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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Merillat Industries, LLC

Serial No. 78563328

Edgar A. Zarins, Masco Corp. for applicant.

Paul E. Fahrenkopf, Trademark Examining Attorney, Law Office
101 (Ronald R. Sussman, Managing Attorney).

**Before Bucher, Walsh, and Mermelstein, Administrative
Trademark Judges.**

Opinion by Mermelstein, Administrative Trademark Judge:

Merillat Industries, LLC has filed an application to register on the Principal Register the mark SOFTACTION in standard character form for (as amended) "cabinet hardware, namely, metal door guide" in International Class 6.¹

The examining attorney has issued a final refusal to register, under Trademark Act § 2(e)(1), 15 U.S.C. § 1052(e)(1), on the ground that applicant's mark is merely descriptive in connection with the identified goods.

¹ Serial No. 78563328, filed February 9, 2005, based on an allegation of a bona fide intention to use the mark in commerce.

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We reverse the refusal to register.

Issue

The examining attorney's argument is set out in his brief:

"Soft" is defined, *inter alia*, as "demanding little work or effort."
"Action" is defined, *inter alia*, as "an operating mechanism" and "the manner in which a mechanism or instrument operates." ... Thus, "action" is clearly descriptive of applicant's goods. "Soft" in this context is, in essence, a laudatory term. Laudatory terms, i.e., those terms that attribute quality or excellence to the goods or services, are considered descriptive terms under Trademark Act Section 2(e)(1)... That is, laudatory terms, phrases and slogans are nondistinctive and unregistrable without proof of acquired distinctiveness. ... Thus, SOFTACTION, as applied to applicant's goods, would mean that the drawer guide mechanisms demand little work or effort to operate.

Examiner's Br. at 2 (citations omitted). Thus, the examining attorney argues, SOFTACTION is descriptive of applicant's cabinet hardware because it indicates that the goods require little effort to use.

Evidence

In support of the refusal, the examining attorney made several internet web pages of record with his first office action:²

1. Heavy duty locks and latches

HL72' Modular Lock System is a full suite of heavy duty mortise locks and latches designed to support the entire Allgood range of levers, knobs and other unsprung furniture. The range is suitable for general commercial and heavy industrial use. Offering complementary build quality, design integrity, and choice of external finishes, HL guarantees the perfect match between form and function whenever you specify Allgood architectural ironmongery.

* * *

Two way soft action mechanism in locks and latches for knob furniture - allows easy and convenient operation.

www.allgood.co.uk/graphics/products/2004_pdf/72_series.pdf.

(Sept. 7, 2005).

2. Gemini Professional Top Load CD Player CDJ-01

Pro. Top Load CD Player / Instant start / Soft action door opening / Variable pitch control - 4%, 8%, 16% / 3-year warranty / 1 year warranty on lasers ... more info

www.jr.com/JRProductPage.process?Product=4023827 (Sept. 7,

2005).

3. Build a simple, soft-action muting switch

² Emphasis added in each instance.

* * *

The circuit in **Figure 1** adds a soft-muting switch with power-up/power-down muting to a line-level audio circuit.

www.ednasia.com/article.asp?articleid-1401 (Sept. 7, 2005).

4. Felco F-2 "The Original" Hand Pruner

* * *

Amazon.com Review

Ideal for trimming rose bushes and woody perennials, the Felco Original's smooth, soft action, ergonomic comfort, and exceptional durability put it in a class of its own. * * *

-Mary Park

www.amazon.com/exec.obidos/tg/detail/-/B00023RYS6/103-4124407-0303011?v=glance (Sept. 7, 2005).

- 5. **Pneumatic Shutter Drive:** The PSD ... is a pneumatically driven actuator with a soft start and stop motion. The PSD is equipped with two switches to detect the final positions. The moving angle is adjustable. The speed is due to the used air pressure. The actor is easy to mount and unmount for baking. This drive is usable for shutters and other applications.

Technical Data			
Type	ESD	Type	ESD
Flange	NW 16 CF	Flange	NW 16 CF
Length	240 mm (air side)	Length	178 mm (air side)
Max width	75 mm	Moving Angle	0° ... 180°
Weight	880 g (feedthrough included)	Baking Temperature	250°C (after unmounting the electric motor)
Drive voltage	0 ,, 24 VDC or as specified	Drive voltage	NW 16 CF/NW 40 CF/NW 63 CF
Baking temperature	250°C (after unmounting the electric motor)	Soft action shutter drive	Optional

www.specs.com/products/MBE/MBE-Components/shutters

/shutter_drives/shutterdrive.htm (Sept. 7, 2005).

The examining attorney also referred to dictionary definitions of "soft" and "action" in his first office action, although the definitions were not attached to the office action. It appears that the examining attorney attempted to attach this evidence to his office action, but was unsuccessful for some reason. Nonetheless, the Board may take judicial notice of such sources on appeal, *E.g.*, *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). In doing so, we note that although the incomplete reference was attached to the first office action, applicant did not object to or question this evidence throughout prosecution or on appeal. Moreover, it does not appear that applicant disputes the common definition of these terms, but rather argues that its mark as a whole is not descriptive of the identified goods.

Accordingly, we take judicial notice of the following definitions from www.m-w.com, the source referred to by the examining attorney.

6. **soft**
 * * *
 2: demanding little work or effort :
 easy <a soft job>

7. **action**
 * * *

7 **a:** an operating mechanism **b:** the manner in which a mechanism or instrument operates

www.w-m.com (last visited August 24, 2007).

Finally, in his brief, the examining attorney requested that the Board take judicial notice of another sense of the term "soft," apparently taken from the same dictionary as items 6 and 7 above.³ However, because this internet evidence was presented for the first time on appeal, and was not actually attached to the examining attorney's brief, we deny the examining attorney's request for judicial notice. *Compare In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002) (judicial notice taken of internet evidence attached to appeal brief where record indicates online resource is available in book form).

Applicant did not submit any evidence.

Applicable Law

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re*

³ Again, the examining attorney stated that a copy of the definition was attached to his appeal brief, but as was the case with the definitions attached to the first office action, it appears that the attachment was unsuccessful because the only attachment to the brief in the Board's record is a page with the www.m-w.com URL, but no definition.

Serial No. 78563328

Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, or function of the goods. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

Discussion

Applicant's argument is set out in its brief:

The Examining Attorney refused registration of applicant's mark SOFTACTION asserting that the proposed mark merely describes a characteristic of applicant's goods. The Examining Attorney maintains that the term defines devices that "demand little work or effort in their use." The goods identified by the mark are guides used to control the movement of drawers in a cabinet. By their very nature, cabinet drawers are not difficult to operate and therefore there would be no need to add cost and complexity to a drawer to make them more effortless to operate. Although previous users of the term may have used it to describe the ease of operation of their device, the same does

not automatically apply to applicant's goods.

The Examining Attorney maintains that it is undisputed that "soft" is defined as "demanding little work or effort." However, the SOFTACTION system has no bearing on the work or effort it takes to operate the cabinet drawer. The SOFTACTION system is a closing mechanism built into the drawer guides to facilitate closure of the drawer without rattling the contents of the drawer or creating excessive wear on the drawer assembly. The Examining Attorney has mischaracterized the mark to fit within the evidence of prior uses of similar terms.

App. Br. at 1.

We find that the evidence of record is insufficient to support the refusal in this case. While the dictionary definitions of "soft" and "action" might possibly support a descriptiveness refusal as applied to different goods, a descriptiveness refusal under Trademark Act § 2(e)(1) cannot be made upon an abstract analysis of the mark. Rather, descriptiveness must be determined in relation to the goods identified in the application. *In re Recovery*, 196 USPQ at 831.

To begin with, We disagree with the examining attorney's assertion that the term "soft" is laudatory as applied to applicant's goods. Laudatory terms are those which attribute a level of quality or excellence to the goods at issue. As demonstrated by the cases cited in the examining attorney's brief, laudatory marks typically

Serial No. 78563328

include terms such as "ultimate," *In re Nett Designs, Inc.*, 236 F.2d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001), "best," *In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999), or "super," *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995). Apart from their attribution of quality, such terms do not otherwise describe attributes of the goods.

The examining attorney argues that "soft," as applied to the applicant's goods, indicates that the goods require little effort or are easy to use. But even if this is correct, such a use of "soft" does not indicate that applicant's goods are better or more desirable than any other such goods. Accordingly, our analysis does not focus on whether "soft," as used in applicant's mark is laudatory, but rather whether "soft" and the mark as a whole, is descriptive in the usual sense.

Applicant seeks registration of SOFTACTION as a trademark for cabinet hardware. Although the examining attorney speculates that the mark indicates that applicant's goods take little effort to operate, there is nothing in this record to indicate that cabinet drawers in general or the particular drawers for which applicant's goods are made are difficult to operate. As applicant argues, whatever the meaning of SOFTACTION (or "soft" and "action") may be as

applied to other goods, the examining attorney's theory makes little sense as applied to the goods at issue here.

The web pages submitted by the examining attorney do not support a different result. Of the five references attached to the first office action, four appear to refer to goods far afield from those of the applicant. The closest piece of evidence, from www.allgood.co.uk, mentions "soft action" in the context of locks for furniture: "Two way soft action mechanism in locks and latches for knob furniture - allows easy and convenient operation." But whatever the need or desirability of "easy and convenient operation" for locks, it is not apparent from the evidence or argument that the same applies to drawers, or that a passing reference to "soft action" on a foreign⁴ website is sufficient to meet the Office's burden of showing that the mark immediately conveys this information to the potential purchaser.

⁴ The relevant inquiry is whether consumers in this country would consider the mark descriptive. While foreign web sites may be considered as evidence, *In re Remacle*, 66 USPQ2d 1222 (TTAB 2002) ("It is reasonable to assume that professionals in medicine, engineering, computers, telecommunications and many other fields are likely to utilize all available resources, regardless of country of origin or medium."), it does not seem likely that many purchasers of cabinet hardware or locks for furniture would spend appreciable time perusing the web sites of foreign vendors the way that professionals in highly technical jobs keep abreast of foreign developments in their field. But even when it is appropriate to consider such materials, caution is in order because English usage differs significantly from country to country. Accordingly, while we have considered this evidence,

Serial No. 78563328

Decision: The refusal under Section 2(e)(1) of the Act is reversed.

under these circumstances we feel it is entitled to little weight in determining the meaning of SOFTACTION in the U.S.