

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

DEC 17, 97

Paper No. 16
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jinwoong, Inc.

Serial No. 74/538,475

Michael J. Hughes of The Intellectual Property Law Office of
Michael J. Hughes for applicant.

Anil V. George, Trademark Examining Attorney, Law Office 108
(David E. Shallant, Managing Attorney).

Before Rice, Simms, and Hairston, Administrative Trademark
Judges.

Opinion by Rice, Administrative Trademark Judge:

An intent-to-use application has been filed by
Jinwoong, Inc. to register the mark CANVAS CLASSICS and
design, as shown below (in reduced size),



for luggage, tote bags, duffel bags, knapsacks, and casual luggage components, namely, identification tags, straps for luggage and collapsible, non-motorized luggage carts.¹

The Examining Attorney has made final a requirement for a disclaimer of the words CANVAS CLASSICS apart from the mark as shown, pursuant to Sections 2(e)(1) and 6(a) of the Act, 15 U.S.C. §§1052(e)(1) and 1056, on the ground that these words, when applied to the goods of the applicant, merely describe an ingredient, quality, characteristic, function, feature, purpose or use of them. Applicant has appealed.

In support of the refusal to register, the Examining Attorney has made of record a substantial amount of evidence, namely, excerpts from more than 30 different stories from the NEXIS® database; copies of 23 third-party applications/registrations containing disclaimers of the terms CLASSIC, CLASSICS, or CANVAS; copies of eight third-party advertisements; and certain dictionary definitions.

The NEXIS® story excerpts all include the term CLASSIC or CLASSICS used within five or ten words of the term LUGGAGE (or, in a few instances, the terms TOTE BAG or

¹ Application Serial No. 74/538,475, filed June 16, 1994 under Section 1(b) of the Trademark Act of 1946, 15 U.S.C. §1051(b). An amendment to allege use, asserting first use and first use in commerce on September 28, 1994, was filed by applicant, pursuant to Section 1(c) of the Act, on February 5, 1996 and was approved by the Examining Attorney. It is stated in the application that

KNAPSACK or DUFFEL). Some of the most pertinent excerpts are quoted below (**emphasis** added):²

"The bag borrows features from **classic duffel** and **luggage** designs. It's a roomy carry-on that will fit under an airplane seat." -- The San Diego Union-Tribune (June 25, 1995)

"... the new Florentia is one of the largest **luggage** collections she has seen in years. There are three sizes of **classic luggage** and 10 to 15 additional items that include garment bags and two-suiters for men." -- The Post and Courier (December 9, 1994)

"Mrs. Moltedo supervises the teams of designers who seasonally produce fresh takes on Bottega's **classic** handbags, shoes, belts, gloves and **luggage**." -- The Dallas Morning News (November 1, 1992)

"The lifestyle-oriented Marco Polo Collection, ranging from day bags to **luggage**, is always available in **classic** shapes in black, navy, red, green or brown." -- The San Francisco Chronicle (August 6, 1990)

"The merchandise line includes a **classic** structured **luggage** group updated with bright primary colors ..." -- Women's Wear Daily (July 13, 1990)

"... square-foot store, located between Madison Avenue and Park Avenue, will carry the entire Ghurka collection, including its **classic** khaki

the lining and stippling shown in the drawing are features of the mark and are not intended to indicate color.

² A few of the story excerpts are from foreign publications, which do not show the significance of the term CLASSIC, in relation to goods of the type listed in applicant's identification, in the United States. A few of the other excerpts come from newswire stories. Unless there is evidence that these stories have been picked up and printed, they are not evidence that the usage shown therein has had any impact on public perception of the significance of the term CLASSIC in relation to luggage products. Accordingly, we have not considered the excerpts from foreign publications at all, and have accorded little probative value to the newswire excerpts.

twill and leather bags and **luggage** ..." --
Women's Wear Daily (April 27, 1990)

"... took plenty of time to see America, but no more **luggage** than today's weekend traveler. For him, the **classic** sport **duffel**, either a vertical 'north-south' model that hangs cylinderlike from the shoulder or an 'east-west' version ..." -- The New York Times (June 25 1989)

"Designer Jon Darmstadter takes **classic luggage** styles and updates them with fashion-forward fabrics." -- Chicago Tribune (May 15, 1985)

"... **classic** hard-sided handmade **luggage** runs from \$535 to \$775 ..." -- The New York Times (December 5, 1982)

"With this **classic** English (sic) gardeners' **tote bag**, there's no excuse for misplacing your tools." -- Forbes (March 14, 1994)

"The **knapsacks**, in combinations of suede, denim and plaids in the dark fall colors, are **classic-looking** ..." -- The Times Union (August 25, 1994)

The third-party applications/registrations made of record by the Examining Attorney include 19 applications/registrations of composite marks containing the term CLASSIC or CLASSICS, all of which include a disclaimer of the term apart from the mark as shown. Eleven of them are for goods similar, at least in part, to applicant's; seven for related goods (e.g., handbags, wallets, etc.); and one for unrelated goods (kits for making horse sheets and horse blankets). There are also four applications/registrations of composite marks containing the term CANVAS, all of which include a disclaimer of that term.

Three of these are for goods similar, at least in part, to applicant's; one is for related goods (ladies' handbags).

The eight third-party advertisements show use of CLASSIC or CLASSICS either as part of descriptive text or as part of trademarks in which the term appears to play a descriptive role. Some of the advertisements are for goods similar, at least in part, to applicant's; the rest are for related goods such as attaché cases, portfolios, and handbags.³

Finally, the Examining Attorney relies upon two definitions from the Man-Made Fiber and Textile Dictionary (1981). The first definition is for the word CANVAS and reads simply, "See DUCK." The definition for DUCK reads as follows:

A compact, firm, heavy, plain-weave fabric with a weight of 6 to 50 ounces per square yard. Plied yarn duck has plied yarns in both warp and filling.

³ For example, an ad in the August 1989 issue of Travelware features briefcases identified by the mark RENASCENCE and, thereunder, the phrase "NEW AGE" CLASSICS. An ad in the March 1995 issue of the same publication pictures plaid luggage identified by the mark ANDIAMO and also includes, above the picture, the words CLASSIC BLACK WATCH. An ad in the September 1993 issue of Accessories pictures handbags and what looks like a briefcase and, above the picture, the wording "Insist on the original ANDANTINI® CLASSICS". The same issue includes an ad by Carpetbags of America picturing handbags and possibly a carpetbag with text which includes the sentence, "THIS SEASON, THE EMPHASIS IS ON CLASSIC STYLE EXPRESSED IN A BROAD RANGE OF DISTINCTIVE FABRICS." An ad in the April 1994 issue of Accessories pictures handbags accompanied by text which reads in part, "Let us find you the right Brahmin Handbags for your store from our best selling classics and exciting NEW alternatives." A Spiegel catalog listing for a carpetbag includes the text, "This roomy cotton tapestry bag combines the timeless appeal of the classic equestrian theme with today's functional demands."

Flat duck has a warp of two single yarns woven as one and a filling of either single or plied yarn.

We also note that the adjective "classic" is defined in The Random House Dictionary of the English Language (Second Edition Unabridged, 1987) as, inter alia, "of the first or highest quality, class, or rank", "serving as a standard, model, or guide", "of enduring interest, quality, or style", and "traditional or typical". The noun form of the word is defined in the same dictionary as, inter alia, "a work that is honored as definitive in its field", "something noteworthy of its kind and worth remembering", and "an article, as of clothing, unchanging in style".

A mark is merely descriptive if, as used in connection with the goods or services in question, it describes, i.e., immediately conveys information about, an ingredient, quality, characteristic, feature, etc. thereof, or if it directly conveys information regarding the nature, function, purpose, or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Eden Foods Inc.*, 24 USPQ2d 1757 (TTAB 1992); and *In re American Screen Process Equipment Co.*, 175 USPQ 561 (TTAB 1972). The question of whether a mark is merely descriptive must be determined not in the abstract, that is, not by asking whether one can guess from the mark itself, considered in a vacuum, what the goods or services are, but

rather in relation to the goods or services for which registration is sought, that is, by asking whether, when the mark is seen on the goods or services, it immediately conveys information about their nature. See *In re Abcor*, *supra*.

In the present case, the specimens submitted with applicant's amendment to allege use show that its various products are made of canvas. Thus, the term CANVAS describes a characteristic or feature of applicant's goods. Moreover, the evidence made of record by the Examining Attorney establishes that the term CLASSICS likewise has descriptive significance with respect to goods of the type specified in applicant's application, in that it describes their nature or a characteristic or feature of them. The combination of the two terms as CANVAS CLASSICS does not result in any different significance. Rather, the combination simply conveys the merely descriptive meanings of its parts. Under the circumstances, we fully agree with the Examining Attorney's conclusion that the words CANVAS CLASSICS are merely descriptive of applicant's goods and thus must be disclaimed apart from the mark as shown.⁴

⁴ It should be noted that the Examining Attorney has not taken the position that the design portion of applicant's mark is lacking in distinctiveness. Rather, the Examining Attorney maintains (quite correctly, in our opinion) that the mark includes not only the distinctive design of the man, dog, house, etc., but also the words CANVAS CLASSICS, and that because these words are merely descriptive as applied to applicant's goods, the

Applicant argues, inter alia, that it owns a registration on the Supplemental Register of the designation CANVAS CLASSICS for the same goods as those specified in the present application; that in light of applicant's established right to the word mark, a blanket disclaimer is out of the question; that applicant should not be forced to vitiate its already established rights in order to obtain protection for its distinctive logo form of the mark; and that applicant instead should be allowed to submit a qualified disclaimer in the following form:

Applicant is the owner of U.S. Trademark Registration No. 1,971,971 for the mark CANVAS CLASSICS (typed drawing), issued 30 April 1996 on the Supplemental Register, for the same goods as the present matter. Applicant relies on such registration for any claim of right to the words "CANVAS CLASSICS" for the goods stated herein, and accordingly disclaims any rights to such words as a part of the present matter, apart from the mark as shown.

It is clear that applicant misunderstands the nature of a registration upon the Supplemental Register. Section 7(b) of the Act, 15 U.S.C. §1057, provides that a certificate of registration upon the Principal Register shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the

mark as a whole is not registrable on the Principal Register without a disclaimer of the words.

goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate. The same is not true of a certificate of registration upon the Supplemental Register. To the contrary, Section 26 of the Act, 15 U.S.C. §1094, specifically provides that registrations upon the Supplemental Register shall not receive the advantages of §7(b). Indeed, while a registration upon the Supplemental Register is not evidence that registrant has any existing rights in the registered mark, it does constitute, in cases such as this, evidence of applicant's concession that at least at the time of registrant's first use of the registered term, the term was merely descriptive as applied to the goods or services specified in the registration. *See, for example, In re Medical Disposables Co.*, 25 USPQ2d 1801 (TTAB 1992); *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134 (TTAB 1992); *In re Federated Department Stores Inc.*, 3 USPQ2d 1541 (TTAB 1987); *In re France Croissant, Ltd.*, 1 USPQ2d 1238 (TTAB 1986); and *In re Hester Industries, Inc.*, 230 USPQ 797 (TTAB 1986).

For the foregoing reasons, the requirement for a disclaimer, in the form specified by the Examining Attorney, of the designation CANVAS CLASSICS is affirmed. Applicant is allowed until 30 days from the mailing date of this

decision in which to submit the required disclaimer. If applicant submits the disclaimer during the time allowed, the decision will be set aside.

J. E. Rice

R. L. Simms

P. T. Hairston

Administrative Trademark
Judges, Trademark Trial
and Appeal Board