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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re John Knoell & Son, Inc.

Serial No. 75/283,361

Stanley B. Kita of Howson & Howson for applicant.

Michael L. Engell, Trademark Examining Attorney,
Law Office 108 (David Shallant, Managing Attorney)

Before Simms, Bucher and McLeod, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

John Knoell & Son, Inc. (applicant), a Pennsylvania corporation, has appealed from the final refusal of the Trademark Examining Attorney to register the mark BEAUTIFUL WALLS for retail store services featuring wall decorations.¹ The Examining Attorney has refused registration under Section 2(e)(1) of the Act, 15 USC §1052(e)(1), arguing that applicant's mark is merely descriptive of its

services. Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

We reverse.

The record of this case consists of dictionary definitions, printouts of third-party registrations wherein the word "BEAUTIFUL" was disclaimed, and excerpts from newspaper and magazine articles retrieved from the Nexis computer search system.

It is the Examining Attorney's position that applicant's mark is merely descriptive because it refers to the purpose or result of using applicant's retail store services. Because applicant's retail store services featuring wall decorations will result in making walls more beautiful, the Examining Attorney argues that applicant's mark is merely descriptive. Competitors in applicant's field should be free to claim that their wares will give customers beautiful walls, according to the Examining Attorney. The Examining Attorney has also cited cases in support of the proposition that a term which identifies what is sold in a retail store is not registrable.

Applicant, on the other hand, maintains that its asserted mark is only suggestive of its services and that

¹ Application Serial No. 75/283,361, filed April 29, 1997, based upon allegations of applicant's bona fide intention to use the

thought and imagination are needed to determine the nature of applicant's services. Applicant argues that its mark does not describe its services or the picture and mirror frames, photographs, original art, clocks and other forms of wall decorations which applicant intends to sell under its service mark. Applicant maintains that at most the term is suggestive of the effect that could be achieved by availing oneself of applicant's services.

We agree. While, of course, laudatory terms such as those which attribute quality or excellence to goods or services may be merely descriptive of the goods or services in connection with which they are used, a term is merely descriptive if it *immediately* describes an ingredient, quality, characteristic or feature of the goods or services, 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, 217-18 (CCPA 1978). There is often a thin line between a suggestive and a merely descriptive designation, and it is often difficult to determine the permissible scope of suggestiveness and the impermissible descriptiveness of a term. In this case we believe that applicant's asserted mark BEAUTIFUL WALLS does not directly

mark in commerce.

describe applicant's services but only indirectly describes the result of use of those services. The fact that goods, such as picture frames, mirrors, clocks and wall hangings, may be used to decorate and to beautify a wall offers only an indirect connection between the asserted mark and applicant's services. If applicant were to sell walls themselves, or perhaps wall segments, then applicant's asserted mark might well be descriptive. However, because the asserted mark only suggests the end result of the use of applicant's services, we agree with applicant that its mark is not merely descriptive. Applicant's asserted mark does not immediately or directly convey the purposes of its services but only indirectly does so. Also, in these kinds of cases, any doubt must be resolved in favor of publication. In re Atavio Inc., 25 USPQ2d 1361, 1363 (TTAB 1992) and In re Rank Organization Ltd., 222 USPQ 324, 326 (TTAB 1984).

Decision: The refusal of registration is reversed.

R. L. Simms

D. E. Bucher

L. K. McLeod

Ser. No. 75/283,361

Administrative Trademark
Judges, Trademark Trial
and Appeal Board