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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Homax Products, Inc.

Serial No. 78363723

Michael R. Schacht of Schacht Law Office, Inc. for Homax  
Products, Inc.

Mark Leipzig, Trademark Examining Attorney, Law Office 115  
(Tomas V. Vlcek, Managing Attorney).

Before Bucher, Holtzman and Cataldo, Administrative  
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Homax Products, Inc. seeks registration on the  
Principal Register of the mark **SOFTARP** (*in standard character  
form*) for goods identified in the application as "flexible  
sheet material in the nature of a tarpaulin for use in  
covering, lining, or separating objects and materials" in  
International Class 22.<sup>1</sup>

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<sup>1</sup> Application Serial No. 78363723 was filed on February 6,  
2004 based upon applicant's allegation of a *bona fide* intention  
to use the mark in commerce. The original drawing showed the  
mark as SOFT TARP, but the Trademark Examining Attorney permitted  
an amendment of the mark to its current, telescoped form,  
SOFTARP.

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation under Section 2(e)(1) of the Trademark Act based upon the ground that the mark is merely descriptive when considered in relation to applicant's identified goods, i.e., that the term "soft tarp" immediately informs potential purchasers about a quality or characteristic of applicant's goods.

Both applicant and the Trademark Examining Attorney have fully briefed this appeal, but 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, 15 U.S.C. § 1052(e)(1), 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. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). See also *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) [A "mark is merely descriptive if the ultimate consumers immediately associate it with a quality

or characteristic of the product or service"]. Hence, the ultimate question before us is whether this term conveys information about a significant quality or characteristic of applicant's goods with the immediacy and particularity required by the Trademark Act.

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); and In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986).

The question of whether a particular term is merely descriptive is not decided in the abstract. That is, when we analyze the evidence, we must keep in mind that the test is not whether prospective purchasers can guess what applicant's goods are after seeing applicant's mark alone. In re Abcor, *supra* at 218 ["Appellant's abstract test is deficient - not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as required by statute"]; In re Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990); and

*In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). Rather, the proper test in determining whether a term is merely descriptive is to consider the alleged mark in relation to the goods or services for which registration is sought, the context in which the mark is used, and the significance that the mark is likely to have on the average purchaser encountering the goods or services in the marketplace. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792 (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).

Applicant argues that the term "soft" does not have a well-defined meaning in the context of applicant's goods, and moreover, that when the two separate terms, "soft" and "tarp" are combined, the resulting composite is not merely descriptive of the identified goods. By contrast, the Trademark Examining Attorney contends that the term "soft" is clearly descriptive of at least one feature or quality of applicant's flexible tarpaulins, or "tarps."

Citing to twenty-one definitions of the word "soft,"<sup>2</sup>  
applicant argues that given the many definitions of the

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- <sup>2</sup> **soft** 1 giving away easily under pressure, as a feather pillow or moist clay  
2 easily cut, marked, shaped, or worn away, as pine wood or pure gold  
3 not hard for its kind; not as hard as is normal, desirable, etc.  
4 smooth or fine to the touch, not rough, harsh or coarse  
5 **a)** bland; not acid, sour, or sharp **b)** easy to digest because free from roughage  
6 nonalcoholic; said of drinks  
7 having in solution few or none of the mineral salts that interfere with the lathering and cleansing properties of soap  
8 mild, gentle, or temperate, as a breeze, the weather, climate, etc.  
9 **a)** weak or delicate; not strong or vigorous **b)** having flabby muscles  
10 requiring little effort; easy  
11 **a)** kind or gentle, esp. to the point of weakness; lenient or compassionate **b)** easily impressed, influenced, or imposed upon  
12 not bright, intense, or glaring; subdued: said of color or light  
13 showing little contrast or distinctness; not sharp in lines, tones, focus, etc.  
14 gentle; low; not loud or harsh: said of sound  
15 based on data from interviews, surveys, etc., rather than from controlled, repeatable experiments  
16 replenished by nature, or capable of being used with relatively little damage to the environment  
17 providing information other than the basic facts of a news story  
18 Finance **a)** unstable and declining **b)** not readily accepted as foreign exchange **c)** having very favorable terms  
19 *Mil.* Above ground and vulnerable: said of targets or bases  
20 *Phonet.* **a)** designating *c* sounded as sounded in voice org sounded as in age  
21 Radiology of low penetrating power: said of X-rays

WEBSTER'S NEWWORLD DICTIONARY, THIRD COLLEGE EDITION.

term soft, prospective purchasers might actually "conjure up an arbitrary connotation of the overall mark SOFTARP." Applicant's appeal brief, p. 5. The Trademark Examining Attorney points out that "descriptiveness is considered in relation to the relevant goods," adding that,

[t]he fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness. In re Chopper Industries, 222 USPQ 258 (TTAB 1984); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979); In re Champion International Corp., 183 USPQ 318 (TTAB 1974); TMEP §1209.03(e). Given that applicant has conceded that "a tarp may be soft," see Applicant's Brief at 4, the descriptiveness of the term "soft" in relation to tarps is apparent.

Trademark Examining Attorney's brief, unnumbered p. 3.

Applicant does, in fact, argue that "softness is not a defining feature" of its goods:

Nothing in the definition of a tarp as set forth above suggests that a tarp is or need be soft. While a tarp may be soft, "softness" is not a defining feature of a tarp. To the contrary, the Applicant submits that the many definitions of the term "softness" require the buyer to use imagination to determine any relationship between the term "soft" and the quality or characteristics of a tarp. The Applicant respectfully submits that the mark SOFTARP does not provide a direct message about the quality or characteristics of a tarp.

Applicant's brief, p. 4.

The Trademark Examining Attorney covered that line of argument by stating:

... Under such logic, however, similarly descriptive terms such as REDTARP or SMALLTARP would not be found descriptive of red or small tarps, since redness and/or smallness are not necessarily considered "defining features" of tarps. Of course, such is not the standard - it is well settled that a term need not describe all of the purposes, functions, characteristics or features of the goods to be merely descriptive. For the purpose of a Section 2(e)(1) analysis, it is sufficient that the term describe *only one attribute* of the goods to be found merely descriptive. In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982); In re MBAssociates, 180 USPQ 338 (TTAB 1973); TMEP §1209.01(b). In the present case, the term "SOFT" is descriptive of at least one quality of applicant's goods - softness. To the extent that applicant provides "soft" tarpaulins (likely, given the "flexible" identification of applicant's goods), the term "soft" merely describes a feature of applicant's goods.

Trademark Examining Attorney's brief, unnumbered pp. 3 - 4 (*emphasis* in the original).

Our primary reviewing Court also makes it clear that a mark need not describe the full scope of the applicant's goods in order to be found merely descriptive. In re Oppendahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1371-72 (Fed. Cir. 2004). For example, to the extent applicant's tarpaulin for "covering, lining, or separating" may have one side that is "smooth to the touch" (from

dictionary definition), "soft" would seem to be a salient feature of such a tarp.

Another tenet of trademark law is that when two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. See In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1988) [SCREENWIPE generic for wipes that clean computer and television screens]; In re Tower Tech, Inc., 64 USPQ2d 1314, 1318 (TTAB 2002) [SMARTTOWER merely descriptive of commercial and industrial cooling towers]; and In re Sun Microsystems Inc., 59 USPQ2d 1084, 1087 (TTAB 2001) [AGENTBEANS merely descriptive of computer programs for use in development and deployment of application programs].

Here, we agree with the Trademark Examining Attorney that the combination of the terms "soft" and "tarp" creates no double entendre, ambiguity or unique commercial impression so as to remove the mark from the category of

being merely descriptive when used in connection with flexible tarpaulins. That is, as used in the common parlance, the composite phrase immediately, and without conjecture, describes a salient quality or characteristic of tarps. As noted by the Trademark Examining Attorney, “[c]learly, a ‘soft tarp’ would consist of a more pliant covering, capable of fitting over irregularly-shaped objects more easily, while less likely to damage said objects.” Trademark Examining Attorney’s brief, unnumbered p. 3.

As was also pointed out by the Trademark Examining Attorney, the telescoped nature of applicant’s mark, as amended, does not diminish the overall descriptiveness of its mark.<sup>3</sup>

Finally, applicant relies on third-party registrations that it contends are similar to its mark, which demonstrate “a clear and consistent pattern of registrations published by the Trademark Office” in support of its contention that marks such as SOFTARP are not merely descriptive.

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<sup>3</sup> In light of the evidence that the term “first tier” describes a class of banks, applicant’s composite design mark (shown to the right) was refused in the absence of an appropriate disclaimer. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987).



<b>SOFTNET</b>	for "knitted pallet wrap plastic netting" in International Class 22; <sup>4</sup>
<b>SOFT-FENCE</b>	for "area enclosure netting" in International Class 22; <sup>5</sup>
<b>SOFTBAND</b>	for "lanyards for holding identification badges around a person's neck" in International Class 22; <sup>6</sup>
<b>SOFT SIDES</b>	for "hammocks" in International Class 22; <sup>7</sup>
<b>SOFT SHAPES</b>	for "polyester stuffing fiber and polyester fiber batting" in International Class 22; <sup>8</sup> and
<b>SOFLIFT</b>	for "nylon and polyester web slings for towing and recovery of vehicles" in International Class 22. <sup>9</sup>

However, the Trademark Examining Attorney finds applicant's reliance on these third-party registrations to be misplaced:

In general, third-party registrations are not conclusive on the question of

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<sup>4</sup> Reg. No. 1744576 issued on January 5, 1993 claiming use anywhere and use in commerce since at least as early as April 24, 1992. Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged; renewed.

<sup>5</sup> Reg. No. 1472333 issued on January 12, 1988 claiming use anywhere and use in commerce at least as early as September 1986. Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

<sup>6</sup> Reg. No. 2651425 issued on November 19, 2002 claiming use anywhere and use in commerce at least as early as September 1997.

<sup>7</sup> Reg. No. 2806502 issued on January 20, 2004 claiming use anywhere at least as early as July 26, 1992 and use in commerce at least as early as August 17, 1992.

<sup>8</sup> Reg. No. 1853677 issued on September 13, 1994 claiming use anywhere and use in commerce at least as early as June 1978. Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged; renewed.

<sup>9</sup> Reg. No. 1540562 issued on May 23, 1989 claiming use anywhere and use in commerce at least as early as April 1, 1988. Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

descriptiveness. The examining attorney must consider each case on its own merits. A mark which is merely descriptive is not registrable merely because other similar marks appear on the register. In re Scholastic Testing Service, Inc., 196 USPQ 517 (TTAB 1977). Indeed, none of the referenced third-party registrations include tarpaulin-type covers. Thus, such registrations are of no relevance to the facts at hand.

Of course, the fact that third parties registered marks containing the leading element SOFT (or SOF-) for other unrelated products in International Class 22, is not persuasive of a different result herein. Suffice it to say that these registrations are of little help in determining the registrability of the mark at issue in this case. We are not convinced that the instant case (e.g., SOFT plus clearly generic designation for goods, where "soft" has an obvious meaning) fits into "a clear and consistent pattern" established by these registrations, as argued by applicant. As has often been noted by the Board, each case must be decided on its own set of facts. None of these marks involved this particular combination of terms, or these same goods, and thus the facts in those records (to which we are not privy) would obviously be different. Moreover, even if the

situations of these third-party registrations appeared to be close to the facts of the current case, the Board is not bound by actions taken by Trademark Examining Attorneys. In re National Novice Hockey League, Inc. 222 USPQ 638, 641 (TTAB 1984) and In re Scholastic Testing Service, Inc., 196 USPQ 517, 519 (TTAB 1977). While uniform treatment under the Trademark Act is highly desirable, our task here is to determine, based upon the record before us, whether applicant's asserted mark is registrable.

*Decision:* We find the well-crafted arguments of the Trademark Examining Attorney to be most convincing, and hence, his refusal to register this mark on the Principal Register based upon Section 2(e)(1) of the Lanham Act is hereby affirmed.