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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cohber Press, Inc.

Serial No. 78919789

Brian B. Shaw of Harter, Secrest & Emery for Cohber Press,
Inc.

Tasneem Hussain, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Hohein, Grendel and Bergsman, Administrative
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Cohber Press, Inc. filed a use-based application for registration of the mark ARCTIC ART in standard character form for "coated paper for printing," in Class 16 (Serial No. 78919789). The Trademark Examining Attorney finally refused registration on two grounds. First, the Examining Attorney refused registration on the ground that ARCTIC ART, when used in connection with "coated paper for printing," so resembles the mark ARCTIC WHITE for "bond, onionskin, wedding, bristol, cover and text paper" as to be

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likely to cause confusion. Since Registration No. 1431100 for the mark ARCTIC WHITE was registered on March 3, 1987, the registrant was allowed until March 3, 2007 to file a renewal application under Section 9 of the Trademark Act of 1946, 15 U.S.C. §1059, and a declaration or affidavit of use under Section 8 of the Trademark Act of 1946, 15 U.S.C. §1058. The Trademark Act allows a registrant a six-month grace period, or in this case until September 3, 2007, to file a late renewal application and declaration or affidavit of use. Registrant has not filed its renewal application or declaration of use. Accordingly, the cited registration will be cancelled in due course. In view thereof, action in this appeal will be suspended pending the cancellation of the cited registration.

The Examining Attorney also issued a requirement that applicant disclaim the exclusive right to use the word "art" on the ground that "art" is merely descriptive. See Section 6(a) of the Trademark Act of 1946, 15 U.S.C. §1056(a). The Examining Attorney contends that the word "art" is merely descriptive when used in connection with "coated paper for printing" because the word "art" refers to a type of paper (*i.e.*, art paper). The Examining Attorney introduced the following evidence in support of the disclaimer requirement:

1. Three (3) third-party registrations for marks that include the word "art" for paper registered either on the Supplemental Register or on the Principal Register with a disclaimer of the exclusive right to use the word "art."¹

These are:

- A. Registration No. 1419594 (Supplemental Register) for the mark SATIN ART for "paper goods, namely, clay-coated art paper and printing paper";
- B. Registration No. 2055353 (Principal Register) for the mark PARSONS RENAISSANCE ART PAPER for "paper goods, namely, paper used for letterpress, offset, gravure and silk-screen print applications" with a disclaimer of the exclusive right to use "art paper"; and,
- C. Registration No. 2851768 (Principal Register) for the mark AURORA ART for "coated offset printing paper" with a disclaimer of the exclusive right to use "art";

¹ The Examining Attorney submitted ten (10) registrations. However, only the registrations listed above were relevant. Registration No. 2851768 for the mark AURORA ART was listed twice and the other registrations were for art supplies, arts and crafts material, or gift items made of paper.

2. Four (4) third-party registrations for marks that include "art paper" in the description of goods;

3. An excerpt from the Epson website (www.epson.com) demonstrating that "art paper" is a type of coated paper;

4. The hit list from a Google search engine search for "art paper" demonstrating that "art paper" is a type of paper;

5. A definition of the term "coated art paper" from A Dictionary of Descriptive Terminology from the Bookbinding and the Conservation of Books website reading as follow:

A coated paper particularly suited for printing, especially halftones where definition and detail in shading and highlights are an essential consideration. It is usually a paper of good quality, with a high brightness and a glossy, highly uniform printing surface.

(<http://palimpesest.stamford.edu>);

6. An excerpt from the Alibaba.com website requesting bids for the sale of two-sided coated art paper;

7. An excerpt from the TradeKey.com website for art paper exporters, suppliers, manufacturers, and distributors; and,

8. An excerpt from the website of the Natural Resources Council of Maine (www.nrcm.org) listing

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Scheufelen Job Parilux as a brand of premium coated art paper.

On the other hand, applicant contends that the word "art" as used in the ARCTIC ART mark is not merely descriptive because ARCTIC ART is a unitary mark, and therefore a disclaimer is not necessary. Applicant argues that "consumers will not break the components of ARCTIC ART into its elements due to the alliterative rhythm of the 'ar' beginning each word. Consumers will not perceive the mark as two separate components, but as one unitary mark." In addition, applicant asserts that the mark conveys the commercial impression of "art" of the "arctic," not arctic art paper, because the word "art" is a noun modified by the adjective "arctic." (Applicant's Brief, pp. 8-9).

Section 6(a) of the Trademark Act of 1946, provides in part that an applicant may disclaim the exclusive right to use an unregistrable component of an otherwise registrable mark. The purpose of the disclaimer is to make it clear, if it might otherwise be misunderstood, that the applicant is not claiming the exclusive right to use the unregistrable component of the mark. *In re Kraft, Inc.*, 218 USPQ 571, 572-573 (TTAB 1983). When the composite mark is unitary in nature, no disclaimer is required. *Id.*

A unitary mark is a mark with multiple elements that create a single and distinct commercial impression separate and apart from the meaning of its constituent elements.

Dena Corp. v. Belvedere International Inc., 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991). See also, *In re Kraft, Inc.*, *supra* (the elements of a unitary mark are so integrated or merged that they cannot be regarded as separate elements, and it is obvious that no claim is made other than to the entire mark). In *Kraft*, the Board explained that a unitary mark could be created "where the words which have been put together function as a unit, with each relating to the other rather than directly to the goods." 218 USPQ at 573. See also *In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981).

To determine whether a composite mark is unitary, the Board must determine "how the average purchaser would encounter the mark under normal marketing of such goods and also . . . what the reaction of the average purchaser would be to this display of the mark." *Id.*, quoting *In re Magic Muffler Service*, 184 USPQ 125, 126 (TTAB 1974). This can best be accomplished by looking at the specimen filed with the application because it shows how the mark is used in connection with the goods. *In re Magic Muffler Service*,

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supra. A label used by applicant displaying the mark sought to be registered is set forth below.



In the present case, we have no doubt that the word "art" is merely descriptive of a type of paper (*i.e.*, art paper). However, the descriptive significance of the word "art" is lost in the mark as a whole. The mark ARCTIC ART has an alliterative cadence that encourages potential consumers encountering the mark to perceive it as a whole. Moreover, we agree with applicant that the mark conveys the commercial impression of "art" of the "arctic" because the word "art" is a noun modified by the adjective "arctic." In other words, as shown in the specimen of use, consumers will perceive applicant's mark as ARCTIC ART brand premium coated paper, not ARCTIC brand art paper. See *In re J. R. Carlson Laboratories, Inc.*, 183 USPQ 509, 511 (TTAB 1974) (consumers will call for applicant's product as E GEM notwithstanding the fact that they would recognize the descriptive significance of the letter "E"). For these reasons, we believe that purchasers will not go through the mental process of parsing the mark ARCTIC ART into its

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component parts, but will regard it as a unitary mark. Under the circumstances presented by the record before us, the registration of the mark ARCTIC ART does not create or recognize any rights in the individual elements of the mark apart from the mark as a whole, and it will not preclude others from using the word "art" in connection with "coated paper for printing" or art paper. Therefore, we conclude that the requirement for a disclaimer of the word "art" is not necessary.

Decision: The requirement for a disclaimer is reversed.

Further action in this appeal is suspended pending the cancellation of Registration No. 1431100 for the mark ARCTIC WHITE. When Registration No. 1431100 is cancelled, this application will be forwarded for publication.

Opinion by Hohein, Administrative Trademark Judge,
concurring in part and dissenting in part:

While I agree with suspending this appeal with respect to the issue of likelihood of confusion in view of the impending cancellation on or about December 3, 2007 of Reg. No. 1,431,100 for the mark ARCTIC WHITE,¹ I would affirm the requirement for a disclaimer of the word "art" in applicant's ARCTIC ART mark.

Applicant offers two arguments as to why it believes the required disclaimer to be inappropriate. First, it reiterates in its main brief the contention, which it raised as its sole argument prior to filing its appeal, that "in the present matter ART does not merely describe 'coated paper for printing.'" Specifically, and with respect to the various third-party registrations made of record by the Examining Attorney as support for the disclaimer requirement, applicant asserts that:

Respectfully, Applicant does not seek to register its mark for "art paper", "coated art paper", "good quality paper" or "paper for use for art"; Applicant seeks to register for "coated paper for printing." The logical conclusion of the Examining Attorney's argument is that since anything can be used in connection with art, ART merely describes everything. Regardless of the

¹ See TBMP §1213 (2d ed. rev. 2004) and TMEP §716.02(e) (5th ed. 2007) (which among other things indicates that a registration will be automatically canceled three months after the expiration of the statutory grace period).

quality of Applicant's paper or whether paper can be used in connection with art, ART is not merely descriptive of "coated paper for printing".

The Examining Attorney also pointed to a number of registrations in connection with which the respective applicants disclaimed ART in support of his [sic, should be "her"] refusal to register. First, simply because other applicants disclaimed a portion of their marks does not obligate Applicant to disclaim the same portion of its mark. Second, it is not surprising that the applicants in the cited registrations disclaimed ART because in the cited registrations, ART merely described the goods (*i.e.*, "art paper", "[paper goods, namely,] paper used for letterpress, offset, gravure and silk-screen print applications," ...).

As the Examining Attorney notes in her brief, while applicant "appears to argue that because its recitation of goods does not include the word 'art,' the word ART is not descriptive of its goods," it is plainly the case that several of the third-party registrations, including in particular Reg. No. 2,055,353 for the mark PARSONS RENAISSANCE ART PAPER for "paper goods, namely, paper used for letterpress, offset, gravure and silk-screen print applications" in which the term ART PAPER is disclaimed, include a disclaimer of the word "art." "These registrations," the Examining Attorney properly points out, "serve to establish the descriptive nature of the word ART when used in connection with types of paper and to strengthen the requirement for the disclaimer."

Furthermore, the majority concedes in any event that, "[i]n the present case, we have no doubt that the word 'art' is merely descriptive of a type of paper (*i.e.*, art paper)" and I concur that the evidence of record fully supports such a finding. Moreover, because applicant's goods are identified as "coated paper for printing" and the record shows that "art paper" is a type of coated paper which is particularly suited for printing in that it is usually a paper of good quality with a high brightness and a glossy, highly uniform printing surface, it is obvious that applicant's goods necessarily include art paper as a type of "coated paper for printing." Inasmuch as it is clear that the word "art" is merely descriptive of a type of coated paper for printing known generically as art paper, such word undeniably is at least merely descriptive of applicant's goods and therefore, unless its mark is unitary, the word "art" must be disclaimed in order for the mark ARCTIC ART to be registrable. Applicant's semantic argument to the contrary is thus without merit.

Applicant's second argument, apparently added as an afterthought following the filing of its appeal, is that its mark is indeed unitary because, as the majority so finds, "the descriptive significance of the word 'art' is lost in the mark as a whole." Specifically, the majority

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believes among other things that "[t]he mark ARCTIC ART has an alliterative cadence that encourages potential consumers encountering the mark to perceive it as a whole." While admittedly a subjective judgment, to me such an argument would have more force if, for instance, applicant's mark were ARCTIC ARTIST for artists' brushes. Here, however, I find that absent something more, such as the overall suggestiveness conveyed by the expression LIGHT N' LIVELY when used as a mark for reduced calorie mayonnaise as in *In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983), the mere repetition of the "ar" sound of the first syllable of the word "arctic" fails to unify applicant's ARCTIC ART mark such that the mere descriptiveness of the word "art" is lost in the whole.

In this regard, the Examining Attorney persuasively observes in her brief that:

[J]ust because ARCTIC and ART begin with the same letter[s] does not make the mark unitary. The Board in *In re Lean Line, Inc.*, 229 USPQ 781 (TTAB 1986) found the mark LEAN LINE for low calorie foods not unitary and the requirement for a disclaimer of LEAN was held to be proper. As the Board stated, "there is nothing in the record to suggest that the mere fact that both words which form the mark begin with the letter 'L' would cause purchasers to miss the merely descriptive significance of the term 'LEAN' or consider the entire mark to be a unitary expression." Similarly, a consumer encountering the mark ARCTIC ART in connection with Applicant's coated paper [for printing] would

perceive the mark as two separate components with the ART component describing the paper's quality or use. ARCTIC ART is not a double entendre or an expression; nor is it connected in any way to make it unitary. Applicant's mark is not ARCTIC 'N ART but rather ARCTIC ART in which the word ART is easily separable from the initial word to describe Applicant's coated paper goods.

This case, as the Examining Attorney accurately adds, accordingly is strictly analogous to, in particular, Reg. No. 2,055,353, a third-party registration of record which involves the mark AURORA ART for "coated offset printing paper" and which includes a disclaimer of the term "ART."

Nonetheless, the majority further agrees with applicant that its ARCTIC ART mark "conveys the commercial impression of 'art' of the 'arctic' because the word 'art' is a noun modified by the adjective 'arctic,'" finding that "as shown in the specimen of use, consumers will perceive applicant's mark as ARCTIC ART brand premium coated paper, not ARCTIC brand art paper." While, if applicant's goods were, for example, mounted prints, photographs or other images of art or original works of art, its contention might be plausible, I fail to appreciate how the commercial impression immediately engendered by the mark ARCTIC ART can be said to be "art of the arctic" region when such mark is used in connection with coated paper for printing, including in particular art paper.

Given the fact that arctic paper is characterized as a kind or grade of coated paper which is particularly suited for printing, especially as to halftones where definition and detail in shading and highlights are an essential consideration, and is usually a paper of good quality, with a high brightness and a glossy, highly uniform printing surface, purchasers encountering applicant's mark as used on the specimen of record would be likely to be immediately struck by the display of the words "ARCTIC ART" for a "PREMIUM COATED PAPER" that the word "arctic" suggests in relation to applicant's goods that they feature or are characterized by the high brightness or pure white of arctic ice and snow. Such a commercial impression seems far more probable, especially with respect to the purchase of art paper, than one which brings to mind the apparently unknown genre or category of "art of the arctic." The latter simply is too speculative given that, tellingly, nothing in this record even hints that consumers could, much less would, plausibly think that applicant's coated paper for printing had something to do with "art of the arctic." Instead, because combining the words "arctic" and "art" to form the composite mark ARCTIC ART does not alter, obscure or otherwise change the merely descriptive significance of the word "art" in relation to applicant's

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goods, the requirement for a disclaimer of such word is proper and I would accordingly affirm the requirement therefor by the Examining Attorney.²

² In accordance with the Board's practice, however, the decision affirming the disclaimer requirement would be set aside and applicant's mark would be published for opposition if applicant, within thirty days of the issuance of such decision, elected to submit the required disclaimer. See Trademark Rule 2.142(g).