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Mailed:
February 9, 2004
Paper No. 11
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bradley J. Holmes

Serial No. 76329452

David A. Lowe of Black Lowe & Graham PLLC for Bradley J. Holmes.

Ronald McMorrow, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Simms, Bucher and Rogers, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Bradley J. Holmes seeks registration on the Principal Register for the mark INFIDELITYKIT for "forensic test kits for home use consisting primarily of diagnostic reagents for detecting the presence of semen on any material," in International Class 1.¹

This case is now before the Board on appeal from the final refusal to register on the ground that the alleged mark is merely descriptive of applicant's goods under Section 2(e)(1) of the Lanham Act, 15 U.S.C. §1052(e)(1).

¹ Application Serial No. 76329452 was filed on October 24, 2001 based upon applicant's allegations of a *bona fide* intention to use the mark in commerce.

Both applicant and the Trademark Examining Attorney have fully briefed the case. Applicant did not request an oral hearing before the Board.

We affirm the refusal to register.²

A mark is merely descriptive, and therefore unregistrable pursuant to the provisions of Section 2(e)(1) of the Trademark Act, if it immediately conveys information of significant features, functions or uses of the goods with which it is intended to be used. A mark is suggestive, and therefore registrable on the Principal Register without a showing of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

The question of whether a particular term is merely descriptive is not decided in the abstract. Rather, the proper test in determining whether a term is merely descriptive is to consider the mark in relation to the goods for which registration is sought, the context in which the mark is used or is intended to be used, and the possible significance that the mark is likely to have on the average purchaser encountering the goods in the marketplace. See *In*

² In a decision issued on December 11, 2003, the Board had earlier held the mark 5 MINUTE INFIDELITY TEST KIT to be merely descriptive of the same goods in an application based upon applicant's allegation of use in commerce.

re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

The Trademark Examining Attorney takes the position that applicant's proposed mark "immediately and unequivocally provides information about the nature of the goods - clearly indicating that the goods are a kit for detecting infidelity." (Trademark Examining Attorney's appeal brief, unnumbered page 4) In support of his position that this proposed mark is merely descriptive, the Examining Attorney placed into the record a dictionary definition of the word "infidelity" as meaning "unfaithfulness to a sexual partner, especially a spouse" or "an act of sexual unfaithfulness." He argues from the plain meaning of the word "infidelity" that "the proposed mark clearly indicates that the goods are intended to prove infidelity." (Office action of January 16, 2002, unnumbered page 2)

In response, applicant argues that his trademark is not merely descriptive, while conceding that it may well be suggestive. As noted above, a mark is suggestive if imagination, thought or perception is required to reach a conclusion on the purpose or features of the goods. See In re Gyulay, *supra*. Accordingly, applicant argues that potential consumers would have to use some imagination or thought in order to understand the purpose or features of

the goods being offered by applicant in connection with this alleged mark:

It requires a great deal of imagination, thought, or perception to discern from Applicant's INFIDELITYKIT that it is a "forensic test kit[] for home use consisting of [sic] primarily of diagnostic reagents for detecting the presence of semen on material." Nothing in the term INFIDELITY takes the public immediately to the notion of semen detection for the purpose of finding infidelity.

(Applicant's reply brief, p. 4).

As to whether the alleged mark herein immediately conveys information about the purpose for the goods, applicant focuses primarily on the word "infidelity." Applicant then argues that the dictionary definition relied on by the Trademark Examining Attorney does not support the Trademark Examining Attorney's position. Based upon that definition, applicant argues that the word "infidelity" in applicant's mark may well conjure up images of sexual unfaithfulness, but that the term "does not in any clear or precise way ... *immediately* describe forensic semen detection," and hence is not merely descriptive.

In support of his position that this phrase is suggestive, applicant argues that the fact that there is no dictionary entry for the phrase "infidelity kit" should weigh in applicant's favor. *In re Sundown Tech. Inc.*, 1 USPQ2d 1927, 1928 (TTAB 1986) [GOVERNOR is nebulous as

applied to amplifier controls, and the dictionary definition does not list GOVERNOR as a term of art in the electronics field]; In re Men's Int'l Professional Tennis Council, 1 USPQ2d 1917, 1918 (TTAB 1986) [In application to register MASTERS as a service mark for "organizing and conducting an annual tennis tournament," Board found that "the absence of any particular reference to tennis in the dictionary [entry for the word "master"] probably favors appellant's position that the mark should be published rather than that it should be refused *ex parte*."].

However, it is well settled that in order to make a *prima facie* case of descriptiveness, the Trademark Examining Attorney may rely upon dictionary definitions of individual elements in a combined term, as the Trademark Examining Attorney has done in the instant case. See In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) [SCREENWIPE for a premoistened, antistatic cloth for cleaning computer and television screens]. If each component retains its descriptive significance in relation to the goods, the combination results in a composite that is itself descriptive. See In re Putman Publishing Co., 39 USPQ2d 2021 (TTAB 1996) [FOOD & BEVERAGE ONLINE held to be merely descriptive of news and information service for the food processing industry]; In re Copytele Inc., 31 USPQ2d

1540 (TTAB 1994) [SCREEN FAX PHONE merely descriptive of "facsimile terminals employing electrophoretic displays"]; In re Serv-A-Portion Inc., 1 USPQ2d 1915 (TTAB 1986) [SQUEEZE N SERV held to be merely descriptive of ketchup and thus subject to disclaimer]; In re Uniroyal, Inc., 215 USPQ 716 (TTAB 1982) [STEELGLAS BELTED RADIAL held merely descriptive of vehicle tires containing steel and glass belts].

In support of his position that this alleged mark is suggestive, applicant argues that "[i]t requires speculation and luck - much more even than a great deal of imagination, thought or perception - to discern from Applicant's mark the precise description of the nature of Applicant's goods." (Applicant's appeal brief, p. 5) However, the cases cited by applicant at this point in his brief³ are not that helpful to applicant's position as these marks were found to be registrable because the combination of merely descriptive components created a unitary mark having a unique, nondescriptive meaning as applied to those goods. Here, applicant has not demonstrated what new, nondescriptive connotation the combined term creates when applied to the identified goods.

³ See e.g., In re Colonial Stores Inc., 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) [SUGAR & SPICE held not merely descriptive of bakery products] and In re Shutts, 217 USPQ 363 (TTAB 1983) [SNO-RAKE held not merely descriptive of a snow removal hand tool].

Applicant expressly agrees that the question of whether a particular term is descriptive or suggestive must not be determined "in the abstract." Yet applicant goes on to argue that the mark is not merely descriptive because one cannot tell from the mark alone that the product involves forensic semen detection:

... [E]ven if one makes the mental leap to associate the INFIDELITYKIT mark with a test kit for proving, predicting or detecting sexual unfaithfulness, the mark could describe a wide variety of types of kits, limited only by the imagination of the person hearing or seeing the mark.

(Applicant's reply brief, p. 4) The standard derived from Lanham Act precedential decisions does not require, for a descriptiveness refusal, that it is possible for a blindfolded consumer who has been given only the proposed mark to enumerate the exact features, technologies or methodologies employed in the goods. Rather, the question is whether someone who knows what the goods are will understand the term or phrase to convey significant information about them - namely, the idea that these kits are designed to provide a means to test for evidence of the sexual infidelity of one's partner. See In re Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990); and In re American Greetings Corp., 226 USPQ 365 (TTAB 1985).

We agree with the Trademark Examining Attorney that the question to ask is whether the term "infidelity kit" immediately conveys information about the purpose of a home test kit designed to uncover evidence of the sexual activities of one's partner. Applying the general standard enunciated above to the facts of this case, it is not a requirement of the case law that the prospective customer for these goods (e.g., the suspicious partner) knows immediately upon seeing or hearing the alleged mark that the methodology involves semen detection. Rather, it is sufficient that a consumer in the market for a forensic test kit for detecting semen, when confronted with such a kit marketed under the designation "INFIDELITYKIT," would know immediately the purpose for this kit.

Decision: The refusal to register under Section 2(e)(1) of the Act is hereby affirmed.