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THE REPORT OF
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Royal Appliance Mfg. Co.

Sams
Attys
6-23-97

Serial No. 74/602,204

Partrick R. Roche of Fay, Sharpe, Beall, Fagan, Minnich &
McKee for Royal Appliance Mfg. Co.

Gary R. Thayer, Trademark Examining Attorney, Law Office 103
(Michael A. Szoke, Managing Attorney).

Before Sams, Cissel and Hanak, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge.

On October 23, 1994, applicant filed an application to
register the mark "MAXIMUM VACUUM POWER" on the Principal
Register for "electrical vacuum cleaners for both domestic
and industrial use, in International Class 9." The
application was based on applicant's assertion that it
possessed a bona fide intention to use the mark on these
goods in commerce.

Registration was refused under Section 2(e)(1) of the
Act on the ground that the proposed mark is merely

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descriptive of the goods set forth in the application. In support of the refusal to register, the Examining Attorney submitted copies of dictionary definitions of "maximum" as "the greatest quantity or value attainable or attained the upper limit allowed (as by legal authority) or allowable"; of "vacuum" as "of or relating to a vacuum device or system"; of "vacuum cleaner" as "an electrical appliance for cleaning (as floors, carpets, tapestry, or upholstered work) by suction-called also vacuum sweeper"; and of "power" as the "ability to act or produce an effect." From these definitions the Examining Attorney concluded that using the mark in connection with vacuum cleaners would lead reasonable purchasers to understand that the vacuum cleaners bearing the mark have the greatest attainable vacuuming power.

Applicant responded by arguing that the mark does not convey to consumers an immediate idea of vacuum cleaners, that it has not been used by others in the field, and that applicant's use does not deprive competitors of a way to describe their goods. Applicant included a list of third-party registrations of marks which include the words "MAXIMUM," "VACUUM," or "POWER," although copies of the registrations were not submitted, and the goods with which the registered marks are allegedly registered were not specified.

The Examining Attorney was not persuaded, and his second Office Action made the refusal final. He maintained that "prospective customers would immediately understand the mark as describing the fact that the vacuum cleaners have the highest or maximum vacuum/cleaning/suction power available "

Attached to the final refusal were copies of excerpts from a Sears catalog wherein the power of various vacuum cleaners is touted. Among others, the following terms are used in connection with these vacuum cleaners: "suction power," "cleaning power," "power level," "power levels," "maximize suction power," "power packed," "variable power control," "extra cleaning power," and "more power." Also submitted with the final refusal were copies of a number of third-party registrations wherein the word "MAXIMUM" is disclaimed apart from each particular mark as a whole.

On June 24, 1996, applicant timely filed a notice of appeal and submitted four exhibits with its brief. Exhibit A is a copy of the dictionary definition of "vacuum cleaner" submitted by the Examining Attorney with his first Office Action. Exhibit B consists of five excerpts from different publications wherein "Maximum Vacuum Power" is used in connection with applicant's upright vacuum cleaners. Exhibit C appears to be the same list applicant had previously submitted of registered marks which incorporate

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either "MAXIMUM," "VACUUM," or "POWER." Exhibit D is a print-out of a search report from a commercial data base. It lists a number of third-party registrations of marks which include or consist of the word "POWER," as well as the products in connection with which they are reported to be registered.

Applicant argues that its mark is an incongruous combination of words which does not provide the consumer with the knowledge that its product is for cleaning. Applicant suggests that because the mark does not cause one immediately to think of electric vacuum cleaners, it is not merely descriptive within the meaning of the Lanham Act. According to applicant, a person would need to "make a mental pause to deduce that the mark MAXIMUM VACUUM POWER even suggests electrical vacuum cleaners." (brief, p.5.) Further, applicant argues that the three words in its mark are not ordinarily combined into a single expression or as a trademark for anything, and that they have no particular significance when viewed as a combination. Applicant argues that the words are not used by others, either descriptively or as marks, and that third-party registrations of marks which include the word "POWER" demonstrate that applicant's mark should be registered as well.

On October 30, 1996, the Examining Attorney requested suspension of action on the appeal and remand for the

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introduction of additional evidence under Trademark Rule 2.142(d). The Board granted the request, and on December 16, 1996, the Examining Attorney issued another Office Action, attached to which were copies of photographs taken by the Examining Attorney of actual cartons containing applicant's products. He noted that "[b]eyond the prominent display of the phrase 'MAXIMUM VACUUM POWER' at the top of the carton, it is also quite telling that the proposed mark appears again as one item in a list of descriptive features of the vacuum cleaners as displayed in the text on the left side of the carton under the 'Dirt Devil' logo, [i.e., 'Maximum Vacuum Power ' 'Maximum Deep Cleaning ' 'Eliminates Fan and Motor Damage ' 'Effortless Above-the-Floor Cleaning ' etc.]" He argued further that "the obvious meaning of 'Maximum Vacuum Power' is emphasized in the features listing by the following on-carton statements: '50% More Suction at the hose Than Conventional Brands' and 'Maximum Deep Cleaning with powerful 12 amp motor- maximum allowed by UL. [Emphasis added].'" The Examining Attorney found applicant's language on its carton to be further evidence that the words "MAXIMUM VACUUM POWER" would be immediately understood by purchasers as indicating that applicant's vacuum cleaners have the greatest available power.

The file was returned to the Board for resumption of action on the appeal. Applicant was allowed to file a supplemental brief to respond to the additional evidence submitted by the Examining Attorney. Along with its arguments, applicant submitted three more exhibits. Exhibit E is a copy of the black and white photograph of applicant's carton made of record by the Examining Attorney. Exhibit F is a copy of a color photograph of the same carton for applicant's goods. Applicant emphasized that the words sought to be registered are shown in the color red, in contrast with the list of features shown below it, and that the superscript "TM" follows the presentation of the term sought to be registered. Exhibit G is the second photo supplied by the Examining Attorney. Applicant argued that it shows its mark presented not in a merely descriptive manner, but rather as applicant's trademark

After applicant's supplemental brief was submitted, the Examining Attorney filed his appeal brief. Attached to it were copies of previously submitted exhibits and copies of additional dictionary definitions from a different dictionary than the one originally used to support the refusal. The first Office Action included the quoted excerpts from the 1990 edition of Webster's Ninth New Collegiate Dictionary. The additional definitions submitted with the brief are from the second edition of the Random

House Unabridged Dictionary. It lists "maximum" as meaning "greatest or highest possible or attained." The word "vacuum" is defined as "a vacuum cleaner or sweeper," and "power" is listed as meaning the "ability to do or act; capability of doing or accomplishing something."

Applicant did not respond to the brief of the Examining Attorney, nor did it request an oral hearing. We therefore turn to consideration of the merits of this appeal.

We are guided by a number of well settled principles in resolving the question of descriptiveness under the Lanham Act. A term need not name the goods with which it is used in order for it to be considered merely descriptive of them. Rather, a mark is merely descriptive if, as used in connection with the goods in question, it describes, i.e., immediately conveys information about, an ingredient, quality, characteristic, feature of them, or if it directly conveys information regarding their nature, function, purpose, or use. 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). Additionally, whether a mark is merely descriptive is determined not in the abstract, as applicant has argued in the instant case, by asking whether one can guess from the mark itself, without anything else, what the goods are, but

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rather in relation to the goods set forth in the application. We must ask whether, when the mark is viewed as it is used on the goods, it immediately conveys information about their nature. See *Abcor*, supra.

The fact that only an applicant is presently using a merely descriptive term in connection with a particular kind of product is not a sufficient basis for issuance of a registration to that applicant. Further, the use of the designation "TM" in connection with a term does not convert an otherwise unregistrable term into a registrable trademark. In *re Nosler Bullets, Inc.*, 169 USPQ 62 (TTAB 1971).

Finally, the Board is not bound by prior decisions of Examining Attorneys which resulted in the registration of other marks by third parties. Each case must on appeal before us must be decided on its own merits based on the evidence of record. In *re Hechinger Investment Co. of Delaware, Inc.*, 24 USPQ2d 1057 (TTAB 1991).

After careful consideration of the record in this application and the arguments of both applicant and the Examining Attorney, we find that the refusal to register is proper. The evidence, especially the second set of dictionary definitions, plainly shows that when the ordinary meanings of the three words in applicant's mark are considered together in connection with applicant's vacuum

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cleaners, purchasers or prospective purchasers would readily understand them to indicate that applicant's vacuum cleaners have the most power available in such a product. The evidence submitted with the first Office Action establishes that power is a desirable feature or characteristic for a vacuum cleaner. "MAXIMUM VACUUM POWER" is not an incongruous term or one without meaning; when viewed in conjunction with vacuum cleaners, it immediately and forthwith conveys this information about this characteristic or feature of the goods.

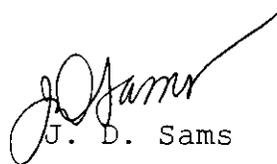
Applicant's own packaging confirms that this information is significant to purchasers by claiming that applicant's product provides "Maximum Deep Cleaning" because of its "powerful 12 amp motor," which is the "maximum allowed" by Underwriters Laboratories.

In view of the case law cited earlier in this opinion, it does not matter that the record contains no evidence that other vacuum makers use this term to describe their products, or that other trademarks containing the word "POWER" have been registered by other businesses. Nor is it significant that applicant has used contrasting colored ink and the "TM" designation on its carton to set this information off from the other descriptive language about other product features also listed on the carton. The plain meaning of "MAXIMUM VACUUM POWER" in connection with vacuum

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cleaners is merely descriptive of a significant characteristic of them. Neither the color of the printing on the carton nor the use of the superscript indicating that applicant wants to have proprietary rights in this term converts this descriptive terminology into a trademark.

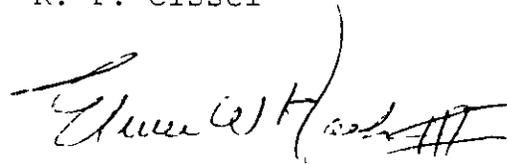
Accordingly, the refusal to register under Section 2(e)(1) of the Act is affirmed.



J. D. Sams



R. F. Cissel



E. W. Hanak
Administrative Trademark Judges
Trademark Trial & Appeal Board