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PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re MagnetNotes, Ltd.

Serial No. 78611219

Lisa Ryan-Lindquist of Vidas, Arrett & Steinkraus, P.A. for
MagnetNotes, Ltd.

S. David Sterkin, Trademark Examining Attorney, Law Office
110 (Chris A. F. Pedersen, Managing Attorney).

Before Hairston, Holtzman and Bergsman, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

MagnetNotes, Ltd. has filed an application to register
the mark MAGNETNOTES, in standard character form, for goods
identified as "magnetic paper."¹

The trademark examining attorney has issued a final
refusal to register, under Section 2(e)(1) of the Trademark

¹ Application Serial No. 78611219, filed on April 18, 2005, based on an
asserted bona fide intention to use the mark in commerce.

Act, 15 U.S.C. § 1052(e)(1), on the ground that applicant's mark, when applied to applicant's goods, is merely descriptive of them. Applicant appealed. Applicant and the examining attorney have filed briefs. We reverse the refusal to register.

The examining attorney's position is that applicant's mark combines two terms, MAGNET and NOTES, both of which "merely describe the nature of Applicant's goods, 'magnetic paper.'" (Examining attorney's Brief at unnumbered p. 2). In reaching that conclusion, the examining attorney first reasons that MAGNET "is defined as meaning, in part, 'An object that is surrounded by a magnetic field and that has the property, either natural or induced, of attracting iron or steel.'" (*Id.* (quoting the first of ten definitions of "magnet" from the online source Dictionary.com)). The examining attorney then looks to applicant's own website to find that applicant's goods consist of plain paper with a magnetic coating.² From that description, the examining attorney concludes that "the term MAGNET merely

² We do not have before us any actual specimens. The examining attorney based his analysis on a detailed description of the goods found on applicant's own website. Applicant has not challenged the examining attorney's reliance on that description. Thus, we conclude that the examining attorney's description is accurate.

describes a characteristic of Applicant's goods."

(Examining attorney's Brief at unnumbered p. 3).

The examining attorney then focuses on the term NOTES, first observing that "[t]he term NOTES is defined, in part, as 'A brief record especially one written down to aid the memory: *took notes in class.*'" (*Id.* (quoting the first of eight definitions of "note" from the online source Dictionary.com)). The examining attorney further explains that the term NOTES is frequently used to describe paper products. The examining attorney submitted the results of an online search showing an extremely high number of instances where the term PAPER is used together with the term NOTES. The examining attorney specifically cites a number of uses of the phrase "note paper" and concludes that the "evidence clearly shows that the term NOTES is commonly treated in a descriptive manner in connection with paper goods such as Applicant's." (Examining attorney's Brief at unnumbered p. 5). Further, the examining attorney submitted a number of third-party registrations for marks that include the term NOTES for paper and paper products, which bear a disclaimer of the term.

Finally, having addressed the terms individually, the examining attorney considers the combination of the two terms, MAGNETNOTES. The examining attorney concludes that

combining the two terms does not create a commercial impression separate and distinct from the independent meaning of each of the two terms, and that, as such, the mark as a whole is descriptive of applicant's identified goods. (Examining attorney's Brief at unnumbered p. 6).

Applicant's position is that "the mark MAGNETNOTES does not immediately convey the goods claimed in the application. Rather, imagination, thought, or perception is required to determine the nature of the goods from the mark." (Applicant's Reply Brief at p. 2 (internal quotes omitted)). Applicant points to various definitions of the term NOTE that are directed to records but are not limited to paper products. (Applicant's Opening Brief at pp. 4-5 (quoting eleven definitions of "note" from The American Heritage College Dictionary, 3rd Ed. (2000)). Applicant further observes that other commercial products associate notes or records with magnetic properties but do not involve paper. (Applicant's Reply Brief at p. 2 (describing a magnetic drawing toy sold under the mark MAGNA DOODLE), Applicant's Opening Brief at p. 5 (describing various forms of magnetic media used to store records)). Applicant thus argues that because MAGNETNOTES could be associated with other products, and because association of that term with

magnetic paper requires pause and reflection, the term is at most suggestive.

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 goods in connection with which it is used, or intended to be used. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); *In re Abcor Dev. 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 in order to be considered merely descriptive; it is enough that the term describes one significant attribute or function of the goods. Furthermore, descriptiveness is not determined in the abstract, but in relation to the goods identified in the application, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods. *In re Polo International Inc.*, 51 USPQ2d 1061, 1062 (TTAB 1999); and *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). In other words, the issue is whether someone who knows what the goods 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).

If, however, reasoning or imagination is required to determine the attributes or characteristics of the products associated with a mark, that mark is suggestive rather than descriptive. See *In re Atavio*, 25 USPQ2d 1361, 1362 (TTAB 1992). Even where individual terms are descriptive, combining them together may evoke a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods, without the combination of terms creating a unique or incongruous meaning, then the resulting combination is also merely descriptive. See, e.g., *In re Tower Tech., Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002). There is a narrow line between terms that are merely descriptive and those that are only suggestive. *Id.* (citing *In re TMS Corp. of America*, 200 USPQ 57 (TTAB 1978)). Any doubt as to whether a mark is descriptive or suggestive is resolved in favor of publication of the mark for opposition. *In re Conductive Systems, Inc.*, 220 USPQ 84, 86 (TTAB 1983); *In re Morton-Norwich Prods., Inc.*, 209 USPQ 791 (TTAB 1981).

Despite the examining attorney's arguments and support, we are not convinced that MAGNETNOTES, when

applied to magnetic paper, is merely descriptive thereof. Much of the evidence relied on by the examining attorney does not use the term NOTES alone, but instead links that term together with the term PAPER. For example, the examining attorney refers to a "GOOGLE® screenshot . . . [indicating] the extremely high number of cases in which the term PAPER is used in conjunction with the term NOTES." (Examining attorney's Brief at unnumbered p. 5 (providing specific examples of the phrase "note paper" on various websites)). Frequent use of the phrase "note paper" does not establish that the term NOTES is the equivalent of the term "paper." To the contrary, if NOTES were descriptive of paper in the way the examining attorney maintains, the phrase "note paper" would be redundant. Thus, while "note paper" might immediately convey a description of paper that can be used for note-taking purposes, the examining attorney has not established that the term NOTES by itself is the equivalent of the term "paper." Paper, even note paper, does not become a note until the paper has been used.

Turning from the individual term NOTES to the mark itself, we conclude that MAGNETNOTES does not immediately inform prospective purchasers of a feature, characteristic, or quality of the goods, which in this case is magnetic

paper. Rather, the term provides a starting point for a multi-step thought process that might lead to magnetic paper. Upon first impression, MAGNETNOTES creates an incongruity, as it combines two nouns, MAGNET and NOTES, normally associated with disparate objects, magnets and short records. The goods in question are neither the conventional magnets with which a consumer is familiar, nor actual records, *i.e.*, notes. The consumer must next contemplate the adjectives associated with the underlying terms, *i.e.*, MAGNETIC, and in the case of the phrase "note paper," NOTE. Only after mentally converting MAGNETNOTES to *magnetic note paper*, can the consumer derive a description of the goods in question from the mark. Thus, even if the term NOTES alone was the equivalent of the term "paper," the necessity of the multi-step thought process when considering the combined term MAGNETNOTES requires reversal of the examining attorneys refusal to register under Section 2(e)(1). *See In re Copytele Inc.*, 31 USPQ2d 1540, 1542 (TTAB 1994) ("[A] nondescriptive trademark may be fashioned from the incongruous combination of several words that are, individually, merely descriptive of an applicant's goods . . .").

In sum, on this record, we cannot conclude that MAGNETNOTES is merely descriptive of the goods in this

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case, magnetic paper. We are not convinced that the term NOTES is the equivalent of the term "paper." Further, the combined term MAGNETNOTES creates an incongruity that requires some thought to make the jump to the goods in this case. Finally, as we have indicated, if there is doubt about the descriptive character of a mark, that doubt must be resolved in applicant's favor.

Decision: The refusal to register under Section 2(e)(1) is reversed.