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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sonco Worldwide, Inc.

Serial No. 78772258

Scott D. Woldow of Smith, Gambrell & Russell, LLP for Sonco
Worldwide, Inc.

Jason Paul Blair, Trademark Examining Attorney, Law Office
104 (Chris Donniger, Managing Attorney)

Before Zervas, Walsh and Bergsman, Administrative Trademark
Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Sonco Worldwide, Inc. filed an intent to use
application on the Principal Register for the mark SATIN
SMOOTH, in standard character format, for goods ultimately
identified as "galvanized metal chain link fencing, metal
chain link fencing; metal fencing panels," in Class 6
(Serial No. 78772258). The Examining Attorney refused
registration under Section 2(e)(1) of the Trademark Act of
1946, 15 U.S.C. §1052(e)(1), on the ground that SATIN
SMOOTH, when used in connection with applicant's products,
is merely descriptive. The Examining Attorney contends

that the mark SATIN SMOOTH directly conveys the fact that applicant's metal fencing products free from irregularities and roughness: that is, the surface of applicant's fencing products is smooth. To support his refusal, the Examining Attorney submitted the following evidence:

1. A dictionary definition of the word "satin" as "glossy, sleek, and smooth";¹

2. A dictionary definition of the word "smooth" as "having a surface free for irregularities, roughness, or projections";²

3. An excerpt from the K-9 Kennels Systems website featuring an advertisement for a boxed kennel system with the following description: "Our satin smooth galvanized fence fabric is safe for use with expensive breeds as well as your beloved stray"³;

4. An excerpt from the American Fence, Inc. website. The description of that company's dog kennel includes the following statement: "11 ½ gauge satin smooth galvanized wire standard"⁴;

¹ Dictionary.com derived from The American Heritage Dictionary of the English Language (4th ed. 2000).

² *Id.*

³ www.southwesternwire.com.

⁴ www.american-fence.com.

5. An excerpt from the Fence Center website. The company describes its chain link mesh as "galvanized, satin smooth"⁵; and,

6. An excerpt from the Imperial Blasting Technologies website, a company involved in commercial and industrial surface preparation. In touting its services, the company states that its "mineral blasting process removes rust and/or contaminants safely, leaving you with a satin smooth, undamaged pre-treated surface suitable for powder coating or painting."⁶

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the products it identifies. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a particular term is merely 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 a relevant purchaser who knows what the products are will understand

⁵ www.fencecenter.com.

⁶ www.imperialblasting.com.

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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).

The evidence clearly shows that "satin smooth" is used by others and understood by consumers to refer to chain link fencing that is very smooth and without irregularities or roughness. Imperial Blasting Technologies stated in its website that its process of preparing surfaces, including many grades of metal, leaves the consumer with a "satin smooth" surface. In fact, in its brief, applicant stated that its fencing products "undergoes a process so that the rough metal is treated so that it becomes 'smooth' like soft flowing fabric, such as, silk or 'satin.'"⁷ In other words, applicant uses SATIN SMOOTH in connection with its fencing products to describe its smooth surface.

Applicant argues that SATIN SMOOTH is suggestive because its metal fencing products are not made of satin. Thus, the mark is incongruous. "Applicant is suggesting

⁷ Applicant's Brief, p. 3.

that the metal is so smooth that it rivals satin or silk, but at the same time, is rigid and strong. . . . This causes the goods to be 'smooth' and suggests that the goods reach the ultimate degree of smoothness as opposed to rough cut metal."⁸ Applicant's argument is unpersuasive because the commercial impression engendered by the term "satin smooth" is that the products are as smooth as satin, not that the products are made of satin.

Applicant also argues that "[t]he Examiner improperly dissects the mark and ignores the suggestive meaning of the marks as whole."⁹ To the contrary, it is applicant, not the Examining Attorney, who has improperly dissected its mark by arguing that its fencing products are not made of satin. As indicated above, "satin smooth" engenders the commercial impression that the products at issue are as smooth as satin, not that they are made of satin.

Applicant contends that one must follow a multiple step reasoning process to determine the product characteristics described by the mark. Applicant's multiple step reasoning process is set for the below:

In the present case the goods are "metal fencing", which is usually rough in nature. The mark brings to mind that it is unusual for a product that

⁸ Applicant's Brief, p. 3.

⁹ Applicant's Brief, p. 4.

is often associated with burrs and
barbs to be smooth like fine silk or
satin.¹⁰

Applicant's explanation fails to persuade us that consumers familiar with its products will not immediately understand that the term SATIN SMOOTH means that applicant's fencing products are very smooth. As indicated above, the issue is whether a relevant purchaser familiar with applicant's products will understand the mark to convey information about the products.

Applicant argues that its proposed use of SATIN SMOOTH in connection with metal fencing products constitutes "a clever double entendre."¹¹ "A 'double entendre' is a word or expression capable of more than one interpretation. For trademark purposes, a 'double entendre' is an expression that has a double connotation or significance *as applied to the goods or services*. The mark that comprises the 'double entendre' will not be refused registration as merely descriptive if one of its meanings is not merely descriptive in relation to the goods or services." TMEP §1213.05(c) (5th ed. 2007). Applicant's double entendre argument is unpersuasive because applicant does not identify any

¹⁰ Applicant's Brief, pp. 4-5.

¹¹ Applicant' Brief, p. 5.

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alternative meaning for the term "satin smooth."

Accordingly, there is no double entendre.

Finally, applicant argues that the term "satin smooth" is suggestive because of past Office practice in registering four other "Satin Smooth" trademarks. We are not persuaded by these prior registrations that applicant's mark is not merely descriptive. First, we must decide each case on its own merits. "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." *In re Nett Designs Inc.*, 236 F.2d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Second, the four registrations are not for products related to those in the application at issue. Therefore, the registrations are of limited, if any, probative value.

In view of the foregoing, we find that applicant's mark SATIN SMOOTH, when used in connection with "galvanized metal chain link fencing, metal chain link fencing; metal fencing panels," is merely descriptive.

Decision: The refusal to register is affirmed.

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