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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bradley J. Holmes

Serial No. 78055793

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

Tarah K. Hardy Ludlow, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, 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 5 MINUTE INFIDELITY TEST KIT 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 entire

¹ Application Serial No. 78055793 was filed on March 29, 2001 based upon applicant's allegations of use in commerce since at least as early as May 5, 2000. At the request of the Trademark Examining Attorney, applicant has agreed to disclaim the generic term TEST KIT apart from the mark as shown.

alleged mark, 5 MINUTE INFIDELITY TEST KIT, is merely descriptive of applicant's goods under Section 2(e)(1) of the Lanham Act, 15 U.S.C. §1052(e)(1).

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.

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 ingredients, qualities, characteristics, features, functions, purposes or uses of the goods or services with which it is used or 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 re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978); In re Intelligent Instrumentation Inc., 40 USPQ2d 1792, 1793 (TTAB 1996); In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995); In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991); In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986); and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979).

Does the term immediately convey information?

The Trademark Examining Attorney, having examined the entire five-word phrase, takes the position that "[t]he applicant's proposed mark merely describes the type of product, the length of time required to use the product, and the purpose of the product." (Trademark Examining Attorney's appeal brief, p. 1)

With regard to the length of time required to use the product, we note that applicant has not discussed at length the appropriateness of the descriptiveness refusal as to the "5 MINUTE" portion of the phrase. Indeed, the record shows that applicant appears to use "Quick and Easy" on his website and the trade dress of the packaging in a manner

parallel to the use of the term "5 Minute" at the beginning of his applied-for mark. While we must look at the entire phrase, we find that the initial descriptive modifier, "5 minute," does not really affect the nub of this discussion. Rather, the real issue in this appeal has to do with the merely descriptive nature of the separable "infidelity test kit" portion of the mark, with or without the prefatory term "5 Minute."

Furthermore, applicant and the Trademark Examining Attorney have focused much of their discussion on the word "Infidelity" alone. However, the ultimate question before us is whether this entire phrase (not the word "Infidelity" alone) conveys information about the purpose or significant features of the listed goods with the immediacy required by Section 2(e)(1) of the Lanham Act.

In partial support of her position that the entire phrase is merely descriptive, the Trademark 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." She argues from the plain meaning of the word "infidelity" that applicant is using the term "infidelity test kit" to "describe the purpose of the test, namely, to provide evidence of infidelity." (Trademark

Examining Attorney's appeal brief, unnumbered page 3) She also points to examples from applicant's website where the product is referred to as an "infidelity test kit" or merely as an "infidelity test." She contends that these readily understood and abbreviated uses are further evidence that the term "infidelity" is being used descriptively by applicant, and not as a source indicator.

Or does the term require multi-stage reasoning?

The Trademark Examining Attorney contends that "[n]o mental jump need be made to determine that the applicant is providing a TEST KIT that takes 5 MINUTES to perform in order to determine INFIDELITY." (Trademark Examining Attorney's appeal brief, unnumbered page 4)

By contrast, 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 readily 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 5 MINUTE INFIDELITY TEST KIT that it is a "forensic test kit" (sic) for home use consisting of (sic) primarily of diagnostic reagents for detecting the presence of semen on material." Nothing in the mark 5 MINUTE INFIDELITY TEST KIT takes the public immediately to the notion of semen detection for the purpose of finding infidelity. This, by definition, confirms that applicant's mark is suggestive rather than merely descriptive.

(applicant's reply brief, p. 3).

Applicant argues that the term "infidelity" as used in applicant's 5 MINUTE INFIDELITY TEST KIT mark does not describe "semen detection." Applicant then argues that neither the dictionary definition relied on by the Trademark Examining Attorney nor the several references to "infidelity" on applicant's website supports the Trademark Examining Attorney's position.

As to whether the entire claimed mark herein immediately conveys information about the purpose or significant features of the goods, applicant focuses on the word "infidelity" alone. He then argues that the definition of "infidelity" provided by the Trademark Examining Attorney points to sexual unfaithfulness, but "does not describe forensic semen detection." While the term "infidelity" clearly conjures up images of sexual unfaithfulness, in order to be descriptive, according to

applicant, "it must *immediately* describe forensic semen detection, which it does not."

In support of his position that this phrase is suggestive, applicant argues that the fact that there is no dictionary entry for the phrase "5 minute infidelity test 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 "is notable for its absence ... 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*."].

The Trademark Examining Attorney counters that whether or not a term is found in the dictionary is not controlling on the question of registrability provided the term has a recognized meaning. In re Orleans Wines, Ltd., 196 USPQ 516 (TTAB 1977) [BREADSPRED is merely descriptive of

function or use of jams and jellies even if it is not a dictionary term].

We note that all three of these cases involved single word marks (GOVERNOR, MASTERS and BREADSPRED). By contrast, rarely would a five-word phrase appear in any dictionary as a single entry. 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 multi-word phrase, as the Trademark Examining Attorney has done in the instant case. 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 returns to "the mental leap that the public must make in the Examiner's descriptiveness analysis in order to associate applicant's mark with semen detection." Applicant argues that "one must exercise 'mature thought or follow a multi-stage reasoning process' to determine that semen detection is an attribute of Applicant's 5 MINUTE INFIDELITY TEST KIT," citing to In re Tennis in the Round, Inc., 199 USPQ 496 (TTAB 1978) [TENNIS IN THE ROUND held not descriptive of tennis facilities].

However, the Board, in discussing the TENNIS IN THE ROUND mark, expressly found that this term created a misleading association, and that the mark as a whole was incongruous as applied to the recited services:

In the instant case, applicant's marks "TENNIS IN THE ROUND" and "TENNIS IN THE ROUND INC." and design evoke an immediate association with the well-known phrase "theater-in-the-round." ... This association of applicant's marks with the phrase "theater-in-the-round" creates an incongruity because applicant's tennis facilities are not in fact at all analogous to those used in a "theater-in-the-round" ... In contrast, the placement at applicant's facility of 11 tennis courts one next to another in a circular configuration has no real effect upon the manner in which tennis is practiced at such facility, nor upon the

rendering of applicant's services. Insofar as the record herein shows, the placement of applicant's tennis courts in a circular configuration, rather than in rows, for example, serves no particular purpose in the performance of applicant's services. Nor does it appear that others engaged in the services of providing tennis facilities in the form of courts and tennis ball machines and offering instruction in tennis would have any need to use the phrase "in the round" in describing such service.

In re Tennis in the Round, Inc., 199 USPQ at 498. Here, there is no misleading association involved in the applied-for mark and applicant has not contended that this mark creates any incongruity when applied to the identified goods. Hence, we find that this case does not support applicant's position herein.

Descriptiveness is not determined in the abstract:

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:

Even if it is assumed, based on the definition of "infidelity" offered by the Examiner, that the context for the mark is 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. As described in Applicant's opening brief, none of these attributes need include forensic semen detection.

(applicant's reply brief, p. 3) Applicant and the Trademark Examining Attorney have agreed with the principle that this question should not be determined "in the abstract." 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 term or phrase making up the 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 test kit" immediately conveys information about the purpose of a home test kit designed to shed light on the sexual

faithfulness 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 "5 MINUTE INFIDELITY TEST KIT," would immediately know the purpose of the kit, and a significant feature of the goods, such as how long it takes to use the product.

This is not a case like In re Reynolds Metals Company, 480 F.2d 902, 178 USPQ 246 (CCPA 1973), wherein BROWN-IN-BAG was held suggestive, not merely descriptive, because that applicant was "not seeking to register a direction such as 'brown foods in this bag'" and because the bag had multiple purposes. In the instant case, applicant's product has one purpose, i.e., a quick test for the presence of semen as evidence of infidelity, and the designation applicant claims as a mark does nothing but immediately reveal this single purpose for the product.

Context:

Applicant argues that upon the introduction of these goods, there was no existing "context" for the applicant's product:

The public has no exposure to these types of test kits, and therefore cannot frame any particular characterization for the description of Applicant's goods outside of Applicant's own branding.

(Applicant's reply brief, p. 3) Indeed, nothing in the record contradicts applicant's contention that consumers are only recently getting their first exposure to this novel test kit. To the extent that such exposure comes from applicant's website and the product's trade dress, it behooves us then to look more closely at this context.

The best evidence in the record providing context for applicant's product is applicant's own website. Upon examining these webpages, we note that applicant himself seems to use "infidelity test kit" and "semen detection test kit" interchangeably. The entire term "5 minute infidelity test kit" appears on this site in all lower-case letters.

Nonetheless, with regard to these appearances of the word "infidelity" in a variety of ways on applicant's website, applicant argues that he is not using the term to describe the purpose of the product. Instead, applicant

argues that the repeated uses of the word "infidelity" in various forms stands as an indication of the success of applicant's having created a "brand image" around the suggestive term, "Infidelity."

We disagree, and find that "infidelity" is used repeatedly by applicant in its ordinary, dictionary sense, to mean "sexual unfaithfulness," in a context where detecting the unfaithfulness of one's partner is the total focus of the kits as well as the manner in which applicant markets these goods.

We do not question but that applicant expected that the term 5 MINUTE INFIDELITY TEST KIT would distinguish his goods from potentially competitive goods offered by others. On the other hand, having chosen these informative words, and then having employed them in a context totally consistent with their ordinary meaning, applicant accepted the risk that this prosaic string of words may not function as a source indicator for his goods. We note the analysis and results of In re The Standard Oil Company, 275 F.2d 945, 125 USPQ 227 (CCPA 1960) [GUARANTEED STARTING for winterizing automobile engines].

In the present case it may be conceded that in using the words "guaranteed starting" in order to bring its services to the attention of the public the applicant intended and hoped, or perhaps expected, that they would

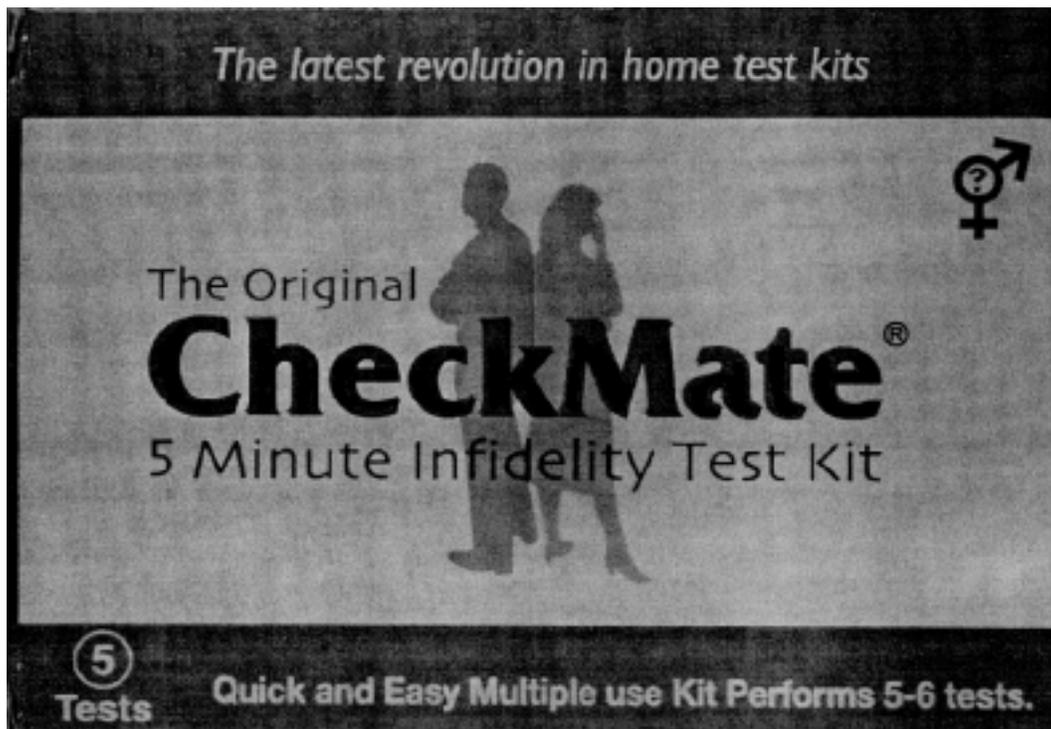
distinguish them from similar services offered by others. However, having chosen words which, taken in their normal meaning, do no more than inform the public with reasonable accuracy what is being offered, it did not succeed.

The words are well understood, English words in common use. Taken together, they amount to no more than a sort of condensed announcement that the applicant will guarantee the work done in order to insure the starting of the customer's car. It must be assumed that the ordinary customer reading the advertisements displayed by an automobile service station would take the words at their ordinary meaning rather than read into them some special meaning distinguishing the services advertised from similar services of other station operators. Whatever may have been the intention of the applicant in using them, their use has not accomplished what the applicant wished to do. Hence, they are not a service mark.

Hence, we find that applicant's own website provides the most damaging evidence that its alleged mark is highly descriptive and would be perceived by the purchasing public as merely a common descriptive term for its goods rather than as a mark identifying the goods' source. See In re Gould Paper Corp. 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); see also In re Diagnostic Products Corp., 216 USPQ 170 (TTAB 1982) ["On review of [applicant's instructional literature], it is clear to the Board that the references to 'PREMIX' in such literature cease, as some point, to refer to applicant's kit as such and become a descriptor or

referent ... confirming the descriptive possibilities and tendencies of the term in the context of applicant's actual usage ..." 216 USPQ at 172, footnote 4].

In addition to the website, the trade dress of the packaging for the goods provides another significant context for framing consumers' impressions of applicant's product and the relevant source-identifying matter. Images of applicant's product packaging are portrayed repeatedly on applicant's website. These images are identical to a color photograph of one surface of the package or carton that serves as the specimen of record in the instant file:



The prominent text in the large center area of the carton immediately shows the prospective customer that this is "The Original **CheckMate**[®] 5 Minute Infidelity Test Kit. These are "Quick and Easy" (viz. "5 Minute") "home test kits" (or "Test Kit") that seems clearly to be the **CheckMate**[®] brand of such kits. While a single product may clearly carry multiple marks, the trade dress of the packaging uses **CheckMate** in the prominent manner that consumers are accustomed to seeing in source-identifiers. Unlike the phrase that is the subject of this appeal, the **CheckMate** term is clearly a suggestive mark. As applied to these goods, it also employs a clever play on the well-known chess term. In this context, then, it is not at all surprising that the testimonial of a satisfied customer shown on applicant's own website uses "**CheckMate**" as the brand name modifying the descriptive phrase "infidelity test kit."

To the extent that one does focus on the word "Infidelity," as applicant would have us do, we find that it is unlikely that any reasonable consumers would perceive the word "Infidelity" - buried as it is in the middle of this five-word phrase - as applicant's trademark. Indeed, if "5 MINUTE ... TEST KIT" is highly descriptive of applicant's "quick and easy ... semen detection kits," and

given that applicant uses "infidelity test kit" and "semen detection kit" interchangeably, any permutation of these components derives a phrase that is also highly descriptive of applicant's goods irrespective of which precise formulation is used (e.g., "5 minute semen detection kit," "quick and easy infidelity test kit," "5 minute infidelity test kit," "quick and easy semen detection kit," etc.).

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