

**THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Legal Promotions, Inc.

Serial No. 76655995

Howard A. MacCord, Jr. of MacCord Mason PLLC for Legal Promotions, Inc.

Ada P. Han, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Zervas, Cataldo and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Legal Promotions, Inc. filed a use-based application for the mark THEAUTOFILE (as amended), in standard character format, for "vinyl folders to hold auto insurance papers and the like sized to fit in an automobile glove box," in Class 16. Applicant disclaimed the exclusive right to use the word "file."

The Trademark Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act of 1946, 15 U.S.C. §1052(e)(1), on the ground that the mark THEAUTOFILE

is merely descriptive. To support her refusal, the Examining Attorney submitted the following evidence:

1. A definition of the word "the" as a definite article that when used before a noun has "a specifying or particularizing effect";¹
2. A definition of the word "auto" as "automobile";² and,
3. A definition of the word "file" as "a folder, cabinet, or other container in which papers, letters, etc., are arranged in convenient order for storage or reference."³

The Examining Attorney contends that the mark THEAUTOFILE is merely descriptive for the following reasons:

1. The term "the" is a definite article that does not have any trademark significance;
2. The word "auto" means "automobile" because it is used in connection with a file for storing automobile related papers in an automobile;
3. The word "file" means "a folder" for organizing papers; and,

¹ *Dictionary.com* based on the Random House Unabridged Dictionary (2006) attached to the August 24, 2006 Office Action.

² *Id.*

³ *Id.*

4. The term THEAUTOFILE is a composite mark in which each component retains its original descriptive meaning.⁴

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the products it identifies. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the products for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the issue is whether a relevant purchaser who knows what the products are will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

"On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order

⁴ The August 24, 2006 Office Action.

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to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive." *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978). *See also, In re Shutts*, 217 USPQ 363, 364-365 (TTAB 1983); *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980). Even where individual terms are descriptive, combining them together may evoke a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods, without the combination of terms creating a unique or incongruous meaning, then the resulting combination is also merely descriptive. *In re Tower Tech., Inc.*, 64 USPQ2d 1314, 1317-1318 (TTAB 2002).

The record clearly shows that the mark THEAUTOFILE used in connection with "vinyl folders to hold auto insurance papers and the like sized to fit in an automobile glove box" is merely descriptive. The mark is applied to the cover of the folder in the following manner:

TheAutoFile™

GloveBox
ORGANIZER



Vehicle Registration



Insurance Cards



Warranty Papers



Emergency Information

The mark as used by applicant immediately conveys to consumers that the product is a file folder for storing automobile related documents. The specimen of record does not support applicant's argument that consumers will perceive THEAUTOFILE as a French word based on the EAU combination of letters⁵ because, as shown in the specimen, THEAUTOFILE is displayed as three distinct words, not one. Moreover, there is nothing incongruous about the combination of words comprising the mark, and no multiple

⁵ Applicant's Brief, pp. 4-5.

step reasoning process is needed to determine the nature of the product.

Applicant argues that the Board has adopted a three-part test for determining whether a mark is descriptive or suggestive, citing *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502, 507 (TTAB 1985).⁶ *No Nonsense Fashions* holds that third-party use of the mark at issue does not detract from the applicant's trademark rights unless the third-party use:

1. directly conveys the purpose, quality, characteristics, or functions of the product;
2. has been so extensive that consumers will not perceive the term as a mark; and,
3. deprives competitors of an apt descriptive name for their products.

Id. Relying on *No Nonsense Fashions*, applicant contends that THEAUTOFILE is suggestive because competitors do not need to use the term THEAUTOFILE, and there is no evidence that any other entity uses, or has registered, that term. However, applicant's reliance on *No Nonsense Fashions* is misplaced because, as indicated above, *No Nonsense Fashions* concerns whether third-party use of the mark sought to be

⁶ Applicant's Brief, p. 6.

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registered affects applicant's trademark rights, and there is no evidence of third-party use in this case.

In view of the foregoing, we find that applicant's use of the mark THEAUTOFILE in connection with "vinyl folders to hold auto insurance papers and the like sized to fit in an automobile glove box" is merely descriptive.

Decision: The refusal to register is affirmed.