

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 4/21/00
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ReloAction

Serial No. 75/143,563

Douglas A. Chaikin of Peninsula IP Group for ReloAction.

Kimberly Krehely, Senior Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

Before Chapman, Wendel and Bucher, Administrative Trademark Judges.

Opinion by **Chapman**, Administrative Trademark Judge:

An application has been filed by ReloAction, a California corporation, to register the mark LIVING IN THE BAY AREA for "informational publications, namely, pamphlets, brochures, newsletters, journals and magazines relative to adapting to living in the San Francisco Bay area, including relocation" in Class 16.¹

¹ Application Serial No. 75/143,563, filed August 1, 1996, in which applicant claims a date of first use of October 1, 1993.

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that the mark LIVING IN THE BAY AREA, when applied to the goods of the applicant, is merely descriptive of them.

Applicant has appealed, and both applicant and the Examining Attorney have filed briefs. Applicant requested an oral hearing but later withdrew said request.²

The Examining Attorney contends that the mark LIVING IN THE BAY AREA is merely descriptive because it describes a significant feature of the goods, specifically, the subject matter of applicant's publications. In support thereof she submitted, inter alia, The American Heritage Dictionary (2nd ed.) definition of the term "live" or the verb "living" which includes the following meanings:

"1. To be alive; exist. 2. To continue to be alive. 3. To support oneself; subsist. 4. To reside; dwell. 5. To conduct one's life in a particular manner. 6. To pursue a positive, satisfying existence; enjoy life to the utmost. 7. To remain in human memory."

The Examining Attorney also points to applicant's specimens of record, which include statements such as "Our intent here, however, is to look beneath the surface a

² In a telephone conversation with the author of this opinion, applicant's attorney reiterated that he had withdrawn applicant's request for an oral hearing.

little for the benefit of those who are considering *living in the Bay Area*" (emphasis in original); "We will explain [various factors, e.g. cultural diversity, economic resources] because these become more important to someone who intends to live in the Bay Area"; and "This is a primer on what it is like to live in the Bay Area."

Applicant contends that its mark LIVING IN THE BAY AREA "sheds light upon the characteristic of the goods, but requires imagination in order to understand the magazine is for a relocation service" (brief, p. 5); that the mark suggests a quality, but the purchasing public will not automatically know what the goods are; that its publications are not for persons living or residing in the Bay area, but rather are for people considering relocating to the Bay area; and that applicant's use of its mark will not prevent competitors from using "a slightly different name" (brief, p. 10), and allowing the mark to be published for opposition will not inhibit competition.

The test for determining whether a mark is merely descriptive is whether the term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200

USPQ 215 (CCPA 1978); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). A mark does not have to describe every quality, feature, function, etc. of the goods or services in order to be found merely descriptive; it is sufficient for the purpose if the mark describes a single significant quality, feature, function, etc. thereof. See *In re Venture Associates*, 226 USPQ 285 (TTAB 1985).

Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991). Consequently, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

We note that the sole issue before this Board is whether the mark is merely descriptive of applicant's goods under Section 2(e)(1) of the **Trademark Act**.

We agree with the Examining Attorney that this mark immediately and directly conveys information about a significant feature, i.e., the subject matter of the involved goods--"informational publications, namely, pamphlets, brochures, newsletters, journals and magazines relative to adapting to living in the San Francisco Bay area, including relocation." The Courts and the Board have recognized that the titles of publications are not considered differently from trademarks for other products. That is, the criteria applied in determining the descriptiveness of a trademark are equally applicable to determinations as to the descriptiveness of a publication title under Section 2(e) when that title is presented as a trademark. See *In re Waverly Inc.*, 27 USPQ2d 1620 (TTAB 1993), and cases cited therein; and *In re San Diego National League Baseball Club, Inc.*, 224 USPQ 1067 (TTAB 1983).

As stated by McCarthy in Vol. 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:19 (4th ed. 2000):

To be characterized as 'descriptive,' a term must directly give some reasonably accurate or tolerably distinct knowledge of the characteristics of a product.

Ser. No. 75/143563

In this case, when the mark LIVING IN THE BAY AREA is viewed in the context of applicant's goods, the purchasing public would immediately understand the nature of the goods, specifically, that applicant's various publications are about life in the San Francisco Bay area. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792 (TTAB 1996); and *In re Time Solutions, Inc.*, 33 USPQ2d 1156 (TTAB 1994). Applicant's mark requires no imagination or thought in order to ascertain its meaning in relationship to applicant's identified goods. In fact, applicant's specimens and the identification of goods in the application make clear that these publications cover topics relating to 'living in the San Francisco Bay area.'

Decision: The refusal to register under Section 2(e)(1) is affirmed.

B. A. Chapman

H. R. Wendel

D. E. Bucher
Administrative Trademark Judges,
Trademark Trial and Appeal Board