

8/15/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 10
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Meramec Group, Inc.

Serial No. 75/430,345

Paul M. Denk for Meramec Group, Inc.

Mary Rossman, Trademark Examining Attorney, Law Office 9
(**Ronald Sussman**, Managing Attorney).

Before **Simms**, Cissel and Quinn, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On February 6, 1998, applicant filed the above-identified application to register the mark "INDUSTRIAL STRENGTH COMFORT" for "footwear components," in Class 25. The basis for the application was applicant's assertion that it possessed a bona fide intention to use the mark on these goods in commerce.

The Examining Attorney refused registration under two different sections of the Lanham Act and made several requirements. Registration was refused under Section 2(d)

of the Lanham Act on the ground that the mark applicant seeks to register so resembles the mark "INDUSTRIAL STRENGTH," which is registered¹ for "orthopedic braces," in Class 10, that confusion would be likely if applicant were to use its mark in connection with footwear components. Registration was also refused under Section 2(e)(1) of the Act on the ground that, as applied to footwear components, applicant's mark is merely descriptive. The Examining Attorney also required applicant to provide additional information concerning the goods with which applicant intends to use the mark it seeks to register, including submission of photographs and advertisements or promotional materials for goods of the same type. She also advised applicant that the identification-of-goods clause in the application as filed is indefinite, and applicant was required to amend the identification to specify the commercial name of each particular footwear component referred to in the application. Additionally, applicant was required to claim ownership of two other registrations that it appeared to own.

In support of the refusal based on likelihood of

¹ Reg. No. 1,846, 639, issued on the Principal Register to Chase Ergonomics Inc. on July 26, 1994; affidavit under Sections 8 and 15 accepted and acknowledged.

confusion, the Examining Attorney attached copies of other registrations owned by applicant which show that applicant uses other marks on orthopedic back supports. In support of the refusal based on mere descriptiveness, the Examining Attorney attached copies of a number of third-party registrations wherein the term "INDUSTRIAL STRENGTH" is either disclaimed or is registered under the provisions of Section 2(f) of the Act based on a claim of acquired distinctiveness.

In response to the first Office Action, applicant amended the application to claim ownership of its two prior registrations and provided argument with respect to both the refusal based on descriptiveness and the refusal based on likelihood of confusion. Applicant failed to comply, however, with either the requirement for amendment to the identification-of-goods clause or the requirement to submit photographs, advertising and promotional materials for goods of the same type as those with which applicant intends to use the mark. Applicant did, however, submit copies of two 1999 decisions by the Trademark Trial and Appeal Board, but each of these was specifically designated as "not citable as precedent," so we have not considered either of these cases.

With her second Office Action, the Examining Attorney made final the requirements for amendment to the identification-of-goods clause and for submission of photographs and samples of advertisements or promotional materials for goods of the same type. The refusals to register based on Sections 2(d) and 2(e)(1) of the Act were also made final.

Many additional materials were made of record with this action, including dictionary definitions of "industrial," "strength" and "comfort"; excerpts from published articles retrieved from the Nexis database of publications showing the term "industrial strength" used in connection with a variety of products, including shoes, boots and components for shoes and boots, and that there is a retail market for orthopedic braces and supports; a third-party registration wherein the goods listed include arch supports, foot supports, heel supports, heel cups, and inner soles, as well as wrist supports, elbow supports and elastic body wraps for therapeutic use; excerpts from Internet web sites; copies of third-party registrations wherein the goods are identified as footwear and the word "comfort" is disclaimed or the registration is either on the Supplemental Register on the Principal Register under the provisions of Section 2(f) of the Act; a dictionary

definition of the word "brace" as "an orthopedic appliance used to support, align, or hold a bodily part in the correct position"; an application and registrations owned by the owner of the cited registration wherein the goods are designated as "orthopedic back supports" and "orthopedic braces and elastic wraps"; a promotional sheet for registrant's back supports, wrist braces and wraps; copies from the web site sharperimage.com which advertises both orthopedic supports and heel cushion inserts for footwear; and a copy of an advertisement from another catalog business offering magnetic insoles, magnetic knee supports, insoles, back supports, and neck and shoulder wraps.

Applicant timely filed a Notice of Appeal. Both applicant and the Examining Attorney filed briefs on appeal², and applicant filed a reply brief, but did not request an oral hearing before the Board.

Based on careful consideration of the written record and arguments presented by applicant and the Examining Attorney in light of the relevant legal precedents in

² The Examining Attorney objected to the submission of three prior registrations with applicant's brief on appeal. The objection is sustained. Trademark Rule 2.142(d). We have not considered this evidence. Moreover, even if we had considered them, these registrations would not have established that applicant's mark is registrable.

connection with the issues before us, we hold that registration to applicant must be refused because, although the refusal based on descriptiveness is not well taken, we must affirm the refusal based on likelihood of confusion as well as the requirements for amendment of the identification-of-goods clause and for submission of photographs and advertising and promotional materials for goods of the same type.

Turning first to the refusal under Section 2(e)(1) of the Act, we note that the materials of record clearly establish that the terms "INDUSTRIAL STRENGTH" and "COMFORT" are each merely descriptive of components for footwear because each term identifies a desirable characteristic or feature of such goods. In re Bright-Crest Ltd., 204 USPQ 591 (TTAB 1979). When these terms are combined, however, the combination results in an unexpected incongruity that removes the mark from the proscription of Section 2(e)(1). Whereas "INDUSTRIAL STRENGTH" connotes that the goods sold thereunder possess superior durability, the term "COMFORT," in connection with components for footwear, would be understood to mean that the goods possess "the capacity to give physical ease and well-being," as indicated by the dictionary definition which is of record.

We find persuasive applicant's argument that combining these two descriptive terms results in a mark which does more than merely describe the goods identified in the application. In *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968), the mark "SUGAR & SPICE" was found to evoke a commercial impression which was more than merely descriptive of the bakery products with which the mark was used in view of the double entendre association with the nursery rhyme phrase. In a similar sense, the mark sought to be registered in the instant application combines two terms which describe features or characteristics of the goods in question, but the combination results in something in addition to the combined descriptive connotations of the component terms. There is no evidence that "INDUSTRIAL STRENGTH" and "COMFORT" are ever used together by anyone else in this field, either descriptively or as source identifiers. The two terms together create an unexpected, unusual juxtaposition of what could be perceived as mutually exclusive characteristics for footwear components: industrial-type durability and comfort, i.e., "hard" and "soft." Moreover, if we were left with any doubt about the descriptiveness of a term in an ex parte appeal, such doubt would necessarily be resolved in favor of the applicant.

In re Bliss & Laughlin Industries, Inc., 198 USPQ 127 (TTAB 1978). Accordingly, the refusal to register based on Section 2(e)(1) of the Act is not well taken.

The refusal to register based on Section 2(d) the Act, however, is plainly supported by the record, and applicant has provided no acceptable explanation for its failure provide the required materials with regard to similar goods made by others or to comply with the requirement for amendment to the identification-of-goods clause, so this application will not proceed to publication.

With regard to the refusal based on likelihood of confusion, the Examining Attorney has met her burden of establishing that applicant's mark is similar to the cited registered mark and that the goods set forth in the application are commercially related to the products identified in the registration. The above-referenced materials submitted by the Examining Attorney show that consumers have a basis upon which to expect that footwear components and orthopedic braces sold under similar marks emanate from a common source. The marks in question create similar commercial impressions by virtue of the fact that applicant seeks to register the entire registered mark, to which it has added only the merely descriptive term "COMFORT." As the Examining Attorney points out, the

general rule is that the likelihood of confusion between otherwise similar marks is not avoided by merely adding or deleting wording that is descriptive in relation to the goods identified in the application. Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc., 526 F.2d 556, 188 USPQ 105 (CCPA 1975). The descriptive word "COMFORT" in applicant's mark is insufficient to distinguish between these marks. Consumers familiar with the registered mark in connection with orthopedic braces are likely to view the mark applicant seeks to register as an indication that applicant's footwear components are comfortable "INDUSTRIAL STRENGTH" goods produced by the same entity that produces the "INDUSTRIAL STRENGTH" orthopedic braces with which they are familiar. Moreover, as the Examining Attorney points out, the fact that both applicant's mark and the cited registered mark are both presented in typewritten form means that the registrant may present "INDUSTRIAL STRENGTH" in the same form to be used by applicant, and applicant could present the first term in its mark, "INDUSTRIAL STRENGTH," in the same style of lettering that registrant uses for its mark, showing the word "COMFORT" in a clearly subordinate fashion, on another line and in smaller type.

Under these circumstances, the similarity of the marks at issue in this appeal is even more evident. In view of

the established relatedness of the goods set forth in the application and the cited registration, respectively, confusion would be likely. Accordingly, the refusal to register under Section 2(d) of the Act is well taken and must be affirmed.

As noted above, applicant has failed to submit the required photos or advertising relating to similar products made by others. Applicant did not address either of these issues in its initial brief, but in its reply brief, applicant stated that in view of the fact that the application is based not on use, but rather on the intent to use, applicant does not yet have samples of advertising or promotional materials. As noted throughout the prosecution of this application, however, the Examining Attorney understood that applicant is not claiming to have used this mark yet, but asked applicant to submit this information with regard to similar products made by others. Applicant never seemed to understand this point, but the Examining Attorney was quite clear. Trademark Rule 2.61(b) permits the Examining Attorney to make such a requirement. Applicant did not comply. See also TMEP Sections 1105.01(a)(iv) and 1105.02.

In a similar sense, the requirement for a definite statement of the particular footwear components with which

applicant intends to use the mark was clear and unambiguous. Applicant failed to address this issue, in its brief or even in its reply brief. Trademark Rule 2.71(a) allows the Examining Attorney to make such a requirement. Accordingly, both the requirement for a more definite identification-of-goods clause and the requirement for information regarding similar products made by others are affirmed.

In summary, although the refusal to register under Section 2(e)(1) is reversed, the refusal to register under Section 2(d) is affirmed, as are the two requirements discussed above.

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