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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Escaleras, S. De R. L. De C. V.

Serial No. 78453014

John S. Egbert and Jeremy Craft of Harrison & Egbert for
Escaleras, S. De R. L. De C. V.

Carol Spils, Trademark Examining Attorney, Law Office 101 (Chris
Doninger, Managing Attorney).

Before Seeherman, Hohein and Holtzman, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Escaleras, S. De R. L. De C. V. has filed an
application to register the term "ONE STEP" on the Principal
Register in the stylized form shown below for "metal ladders and
metal step stools" in International Class 6.¹

*One
Step*

Registration has been finally refused under Section
2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the
ground that, when used in connection with applicant's goods, the
term "ONE STEP" is merely descriptive thereof.

¹ Ser. No. 78453014, filed on July 19, 2004, which is based on an
allegation of a bona fide intention to use such term in commerce.

Applicant has appealed and briefs have been filed. We affirm the refusal to register.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, 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 or is intended to be 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 such use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Applicant, in its brief, asserts that when used in connection with its metal ladders and metal step stools, its

stylized "ONE STEP" mark "is incongruous, susceptible to multiple connotations, or requires imagination, cogitation or gathering of further information in order for the relevant public to perceive any significance of the mark as it relates to a significant aspect of the Applicant's goods." Although impermissibly arguing that in the abstract, rather than in the context of metal ladders and metal step stools, the "relevant public could not possibly infer from the mark alone that the mark is for these goods," applicant also maintains that instead of connoting "a ladder with one step," as contended by the Examining Attorney, its mark is no more than suggestive of such goods. Specifically, applicant insists that:

Applicant has created a coined and suggestive mark in which "ONE STEP" ... is suggestive of the term "ONE STOP SHOPPING" which is often used in conjunction with shopping and various other services and goods to describe something that takes care of every need. The term "ONE STEP" is not a common descriptive term in today's lexicon, nor does it describe the actual composition of the goods. Without the gathering of further information, the relevant public would believe the mark to be either arbitrary, fanciful or suggestive.

Applicant, in particular, urges that "[t]he suggestiveness of the term 'ONE STEP' is that the Applicant's goods are a 'ONE STOP' good in that a consumer would not need any other ladder for all of their ladder uses and needs." While also asserting that "[t]he mark 'ONE STEP' could convey to the ordinary consumer a wide variety of meanings," applicant has not set forth any plausible examples thereof, arguing instead that its "use of the ... mark 'ONE STEP' would not deprive competitors of proper descriptions of their goods" inasmuch as "[a]n infinite amount of

other terms could easily be employed to describe and serve as an identifier of source for the competitor's goods."

In addition, with respect to the evidence made of record by the Examining Attorney to support her position, applicant contends that:

The LEXIS-NEXIS excerpts provided by the Examiner shows [sic] that a total of eight news stories (five are repeats of the same story) throughout the U.S. contain the use of the term "ONE STEP" as describing a one-step stool of various uses. However, there is no direct evidence that this alleged type of stool or ladder has achieved any degree of success or popularity or that the public is familiar with the use of the "ONE STEP" term as descriptive of a type of ladder or stool. The Examiner did not provide any evidence in this case of commercial use in catalogs and promotional material which would show that purchasing consumers would understand the use of the term "ONE STEP" as being merely descriptive. The Examiner's search of all news stories in the United States only shows eight particular uses of the term "ONE STEP." The mere use of loose language, slang and colloquialism in eight lifestyle news articles is hardly evidence that the primary significance of a term is descriptive. On the contrary, it would appear that the use of the term "ONE STEP" to describe a stool or ladder is exceedingly rare. In short, this limited evidence provided by the Examiner fails to establish that purchasers of Applicant's goods would understand "ONE STEP" to represent a ladder or stool which only has one step.

The Examining Attorney, on the other hand, argues in her brief that, when used in connection with metal ladders or metal step stools, "the proposed mark describes a **feature or characteristic** of the goods, which are 'one step ladders or 'one step stools, or ladders or stools with one step" (emphasis in original). Requesting that the Board take judicial notice of the

following definitions from The American Heritage Dictionary of the English Language (3rd ed. 1992),² the Examining Attorney maintains that (footnotes omitted):

Dictionary definitions alone support the descriptive nature of the [mark as applied to] the goods. ONE is defined as "Being a single entity, unit, object, or living being; not two or more." STEP is defined as "(a.) A rest for the foot in ascending or descending. (b.) Steps, Stairs. (c.) Something, such as a ledge or an offset, that resembles a step of a stairway."

The Examining Attorney also relies upon 11 of the 12 excerpts which she retrieved from her search of the "LEXIS/NEXIS" computer database, and made of record with her final refusal, in support of her finding of mere descriptiveness.³ Of those excerpts, the following are illustrative (emphasis added):

"Miller suggests a small, **one-step stool** for a grown-up boost." -- Orlando Sentinel (Florida), June 15, 2005;

"Police are investigating the theft of two, **one-step stools** valued at \$250 each." -- Star-Gazette (Elmira, New York), June 8, 2005;

"A sturdy **one-step stool**." -- Duluth News-Tribune (Minnesota), March 22, 2003;

² Inasmuch as the Board may properly take judicial notice of dictionary definitions, the request is granted. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 n.7 (TTAB 1981).

³ Specifically, the Examining Attorney ran the search request "ONE STEP STOOL" using the "NEWS" library. While the result thereof indicates that 13 stories were actually located which satisfy the search criteria, the record contains excerpts from only 12 of such stories. However, with but one exception, all of the excerpts of record are clearly pertinent to the issue of mere descriptiveness.

"If you have no other choice other than to use a 4X4 vehicle, I would suggest carrying a sturdy **one-step stool** and making sure that you hold on securely to your senior passenger as he or she enters and exits." -- Sacramento Bee, November 1, 2002;⁴

"Two-step stool, plus a **one-step stool** for reaching closet shelves, Kmart, \$15.99." -- Contra Costa Times (California), February 3, 2001;⁵

"A white, compact **one-step stool** (\$16.99, Linens 'n Things) will fit into any size closet." -- St. Louis Post-Dispatch, March 28, 1998; and

"Use a sturdy **one-step stool** with a hand rail if you must climb." -- Pantagraph (Bloomington, Indiana), March 10, 1997.

With respect to applicant's assertion that its mark may convey a wide variety of meanings to consumers for its goods, the Examining Attorney, citing *In re Chopper Industries*, 222 USPQ 258, 259 (TTAB 1984), observes in her brief that "[t]he fact that a term may have other different meanings in other contexts is not controlling on the question of [mere] descriptiveness." As to applicant's argument that its mark for its goods "is suggestive of the term 'ONE STOP SHOPPING' which is often used in conjunction with shopping and various other services and goods to describe something that takes care of every need," the Examining Attorney points out in response that:

⁴ Essentially the same excerpt, with the sole difference being the substitution of the phrase "loved one" for "senior passenger," also appeared in the Atlanta Journal-Constitution, (October 25, 2002), and in two separate sections ("Financial Pages" and "Lifestyle") of the Cox News Service, (October 24, 2002).

⁵ The same excerpt also appeared in the Daily News of Los Angeles, (January 27, 2001).

Applicant provides no evidence that consumers would view "ONE STEP" like "ONE STOP". Moreover, unlike "ONE STOP" for retail services and goods, "ONE STEP" actually describes a feature or characteristic of the relevant goods in this case. The determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *In re Polo International Inc.*, 51 USPQ2d 1061 (TTAB 1999) (Board found that DOC in DOC-CONTROL would be understood to refer to the "documents" managed by applicant's software, not "doctor" as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (CONCURRENT PC-DOS found merely descriptive of "computer programs recorded on disk," [in that] it is unnecessary that programs actually run "concurrently," as long as relevant trade clearly uses the denomination "concurrent" as a descriptor of this particular type of operating system); ... TMEP §1209.01(b).

Lastly, concerning applicant's argument that there is no competitive need for third parties to utilize the term "ONE STEP," the Examining Attorney maintains that the "LEXIS/NEXIS" evidence "indicates that other businesses need the freedom to use the term 'ONE STEP' when describing their goods to the public in advertising and marketing materials."

Upon consideration of the arguments and evidence presented, we agree with the Examining Attorney that the term "ONE STEP" is merely descriptive of applicant's goods. Such term immediately conveys, without the need for speculation, imagination or conjecture, that a significant feature or characteristic of applicant's "metal ladders and metal step stools" is that they have one step rather than several steps. Plainly, when viewed in the context of applicant's goods, there is nothing in the term "ONE STEP" which is incongruous, ambiguous

or even suggestive, nor is there anything which would necessitate the gathering of further information, in order for the merely descriptive significance thereof to be readily apparent to consumers of applicant's goods. Nothing in such term even remotely suggests that customers for metal ladders and metal step stools regard such term, according to applicant, as connoting "a 'ONE STOP' good" in the sense that "consumer[s] would not need any other ladder for all of their ladder uses and needs."

Instead, the term "ONE STEP" merely describes, with the requisite particularity, a significant feature or characteristic of applicant's goods, namely, their single or one step. In particular, and contrary to applicant's contentions, the term "ONE STEP" appears to be in common or everyday use to describe metal step stools and step ladders of the one-step variety which are available, for instance, from retailers such as Kmart and Linens 'n Things. Moreover, even though the record does not disclose any examples of use of the term "ONE STEP" by possible competitors of applicant, it is well settled that even if applicant may be or intends to be the first and/or sole user of a merely descriptive term as its mark, such does not entitle it to registration thereof where, as here, the evidence of record demonstrates that the term projects only a merely descriptive significance in the context of applicant's goods.⁶ See, e.g., In

⁶ Applicant, in its brief, notes that it has "offered to amend the present application to the Supplemental Register if the Examiner was not convinced by the arguments that the mark is not merely descriptive of the goods." However, as the Examining Attorney points out in her brief, such an amendment "may be considered only upon filing" and "to date, applicant has repeatedly elected not to file ... an allegation of use or an election to the Supplemental Register." Suffice it to

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re National Shooting Sports Foundation, Inc., 219 USPQ 1018, 1020 (TTAB 1983); and In re Mark A. Gould, M.D., 173 USPQ 243, 245 (TTAB 1972).

Decision: The refusal under Section 2(e)(1) is affirmed.

say that, at this juncture, Trademark Rule 2.142(g) provides in relevant part that, with certain exceptions not pertinent hereto, "[a]n application which has been considered and decided on appeal will not be reopened" for further prosecution.