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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re OMNOVA Solutions Inc.

Serial No. 78322941

Daniel J. McMullen of Calfee, Halter & Griswold LLP for
OMNOVA Solutions Inc.

Carolyn V.C. Gray, Trademark Examining Attorney, Law Office
111 (Craig D. Taylor, Managing Attorney).

Before Grendel, Kuhlke and Walsh, Administrative Trademark
Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of THE FLEXIBLE WHITEBOARD in the stylized manner depicted
below



for goods identified in the application as "wall coverings" in Class 27.¹

At issue in this appeal is the Trademark Examining Attorney's final refusal to register the mark on the ground that it is either merely descriptive of the goods or is deceptively misdescriptive of the goods, and thus is unregistrable pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1).

The appeal is fully briefed. After careful consideration of the evidence of record and the arguments of counsel, we affirm the Section 2(e)(1) refusal to register based on mere descriptiveness. Because we find the mark to be merely descriptive, we do not reach the Trademark Examining Attorney's alternative deceptive misdescriptiveness refusal.

¹ Serial No. 78322941, filed on November 4, 2003. The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a). October 20, 2003 is alleged in the application as the date of first use of the mark anywhere and as the date of first use of the mark in commerce.

Applicant's goods are identified in the application as "wall coverings." The record shows that applicant's product is, in essence, vinyl wallpaper which, once it is applied to a wall, can be written upon with dry-erase markers. In its appeal brief, applicant explains that its product comprises "a continuous, dry-erase surface that can be adhered to walls, pillars and other multi-planar surfaces of almost any size and shape." It consists of "thin, treated vinyl sheets than can be formed and applied continuously in a wide range of configurations." Applicant's brochure, made of record by applicant, informs purchasers that "MemErase® The Flexible Whiteboard™ dry-erase surface offers limitless possibilities for collaboration and communication. Wrap it around columns, run it down hallways, or innovate the conference room." The brochure also informs purchasers that the product is "Functional and Flexible," and that it "provides a dry-erasable writing area for a myriad of applications and can be used with any dry-erase marker. MemErase surfaces install horizontally to seamlessly cover a wall, an entire room, even wrap corners and follow curves." The brochure includes photographs of what appear to be an office conference room in which the walls and round pillars or

columns are covered by a white surface, upon which people are writing with markers (and erasing with erasers).

The record includes a dictionary definition of "flexible" which reads, in pertinent part, "capable of being bent or flexed; pliable." The American Heritage Dictionary of the English Language (4th ed. 2000). Also of record are two definitions of "whiteboard": "a white surface for use as a blackboard but accepting felt-tipped pens and wax crayons" (Oxford English Dictionary (2d ed. 1989)); and "a smooth, glossy sheet of white plastic that can be written on with a colored pen or marker in the manner of a blackboard" (Random House Unabridged Dictionary (1997)). Further with respect to the references to "blackboard" in these definitions of "whiteboard," applicant has submitted various definitions of "blackboard" similar to one which reads "a smooth, hard, dark-colored panel for writing on with chalk." The American Heritage Dictionary of the English Language (4th ed. 2000).

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).

Applicant argues that

a whiteboard is a specific type of dry-erase surface, particularly one that (like a blackboard) is hard, board-like and requires mechanical mounting - i.e., with screws, braces, etc. - to attach to a wall. ... Wallboards, white or black, historically have been the only type of dry erasable wall-mounted surface available. However, by definition, such wallboards are hard panels affixed to the single plane of a wall. In distinct contrast, a wall covering is not mechanically affixed, and instead is adhered to a surface. Moreover, the wall covering goods with which the instant mark is associated - thin, treated vinyl sheets that can be formed and applied continuously in a wide range of configurations - are not hard, size-defined panels. As the images in the product brochure submitted by Applicant illustrate, Applicant's goods comprise a continuous, dry-erase surface that can be adhered to walls, pillars and other multi-planar surfaces of almost any size and shape. ... Thus, Applicant's goods function as dry-erase surfaces that can be deployed in novel configurations and architectural applications, not as mere whiteboards. Consequently, when considered in relation to Applicant's goods, the term "whiteboard" is not descriptive.

(Applicant's brief at 4-5.) In essence, applicant's primary argument appears to be that (a) its product is not a "whiteboard" because it is not a blackboard-like hard panel and because it is not mechanically affixed to a wall but rather is adhered to the wall, and that (b) because its

product for these reasons technically is not a whiteboard, "whiteboard" is not merely descriptive of the product.

Applicant also argues, with respect to the word FLEXIBLE in the mark, that because whiteboards by nature are hard panels, they are not "flexible." Therefore, applicant contends, THE FLEXIBLE WHITEBOARD is an oxymoron, and oxymorons are not merely descriptive.²

We are not persuaded by applicant's arguments. First, we find that the presence of the word THE in the mark does not affect our mere descriptiveness determination in this case. That is, if FLEXIBLE WHITEBOARD is merely descriptive of applicant's goods, then the addition of the word THE does not negate the mere descriptiveness of the mark as a whole.

Next, we find that FLEXIBLE merely describes a key characteristic or feature of the product, i.e., its flexibility. The wall covering is pliable and flexible, so that it may be wrapped around corners or around curves.

We further find that WHITEBOARD merely describes a key purpose or function of the product - once it is attached to the wall, it is used exactly like a whiteboard and for the

² Applicant has not argued that the mark is not merely descriptive due to the stylized manner in which the words THE FLEXIBLE WHITEBOARD are depicted in the mark. We find in any event that the stylization of the wording does not negate the mere descriptiveness of the wording.

same purpose as a whiteboard, i.e., as a dry erase writing surface. Applicant's argument that "whiteboard" doesn't describe the product because the product is not technically a whiteboard (in that it is a wallcovering adhered to the wall rather than a hard panel screwed or otherwise mounted on the wall) is not persuasive. Even if the product does not display those particular characteristics of a whiteboard, it clearly embodies one other key feature of a whiteboard, i.e., it is a dry erase surface that, when attached to the wall, functions exactly like a whiteboard. The word WHITEBOARD directly and immediately informs purchasers of this key feature and function of the product.

Finally, we are not persuaded by applicant's argument that FLEXIBLE WHITEBOARD is not merely descriptive because it is an oxymoron. That is, we find that the combination of the two words does not result in a composite which, as applied to applicant's goods, is incongruous or otherwise inherently distinctive. Applicant's wall covering is flexible, and it functions exactly like a whiteboard and will in fact be used as a whiteboard. Applicant's contention that a product which is used as a whiteboard is not a whiteboard merely because it is not non-flexible is not persuasive. Purchasers will immediately understand THE

FLEXIBLE WHITEBOARD to describe, directly and without incongruity, the two key features of applicant's product, i.e., it is a wall covering surface which can be written on and erased exactly like a whiteboard, and it is flexible enough to be attached to the wall and wrapped around corners and curves. Competitors (current or future) need to and are entitled to use the words "flexible" and "whiteboard," whether separately or together, to describe these key features of their competing products.

For these reasons, we find that applicant's mark THE FLEXIBLE WHITEBOARD is merely descriptive of applicant's goods.

Decision: The Section 2(e)(1) mere descriptiveness refusal to register is affirmed.