

This Opinion is Not  
Citable as Precedent  
of the TTAB

Hearing:  
July 16, 2002

Paper No. 12  
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Thomas P. Muchisky

Serial No. 75/576,467

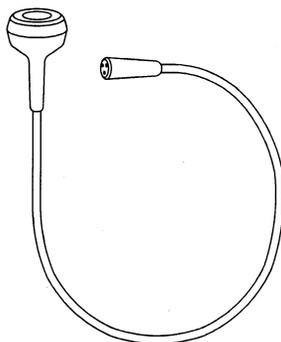
Lionel L. Lucchesi of Polster, Lieder, Woodruff & Lucchesi,  
L.C. for Thomas P. Muchisky.

Jennifer Stiver Chicoski, Trademark Examining Attorney, Law  
Office 115 (Tomas V. Vlcek, Managing Attorney).

Before Hanak, Quinn and Rogers, Administrative Trademark  
Judges.

Opinion by Rogers, Administrative Trademark Judge:

By application serial no. 75/576,467, applicant seeks  
registration of the design depicted below:



Applicant asserts that he has a bona fide intention to use the design in commerce, for goods identified in the application as "head and cable assembly for use in conjunction with professional use massage machines." The description in the application reads: "The mark consists of a pictorial representation of the head and cable assembly used in conjunction with professional massage machines."

Originally, applicant identified the goods as "professional use massage machines," and did not include a description of the mark, but did state his intention "to use the mark by applying it to the goods, to labels for the goods, to packaging for the goods, and in other ways customary in the trade." Applicant also stated, "The drawing is lined for the color black, and color is claimed as a feature of the mark."

In her initial Office action, the examining attorney did not refuse registration of applicant's design but set forth possible bases for refusal that might be advanced subsequent to applicant's filing of an amendment to allege use or statement of use, when the examining attorney would have a clearer understanding of the mark and how it would eventually be used. These potential refusals are not at issue in this appeal. Also in her initial action, the examining attorney explained that the color lining in the

drawing was for yellow or gold, not for black. Thus, she required applicant to amend either the color lining statement or the drawing, to remedy the inconsistency. Operating on the theory that applicant might actually be seeking to register the configuration of its head and cable assembly, as opposed to an illustration thereof<sup>1</sup>, the examining attorney suggested applicant submit a description of the proposed mark. Finally, she noted that the identification of goods appeared too broad, because she had concluded from her initial examination that applicant's goods likely consisted not of entire professional massage machines but, rather, of only a portion thereof, i.e., the head and cable assembly for such machines. The examining attorney therefore suggested amendment of the identification to list only the head and cable assembly. The suggestion was for applicant to adopt the proposed amended identification "if accurate."<sup>2</sup>

In his response to the initial Office action, applicant adopted the suggested description of the mark

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<sup>1</sup> As noted, during initial examination, there was no description of the mark in the application.

<sup>2</sup> We note that the Office action closed with the following: "If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney." The examining attorney's phone number followed her signature.

[but later, that was further amended to the description recited at the outset of this decision]; submitted an amended drawing which deleted the yellow/gold color lining and, according to applicant, was "lined for the color black"; and, adopted the suggested identification of goods recited at the outset of this decision.

In her second Office action, the examining attorney accepted the applicant's adoption of the suggested identification of goods, but did not discuss the amended drawing. The examining attorney nonetheless noted in the action that she had discussed the nature of the mark with applicant's counsel. Based on these discussions, she refused registration on the ground that the "proposed mark consists of a drawing of the goods ... immediately conveys the physical appearance of the goods to potential purchasers," and is therefore descriptive of the goods and unregistrable. See Section 2(e)(1) of the Lanham Act, 15 U.S.C. §1052(e)(1).

Though applicant argued against it, the examining attorney made the refusal final. Applicant appealed. Applicant and the examining attorney have filed briefs and oral argument was held. Before considering the question whether the design is descriptive, we must first clarify the essence of what it is that applicant seeks to register.

As noted earlier, the application originally included a claim that the design shown in the drawing was lined for the color black and black was claimed as a feature of the mark. The examining attorney noted the discrepancy between the lining actually utilized in the original drawing to indicate color, which was lining for yellow/gold, and applicant's claim that the color black was a feature of the mark. When applicant responded by filing a substitute drawing, which is shown at the beginning of this order, it did not include any color lining. The examining attorney did not explicitly accept or reject the substitute drawing. During the oral hearing, we asked applicant's counsel to clarify the color issue. Counsel explained that he had agreed to delete the claim to color and the application should no longer be considered as including a claim to color as a feature of the mark. The examining attorney did not dispute this contention. Accordingly, we have considered the design depicted at the beginning of this decision to constitute applicant's proposed mark, with no claim to any particular color.

The question whether a term or, in this case, a design, is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration of the proposed mark is sought, the

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context in which it is being used, or will be used, on or in connection with those goods or services, and the possible significance that the term or design would have to the average purchaser or user of the goods or services.

See In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979) and In re Recovery, 196 USPQ 830 (TTAB 1977).

A proposed mark is considered 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 Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that the term or design describe all of the properties or functions of the goods or services in order for it to be merely descriptive thereof; rather, it is sufficient if it describes a significant attribute or idea about them. In re Venture Lending Associates, 226 USPQ 285 (TTAB 1985).

We agree with the examining attorney that the proposed mark, described by applicant as "a pictorial representation of the head and cable assembly used in conjunction with professional massage machines," which applicant plans to

use "on a tag or label affixed to containers for the goods" (reply brief, p.2), would, when so used, be descriptive of the identified goods, i.e., a "head and cable assembly for use in conjunction with professional use massage machines." Applicant practically concedes the issue in his brief on appeal:

Applicant's mark would not immediately convey the characteristics of the goods even to the professional technician. Each of the fifteen interchangeable [massage] heads is intended to treat a specific disease or disability. While a *technician might recognize the head and cable assembly for a massage machine*, the technician would not know the specific disease or disability to be treated by the head assembly merely by looking at the mark. (*emphasis added*)

Clearly, if a professional massage technician considering applicant's proposed mark would recognize it as a head and cable assembly for a massage machine, the design has imparted information about the nature of the goods to an average purchaser or user of applicant's product. It is inapposite that the technician might have to cogitate or exercise imagination to consider what diseases or disabilities might be treatable by the assembly. Moreover, that some massage technicians might not grasp the nature of the goods "merely by looking at the mark" does not establish that the design is not descriptive. For the test is whether, knowing what the goods are, and considering the

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design in conjunction therewith, the design would inform a prospective purchaser or user of any significant feature, attribute, use, etc. We find that the design would immediately convey to prospective purchasers or users the physical characteristics of the head and cable assembly, specifically, the nature of the plug end, the nature of the head end, the type of cable connecting the two ends (coiled, flat, round, etc.) and convey a sense of the proportional relationship of these elements.

Applicant argues that he has obtained registrations for the designs of a number of the various massage heads that can be used with his head and cable assembly, and argues, "If these applicators themselves do not describe the treatment, it defies logic to say that the head and cable assembly does." Apart from the inapposite focus on whether the designs of these goods "describe the treatment" rather than the goods themselves, we note, as did the examining attorney, that each of the referenced registrations covers a configuration of a massage head, in use in commerce, and was registered under Section 2(f) of the Lanham Act because of a showing of acquired distinctiveness. Thus, the existence of these registrations is not probative evidence that a registration

should issue for a pictorial representation of applicant's head and cable assembly.

Applicant also argues that a pictorial representation of a product can be registered. In support of the argument, he relies on Volkswagenwerk Aktiengesellschaft v. Rickard, 175 USPQ 563 (N.D. Tex. 1972), involving a pictorial representation of the distinctive silhouette of a Volkswagen automobile, and In re General Electric Company, 209 USPQ 425 (TTAB 1980), involving a cord and plug design. These cases, however, are distinguishable from the case at hand. In *Volkswagenwerk*, the automobile depicted in the illustration was itself held to be distinctive and, therefore, the pictorial representation of the automobile was also held distinctive. Though applicant argues that the configuration of its head and cable assembly has been shown, in its co-pending application, to be distinctive, we have, in a separate but concurrently issued decision, refused registration of the configuration of applicant's head and cable assembly as functional and devoid of acquired distinctiveness. Thus, the *Volkswagenwerk* case is not analogous to the case at hand. In addition, in the *General Electric* case, the goods were rechargeable batteries, while the design was a pictorial representation of a plug and cord assembly. Thus, the design did not

depict the goods. In contrast, in the case now before us, the design does depict the goods. In addition, the design of the plug and cord assembly was found to be highly stylized, not a realistic depiction of the assembly.

Applicant argues that the proposed mark does not present an accurate portrayal of the head and cable assembly he has manufactured for more than 30 years but, rather, is a stylized or fanciful depiction of the goods. For this argument, applicant relies on In re LRC Products Limited, 223 USPQ 1250 (TTAB 1984). We do not find that case analogous. In *LRC*, one member of the Board dissented and would have found the two-hand [or two-glove] design descriptive of that applicant's gloves, while the two other members found the design somewhat fanciful<sup>3</sup>, though they were not without doubt on the issue and, accordingly, resolved their doubt in favor of applicant. *Id.* In contrast, we find the illustration of the head and cable assembly to be a very close approximation of the actual product. We have no doubt to resolve and, on a spectrum which puts a realistic depiction of a product on one end and a fanciful or highly stylized depiction on the other,

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<sup>3</sup> Contributing to their finding was the two-color nature of the mark, i.e., one hand was colored yellow and the other was not colored. Applicant no longer claims color as a feature of its design and the design thus does not include a fanciful, contrasting color aspect that was present in *LRC*.

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we find applicant's design much closer to the realistic end.

Decision: The refusal to register applicant's design on the ground that it is a descriptive illustration of his product is affirmed.