use of "super laundry" in the Speed Queen Internet website is either a typographical error because the remainder of the uses shown therein are "Super Suds Laundry," and/or it is an infringer of applicant's mark. There is no evidence to support applicant's theory, and we must therefore consider the text as it appears.

Finally, the Examining Attorney refers to the specimens submitted by applicant, which include the following statements:

For over 30 years, Super Laundry has offered unequalled leadership and service to thousands of satisfied coin-op owners. Our success in turning dirty laundry into tidy profits for clients has made us the largest laundry service company in the nation.

...

You can count on Super for quality and attention to detail right down the line. We sell only the best, most dependable, laundry equipment available.

...

When you choose Super, you're choosing the "Smart Laundromat System."

Computer Design...Plan To Succeed with Super Laundry's Exclusive Computer Design System. ... National Distributors of Commercial Laundry Equipment...

Applicant urges reversal of the refusal to register, arguing that it does not use the phrase in connection with a commercial laundry service, but rather in connection with distributorship, construction and repair services; that applicant's submission of third-party registrations reflects a determination that the term "super" is suggestive, not descriptive; and that there is no rational basis for distinguishing between those third-party registrations and applicant's mark. Applicant specifically

argues that the phrase "SUPER LAUNDRY" is not merely descriptive under any of the tests for mere descriptiveness - the dictionary test ("super" is suggestive as it is used as mere puffery and not to describe size or other desirable characteristics of a product or service, and applicant does not sell "laundry" services); the imagination test (the combination of the two common English words results in the creation of an uncommon term which requires imagination or thought to conclude something about the involved services); the competitor's need test (competitors would not need to use the term in describing their own goods or services); and the competitor's use test (the asserted lack of evidence that others use the term "super laundry" to describe the services involved herein).

As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See e.g., *In re Atavio Inc.*, 25 USPQ2d 1361 (TTAB 1992); and *In re TMS Corporation of the Americas*, 200 USPQ 57 (TTAB 1978). See also, *In re George Weston Limited*, 228 USPQ 57 (TTAB 1985). Thus, it is not surprising that different results have been reached in cases involving the term "super." See

Quaker State Oil Refining Corporation v. Quaker Oil Corporation, 453 F.2d 1296, 172 USPQ 361 (CCPA 1972)(SUPER BLEND held merely descriptive of motor oils); In re Consolidated Cigar Co., supra (SUPER BUY held merely descriptive of cigars, pipe tobacco, chewing tobacco and snuff); In re United States Steel Corporation, 225 USPQ 750 (TTAB 1985)(SUPEROPE held merely descriptive of wire rope); In re Carter-Wallace, Inc., 222 USPQ 729 (TTAB 1984)(SUPER GEL held merely descriptive of lathering gel for shaving); In re Samuel Moore & Company, 195 USPQ 237 (TTAB 1977)(SUPERHOSE held merely descriptive of hydraulic hose); and conversely, In re Ralston Purina Company, 191 USPQ 237 (TTAB 1976) (RALSTON SUPER SLUSH with "SLUSH" disclaimed, held suggestive of a concentrate to make a slush type soft drink); and In re Occidental Petroleum Corporation, 167 USPQ 128 (TTAB 1970) (SUPER IRON held suggestive of soil supplements).

We agree with the Examining Attorney that the phrase SUPER LAUNDRY immediately and directly conveys information about a significant feature or characteristic of both applicant's retail distributorship services and its construction (planning, layout and custom construction) and maintenance/repair services. A laundry, in the context of this case, is a physical place, and certainly "super

laundry" is merely descriptive of a large laundry facility, or one offering lots of "extras." While applicant does not sell laundry services, there is no question that all of applicant's identified services are tangential services which are closely related to the laundry facility itself. Specifically, applicant plans and constructs laundry facilities; offers retail distributorships of laundry facilities; and maintains and repairs laundry equipment. The relevant purchasing public, viewing the mark in connection with such services, would immediately recognize the mark as describing a major characteristic of the services, i.e., that "super laundries" are the object and focus of the distributorship and construction services.

Nor do we agree with applicant's argument that the combination of "super" and "laundry" creates an incongruous or creative or unique mark. Rather, applicant's mark, SUPER LAUNDRY, when used in connection with applicant's identified services, immediately describes, without conjecture or speculation, a significant feature or characteristic of applicant's services, as discussed above. Nothing requires the exercise of imagination or mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's services to readily perceive the merely descriptive

significance of the phrase SUPER LAUNDRY as it pertains to applicant's services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792 (TTAB 1996); and *In re Time Solutions, Inc.*, 33 USPQ2d 1156 (TTAB 1994).

With respect to the third-party registrations for marks including the word "super" made of record by applicant, three of these registrations include disclaimers of the wording (including the term "super") and are "carried" by the design which is part of each of those three marks. Although there are other registrations of marks with no disclaimer of the word "super," this evidence is not persuasive of a different result in this case. While uniform treatment under the Trademark Act is an administrative goal, the Board's task in an *ex parte* appeal is to determine, based on the record before us, whether applicant's mark is merely descriptive. As often noted by the Board, each case must be decided on its own merits. We are not privy to the records of the third-party registration files and, moreover, the determination of registrability of those particular marks by the Trademark Examining Attorneys cannot control the merits in the case

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now before us. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“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.”)

Decision: The refusal to register under Section 2(e)(1) of the Trademark Act is affirmed as to both classes of services.