

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB      AUG. 26, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re The Brita Products Company

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Serial No. 75/061,885

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**Joel J. Hayashida** of The Clorox Company for The Brita  
Products Company.

**Nancy Clarke**, Trademark Examining Attorney, Law Office 108  
(David Shallant, Managing Attorney).

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Before Hanak, Chapman and Wendel, Administrative Trademark  
Judges.

Opinion by Chapman, Administrative Trademark Judge:

The Brita Products Company has filed an application to  
register the mark MAKES TAP WATER TASTE GREAT for "portable  
water dispensers".<sup>1</sup>

Registration has been refused under Section 2(e)(1) of  
the Trademark Act on the basis that, when used on

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<sup>1</sup> Application Serial No. 75/061,885, filed February 20, 1996.  
The claimed date of first use is October 1994.

applicant's goods, the mark is merely descriptive of them. The Examining Attorney also found that applicant's alternative claim of distinctiveness under Section 2(f) is insufficiently supported.

Applicant has appealed.<sup>2</sup> Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

The issues before the Board are (1) whether applicant's mark MAKES TAP WATER TASTE GREAT is merely descriptive when applied to its goods; and (2) if the mark is merely descriptive, whether applicant has submitted sufficient evidence of acquired distinctiveness under Section 2(f) to overcome the refusal to register under Section 2(e)(1).

Turning first to the question of descriptiveness, it is the Examining Attorney's position that applicant's mark is a laudatory, informational slogan which directly refers to and describes a desired purpose or function of the goods, i.e., applicant's portable water dispensers improve the taste of tap water (or any other water); and that

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<sup>2</sup> Along with its brief, applicant also filed a request for a remand to the Examining Attorney for consideration of new evidence. In her brief, the Examining Attorney waived any objection to the entry of all of the evidence submitted with the request for remand. The record is clear that the Examining Attorney considered the involved evidence. The Board has also considered all of applicant's additional evidence.

applicant's competitors need to make similar claims involving their products' ability to improve the taste of water.

Applicant, in urging reversal of the refusal, contends that the mark is inherently distinctive and only suggestive because applicant's goods are not restricted to tap water, but could include use with well water, and because it is not only the storage of water in applicant's dispensers which enhances the quality of the water.<sup>3</sup> In support of its argument that a slogan may be inherently distinctive, applicant submitted copies of four registrations of slogans as trademarks.

A mark is unregistrable under Section 2(e)(1) of the Trademark Act as merely descriptive of the goods on which it is used if it immediately and forthwith conveys information about the characteristics, features or functions of those goods. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

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<sup>3</sup> The wording "water filtration dispenser" appears on applicant's specimens of record.

With regard to slogans, the Board stated the following in the case of *In re Wileswood, Inc.* 201 USPQ 400 (TTAB 1978):

Our evaluation of the meaning projected by the two notations [AMERICA'S BEST POPCORN and AMERICA'S FAVORITE POPCORN] must take into consideration the phrases, the goods in connection with which they are used, the context in which the expressions are used, the significance of the notations in relation to the goods, and the likely reaction of average purchasers to the phrases as they are encountered in the market. (Citations omitted.)

In this context, we agree with the Examining Attorney that this mark immediately and directly refers to the purpose or function of applicant's goods, i.e., to make the water which is placed in applicant's filtration dispenser taste better. The public would readily understand that this slogan is laudatory and merely touts the effectiveness of the product. See *In re Joseph Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

The four third-party registrations submitted by applicant do not convince us otherwise. One registration issued on the Supplemental Register, and one issued under Section 2(f). The remaining two third-party slogans are YOU DESERVE A BREAK TODAY for restaurant services and JUST

FOR BABY for household bleach, and are simply not descriptive or laudatory to the same degree as is applicant's slogan MAKES TAP WATER TASTE GREAT for portable water dispensers.

Accordingly, we find that applicant's mark is merely descriptive as applied to applicant's goods.

Turning now to the merits of applicant's alternative position that its mark MAKES TAP WATER TASTE GREAT has acquired distinctiveness, applicant has the burden of establishing that its mark has become distinctive. See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988). The question of acquired distinctiveness is one of fact which must be determined on the evidence of record. As the Board stated in the case of *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1999 (TTAB 1986):

"[e]valuation of the evidence requires a subjective judgment as to its sufficiency based on the nature of the mark and the conditions surrounding its use. While some terms may never acquire distinctiveness no matter how long they have been used, others may acquire such significance in a relatively short period of time, sometimes even less than five years. See *In re Capital Formation Counselors, Inc.*, 219 USPQ 916 (TTAB 1983)."

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See also, *Braun Inc. v. Dynamics Corp. of America*, 975 F.2d 815, 24 USPQ2d 1121, 1131 (Fed. Cir. 1992).

In support of its alternative claim of acquired distinctiveness, applicant submitted the declarations of Alexis P. Limberakis and Steven Chan, both Brand Managers for applicant, and both responsible for marketing, promoting and advertising applicant's water dispenser and filter products; several photographs of sample packaging showing the mark displayed separate from other indicia on the package; an advertisement from the December 1993 McCall's magazine (which is prior to applicant's claimed date of first use of October 1994) showing use by applicant of the mark MAKES TAP WATER TASTE GREAT; and copies of three point-of-purchase displays sent to retailers and believed by applicant's attorney to be in use by the retailers.

One example of applicant's packaging and one of applicant's point-of-sale displays are reproduced below (in reduced form):

Packaging

Point-of-Sale Display

Both of the declarants aver that applicant has had substantially exclusive and continuous use of the mark for three (Limberakis) to four years (Chan); that the slogan has been a "key aspect" of applicant's advertising, promotion and marketing of this product as evidenced by its appearance on a separate colored band at the top and/or bottom of each package, and the use of a TM symbol; that for at least the last two fiscal years 1996 and 1997 sales to retailers have exceeded one million units; that applicant has experienced at least 10% growth for each fiscal year; and that in 1997 applicant attained a market share of 60% for this product category. In addition, Mr. Chan avers that starting in fiscal year 1994 advertising expenditures (e.g., television and print ads) were about \$5 million and have increased "at least 50% each succeeding fiscal year"; and that promotional expenditures (e.g., coupons, point-of-sale and free-standing inserts) were about \$1 million and have also increased "at least 50% each succeeding fiscal year."

Applicant acknowledges that while the promotional brochure it submitted with the Chan declaration shows applicant's use of the slogan as a trademark, it also includes a descriptive use of the slogan, i.e., in a bulleted list of the principal benefits of the product.

However, applicant, citing the case of *In re First Union National Bank*, 223 USPQ 278 (TTAB 1984), contends that one such use by applicant should not preclude registration when applicant otherwise uses the slogan in a nondescriptive prominent trademark manner.

The Examining Attorney rejected applicant's evidence of acquired distinctiveness because applicant's length of use has been relatively short; its sales figures alone do not show the impact on the purchasing public of the significance of the slogan as an indication of source; and its advertising figures do not prove that the advertising promotes not only the product, but also the slogan as an indication of source of the product. Moreover, applicant provided no direct evidence, such as consumer surveys or purchaser testimony,<sup>4</sup> of acquired distinctiveness.

An applicant may submit any appropriate evidence tending to show that the mark distinguishes applicant's goods. The absence of consumer surveys or affidavits of consumer recognition does not preclude a finding of acquired distinctiveness. See the Yamaha International case, *supra* at 1010. That is, acquired distinctiveness may

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<sup>4</sup> We note that if applicant had submitted form consumer affidavits, they may be criticized or given little weight due to the nature of form affidavits.

be proven by direct or circumstantial evidence tending to prove that the relevant purchasers associate the mark with the applicant. See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §§15:30, 15:61, 15:66 and 15:70 (4<sup>th</sup> ed. 1999). As the Court of Appeals for the Federal Circuit cautioned in the case of West Florida Seafood Inc. v. Jet Restaurants Inc., 31 F.3d 1122, 31 USPQ2d 1660 (Fed. Cir. 1994), individual pieces of evidence must be taken together, so that the body of evidence is viewed as a whole.

Having reviewed the totality of the evidence submitted by applicant, we find it to be sufficient to establish acquired distinctiveness. Applicant's brand managers averred that applicant has made substantially exclusive and continuous use of the mark for approximately four years since October 1994, and applicant submitted an advertisement showing use of the mark in a December 1993 publication of general circulation. Clearly, applicant's volume of sales in product units, and its sales and advertising figures are quite large; and applicant's market share for sales of this product at 60% is very significant. Even though applicant has not presented specifics regarding what portion of the advertising and promotion figures relate to promoting applicant's slogan MAKES TAP WATER

TASTE GREAT, rather than applicant's mark BRITA, it is clear that the slogan is highly visible and is promoted to the purchasing public. This goes beyond a showing of the mere popularity or business success of applicant's product. That is, here the overall evidence of acquired distinctiveness including applicant's large sales volume and advertising figures, applicant's significant market share for this product, applicant's continuous and substantially exclusive use of the mark for about four years, and applicant's manner of use of the mark on its packaging and point-of-purchase displays, are sufficient to establish that applicant's mark has acquired distinctiveness.<sup>5</sup>

Decision: The initial refusal to register the mark under Section 2(e)(1) was appropriate because the mark is merely descriptive of applicant's goods. However, the evidence submitted by applicant establishes acquired distinctiveness. Accordingly, the refusal to register is reversed, and the application will proceed to publication

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<sup>5</sup> While it is not dispositive of our decision on this case, we note that the Examining Attorney stated the following in his final Office action dated October 7, 1997 (p. 3): "These [advertising and promotional] figures are acknowledged to be quite substantial, and, had the applicant's advertising promoted the slogan in question as a mark, would be sufficient to support the applicant's claim of acquired distinctiveness."

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with a notation of applicant's claim of acquired  
distinctiveness under Section 2(f).

E. W. Hanak

B. A. Chapman

H. R. Wendel  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board