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OF THE TTAB

Mailed:
Dec. 5, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Kraft Tool Co.

Serial No. 76578800

John C. McMahon for Kraft Tool Co.

Nicholas K.D. Altree, Trademark Examining Attorney, Law
Office 108 (Andrew Lawrence, Managing Attorney).

Before Bucher, Grendel and Kuhlke, Administrative Trademark
Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark depicted below for goods identified in the
application as "hand tools; namely, masonry jointers."



In the application, applicant voluntarily disclaimed the exclusive right to use the words MASONRY and JOINTER apart from the mark as shown. See Trademark Act Section 6, 15 U.S.C. §1056.

The Trademark Examining Attorney has required applicant to disclaim the word BARBELL as well, on the ground that it is merely descriptive of applicant's goods. See Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1). More specifically, the Trademark Examining Attorney contends that BARBELL merely describes the shape of applicant's goods. Pursuant to Trademark Act Section 6, the Trademark Examining Attorney has issued a final refusal of registration pending applicant's submission of such disclaimer.

Applicant has appealed the final refusal. The appeal is fully briefed. We affirm.

The Trademark Examining Attorney may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. See Trademark Act Section 6. Merely descriptive terms are unregistrable, see Trademark Act Section 2(e)(1), and therefore are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. See *In re Omaha National Corp.*,

819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (C.C.P.A. 1975); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977); *In re Pendleton Tool Industries, Inc.*, 157 USPQ 114 (TTAB 1968).

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *See, e.g., 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, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. *See In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would

have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Moreover, it is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). See also *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985).

It is settled that "a term or word which merely describes the form or shape of a product falls under the proscription of Section 2(e)(1) of the Trademark Act." *In re Metcal*, 1 USPQ2d 1334, 1335 (TTAB 1986). See *In re H.U.D.D.L.E.*, *supra*, (TOOBS, the phonetic equivalent of "tubes," merely descriptive of bathroom and kitchen fixtures in the shape of tubes); *In re Ideal Industries, Inc.*, 134 USPQ 416 (TTAB 1962)(WING NUT descriptive of electrical connectors shaped like a wing nut). See also *Scanwell Laboratories, Inc. v. Department of Transp.*,

Federal Aviation Administration, 181 F.2d 1385, 179 USPQ2d 238 (CCPA 1986)(V-RING merely descriptive of directional antennas, the primary components of which were shaped in the form of a "v" and a "ring"); *In re Walker Manufacturing Co.*, 359 F.2d 474, 149 USPQ 528 (CCPA 1966)(CHAMBERED PIPE merely descriptive of an exhaust system consisting of a series of small tuning chambers); *J. Kohnstam, Ltd. v. Louis Marx & Co.*, 280 F.2d 547, 126 USPQ 362 (CCPA 1960)(MATCHBOX SERIES merely descriptive of toys sold in boxes having the size and appearance of matchboxes); and *In re Zephyr American Corp.*, 124 USPQ 464 (TTAB 1960(V-FILE merely descriptive of card filing device in which the opening between the cards is in the form of a "v").

Both applicant and the Trademark Examining Attorney have made of record photographs of applicant's masonry jointer which are shown on applicant's packaging and on applicant's advertising materials. The photographs of the product, and the accompanying text, reveal that the product is a bar with a round head ball-shaped extension on either end. One of the balls is one half-inch in diameter, and the other is five-eighths of an inch in diameter. The jointer is seven-and-one-half inches long, in all.

In accordance with the caselaw authorities discussed above, and considering the photographs and descriptions of

applicant's product contained in the record, we find that the term BARBELL is merely descriptive of the shape of applicant's goods, and that it therefore is merely descriptive of the goods and subject to disclaimer.

Contrary to applicant's argument, it is irrelevant that applicant's jointer is not big enough to be an actual barbell. Clearly, the jointer is shaped like a barbell. We are not persuaded by applicant's arguments to the contrary, i.e., that the product is not shaped like a barbell because it is asymmetrical, with one end of the barbell being one-half inch in diameter and the other end being five-eighths of an inch in diameter. Even assuming this fact is true as applied to applicant's goods as currently marketed, that difference is too slight to overcome the tool's overall barbell-shaped appearance.

Moreover, purchasers would be further encouraged to view the goods as being barbell-shaped by the design portion of the mark itself, which depicts a man holding a barbell.

Applicant also argues that even if the goods are barbell-shaped, the term BARBELL is not merely descriptive because it creates a double entendre as applied to the goods, suggesting strength, power and agility as well as describing the shape of the goods. We are not persuaded by

this argument, because this alleged second meaning of the term is so attenuated that, standing alone, it would not be readily apparent to purchasers of these goods. For a term to be considered a double entendre as applied to the goods, both meanings must be readily apparent from the term itself. See *In re Wells Fargo & Company*, 231 UPSQ 95 (TTAB 1986). In this case, we find that the sole connotation of BARBELL as applied to applicant's goods is that it describes the shape of the goods.

We also agree with the Trademark Examining Attorney's contention that the term BARBELL must remain free for applicant's competitors to use in connection with their own barbell-shaped jointers. This is so even if applicant is the first or currently the only user of such jointers. See *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983).

In summary, we find that the term BARBELL is merely descriptive of the shape of applicant's goods, and that it therefore is merely descriptive of the goods themselves. The term therefore must be disclaimed pursuant to Trademark Act Section 6. We have considered all of applicant's arguments to the contrary, including those not specifically discussed in this opinion, but we are not persuaded by them.

Decision: The refusal to register based on applicant's failure to disclaim BARBELL is **affirmed**. However, if applicant submits the required disclaimer¹ of BARBELL to the Board within thirty days, this decision will be set aside, the application shall be amended to enter the disclaimer, and the application then shall proceed to publication. See Trademark Act Section 2.142(g), 37 C.F.R. §2.142(g).

¹ The standardized printing format for the required disclaimer text is as follows: "No exclusive right to use MASONRY BARBELL JOINTER is claimed apart from the mark as shown." TMEP §1213.08(a)(4th ed. April 2005).