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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re The Hoover Company

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Serial No. 76263453

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Ray L. Weber of Renner, Kenner, Greive, Bobak, Taylor & Weber for The Hoover Company.

John S. Yard, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

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Before Seeherman, Hohein and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On May 25, 2001, applicant The Hoover Company applied to register the mark NUMBER ONE NAME IN FLOORCARE (typed or standard character drawing) on the Principal Register for goods ultimately identified as "floor cleaning appliances namely, carpet cleaning machines and floor polishing and cleaning machines" in Class 7. The application (Serial No. 76263453) is based on applicant's allegation of a bona fide intention to use the mark in commerce. The application contains a disclaimer of the term "floorcare."

The examining attorney<sup>1</sup> has now ultimately refused to register applicant's mark on two grounds. First, the examining attorney held that applicant's mark is not registrable under the provisions of Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because it is likely to cause confusion, to cause mistake, or to deceive as a result of a registration for the mark THE FIRST NAME IN FLOORCARE (typed or standard character drawing) on the Principal Register for "electrical vacuum cleaners for both domestic and industrial use" in Class 9. The registration (No. 2,463,035) issued June 26, 2001, and it also contains a disclaimer of the term "floorcare."

Subsequently, the examining attorney refused to register applicant's mark under the provision of Section 2(e)(1) of the Trademark Act because the examining attorney found that the mark NUMBER ONE NAME IN FLOORCARE was merely descriptive of applicant's goods. 15 U.S.C. § 1052(e)(1).

Procedurally, applicant appealed the likelihood of confusion refusal and an oral hearing was held on November 6, 2003. After the oral hearing, we remanded the case to the examining attorney to consider whether registration should be refused on the ground of descriptiveness. When

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<sup>1</sup> The current examining attorney was not the original examining attorney in this case.

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the application was refused on that basis, the appeal was resumed and a second oral hearing was held on May 17, 2006.

Previous Litigation

We begin our discussion by observing that applicant had previously unsuccessfully opposed the registration of registrant's mark. In that case, applicant relied on an unregistered mark, NUMBER ONE IN FLOORCARE. Both applicant and the examining attorney refer to the board's and the Federal Circuit's decisions in that opposition and we will also. See The Hoover Company v. Royal Appliance Mfg. Co., Opposition No. 91096834 (TTAB December 17, 1999) (Hoover I), aff'd, 238 F.3d 1357, 57 USPQ2d 1720 (Fed. Cir. 2001) (Hoover II). Inasmuch as the litigation is relevant to the issues in this case and applicant and the examining attorney refer to the previous proceeding, we will summarize the decisions in that opposition.

When registrant's mark THE FIRST NAME IN FLOORCARE was published for opposition, applicant herein filed an opposition in which it asserted that such mark so resembled its mark NUMBER ONE IN FLOORCARE for "electric vacuum cleaners" as to be likely to cause confusion. Hoover I, slip op. at 1. Applicant also asserted that registrant's mark was "deceptive, under Section 2(a) of the Trademark Act, or deceptively misdescriptive, under Section 2(e)(1)

of the Trademark Act, ... because it is a false statement which bestows upon [such] applicant's [products] an appearance of greater quality or salability to which the goods are not entitled." Hoover I, slip op. at 1.

The board disposed of the likelihood of confusion issue by finding that "the slogan NUMBER ONE IN FLOORCARE is a generally laudatory phrase, as opposer's own statements indicate, and, thus, it is not inherently distinctive." Id. at 4. In order to establish its priority, applicant herein (as opposer in Hoover I) was required to establish that the term had acquired distinctiveness. The board, however, concluded that it had "not established that its slogan ha[d] acquired distinctiveness" (Id.) and therefore, the claim of priority and likelihood of confusion failed.

Regarding the misdescriptiveness claim, the board concluded (Id. at 5) as follows:

[W]e find that opposer has not established that THE FIRST NAME IN FLOORCARE either misdescribes or misrepresents applicant's electrical vacuum cleaners. Rather, it appears to be a phrase that vaguely suggests, as in advertising puffery, general familiarity or quality. Opposer has failed to establish that "THE FIRST NAME" would be perceived by consumers as having the same connotation as "NUMBER ONE." Applicant's contentions that "THE FIRST NAME" has connotations suggesting familiarity, as in being on a "first name" basis, are equally reasonable. Further, even if "THE FIRST NAME" connotes a position of preeminence, it is a general connotation of

preeminence - it is not clear that consumers would immediately understand the category or categories to which the phrase would or could pertain. Thus, we find that applicant's mark is not deceptively misdescriptive.

The board also concluded that the term was not deceptive.

On appeal, the Federal Circuit affirmed the board's determinations. Regarding the question of the distinctiveness of the present applicant's mark, the court held that "[s]ubstantial evidence, however, supports the board's finding that 'Number One in Floorcare' is a generally laudatory phrase, and thus is not inherently distinctive. Hoover's Vice President of Marketing confirmed the self-laudatory nature of the slogan." Hoover II, 57 USPQ2d at 1722.

The court went on to hold (Id. (citation omitted)):

However unlikely, Hoover could fall from the number one ranking in one or more of the numerous categories (e.g., innovation, brand awareness, purchase intent, loyalty, market share), that it suggests render it "Number One in Floorcare." Because the "number one" source in each category could change at any time, the laudatory phrase of "Number One" does not necessarily indicate a single source. The new "number one" source should be free to "truthfully employ" the descriptive term "Number One" to describe its goods as well. Therefore, substantial evidence supports the board's finding that the mark "Number One in Floorcare" is not inherently distinctive.

On this issue, the court concluded: "Because substantial evidence supports the board's factual findings that Hoover's unregistered mark is not inherently

distinctive and has not acquired distinctiveness, the board properly held that Hoover did not have a trademark on which a likelihood of confusion count could be based." Id.

On the remaining issues of misdescriptiveness and deceptiveness, the court again upheld the board's determinations.

Hoover [applicant in the present case] argues that Royal's [registrant in the present case] mark would be perceived by consumers as meaning "number one," a position that Royal does not hold in the floorcare industry. The board acknowledged that the term "The First Name" connotes a position of preeminence in a general sense, but it is unclear which category or categories to which the phrase would or could pertain. It found equally reasonable Royal's contentions that the term "The First Name" suggests general familiarity, as in being on a "first name" basis with an individual.

The possibility of drawing two inconsistent conclusions from the evidence does not prevent the board's finding from being supported by substantial evidence. A reasonable person could find that the evidentiary record supports the board's conclusion that Royal's mark suggests a general familiarity, and does not misdescribe or misrepresent Royal's goods. Because substantial evidence supports the finding that the phrase does not either misdescribe or misrepresent Royal's goods, the board correctly held that Royal's mark was not deceptive.

Hoover II, 57 USPQ2d at 1723 (citation omitted).

We add that the ultimate decision on whether marks are confusingly similar rests with the board and the courts.

The opinion of an interested party respecting the ultimate conclusion involved in a proceeding would normally appear of no moment in that proceeding. Moreover, it is known at the outset. One may assume,

for example, that an opposer believes confusion likely and that a defending applicant does not. That a party earlier indicated a contrary opinion respecting the conclusion in a similar proceeding involving similar marks and goods is a fact, and that fact may be received in evidence as merely illuminative of shade and tone in the total picture confronting the decision maker. To that limited extent, a party's earlier contrary opinion may be considered relevant and competent. Under no circumstances, may a party's opinion, earlier or current, relieve the decision maker of the burden of reaching his own ultimate conclusion on the entire record.

Interstate Brands Corp. v. Celestial Seasonings, Inc., 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978) (footnote omitted).  
See also Specialty Brands, Inc. v. Coffee Beans Distributors, Inc., 748 F.2d 669, 223 USPQ 1281, 1283 (CCPA 1984).

Finally, the court refused to consider applicant's attempt to argue that registrant's mark was a generally laudatory term as the board had found applicant's term to be. 57 USPQ2d at 1723 (citation omitted) ("Hoover contends that Royal's mark, 'The First Name in Floorcare,' is unregistrable as a generally laudatory descriptive phrase. This issue was not raised in Hoover's Notice of Opposition and the board did not rule on it. We decline to address it for the first time on appeal").<sup>2</sup>

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<sup>2</sup> After the oral hearing, applicant filed a paper that responded to a question at the hearing and referred the board to a paragraph of the Federal Circuit opinion. We have granted applicant's request to consider this paper.

Likelihood of Confusion

We begin by addressing the examining attorney's refusal to register on the ground that applicant's mark is likely to cause confusion with the mark of the cited registration. In likelihood of confusion cases, we look to the factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) to determine whether there is a likelihood of confusion. See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Because of the previous litigation, we start our discussion of the likelihood of confusion issue by noting that this issue was not specifically decided by the board or the Federal Circuit previously because applicant (then opposer) was unable to prove priority. Therefore, any discussion of the meaning of the marks was in the context

of the question of whether applicant's mark was descriptive and therefore not inherently distinctive or whether registrant's mark was deceptively misdescriptiveness or deceptive. The board has previously explained how a mark with more than one meaning impacts different refusals. In re White Swan Ltd., 8 USPQ2d 1534 (TTAB 1988).

[A]pplicant contends that its mark SHAKE SCATTER & GROW "brings to mind the well-known song or expression 'Shake, Rattle & Roll.'" Continuing, applicant argues that its "mark does not 'conjure up the same general connotation' as registrant's mark because applicant's mark brings to mind 'Shake, Rattle & Roll' whereas registrant's mark does not."

Registrant's mark SHAKE-N-GROW does not bring to mind a song. On the other hand, applicant's mark SHAKE SCATTER & GROW probably does -- for some consumers -- bring to mind a song. However, we are not convinced that applicant's mark is so like the title of a song, and that that song is so well known, that the overwhelming majority of consumers associate applicant's mark solely with the song. Stated differently, we think that at least an appreciable number of consumers would not associate applicant's mark with a song, and would simply view applicant's mark -- as well as registrant's mark -- as suggestive of how the products might be utilized. Likewise, even for those consumers who do make a connection between applicant's mark and a song, we believe that at least some of these consumers would also view applicant's mark as suggestive of how applicant's product is to be utilized.

Applicant has cited three cases in which marks were held to be not "merely descriptive" because they had two meanings, one of which was descriptive of the ingredients, qualities or characteristics of the goods or services, and the other of which was not. Applicant apparently asks this Board to extend this concept to the issue of likelihood of confusion and find that there is no likelihood of confusion in this

case because even assuming that applicant's mark has one connotation similar to registrant's mark, the other connotation of applicant's mark -- that of the song "Shake, Rattle & Roll" -- is totally dissimilar from the connotation of registrant's mark SHAKE-N-GROW.

However, there is a basic difference between a refusal to register on the ground of likelihood of confusion [Section 2(d) of the Lanham Trademark Act] and a refusal to register on the ground of "merely descriptive" [Section 2(e) of the Lanham Trademark Act] that causes us to reject applicant's request. In appropriate cases, the fact that a descriptive word has a double meaning may indicate that the word is not "merely descriptive" of the goods or services. See In re Quick-Print Copy Shop, Inc., 616 F.2d 523, 203 USPQ 505, 507 n.7 (CCPA 1980) ("Merely" means "only."); In re Colonial Stores, Inc., 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE for bakery products also reminiscent of nursery rhyme). In contrast, in the context of likelihood of confusion, the fact that a word mark will be understood by some individuals in a manner such that confusion with a prior mark is likely and by other individuals in a manner such that confusion is unlikely, will generally still result in a finding of likelihood of confusion, provided that the size of the group of individuals who are likely to be confused is not inconsequential. Cf. 2 J. McCarthy, *Trademarks and Unfair Competition*, §23:18 at pp. 44-45 (2d ed. 1984).

Moreover, in deciding the issue of descriptiveness, it is the policy of this Board to resolve doubts in favor of the applicant and allow the mark to be published. In re Gracious Lady Service, Inc., 175 USPQ 380, 382 (TTAB 1972). In contrast, in deciding the issue of likelihood of confusion, it is the policy of this Board -- as mandated by the Court of Appeals for the Federal Circuit -- to resolve doubts against the applicant in favor of the registrant. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983).

White Swan, 8 USPQ2d at 1535-36 (footnote omitted).

Thus, while the fact that a term with more than one meaning when applied to the goods or services may result in the term not being merely descriptive or deceptively misdescriptive, the same rule does not apply in likelihood of confusion cases. As the White Swan opinion explains, even though a term may have more than one meaning in connection with the goods or services, if a group that "is not inconsequential" would understand that the mark has a meaning that is similar to the registered mark, there can be a likelihood of confusion. In the previous Hoover opinions, the board and the court simply held that registrant's mark was not deceptively misdescriptive because, inter alia, it also had a non-descriptive meaning suggesting being on a first name basis. See Hoover Company, slip op. at 5 ("Applicant's contentions that "THE FIRST NAME' has connotations suggesting familiarity, as in being on a 'first name' basis, are equally reasonable"). Neither the Court nor the board found that the registrant's mark had only one meaning.

With this background, we will now consider the first du Pont factor and begin with a comparison of the marks. This factor "requires examination of 'the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.'" "

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Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison  
Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed.  
Cir. 2005) (quoting In re E. I. du Pont de Nemours & Co.,  
476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973)).

The marks in this case are:

NUMBER ONE NAME IN FLOORCARE (applicant)

THE FIRST NAME IN FLOORCARE (registrant)

Neither mark includes a design or any particular form of display. Both marks also include a disclaimer of the term "floorcare."

Both marks end with the same phrase "Name in Floorcare" and to this extent they are similar in appearance and pronunciation. We acknowledge that the initial portion of the marks are not the same, "Number One" and "The First." However, these terms are similar to the extent that "The First" and "Number One" are references to the numeral "1." With the first Office action (p. 2), the examining attorney attached definitions of "First" as "Ranking before or above all others" and "Number One" as "First in rank, order, or importance." We must conclude that regardless of whatever other meanings the term "Number One Name" may have, at least a non-inconsequential number of purchasers are likely to conclude that it means "first in rank." This meaning would be virtually the same as

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"First." Therefore, for likelihood of confusion purposes, the terms are similar in connotation. Also, for likelihood of confusion purposes, the marks are likely to have, at least for some purchasers, similar commercial impressions. The differences between the marks THE FIRST NAME IN FLOORCARE and NUMBER ONE NAME IN FLOORCARE do not significantly change the marks' commercial impressions. Furthermore, the similarities in sound and appearance of the terms outweigh their differences. Both have the identical ending, "Name in Floorcare," and the words that are different "The First" and "Number One" both involve a variant of "one." It is important to remember that:

The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks.

Baseball America Inc. v. Powerplay Sports Ltd., 71 USPQ2d 1844, 1848 (TTAB 2004). See also Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973); Johann Maria Farina Gegenuber Dem Julichs-Platz v. Chesebrough-Pond, Inc., 470 F.2d 1385, 176 USPQ 199, 200 (CCPA 1972).

We conclude by finding that the marks, in their entirety, are very similar in sound, appearance, meaning, and commercial impression.

In any likelihood of confusion analysis, the next important factor is whether applicant's and registrant's goods are related. Applicant's goods are "floor cleaning appliances namely, carpet cleaning machines and floor polishing and cleaning machines" while registrant's goods are "electrical vacuum cleaners for both domestic and industrial use." We must consider the goods as they are set out in the identification of services in the application and registration. See Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods" or services).

Both applicant's and registrant's goods clean carpets and floors. Registrant's goods include vacuums for domestic and commercial use and the goods identified in applicant's application are not limited to any particular type of purchasers or channels of trade. "Thus, where the goods in a cited registration are broadly described and there are no limitations in the identification of goods as to their nature, type, channels of trade or classes of

purchasers, it is presumed that the scope of the registration encompasses all goods of the nature and type described, that the identified goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers." In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

We thus must assume that both applicant and registrant sell all types of vacuums or floor cleaning appliances to commercial and home users in all normal channels of trade for such goods. To the extent that vacuum cleaners and carpet and floor cleaning machines are different, they are nonetheless very closely related. They originate from the same sources. See [www.oreck.com](http://www.oreck.com) ("Our floor cleaning machine and carpet cleaner are as hard-working as our vacuums"); [www.whatuseek.com](http://www.whatuseek.com) ("Centaur Floor Machines - Manufacturer of bonnet cleaners, industrial and commercial floor cleaning machines and carpet cleaning equipment"); and [www.google.com](http://www.google.com) ([www.arcat.com](http://www.arcat.com) ["Manufacturer of floor cleaning machines, parts and accessories ... carpet wet/dry vacuums"] and [www.business.com](http://www.business.com) [Victor brand floor cleaning machines and vacuums]). Applicant maintains that it is also the source of vacuum cleaners. See Hoover I, slip op. at 1. These products are also sold in the same channels of

trade and the purchasers would be similar.<sup>3</sup> We conclude that applicant's floor cleaning appliances and registrant's vacuums are related and that the purchasers and channels of trade would be similar, if not overlapping.

Under the facts of this case, we conclude that the marks THE FIRST NAME IN FLOORCARE and NUMBER ONE NAME IN FLOORCARE are very similar and the goods are either overlapping or very closely related. Therefore, if applicant used its mark on the identified goods, there would be a likelihood of confusion in view of the mark in the cited registration.

Mere Descriptiveness

The other refusal in this case is that the mark NUMBER ONE NAME IN FLOORCARE is merely descriptive of applicant's goods. Applicant has disclaimed the term "floorcare." A "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service." In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003); In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978).

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<sup>3</sup> See the website of [www.lansinganitary.com](http://www.lansinganitary.com) that advertises floor machines, floor scrubbers, wet/dry "vac's," and vacuums.

The examining attorney argues (Supp. Br. at unnumbered p. 5) that:

The mark NUMBER ONE NAME IN FLOORCARE, taken as a whole, is merely a laudatory phrase as relates to the identified goods. The applicant's mark, merely touts that the applicant's goods are of the first in rank, reputation and renown in the field of floorcare. The mark immediately serves to impress upon prospective customers that the applicant's floor care goods are of the most highly renowned and reputable quality and excellence.

In response, applicant argues:

The Examining Attorney did not analyze the mark in relation to the associated goods of "floor cleaning appliances, namely, carpet cleaning machines and floor polishing and cleaning machines." The proper test for a merely descriptive rejection is that the mark merely describes the goods, not that the mark merely describes the source.  
Supp. Br. at 2.

Rather, the term NUMBER ONE modifies NAME, and neither NUMBER ONE nor NAME in any way relates to the goods for which registration of NUMBER ONE NAME IN FLOORCARE is sought - flooring cleaning appliances.  
Supp. Br. at 3.

Nothing in the mark NUMBER ONE NAME IN FLOORCARE merely describes floor cleaning appliances. Rather, the mark merely suggests that the goods upon which it is used come from a particular source.  
Supp. Br. at 5.

We start by noting that the board previously found that the mark NUMBER ONE IN FLOORCARE was merely descriptive. Hoover I, slip op. at 4 ("We agree with applicant [now registrant] that the slogan NUMBER ONE IN FLOORCARE is a generally laudatory phrase, as opposer's own

statements indicate"). Regarding the statement of Mr. Gault, Hoover's vice president, the board found that he "stated, unequivocally, that the slogan 'Number One in Floorcare' is descriptive of the various areas wherein Hoover is 'first,' such as historically, selling the first vacuum cleaner, and in terms of product sales, reliability and innovation, and consumer brand recognition." Hoover I, slip op. at 3. On appeal, the Federal Circuit held that "[s]ubstantial evidence, however, supports the board's finding that 'Number One in Floorcare' is a generally laudatory phrase, and thus not inherently distinctive." Hoover II, 57 USPQ2d at 1722.

The term "Number One" is defined as "a person , company, etc., that is first in rank, order, or importance: *the number one team in the nation; our number one problem.*" Examining Attorney's Original Brief, *American Heritage Dictionary of the English Language* (3rd ed. 1992).<sup>4</sup> The addition of NAME in applicant's present mark, i.e., THE NUMBER ONE NAME IN FLOORCARE, does not change the connotation of applicant's prior mark, NUMBER ONE IN FLOORCARE. Applicant's mark merely describes the fact that

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<sup>4</sup> To the extent necessary, we take judicial notice of this definition. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

applicant considers itself the number one brand of floor care appliances.

Applicant's main argument is that "the term NUMBER ONE modifies NAME, and neither NUMBER ONE nor NAME in any way relates to the goods." Supp. Br. at 5. The argument is not persuasive. First, the Federal Circuit has found that substantial evidence supported the board's determination that applicant's very similar mark NUMBER ONE IN FLOORCARE was merely descriptive of applicant's goods. Second, as Professor McCarthy has noted:

A "descriptive" term is one that directly and immediately conveys some knowledge of the characteristics of a product or service.

A mark is "descriptive" if it is descriptive of... the provider of the goods or services.

J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 11:16 (4<sup>th</sup> ed. June 2006).

Third, it "is well-established that a term which describes the provider of goods or services is also merely descriptive of those goods or services." In re Major League Umpires, 60 USPQ2d 1059, 1060 (TTAB 2001). In that case, the board found that the applicant's "website also prominently advertises that it is owned and operated by three National League umpires and the biographies of these men, also prominently featured on the website, list their

activities as major league umpires. Accordingly, there can be no question that MAJOR LEAGUE UMPIRE describes the provider of the identified goods." Id. at 1060. See also In re E. I. Kane, Inc., 221 USPQ 1203 (TTAB 1984) (OFFICE MOVERS, INC. unregistrable for office moving services); In re Quatomic, Inc., 185 USPQ 59, 60 (TTAB 1974) (STRIPPERS, "although not the name of the service as the examiner claims, immediately and unequivocally indicates to purchasers and prospective purchasers that applicant is engaged in stripping or removing paint and varnish and other finishes from various wooden and metal surfaces"); and In re Old Boone Distillery Co., 172 USPQ 697 (TTAB 1972) (DISTILLER'S LIGHT merely descriptive for scotch whiskey).

Here, applicant's mark immediately informs prospective purchasers that its products are made by the "number one name in floorcare." Whether that source of the goods is number one in innovation, brand awareness, loyalty or market share, it is obviously a form of puffery and as such is merely descriptive. "Self-laudatory or puffing marks are regarded as a condensed form of describing the character or quality of the goods." In re Boston Beer Co., 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999) (quoting 2 J. Thomas McCarthy, *McCarthy on Trademarks and*

*Unfair Competition*, § 11:17 (4th ed. 1996) (internal quotations omitted)). The slogan "Number One Name in Floorcare," like the phrase "Best Beer in America," immediately describes a characteristic of the goods, i.e., that applicant's products are made by the source that is "first in rank, order, or importance." As a result, consumers would understand that applicant is describing its products as being more desirable than goods from other sources.

Finally, we are unable to recognize any significant differences between the marks NUMBER ONE IN FLOORCARE and NUMBER ONE NAME IN FLOORCARE. The Federal Circuit specifically held that:

However unlikely, Hoover could fall from the number one ranking in one or more of the numerous categories (e.g., innovation, brand awareness, purchase intent, loyalty, market share), that it suggests render it "Number One in Floorcare." Because the "number one" source in each category could change at any time, the laudatory phrase of "Number One" does not necessarily indicate a single source. The new "number one" source should be free to "truthfully employ" the descriptive term "Number One" to describe its goods as well.

Hoover II, 57 USPQ2d at 1722.

It would certainly be odd that the "new 'number one' source" would be able to use the descriptive term NUMBER ONE IN FLOORCARE for its floor care appliances while applicant would have the exclusive right to identify its

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identical products as NUMBER ONE NAME IN FLOORCARE.

Contrary to applicant's argument, the entity that is now the new "Number One in Floorcare" should also be able to claim that it is the new "Number One Name in Floorcare." The term is similarly a laudatory term that is merely descriptive of the goods.

Decision: The refusal to register on the ground that applicant's mark, when used on its identified goods, is confusingly similar to the cited registration is affirmed. The refusal to register applicant's mark on the ground that its mark is merely descriptive is also affirmed.