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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Teknor Apex Company*

Serial No. 76/330,586

Robert S. Salter of *Salter & Michaelson* for *Teknor Apex Company*.

Wanda Kay Price, Trademark Examining Attorney, Law Office 103 (*Craig Taylor*, Managing Attorney).

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

Opinion by *Hairston*, Administrative Trademark Judge:

Teknor Apex Company filed an application to register SOIL SOAKER as a trademark for "garden hose." The application (Serial No. 76/330,586) was filed on October 26, 2001, and it claims dates of first use of September 11, 1989.

The application, as filed, sought registration under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), as a result of the mark becoming distinctive because of

substantially exclusive and continuous use of the mark in commerce for more than five years preceding the filing date of the application. In addition, applicant claimed ownership of Registration No. 1,668,098, which issued on the Supplemental Register for the mark SOIL SOAKER for garden hose (expired).

The Examining Attorney initially refused registration on the ground that applicant's mark was highly descriptive and that applicant's claim of five years use was not sufficient to establish that the mark had become distinctive when applied to the goods. Applicant responded to the refusal by pointing to its ownership of Registration No. 1,668,098 and its use of the mark for over 12 years, and by submitting evidence of distinctiveness.

In the second Office action, the Examining Attorney advised applicant that a claim of distinctiveness may not be based on ownership of a prior registration on the Supplemental Register. In addition, she made final the refusal to register SOIL SOAKER on the ground of mere descriptiveness. Shortly thereafter, the Examining Attorney issued a supplemental Office action wherein she made final the refusal to register SOIL SOAKER on the ground that the evidence of acquired distinctiveness was insufficient and continued the final refusal to register on

the ground of mere descriptiveness. With this supplemental Office action, the Examining Attorney made of record numerous printouts from the NEXIS database, which contain references to "soil soaker(s)."

In response to these final refusals, applicant filed a notice of appeal, followed by an appeal brief. With its appeal brief, applicant submitted additional evidence of distinctiveness. The Examining Attorney then filed her appeal brief, wherein she objects to the additional evidence on the ground that it is untimely. However, the Examining Attorney requested remand of the application for consideration of the evidence if the Board determines that the evidence should be considered.

Applicant then filed its reply brief wherein it states that it was unable to obtain the evidence at the time of the filing the appeal, and that the evidence merely supplements the evidence properly made of record.

Under Trademark Rule 2.142(d), material submitted for the first time with a brief on appeal is normally considered by the Board to be untimely and therefore given no consideration. If applicant desired to have this evidence considered, the proper procedure was to request a remand to the Examining Attorney for this purpose.

In view of the foregoing, the Examining Attorney's objection is well-taken and we have not considered the additional evidence. The Examining Attorney's request for remand is moot.

At the outset, we note that applicant filed its application under the provisions of Section 2(f) of the Trademark Act. Filing under Section 2(f) is an admission that the mark is merely descriptive. Thus, having conceded that its mark is not inherently distinctive, the issue in this case is whether SOIL SOAKER has acquired distinctiveness under the provisions of Section 2(f).

Although the Examining Attorney has made several statements concerning genericness, our review of the record indicates that the Examining Attorney only refused registration based on the mark being descriptive and not having acquired distinctiveness. Nonetheless, the evidence that the Examining Attorney has submitted is relevant to the issue of acquired distinctiveness because the more descriptive the mark, the greater the evidence needed to establish acquired distinctiveness. *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1571, 6 USPQ2d 1001, 1008 (Fed. Cir. 1998).["[L]ogically that standard becomes more difficult as the mark's descriptiveness increases."] Applicant was on notice from the first Office action that

the Examining Attorney considered the mark to be "highly descriptive." (First Office action, p. 2).

Thus, to the extent that the evidence submitted by the Examining Attorney suggests that SOIL SOAKER may be the name of the goods, this evidence indicates the difficulty applicant faces in trying to demonstrate that the mark has acquired distinctiveness.

In support of its Section 2(f) claim, applicant properly submitted product catalogs for each year beginning in 1994 through 2002; an information sheet showing sales of approximately 8 million dollars since 1996; and packaging for the goods used each year beginning in 1996 through 2002. In addition, applicant states that it has used the mark for over 12 years. We are not persuaded by this evidence that applicant's mark has become distinctive when applied to applicant's goods.

Applicant has hardly demonstrated that its own use of the term would clearly be recognized by prospective purchasers as a trademark. For example, on page 19 of applicant's 1998 catalog, there is a list of applicant's "specialty" hoses which are designated as "Boat & Camper," "Soil Soaker," and "Sprinkler Hose." Also, on pages 4-5 of applicant's 2002 catalog, there are pictures of five of applicant's garden hoses with the following wording on the

respective hoses: APEX® COMMERCIAL; APEX® HEAVY DUTY; APEX® MEDIUM DUTY; APEX® SOIL SOAKER; and APEX® LIGHT DUTY. When prospective purchasers see applicant's use of the term in this manner, it is not clear why they would understand that the term SOIL SOAKER is a trademark, rather than a type of garden hose.

Further, applicant's sales and its use of the term on packaging for its goods hardly establish acquired distinctiveness. As noted by the Court in *In re Bongrain International*, 894 F.2d 1316, 13 USPQ2d 1727, 1728-29 (Fed. Cir. 1990), sales "may indicate the popularity of the product itself rather than the recognition of the mark." The Court also noted that sales may indicate acceptance of the other trademark associated with the product. Here, applicant almost always uses SOIL SOAKER with the mark APEX which is usually shown with a registration symbol. It is likely therefore that prospective purchasers would recognize APEX rather than SOIL SOAKER as the trademark for applicant's goods.

In response to this evidence the Examining Attorney submitted twenty-four excerpts from the NEXIS database that

make reference to "soil soaker(s)". The following are representative examples:

Drip-irrigation or soil soaker hoses are best because they deliver water directly to the roots and not to the foliage.
(Kansas City Star, August 6, 1999);

Use of soil soakers and automatic watering devices where feasible frees gardeners to go about their jobs while watering.
(Chicago Tribune, June 30, 1991);

Deeply soak conifers, flowering and fruit trees, shrubs and other ornamentals; use a canvas soil soaker or attach a metal or plastic bubbler to the end of a garden hose; . . .
(The New York Times; August 14, 1998);

. . . a slow trickle from the hose and set it in a shallow soil basin or attach a canvas tube (soil soaker) to a garden hose.
(The New York Times, June 1, 1986);

Canvas soil soakers or perforated plastic hoses are highly efficient as they allow water to trickle slowly into the ground.
(The New York Times; July 24, 1980); and

Water with a soil soaker rather than with a sprinkler.
(The Washington Post, June 24, 1979)

The Examining Attorney maintains that this evidence demonstrates the "genericness/descriptiveness" of the term "soil soaker" as applied to applicant's goods. Applicant, on the other hand, maintains that the Examining Attorney's evidence does not show use of the term "soil soaker" in connection with a garden hose, but rather "shows the

wording SOIL SOAKER used to describe a canvas attachment to a garden hose for allowing water to seep through perforations along the length of the canvas attachment." (Brief, p. 3).

Many of the NEXIS excerpts show use of the term "soil soaker" in connection with a canvas attachment to a garden hose, rather than a garden hose itself. In others, it is simply not clear whether the term is being used to refer to a canvas attachment or a garden hose. However, one of the excerpts does show use of "soil soaker" as the generic name of a type of garden hose. Moreover, very little of applicant's evidence even suggests that potential purchasers would recognize SOIL SOAKER as a trademark for applicant's goods. Consequently, the record establishes that SOIL SOAKER is highly descriptive of applicant's goods, in that it describes the primary function thereof which is to soak the soil, and the evidence offered by applicant is insufficient to establish that such a highly descriptive term as "soil soaker" has acquired distinctiveness.

In sum, applicant has not met its burden of showing that the mark has acquired distinctiveness. We find therefore that SOIL SOAKER is merely descriptive of a garden hose and applicant has failed to submit sufficient

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evidence of acquired distinctiveness to warrant
registration under Section 2(f) of the Trademark Act.

Decision: The refusal to register is affirmed.