THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ocean Divers, Inc.

Serial No. 74/268,952

Michael Slavin of McHale & Slavin P.A. for Ocean Divers, Inc.

Susan Leslie DuBois, Trademark Examining Attorney, Law Office 101 (Jerry Price, Managing Attorney)

Before Seeherman, Walters and Chapman, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Ocean Divers, Inc. has filed an application to register the mark shown below for the following services, as amended: "arranging excursions for tourists in the field of underwater diving" and "restaurant, bar, retail gift and dive shop services."[1]

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[1] Application Serial No. 74/268,952, filed April 24, 1992 and asserting first use on August 1, 1975 and first use in commerce on August 1, 1976. Color is claimed as part of the mark, as follows: The hatching of the mark indicates the blue-gray colors

In the first Office action the Examining Attorney required, inter alia, that applicant enter a disclaimer of "Ocean and Divers," indicating that a properly worded disclaimer should read as follows: "No claim is made to the exclusive right to use Ocean and Divers apart from the mark as shown." Applicant responded to this requirement as follows: "Applicant agrees to a disclaimer of the words 'Ocean' and 'Divers' apart from the mark as shown." The Examining Attorney apparently accepted this disclaimer, and examination continued with respect to other issues.[2] Those issues were resolved but subsequently, upon further examination, the Examining Attorney determined that

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of a hammerhead shark, the lining of the mark indicates the orange-red colors of the sun.

[2] In particular, the Examining Attorney refused registration in light of Registration No. 1,729,908. In attempting to overcome this refusal applicant first sought to submit a concurrent use agreement, following which it brought a cancellation proceeding against the owner of the cited registration, and ultimately asked that a concurrent use agreement be treated as a consent agreement. The Examining Attorney ultimately withdrew the Section 2(d) refusal; we further note that Registration No. 1,729,908 was cancelled on May 11, 1999 for failure to file a Section 8 affidavit.

applicant submit a disclaimer of OCEAN DIVERS, rather than the individual elements OCEAN and DIVERS. It is from this requirement that applicant has appealed.

Both applicant and the Examining Attorney have filed briefs[3]; an oral hearing was not requested.

As applicant has stated in its brief, it has disclaimed the word OCEAN and the word DIVERS, and it makes no claims to those words individually. Brief, p. 8. However, it is well-established that disclaimers of individual components of complete descriptive phrases are improper. See **In re Wanstrath**, 7 USPQ2d 1412, 1413 (Comm'r. 1988) and cases cited therein. Thus, the only issue before us is whether or not OCEAN DIVERS, as used in applicant's mark, constitutes a unitary phrase which must be disclaimed in its entirety.[4]

The Examining Attorney has submitted excerpts from the NEXIS database showing that the phrase "ocean divers" is used to refer to people who do underwater diving in the ocean. See, for example, the following:

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[3] With its brief applicant has submitted a promotional brochure. The Examining Attorney has not objected to this document, and we have therefore treated it as of record.

[4] We note that applicant mentioned, in its brief, that it has used the words OCEAN DIVERS "together to indicate a source of services to the public since 1976…." Brief, p. 8. Applicant has not, however, asserted that the phrase OCEAN DIVERS has acquired distinctiveness, and that this portion of its mark is registrable

> Headline: Diving into a Prickly Situation; In Search of Sea Urchins, Ocean Divers Contend with Constant Threat of Sharks
> "Los Angeles Times," January 11, 1995
>
> Dr. Tom Millington, an east county family practitioner specializing in the care of ocean divers, has seen an increase this year in an ailment he calls "diver's ear."
> "Los Angeles Times," April 15, 1993
>
> Great Lakes divers face different conditions from ocean divers.
> "USA Today," August 30, 1990

Further, applicant's own promotional materials show that applicant operates a dive resort under its mark. Its advertisement in the December 1991 issue of "Diver" magazine touts "PADI 5 star dive facility…," "Open water training dives …," "Night dives …," and "Dive the finest wrecks…." Featured on the cover of its brochure is the statement "Professional Dive Charter and Scuba Instruction in the Florida Keys," and the brochure advertises that

> "Ocean Divers is the Florida Keys' most complete dive resort. Located on a scenic deep-water canal just minutes away from the magnificent coral reefs and the dense, colorful fish populations of the Key Largo National Marine Sanctuary, Ocean Divers fleet of custom dive boats assures maximum diver comfort and convenience. All rental dive gear and tanks are easily accessible at dockside, and Ocean

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pursuant to Section 2(f). Thus, the question of registrability pursuant to Section 2(f) is not before us.

> Divers with its competitive everyday low prices and two retail centers, provides a wide selection of resort wear, T-shirts, scuba and snorkel equipment, film and video tape, and underwater photographic accessories. Ocean Divers can even offer unique scuba and snorkel programs with trained dolphins daily….

When the two words OCEAN and DIVERS, are combined in applicant's mark and used in connection with the identified services of, inter alia, arranging excursions for tourists in the field of underwater diving and dive shop services, it is clear that it is the entire phrase, OCEAN DIVERS, which is merely descriptive of applicant's services, in that this phrase directly conveys information about these services, namely, that the services are for those who wish to go diving in the ocean, or as the newspaper articles refer to them, ocean divers.

Applicant argues that individual disclaimers can be proper and acceptable for multi-word marks, citing **First Savings Bank F.S.B. v. First Bank System Inc.**, 902 F.Supp. 1366 (D. Kan. 1995). That decision, which was reversed at 33 F.3d 1367, 40 USPQ2d 1865 (10th Cir. 1996), did not discuss the issue of the propriety of disclaimers of individual words versus phrases. It simply mentioned, in the course of a likelihood of confusion analysis, that one of the parties had obtained a registration for the mark

FIRST BANK SYSTEM and design with a disclaimer of the individual words BANK and SYSTEM, and that a second registration issued for FIRST BANK SYSTEM per se 18 years later.

Although we have no quarrel with the proposition that in certain marks individual words may be separately disclaimed, we do not view the decision cited by applicant as supporting such a result in this case. The Court never discussed the propriety of the disclaimer or indicated why in certain marks individual elements can be disclaimed separately and in other marks elements must be disclaimed as a phrase.

Decision: The requirement for a disclaimer of the unitary phrase OCEAN DIVERS is affirmed. However, if applicant submits the required disclaimer within thirty days of the mailing of this decision, the refusal will be set aside. See Trademark Rule 2.142(g).

E. J. Seeherman

C. E. Walters

B. A. Chapman
Administrative Trademark Judges
Trademark Trial and Appeal Board