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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mutassem Halawi

Serial No. 78587753

Tama L. Drenski of Renner, Kenner, Greive, Bobak, Taylor & Weber for Mutassem Halawi.

Ray Thomas, Jr., Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw).

Before Quinn, Hohein and Bergsman, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Mutassem Halawi to register on the Principal Register the mark PIZZABOGO (in standard character form) for "restaurant services" in International Class 43.¹

The trademark examining attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that applicant's mark, if used in

¹ Application Serial No. 78587753, filed March 15, 2005, alleging a bona fide intent to use the mark in commerce.

connection with applicant's services, would be merely descriptive thereof.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.²

The examining attorney maintains that the proposed mark merely describes a feature or characteristic of applicant's restaurant services through which pizza is offered on a "buy one get one free" ("BOGO") basis. According to the examining attorney, the proposed compound mark is nothing more than a combination of the merely descriptive word "pizza" and the merely descriptive acronym "BOGO." In support of the refusal, the examining attorney introduced, inter alia, a dictionary definition of "pizza," an acronym dictionary listing for "BOGO," copies of third-party registrations of unitary marks comprising the formative word "PIZZA" followed by endings such as

² Applicant, with its appeal brief, submitted portions of the file history of a third-party application. The examining attorney objected to this submission as untimely. Trademark Rule 2.142(d) provides that the record in the application should be complete prior to the filing of an appeal, and that the Board will ordinarily not consider additional evidence filed after the appeal is filed. See TBMP § 1207.01 (2d ed. rev. 2004). Applicant referred to the third-party application in its request for reconsideration. The examining attorney, in denying the request, implicitly referred to this application. In view thereof, we have elected to consider the evidence to be of record in determining the merits of this appeal. TBMP § 1207.03 (2d ed. rev. 2004).

"-LETTO," "-NO," and "-TO," an excerpt from applicant's website, and excerpts from numerous third-party websites.

Applicant argues that his mark must be considered as a whole in determining the mere descriptiveness thereof, and that, when the mark is so considered, the refusal must be reversed. In making this argument, applicant contends that the examining attorney improperly dissected the mark, and that the derived combination of the definitions of "pizza" and "BOGO" results in a mark that is only suggestive, not merely descriptive. According to applicant, "[t]he distinctive nature of Applicant's lyrical, fun-to-say, catchy mark is much more than the sum of its parts."

(Appeal Brief, p. 3). Applicant argues that the formative "BOGO" would not be viewed by a reasonable consumer as an acronym when it appears, as in applicant's mark, as part of the larger term PIZZABOGO: "the composite unitary mark 'PIZZABOGO' would not be generally understood as representing 'pizza buy one get one' because the formative 'bogo' appears as an indivisible part of a unitary mark 'PIZZABOGO,' and thus loses any acronym character that it might otherwise have." (Appeal Brief, p. 5). Applicant asserts that it is rare to have a single term comprising a word and an acronym, as in the case of applicant's proposed mark, and that the examining attorney's evidence shows only

that BOGO has been used alone, but never in combination with another word to form a single term. Moreover, applicant argues, and in any event, the initials "BOGO" are not merely descriptive of applicant's services. In this connection, applicant points to two meanings of "BOGO" other than "buy one get one (free)," namely "beyond our galaxy online" and "buy one give one." Applicant offers a detailed critique of the examining attorney's evidence, acknowledging its "sheer volume," but contending that a close analysis shows only six uses of the terms "pizza" and "BOGO" in an adjacent manner. In support of his position, applicant submitted a TESS search report listing over 2,000 third-party registrations of marks comprising, in part, "PIZZA,"³ and copies of five third-party registrations of BOGO marks.

A term is 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*

³ Although applicant merely provided a list of the registrations, the examining attorney has considered the registrations to be of record. See *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1477 n. 6 (TTAB 1999); and TBMP § 1208.02 (2ed. rev. 2004).

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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); and *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 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 its use or intended use. That a term may have other meanings in different contexts is not controlling. *In re Polo International Inc.*, 51 USPQ2d 1061 (TTAB 1999); and *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). It is settled that:

...the question of whether a mark is merely descriptive must be determined not in the abstract, that is, not by asking whether one can guess, from the mark itself, considered in a vacuum, what the goods or services are, but rather in relation to the goods or

services for which registration is sought, that is, by asking whether, when the mark is seen on the goods or services, it immediately conveys information about their nature.

In re Patent & Trademark Services Inc., 49 USPQ2d 1537, 1539 (TTAB 1998).

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, e.g., In re Tower Tech, Inc., 64 USPQ2d 1314 (TTAB 2002) [SMARTTOWER merely descriptive of commercial and industrial cooling towers]; In re Sun Microsystems Inc., 59 USPQ2d 1084 (TTAB 2001) [AGENTBEANS merely descriptive of computer programs for use in development and deployment of application programs]; In re Putnam Publishing Co., 39 USPQ2d 2021 (TTAB 1996) [FOOD & BEVERAGE ONLINE merely descriptive of news information services for the food processing industry]; and In re Copytele Inc., 31 USPQ2d 1540 (TTAB 1994) [SCREEN FAX PHONE merely descriptive of facsimile terminals employing electrophoretic displays].

The term "pizza" is defined as "a baked pie of Italian origin consisting of a shallow breadlike crust covered with seasonal tomato sauce, cheese, and often other toppings, such as sausage or olives." (www.dictionary.com). The examining attorney also made of record a listing of the acronym "BOGO" showing it to mean "Buy One Get One." (www.acronymfinder.com).

The record includes an excerpt from applicant's website that shows applicant offers pizza with a "Buy 1 Get 1 Free" deal.

The examining attorney's evidence also includes numerous uses of the acronym "BOGO" in connection with a variety of goods and services. The following uses are representative of the website excerpts relied upon by the examining attorney:

Washington Post consumer columnist Margaret Webb Pressler writes: "I also got a huge response about the growing use of buy-one-get-one-free promotions, or BOGOs, as they're called in the industry...Shoppers don't understand why retailers offer this kind of promotion when it's no better for customers and no more profitable for stores than a half-price sale." On the contrary, BOGOs can be much more profitable for stores than a half-price sale...The BOGO doubles the store's profits!...Although BOGOs may make consumers worse off they generally increase total welfare... (www.marginalrevolution.com)

Two-for-One Dining Programs

...started bold BOGO (Buy one get one free) direct mail coupon inserts during 9 months of off season.
(www.restaurantreport.com)

Fundraiser cards come in all shapes and sizes, but all have the same concept...The cards have an offer or multiple offers on the back. Many of the cards have peel-off coupons with BOGO (Buy one, Get one) offers, free breadsticks with the purchase of a large pizza or a free two-liter with any pizza purchase..."Most of the offers are BOGO..."

(www.pmq.com)

BOGO

Another marketing incentive is the buy-one-get-one-free (BOGO) option. If you dine out with a spouse, colleagues, or a friend, consider eating out at restaurants offering a buy-one-get-one-free coupon.

(www.collegecentral.com)

Free BOGO Pizza Delivery

(www.birchbaychamber.com)

Miscellaneous Coupons

Erin's Coupon Swap

Domino's Pizza BOGO Free any Pizza
(www.home.earthlink.net/-n-side-out)

Domino's Pizza (BOGO)

(www.goodshepherdcollinsville.org)

Safeway Dec. 29-Jan 4

Red Baron classic, pan, or french bread pizza BOGO (3.99)

(www.pinchingyourpennies.com)

LDS Vacuum Shopper

BOGO SALE

BUY ONE GET ONE FREE

B.O.G.O. (Buy One Get One)
Our Biggest Sale Yet - Buy One, Get One
Free!!!
(www.vacuumshopper.stores.yahoo.net)

BOGOS & SPECIALS
BOGO - (BUY ONE GET ONE FREE)
Country Life Max Multi(vitamin) for Men
(www.vnfnutrition.com)

Based on the meanings of the individual terms "PIZZA" and "BOGO," and the numerous third-party uses of "BOGO" in connection with a variety of goods and services, including restaurant services, offered on a "buy one get one free" basis, we conclude that the combination PIZZABOGO also is as merely descriptive as the individual terms. When the proposed mark is viewed in the context of applicant's services, the term PIZZABOGO immediately informs prospective customers that applicant's restaurant services involve offering pizza on a "buy one, get one free" basis. Contrary to applicant's arguments, applicant's proposed usage does not create an unusual or nonsensical usage. The term "PIZZA" is a readily recognized component of the mark, and customers will easily be able to separate out the "BOGO" component; in doing so, they will need no imagination or thought to discern that applicant, through his restaurant services, offers pizza on a buy-one-get-one-free basis.

Applicant's contention that the term "BOGO" has the alternative meanings of "beyond our galaxy online" or "buy one give one" is entirely unpersuasive. The mere descriptiveness of the specific term "BOGO" in applicant's proposed mark must be determined in the specific context of the involved services. The fact that a term may have different meanings in other contexts is not controlling on the question of mere descriptiveness. In re Chopper Industries, 222 USPQ 258 (TTAB 1984). Likewise, applicant's contention that "BOGO" "calls to mind the similar words 'GOGO,' 'TO GO,' and 'POGO'" is of no moment.

The third-party registrations of PIZZA and BOGO marks submitted by applicant do not compel a different result herein.⁴ In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the board or this court."]. While uniform treatment under the Trademark Act is an administrative goal, our task in this appeal is to determine, based on the record before us, whether

⁴ We should add that the examining attorney's evidence of third-party registrations of unitary marks comprising the formative word "PIZZA" followed by endings such as "-LETTA," "-NO," and "-TO" do not aid his case for refusal.

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applicant's particular mark sought to be registered is merely descriptive. In re Stenographic Machines, Inc., 199 USPQ 313, 317 (Comm'r Pats. 1978) ["Consistency of Office practice must be secondary to correctness of Office practice."]. As is often stated, each case must be decided on its own merits. In re Best Software Inc., 58 USPQ2d 1314 (TTAB 2001).

Lastly, the fact that applicant may be the first and only user of the merely descriptive term PIZZABOGO for restaurant services does not justify registration inasmuch as the only significance conveyed by the term is merely descriptive. In re National Shooting Sports Foundation, Inc., 219 USPQ 1018 (TTAB 1983).

Decision: The refusal to register is affirmed.