

**THIS OPINION IS NOT A  
PRECEDENT OF THE T.T.A.B.**

Mailed:  
May 21, 2008

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**  
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In re The Sherwin-Williams Company  
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Serial No. 78571661  
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Robert E. McDonald, Esq. of The Sherwin-Williams Company.

Priscilla Milton, Trademark Examining Attorney, Law Office  
110 (Chris A.F. Pedersen, Managing Attorney).

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Before Walters, Holtzman and Bergsman, Administrative  
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

The Sherwin-Williams Company filed an intent-to-use application for the mark BUILDERS PREMIUM, in standard character format, which it amended to BUILDER'S PREMIUM, in standard character format, for "protective and decorative coatings in the nature interior and exterior paint," in Class 2.<sup>1</sup>

The Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act of 1946, 15 U.S.C.

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<sup>1</sup> Serial No. 78571661, filed February 21, 2005. On April 20, 2006, applicant filed an amendment to allege use claiming April 6, 2006 as applicant's dates of first use anywhere and first use in commerce.

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§1052(e)(1), on the ground that the mark BUILDER'S PREMIUM, when used in connection with applicant's products, is merely descriptive. The Examining Attorney contended that the mark BUILDER'S PREMIUM is merely descriptive because the applicant has combined two descriptive terms that directly conveys information about the goods.

Specifically, the Examining Attorney argued that BUILDER'S PREMIUM identifies the customers who purchase applicant's paint products (*i.e.*, builders) and the quality of the paints (*i.e.*, high quality paint). To support her refusal, the Examining Attorney submitted the following evidence:

1. A dictionary definition of the word "premium" defined as "an unusual or high value" and "of superior quality or value."<sup>2</sup>

2. Two third-party registrations for paint products that include the word "Builders" where the exclusive right to use "Builders" has been disclaimed:<sup>3</sup>

<b>Registration No.</b>	<b>Mark</b>
2340334	BUILDERS SELECT
2966717	BUILDERS SOLUTION

<sup>2</sup> The American Heritage Dictionary of the English Language (3<sup>rd</sup> ed. 1992).

<sup>3</sup> The Examining Attorney also submitted a copy of application Serial No. 78268059 for the mark BUILDER'S EDGE (published for opposition). Because the exhibit submitted by the Examining Attorney does not show that the application has registered, we have not given it any consideration. Applications are evidence only that an application has been filed.

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3. Four third-party registrations for paint products that include the word "Premium" where the exclusive right to use "Premium" was disclaimed:

Registration No.	Mark
1645737	PREMIUM PLUS
2009338	CABOT STAINS PREMIUM QUALITY FOR LONG LASTING PROTECTION
2516484	HOESCH PREMIUM
2984666	THYBONY STOCKHOLM PREMIUM FINISHES

4. Excerpts from six (6) news articles referencing premium quality paints (e.g., "Paint manufacturer Benjamin Moore & Co. . . . sells 2-oz. sample sizes of its premium Regal line of interior paints").

5. Excerpts from seven (7) paint manufacturer's web sites that use the word "premium" to describe the quality of paint.

6. An excerpt from the Forrester Wehrle Homes web site ([www.forresterwehrle.com](http://www.forresterwehrle.com)), a home builder, which describes its interior painting as follows: "Interior surfaces painted and/or stained with Sherwin Williams Builders Premium Grade."

7. An excerpt from applicant's web site with a section featuring paint products for home builders. One of the products is BUILDERS SOLUTION.<sup>4</sup>

8. An excerpt from the AEC DAILY.com web site that identifies architectural products and resources. The web site identifies applicant as a source of paint products for builders, designers, specifiers, property managers and contractors.

9. An April 13, 2006 press release on the buildingonline.com web site indicating that Pulte Homes, a builder, signed a five-year agreement with applicant as its exclusive provider of paint products.

10. An excerpt from applicant's web site touting applicant's BUILDERS SOLUTION interior coating:

Sherwin-Williams Builders Solution Interior Coating System - which includes a latex surfacer and latex topcoat - just got even better with a reformulated flat topcoat that offers the ultimate in touch-up when compared with traditional flat coatings. With the BUILDERS SOLUTION System, homebuilders and painting contractors can now virtually eliminate the common complaints of poor wall appearance due to drywall imperfections and paint touch-ups.

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<sup>4</sup> The copy of Registration No. 2966717 for the mark BUILDERS SOLUTION submitted by the Examining Attorney shows SWIMC, Inc., not applicant, as the owner of the registration.

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For over 135 years, Sherwin-Williams has satisfied the coating and color needs of painting contractors, designers, specifiers, property managers and builders.

To show that its BUILDER'S PREMIUM mark is suggestive, applicant submitted copies of six registrations in Class 2 "that incorporated either BUILDER(S) or PREMIUM in the overall marks without **requiring a disclaimer of either of these terms.**" (Emphasis in the original).<sup>5</sup>

Registration No.	Mark
1889110	BUILDER'S FINEST
2348665	BUILDER'S SPEC
1884482	BUILDER PERFECT (Cancelled)
2091178	BUILDER PREFERRED (Cancelled)
2264671	PREMIUM DÉCOR
1881080	PREMIUM POLYESTER

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the services with which it is used. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a particular term is merely

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<sup>5</sup> These registrations were attached to applicant's brief. Although Trademark Rule 2.142(d), 37 CFR 2.142(d), requires that the record be complete prior to the appeal, because the Examining Attorney did not object to the late submission and, in fact, discussed the evidence, we will consider the registrations for whatever probative value they may have.

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descriptive is determined in relation to the products for which registration is sought and the context in which the term is 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 USPQ2d 1222, 1224 (TTAB 2002). In other words, the issue is whether someone who knows what the products are will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 USPQ2d 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); *In re American Greetings Corp.*, 226 USPQ 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." *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978). See also, *In re Shutts*, 217 USPQ 363, 364-365 (TTAB 1983); *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980).

When descriptive terms are combined, a suggestive term may be formed if the compound mark in its entirety evokes a new and unique commercial impression that is not merely

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descriptive. However, if each component of the compound mark retains its merely descriptive significance in relation to the goods, without creating a unique or incongruous meaning, then the resulting combination is also merely descriptive. *In re Tower Tech., Inc.*, 64 USPQ2d at 1317-1318; *In re Disc Jockeys Inc.*, 23 USPQ2d 1715, 1716 (TTAB 1992).

When applicant uses the term BUILDER'S PREMIUM in connection with interior and exterior paints, it directly conveys that the paint is a high quality, builder's grade product. In the Forrester Wehrle web site, that builder used the term "Builders Premium" to describe the quality of paint ("Sherwin Williams Builders Premium Grade"). The two components of the term, the words "Builder's" and "Premium," retain their individual descriptive meanings. The combination of words forming applicant's mark BUILDER'S PREMIUM does not create an incongruous meaning or a new and different commercial impression from that created by the individual words "Builder's" and "Premium."

Applicant argued that BUILDER'S PREMIUM is suggestive because "[t]he mental translation of the mark 'BUILDER'S PREMIUM' to some suggestion of protective and decorative coatings requires imagination, thought or perception to

reach a conclusion as to the nature of the goods."<sup>6</sup> For example, applicant asserted that "a consumer who has never seen the goods and does not know what it (sic) is could not immediately determine that the mark 'BUILDER'S PREMIUM' refers to Applicant's protective and decorative coatings."<sup>7</sup>

The problem with applicant's analysis is that it starts with the mark BUILDER'S PREMIUM and asks whether the term BUILDER'S PREMIUM provides any hints that the goods are interior and exterior paints. As indicated *supra*, the proper analysis should start with the mark BUILDER'S PREMIUM and inquire whether that term describes interior and exterior paints. In this case, the evidence shows that the mark BUILDER'S PREMIUM describes applicant's paint products as a high quality, builder's grade product.

Applicant argued that the combination of "Builder's" and "Premium" is an incongruous or unusual term, and therefore it creates a suggestive, rather than descriptive mark.<sup>8</sup> It is applicant's contention that the combination of words is incongruous because it does not describe the

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<sup>6</sup> Applicant's Brief, p. 4.

<sup>7</sup> Applicant's Brief, pp. 4-5. See also applicant's arguments that "the consumer who is interested in obtaining protective and decorative coatings would first have to conclude that the combined terms 'BUILDER'S' and 'PREMIUM' even refer to a paint product." Applicant's Brief, p. 6.

<sup>8</sup> Applicant's Brief, p. 6.

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intended purchasers of the products (*i.e.*, builders).<sup>9</sup> Whether the mark describes the intended purchasers of applicant's paints is not dispositive of the descriptiveness issue. Applicant's mark, in its entirety, describes applicant's paint products as high quality, builder's grade paint whether it is purchased by builders, paint contractors, or home owners.

With respect to applicant's argument that "[t]here is nothing in the record from which to infer or substantiate that there is such a product category as BUILDER'S PREMIUM supplies, or that the term BUILDER'S PREMIUM has been used to describe similar goods,"<sup>10</sup> it is well established that the fact that applicant may be the first and only user of BUILDER'S PREMIUM does not alter its descriptive significance and bestow upon applicant any proprietary rights. *In re Sun Microsystems Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001); *In re Acuson*, 225 USPQ 790, 792 (TTAB 1985) ("A descriptive term used first or even only by an applicant is not registrable as long as the purchasing public perceives the term as describing goods"). A term need not be in common usage in a particular industry before

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<sup>9</sup> Applicant's argument is responsive to the Examining Attorney's contention that "Builder's" describes the intended user and that "Premium" is a laudatory term.

<sup>10</sup> Applicant's Brief, p. 7.

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it can be found to be merely descriptive. *In re Sun Microsystems Inc., supra.* Anyone who makes or sells interior and exterior paints may wish to use the term "builder's premium" to convey the fact that such goods are a high quality, builder's grade product.

Finally, with respect to applicant's argument that the third-party registrations incorporating the words "Builder" and "Premium" without a disclaimer prove that the mark BUILDER'S PREMIUM is suggestive, not merely descriptive,<sup>11</sup> we note that in determining the issue of descriptiveness, prior decisions are of little value because each case must be determined on its own facts. *In re Nett Designs Inc.,* 236 F.2d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to Nett Designs' application [LOAD LLAMA THE ULTIMATE BIKE RACK], the PTO's allowance of such prior registrations does not bind the Board or this court"]; *In re Quick-Print Copy Shop, Inc.,* 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980). We are obligated to decide this appeal based on the record before us.

It is therefore concluded that BUILDER'S PREMIUM is merely descriptive when used in connection with "protective

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<sup>11</sup> Applicant's Brief, p. 7.

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and decorative coatings in the nature interior and exterior  
paint."

Decision: The refusal to register is affirmed.