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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Stuller, Inc.

Serial No. 76374859

R. Bennett Ford, Jr. of Roy, Kiesel, Keegan & DeNicola for
Stuller, Inc.

Katherine Stoides, Trademark Examining Attorney, Law Office
110 (Chris A.F. Pedersen, Managing Attorney).

Before Simms, Quinn and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Stuller, Inc. has filed an application to register on
the Principal Register the mark OCTET for "jewelry, namely
rings and gemstone settings," in International Class 14.¹

The Trademark Examining Attorney has issued a final
refusal to register, under Section 2(e)(1) of the Trademark

¹ Serial No. 76374859, filed February 25, 2002, based on an allegation
of a bona fide intention to use the mark in commerce.

Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive in connection with its goods.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

The Examining Attorney contends that OCTET is merely descriptive in connection with the identified goods because "it immediately communicates that the goods utilize settings that have an octet, or 'a group of eight' prongs." (Brief, unnumbered p. 2.) In support of her position, the Examining Attorney submitted a definition from *The American Heritage Dictionary of the English Language*, 3rd ed., 1992, of "octet" as "noun - ... 2. a group of eight: 'A train of heavy wagons rumbled north on the Winnipeg Trail, drawn by octets of oxen, the drovers walking alongside' (Garrison Keillor)."² The Examining Attorney also referred to a photograph submitted by applicant of the ring setting intended to be identified by the mark herein (showing eight prongs grouped in four pairs), and to applicant's statement that it "sells a wide variety of jewelry, including rings with eight stones and settings with eight prongs[;] [h]owever, this mark is intended for use with settings and

² The dictionary definition of "octet" also includes the following entries: "1. *Music*. **a.** A composition written for eight voices or eight instruments. **b.** A group of eight singers or eight instrumentalists. ... 3. See octave. **4.** A set of eight valence electrons in an atom or ion, forming a stable configuration."

rings utilizing settings that have four double prongs."

(Response to Office Action, December 20, 2002, pp. 1-2 and Exhibit B.)

Applicant contends that its identification of goods is broadly worded and "no definition of OCTET is descriptive of 'jewelry, namely rings and gemstones'" (Brief, p. 3); that because its application is based on its intent to use the mark, "[i]t is impossible to make this determination [that the mark is merely descriptive] until an amendment to allege use is made or a statement of use is filed" (Brief, p. 3); and that the "mark connotes at least two additional meanings beyond the general group of eight definition" (Brief, p. 5). Applicant referred to two dictionary definitions of "octet":

"*Noun.* 1. *Music* a. A composition for eight voices or eight instruments. b. A group of eight singers or eight instrumentalists." [*The American Heritage Dictionary of the English Language*, 4th ed., 2000.]

"*n.* 1. A musical composition for eight parts. 2. A group of eight musical performers. 3. Any group of eight; esp., OCTAVE." [*The New International Webster's Concise Dictionary of the English Language*, 1997.]³ Therein, *The Guide to the Use of this Dictionary* includes the following entry: "7. *Definition.* In entries for words having several senses, the order in which the definitions appear is, wherever possible, that of frequency of use, rather than semantic evolution."

Applicant contends that OCTET is not merely descriptive because the word connotes more than one meaning, noting that

³ This definition was submitted with applicant's brief. However, we take judicial notice thereof.

"[t]he ordering of these definitions is not insignificant[;] Webster's lists definitions according to their frequency of use [and] [t]hus, when speakers of English use or see OCTET it is usually in the musical poetic context rather than as a general enumerator."⁴ (Brief, p.5.) Applicant also states that "[o]ne simply does not refer to a group of eight as an octet in the same way that one refers to a group of two as a pair." (Brief, p. 6.) Applicant concludes that the mark has several meanings, two of which have no connection with applicant's goods and, therefore, the mark is not merely descriptive.

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-

⁴ Applicant also discussed the etymology of "octet." However, for determining whether the relevant consumer would consider the mark merely

established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

In this case applicant has admitted that it makes rings with eight gemstones and settings with eight prongs; and that the settings intended to be identified by the mark herein will have eight prongs grouped as four pairs. Regardless of the number of stones and prongs applicant intends to use in rings and gemstone settings to be identified by applicant's proposed mark, OCTET, we know from applicant's own admission that at least some of these rings will have eight gemstones and/or eight-pronged settings. Applicant's identification of goods is broadly worded so that it encompasses rings with eight gemstones and settings with eight prongs.⁵ Further, there is no question that one

descriptive of the identified goods, we find such a discussion inapposite.

⁵ In view thereof, it is immaterial in this case that applicant has not yet submitted an amendment to allege use/statement of use with specimens. While it may not be possible in some cases to discern whether a mark is merely descriptive in connection with the identified goods or services without specimens or additional information, such is not the case herein. Certainly, there is no *per se* rule, as applicant suggests, against a mere descriptiveness refusal in an intent-to-use application in which no specimens have been filed. See *Eastman Kodak v. Bell & Howell*, 994 F.2d 1569, 26 USPQ2d 1912 (Fed. Cir. 1993); and *In re Berman Bros. Harlen Furniture Inc.*, 26 USPQ2d 1514 (TTAB 1993).

of the meanings of "octet" is any group of eight things. Thus, it is likely that the term OCTET will be perceived by prospective purchasers as merely descriptive of the number of gemstones or number of prongs in applicant's ring or setting. While "octet" has other meanings, particularly in the music field, as noted *supra*, we must determine the likely meaning of the term in relation to the goods identified in the application. The mere fact that there are other, unrelated meanings does not render the mark registrable. Nor has applicant established that in relation to the identified goods, both meanings of "octet" are applicable and the effect will be that of a double entendre.

In conclusion, when applied to applicant's goods, the term OCTET immediately describes, without conjecture or speculation, a significant feature or function of applicant's goods, namely the number of gemstones in a ring or the number of prongs in a setting. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's goods to readily perceive the merely descriptive significance of the term OCTET as it pertains to applicant's goods.

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

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