

**THIS DISPOSITION
IS NOT A PRECEDENT
OF THE TTAB**

Date: July 25, 2007

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pennzoil-Quaker State Company

Serial No. 78308090

Kimbley L. Muller of Shell Oil Company for Pennzoil-Quaker
State Company.

Barbara A. Gaynor, Trademark Examining Attorney, Law Office
115 (Tomas V. Vlcek, Managing Attorney).

Before Quinn, Walters and Taylor, Administrative Trademark
Judges.

Opinion by Taylor, Administrative Trademark Judge:

Pennzoil-Quaker State Oil Company filed an application
to register the mark BIOHAZARD, in standard character form,
for "[a]ir fresheners."¹ The Trademark Examining Attorney
has refused registration under Section 2(e)(1) of the
Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that
Applicant's mark is merely descriptive of a feature of the
identified goods.

¹ Application Serial No. 78308090, filed October 1, 2003, and
alleging November 11, 2004 as the date of first use and first use
of the mark in commerce.

When the refusal was made final, Applicant appealed and requested reconsideration of the final refusal. On May 12, 2006, the Examining Attorney denied the request for reconsideration and the appeal was resumed. Applicant and the Examining Attorney have filed briefs.²

Before turning to the merits of the appeal, we must discuss a few preliminary matters. Applicant contends that the Examining Attorney improperly raised a new ground for refusal in her response to the request for reconsideration when she alleged that Applicant's BIOHAZARD word mark should not be protected because it could inhibit competition in the sale of air fresheners and could increase costly infringement suits. Applicant, relying on *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994), also argues that the record should be complete before the filing of an appeal and, consequently, the evidence attached to the Examining Attorney's response, namely website excerpts from an Internet search using the Google[®] search engine showing two other vehicle air fresheners that contain the

² Applicant attached Exhibits A-G to its brief, filed July 17, 2006. With the exception of Exhibit G, i.e., the certificate of service of applicant's brief, the exhibits are either of record automatically, or were previously made of record during prosecution of the application, and need not have been resubmitted.

biohazard symbol design, is untimely and should not be considered.

Applicant is correct in its assertion that the application record should be complete prior to the filing of an appeal. However, when a timely request for reconsideration is filed, the Examining Attorney may submit, with the response to the request, new evidence directed to the issue or issues for which reconsideration is sought. TBMP § 1207.04 (2d ed. rev. 2004). In this case, the request for reconsideration was directed to Applicant's belief that the Examining Attorney had not alleged that the BIOHAZARD word mark (as opposed to the specimen logo of a biohazard symbol) is descriptive for air fresheners. We consider the Examining Attorney's arguments regarding the need of third parties to use the word "biohazard" descriptively as a continuation of the descriptiveness refusal and not a new ground for refusal.³

Accordingly, Applicant's objections are overruled.

The second matter relates to the design on applicant's specimens. The Examining Attorney contends that the design is the universally recognized biohazard symbol while

³ The examining attorney particularly argues that "[i]t is clear from the excerpts that the manufacturers and/or sellers of those air fresheners need to use the word 'biohazard' to describe the design element appearing on the air fresheners."

Applicant contends that the design is a "parodistic" representation of the biohazard symbol. We need not address the dispute in this opinion and, for purposes of this decision only, we will refer to the design shown on Applicant's specimens as the "purported biohazard symbol."

Turning now to the merits of this case, the Examining Attorney contends that the specimen filed with the statement of use shows that the purported biohazard symbol is the prominent ornamental or decorative feature of the goods and, consequently, Applicant's BIOHAZARD mark is merely descriptive of a feature of the goods, and that Applicant's competitors should have the freedom to use common descriptive language when merely describing their own goods or services to the public in advertising and marketing materials. In support of her position, the Examining Attorney has introduced the following website excerpts showing two other vehicle air fresheners that contain the biohazard symbol.



Biohazard Air Freshener Hanging Scent Freshener for Rooms or Cars Music & Entertainment Merchandise

Other products by [OldGlory](#)
[More about this product](#)

Price: \$3.95

Availability: Usually ships in 1-2 business days. Ships from and sold by [OldGlory](#).

[See larger image](#)

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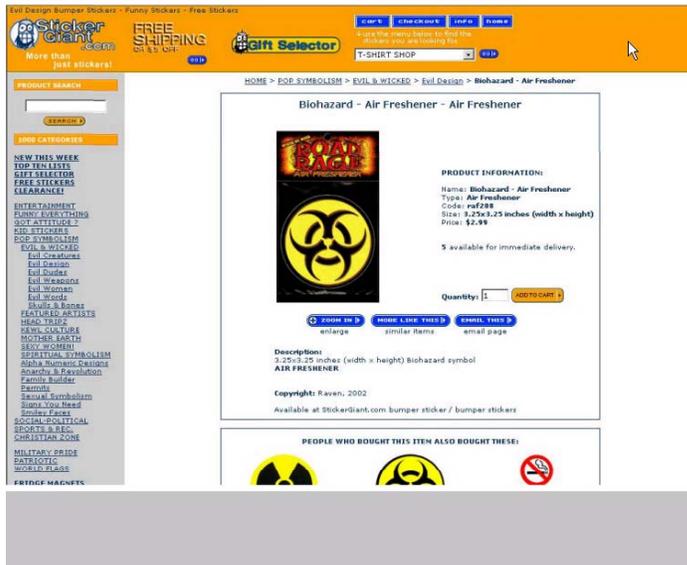
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http://www.stickergiant.com/page/sp/PROD/ids/r/2008_05/12/2008_12_32_38_PM



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⁴ www.amazon.com.

⁵ www.stickergiant.com.

The manufacturers and/or sellers of those air fresheners, she contends, need to use the word "biohazard" to describe the design element appearing on their air fresheners.

In urging that the refusal to register be reversed, applicant contends that it is seeking to register the word mark BIOHAZARD and that the "specimen logo [depicting the purported biohazard symbol] was not submitted to acquire any rights to the biohazard symbol." Citing to the Merriam-Webster Online Dictionary, applicant argues that the word "biohazard" has become known in "everyday parlance" as "a biological agent or condition that constitutes a hazard to humans or the environment, also: a hazard posed by such an agent or condition"⁶ and, "it goes without saying," that no person would buy an air freshener, even with a "parodistic representation" of a biohazard symbol on the air freshener, to contaminate the interior of a car or truck with a biohazard. Because "biohazard" is not a word commonly used in association with air fresheners, applicant argues that the immediate idea conveyed to an average consumer when purchasing an air freshener is not that of a biological agent constituting a hazard to humans or the environment. Thus, the term does

⁶ Merriam-Webster Online Dictionary, <http://www.m-w.com/dictionary/biohazard>.

not immediately convey an idea or a feature of the goods and is, at worst, suggestive.

Applicant further argues that its BIOHAZARD word mark "is not changed, nor does it become descriptive because it is associated with a symbol for "biohazard."

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the goods or services with which it is used, or intended to be used. *In re Gyulay*, 820 F.2d 1216, 3 USPQ 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the goods or services for which registration is sought and the context in which the term is used, or is intended to be 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 USPQ 1222, 1224 (TTAB 2002). In other words, the issue 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 USPQ 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); and *In re American Greetings Corp.*, 226 UPSQ 365, 366 (TTAB 1985).

"On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive. [Internal citations omitted]. . . incongruity is a strong indication that a mark is suggestive rather than merely descriptive." *In re Tennis in the Round, Inc.*, 199 USPQ 486, 498 (TTAB 1978). See also, *In re Shutts*, 217 USPQ 363, 364-365 (TTAB 1983); and *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980).

The Examining Attorney has devoted much of her argument (and evidence) in favor of refusal on the alleged descriptiveness of the purported biohazard symbol in relation to applicant's air fresheners. However, applicant does not seek to register the purported biohazard symbol. Rather applicant seeks registration of the word mark BIOHAZARD. As such, the issue of whether the purported biohazard symbol is descriptive for air fresheners is not before us. The sole issue before us is whether the word mark "BIOHAZARD" describes a significant feature of applicant's air fresheners.

In this instance, and at a time in history where an attack by means of a biological agent is not science fiction, the term "biohazard" immediately calls to mind a

biological condition or hazard to humans and the environment. Air fresheners, by contrast, generally are used to remove odors or freshen the air in a room or a vehicle. Thus, the use of applicant's BIOHAZARD mark with an air freshener creates an incongruity because the average consumer would not purchase an air freshener with the idea that he or she was doing so for the purpose of contaminating a room or vehicle with a hazardous agent. This is so even if the air freshener included a decorative element in the form of a purported biohazard symbol, as such a symbol is antithetical to the purpose served by the air freshener. Moreover, while some decorative elements are more desirable than others, such decorative elements would not affect the quality, characteristic or function of the air freshener itself and are readily interchangeable. The quality or purpose of the air freshener will not change just because there is a rose design, as opposed to a biohazard symbol, on the product or its packaging. In sum, the word BIOHAZARD tells a consumer nothing about the product.

Furthermore, we are not persuaded by the Examining Attorney's argument that third parties have a competitive need to use the designation "biohazard" to describe their air fresheners. While there is evidence of record that two

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other manufacturers use a biohazard symbol as a decorative element of their air fresheners, and the web site listings use the term "biohazard" to describe the decorative design on the products, those manufacturers remain able to identify their products, i.e., air fresheners, without the need to use the term "biohazard," as these products could be listed without reference to the design element.

For the reason discussed above, we are of the opinion that the use of the word BIOHAZARD as a trademark in connection with air fresheners is antithetical and imaginative. In view thereof, we find that the mark is not merely descriptive of such goods.

Decision: The refusal to register is reversed.