

03/16/01

**THIS DISPOSITION
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Paper No. 10
HWR

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Great Beach Vacations, Inc.

Serial No. 75/540,442

B. Craig Killough of Barnwell Whaley Patterson & Helms LLC
for Great Beach Vacations, Inc.

Shanna Winters, Trademark Examining Attorney, Law Office
102 (Thomas Shaw, Managing Attorney).

Before Seherman, Wendel and Bottorff, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Great Beach Vacations, Inc. has filed an application
to register the mark GREAT BEACH VACATIONS and design, as
depicted below, for "real estate listing services, real
estate leasing services, real estate management services."¹

¹ Serial No. 75/540,442, filed August 21, 1998, claiming first
use dates of November 12, 1997.

Registration has been finally refused under Section 6(a) of the Trademark Act on the basis of applicant's failure to comply with the requirement that a disclaimer be entered of the entire word phrase GREAT BEACH VACATIONS apart from the mark as a whole. Applicant has submitted a disclaimer of the words BEACH VACATIONS.

Applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

The Examining Attorney maintains that the wording GREAT BEACH VACATIONS as a whole is merely descriptive of a feature or characteristic of applicant's services and thus must be disclaimed in its entirety. She points out that by applicant's disclaimer of "beach vacations" applicant does not dispute the descriptiveness of this wording. Although applicant contends that the term "great" is distinctive as used in the mark, the Examining Attorney argues that "great" is being used in a laudatory sense and is equivalent to other descriptive terms under Section 2(e)(1). In support of this position, she has made of record dictionary definitions of the word "great"; Nexis articles referring both to "great vacations" and "great beaches"; and copies of third-party registrations in which the word "great" has been disclaimed. She argues that this evidence shows that the terms "great," "beach" and

"vacation", when used together in connection with the identified services, refer to a quality and type of place or property, namely a great beach property for vacation rentals. In addition she points to applicant's own specimens wherein applicant describes its services as having mastered the "art of providing great beach vacations."

Applicant insists that the word portion of its mark, GREAT BEACH VACATIONS, is not merely descriptive of the services provided by applicant; that it is not a travel agency or a resort providing vacation services. Applicant argues that the Examining Attorney has improperly dissected its mark in order to show descriptiveness, rather than considering the phrase as a whole. Applicant notes that while there are references in the evidence of record to "great vacations" or "great beaches," there are no references to the three words together or any references to show that the three words are used to describe real estate agency services. Applicant points to third-party registrations in which no disclaimer of the term "great" was required.²

² In her brief, the Examining Attorney objects to applicant's reliance upon three third-party registrations without providing copies thereof. This objection is not well taken. Applicant first referred to these registrations in its response of September 22, 1999. The Examining Attorney failed to object to

A term or phrase is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic or feature of the goods or services with which it is being used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Whether or not a particular term or phrase is merely descriptive is determined not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the designation is being used, and the significance the designation is likely to have to the average purchaser as he or she encounters the goods or services bearing the designation, because of the manner in which it is used. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).

By its disclaimer thereof, applicant has admitted that the wording GREAT VACATIONS, as used in its mark, is merely descriptive and has acknowledged that it does not have an exclusive right to these words. See *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361 (CCPA 1972); *In re Tennessee Walking Horse Breeders' and Exhibitors' Assn.*, 223 USPQ 188 (TTAB 1984).

the manner of introduction of the third-party registrations in her next action and thus in effect waived any right to later object to the registrations on the basis of this procedural defect, which could have been cured if timely raised.

Applicant's arguments that it is not a travel agency or a resort are to no avail; applicant has admitted that the words BEACH VACATIONS are descriptive of its particular type of real estate services.

The only issue is whether the presence of the term GREAT imparts other than descriptive significance to applicant's mark as a whole. If used merely in a laudatory sense touting the allegedly superior quality of applicant's services, the term GREAT falls within the category of being descriptive as well. See *In re Boston Beer Co. L.P.*, 47 USPQ2d 1914 (TTAB 1998), *aff'd*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999); *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995). The Examining Attorney has made of record a dictionary definition for the term "great" as "superior in quality or character".³ She has also shown extensive use of the term "great" to describe "vacations," in some instances vacations at a beach, as well as to describe a "beach" or "beaches." Thus, we are without any doubt that purchasers would view the term "great" as used in GREAT BEACH VACATIONS as a laudatory term touting the superior quality of applicant's real estate services which admittedly involve beach vacations. The term would be

³ *The American Heritage Dictionary of the English Language* (3rd ed. 1992).

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viewed as part of the phrase GREAT BEACH VACATIONS, and the phrase as a whole is merely descriptive of applicant's services.

If, in fact, there were any doubt as to this reaction by purchasers, we need only look to applicant's own specimens. Evidence of the context in which an applicant is using its mark in brochures or other advertising materials is clearly probative of the reaction of prospective purchasers to the mark. See *In re Pharmaceutical Innovations, Inc.*, 217 USPQ 365 (TTAB 1983). Here applicant's specimens show descriptive use of the entire phrase "great beach vacations" in touting their real estate services, which focus on "vacation rentals" on islands near Charleston. No more evidence is needed to show that the phrase as a whole is merely descriptive of applicant's services.

While applicant has pointed to third-party registrations in which the term "great" has not been disclaimed and the Examining Attorney has noted registrations to the contrary, each case must be decided on its own merits. Here the evidence is fully sufficient to demonstrate the descriptiveness of the term GREAT, as used in applicant's mark.

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Accordingly, the refusal to register on the basis that a disclaimer of the entire phrase GREAT BEACH VACATIONS must be submitted is affirmed. Pursuant to Trademark Rule 2.142(g), this decision will be set aside and applicant's mark will be published for opposition if applicant, no later than thirty days from the mailing date hereof, submits a disclaimer of the words GREAT BEACH VACATIONS apart from the mark as a whole.

Decision: The requirement for a disclaimer is affirmed.

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