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Paper No. 11
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **John Kurowski**

Serial No. 75/**757,611**

Neil L. Arney of **Lathrop & Gage L.C.** for **John Kurowski**.

Kevin M. Dinallo, Trademark Examining Attorney, Law Office 110 (**Chris A.F. Pedersen**, Managing Attorney).¹

Before **Hohein**, **Rogers** and Drost,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

John Kurowski has applied to register BUILT GREEN on the Principal Register, in International Class 200, as a mark for indicating membership in an "association of developers, contractors, builders, and manufacturers in the construction industry who are environmentally friendly."²

¹ Tricia L. Sonneborn examined the application; on appeal, Mr. Dinallo filed the brief for the Office.

² Serial No. 75/757,611, based on applicant's allegation of a bona fide intention to use the mark in commerce.

The Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C.

§1052(e)(1), on the basis that the mark is merely descriptive, although the rationale for this refusal is not entirely clear.³

When the refusal was made final, applicant filed an appeal. Both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

The record in this appeal consists of dictionary definitions of "build" and "green" made of record by both the applicant⁴ and the Examining Attorney; three registrations for other marks made of record by the applicant; excerpts from the NEXIS database of articles

³ In the initial Office action, the Examining Attorney argued that "the proposed mark merely describes the class of members, namely, those whose home construction is 'built green.'" She also wrote that evidence retrieved from the NEXIS database revealed that "the term 'built green' was used in conjunction with construction of environmentally friendly or sensitive homes. As such, the mark is merely descriptive of the applicant's collective membership mark."

In the final Office action, the Examining Attorney wrote that: "[I]t is likely that developers, contractors, builders and manufacturers of environmentally friendly buildings and homes would assume their collective membership mark BUILT GREEN caters to and focuses on men and women who develop, contract, build or manufacture environmentally friendly products. ... As such, the mark is descriptive of a feature, characteristic and the subject matter of the collective membership."

⁴ Applicant attached, to its main brief, not only copies of previously introduced definitions from printed dictionaries, but also printouts from an online dictionary. The latter have not been considered, since they are clearly untimely and improper. Cf. In re Total Quality Group Inc., 51 USPQ2d 1474 (TTAB 1999).

from various periodicals and publications made of record by the Examining Attorney; and various web pages made of record by the Examining Attorney.

The law to be applied to this record is clear and was aptly summarized in Racine Industries Inc. v. Bane-Clene Corp., 35 USPQ2d 1832, 1837 (TTAB 1995)⁵:

[A]s stated in In re Association of Energy Engineers, Inc., 227 USPQ 76, 77 (TTAB 1985):

Section 4 of the Trademark Act specifically provides that the registration of collective [membership] marks is "...subject to the provisions relating to the registration of trademarks..." Accordingly, the analysis regarding descriptiveness or genericness of a collective membership [mark] is the same as that with respect to a trademark or service mark.

See also In re National Association of Legal Secretaries (International), 221 USPQ 50, 52 (TTAB 1983). Thus, just as it is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes a quality, characteristic or feature thereof or directly conveys information regarding the nature, function, purpose or use of the goods or

⁵ It is distressing that neither applicant nor the Examining Attorney discussed, in their respective main briefs, the statements of law made in the *Racine* case, or in other cases squarely dealing with the question of descriptiveness or genericness of collective membership marks, e.g., In re Association of Energy Engineers, Inc., 227 USPQ 76 (TTAB 1985), and In re Association for Enterostomal Therapy, 218 USPQ 343 (TTAB 1983). Whether applicant or Examining Attorney, one's theory of the case ought to be based on the most directly relevant prior case law.

services, see *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978), the same would be the case with respect to a term which describes a significant aspect of an organization or association. Such a term, in the context of a collective membership mark, need not describe all attributes of the organization or association; rather, it is sufficient for purposes of mere descriptiveness that the term immediately convey a meaningful idea or information about the group, such as its composition or membership. Moreover, whether a term is merely descriptive of an organization or association is determined not in the abstract but, as always, in relation to the particular organization involved, the context in which the term is used by the group's members, and the possible significance that the term would have to the average person because of the manner of its use by members of the group. *Cf.* *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

Applying these principles to the record before us, it is clear that the term "green," in the sense of meaning "environmentally sound or beneficial,"⁶ is highly descriptive of the composition or membership of an association of "developers, contractors, builders, and manufacturers in the construction industry who are environmentally friendly." The average person, when considering this term in conjunction with developers, contractors, builders and manufacturers in the construction

⁶ The Examining Attorney's proffered definitions of "green" relate to the political party or movement that goes by that name. We take judicial notice of the following, more apt definition of "green" from the Random House Webster's Unabridged Dictionary (2d ed. 1998), at page xii of the New Words Section: **green** *adj.* environmentally sound or beneficial.

industry, will not need to engage in any thought, imagination or multi-step reasoning to discern that they are environmentally friendly developers, contractors, builders and manufacturers.

We are not persuaded otherwise by applicant's reliance on the many possible meanings for the term green. As the *Racine* decision notes, the meaning that the average person would ascribe to a particular term is assessed in light of "the context in which the term is used by the group's members."

In this case, notwithstanding the Examining Attorney's reference in his brief to "applicant's own specimens," we have no specimens evidencing use by any member of the group.⁷ Nonetheless, it is clear that environmentally friendly developers, contractors, builders and manufacturers will use the term "green," in relation to themselves, to exemplify that they are environmentally friendly, and not, as applicant posits, to allude to such things as money, foliage, youths or novices, untanned leathers or unfired metal materials. In view thereof, we

⁷ In fact, the record, in toto, is silent as to the identity of the group whose members are proposed to be identified by the mark BUILT GREEN. We briefly address, *infra*, certain questions relative to the identity of the group, ownership of the mark and control of the mark's use by members of the group.

find that the term "green," as proposed to be used in the mark BUILT GREEN, is highly descriptive.

In addition, we have little doubt, in view of some of the NEXIS and web page evidence of record, that the average person would view BUILT GREEN as descriptive of certain goods or services provided by developers, contractors, builders and manufacturers.⁸ We have some doubt, however, that the average person, when hearing or seeing BUILT GREEN used in conjunction with developers, contractors, builders and manufacturers, to identify their membership in an organization or association, will *immediately* derive some idea about the composition or membership of an association to which they belong. Literally, the members of the association are not "built green." Instead, the average person would first think of buildings made in an environmentally friendly manner, or development or

⁸ For example, the NEXIS excerpt from *The Rocky Mountain News* (December 20, 1998), about a builder "introduced to green building practices by custom builder Kurowski" is reported to have "announced that every home built by his company in the Denver area would be 'built green,' that is, with environmentally sound practices and materials." We also note the excerpt from an article in *Newsday* (May 29, 1998), which states "a built-green house today looks much like any other, although wood is less and less the major building material...." Finally, we note web page descriptions of the "Fillmore Healthy Homes Project" ("The homes are designed to fit in well with the surrounding home architecture and will also be energy efficient and built green.") and the "Welton Urban Living Project" ("This project will also be energy efficient and built green.").

construction services resulting in such buildings, and then, as a second step, after mature reflection, conclude that the developer, contractor, builder or manufacturer itself must be environmentally friendly.

The mental processing involved may be entirely intuitive but, in our analysis of the purported descriptiveness of a proposed collective membership mark, if we find, as we have in this case, that the average person would need to pause and think, even for a moment, about the significance of the mark in regard to a member of an organization, then we have doubt as to the asserted mere descriptiveness of the mark and must resolve such doubt in favor of publication of the mark for opposition. In re Merrill Lynch, Pierce, Fenner, and Smith Inc., 4 USPQ2d 1141, 1144 (Fed. Cir. 1987) ("It is incumbent on the Board to balance the evidence of public understanding of the mark against the degree of descriptiveness encumbering the mark, and to resolve reasonable doubt in favor of the applicant, in accordance with practice and precedent"). See also, In re Recovery, Inc., 196 USPQ 830, 832 (TTAB 1977) (for mark which "appears, at first blush, to possess a descriptive significance," "scales tip in the direction of suggestiveness" if, to articulate the manner in which a

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term is descriptive, "one cannot come up with an immediate response" but must engage in a mental process).

Nonetheless, although we hold that the term BUILT GREEN is not merely descriptive of applicant's organization or the members thereof, we find it inappropriate to permit the possible registration of this composite term on the Principal Register absent a disclaimer of any claim to an exclusive right to use the merely descriptive term "green" apart from the mark as a whole. Accordingly, while we affirm the refusal to register to the extent that the term "green" is merely descriptive of the membership of an "association of developers, contractors, builders, and manufacturers in the construction industry who are environmentally friendly," this decision will be set aside and applicant's mark BUILT GREEN will be published for opposition if applicant, as permitted by Trademark Rule 2.142(g), submits an appropriate disclaimer of the word "green," no later than thirty days from the mailing date hereof.

In closing, we find it necessary to briefly comment on issues which are not before us, but which may arise during later examination *if* applicant files the referenced disclaimer, survives the opposition period so as to receive a notice of allowance, and files a statement of use.

First, we note that applicant is an individual. Collective membership marks are usually owned by the collective or organization whose members use the mark to identify the fact of their membership. Nonetheless, there is no reason why an individual cannot be owner of the mark, provided he or she controls the group and the use of the mark by the group's members. See In re Stencel Aero Engineering Corp., 170 USPQ 292 (TTAB 1971). Applicant has not identified the group whose members will be using the mark under his direction and control. Thus, our decision does not rule on issues relating to ownership of the mark or exercise of control over use of the mark by members of the as yet unidentified group.⁹

Second, because there are no specimens of use of record, we have not reached the question whether any prospective use of BUILT GREEN by the as yet unidentified organization's members will be proper use as a collective membership mark. Cf. In re Association for Enterostomal Therapy, *supra*; see also, authorities collected in Trademark Manual of Examining Procedure §1306.05(a).

⁹ There is evidence in the record that suggests creation of "Built Green" programs by the Home Builders Association of Metropolitan Denver and the Built Green Colorado Strategic Alliance Task Force. We do not, however, have information regarding their relationship, if any, to each other or to applicant; who legally controls these groups; or who controls the activities of their members.

Decision: Provided that applicant submits an appropriate disclaimer of the word "green" within thirty days of the mailing date of this decision, the refusal to register will be reversed.

Drost, Administrative Trademark Judge, dissenting:

I would affirm the Examining Attorney's refusal to register.

For a collective membership mark to be descriptive, it "need not describe all attributes of the organization or association; rather, it is sufficient... that the term immediately convey a meaningful idea or information about the group, such as its composition or membership." Racine Industries Inc. v. Bane-Clene Corp., 35 USPQ2d 1832, 1837 (TTAB 1995). The question of descriptiveness is not considered in the abstract but "in relation to the particular organization involved." Id.

Here, we are concerned with an association of developers, contractors, builders, and manufacturers in the construction industry who are environmentally-friendly. As the majority holds today, the term "green" is highly descriptive when the term is used in relation to the membership of applicant's association. I would also find that the term "built" is similarly descriptive. Simply

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put, builders build. Using the past tense instead of the present tense hardly seems to make the term any less descriptive of builders. In re Dahlquist, Inc., 192 USPQ 237, 238 (TTAB 1976) ("The past tense, 'phased', of the verb of which 'phase' is the present tense and 'phasing' is the present participle, would, we think, convey to purchasers of, and dealers in, high fidelity sound reproduction equipment the same meaning or connotation as the words 'phase' and 'phasing.'"). When the terms are combined, the phrase immediately provides meaningful information about the membership of the group, i.e. that they include builders who have built green homes.

The absence of the word "homes" does not make the term suggestive because, in the context of applicant's association, the meaning of the term would be clear. See In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978)(GASBADGE at least merely descriptive for devices to determine and monitor personal exposure to gaseous pollutants). In re Melnor Industries, 141 USPQ 257, 258 (TTAB 1964) ("While the designation "H₂OFF" may be, as applicant asserts, a somewhat unusual combination of a chemical formula and English word," it was found merely descriptive of a device that shuts off water).

The "analysis regarding descriptiveness or genericness of a collective membership is the same as that with respect to a trademark or service mark." In re Association of Energy Engineers, Inc., 227 USPQ 76, 77 (TTAB 1985); Racine Industries, 35 USPQ2d at 1837. We have often found that terms descriptive or generic for goods are at least descriptive of the services involving those goods.

We agree with applicant that the sale of pencils is not the central characteristic of applicant's services. Nevertheless, pencils are significant stationery/office supply items that are typically sold in a store of applicant's type, that is, a stationery and office supply. While applicant's stores may carry a variety of products, pencils are one of those products, and, the term "pencils" is merely descriptive as applied to retail stationery and office supply stores.

In re Pencils, Inc., 9 USPQ2d 1410, 1411 (TTAB 1988).

Similarly, the representation of a product can be descriptive of services related to selling those products.

It is hornbook law that a visual representation which constitutes merely an illustration of one's product is unregistrable under Section 2(e)(1) of the Trademark Act just as is a merely descriptive word... The rule has also been applied to subject matter sought to be registered in respect of services where the pictorial representation is of an article which is an important feature or characteristic of the services. In re Eight Ball Inc., 217 USPQ 1183 (TTAB 1983) [Representation of a cue stick and ball held merely descriptive of billiard parlor and/or arcade services].

In re Underwater Connections, Inc., 221 USPQ 95, 95-96

(TTAB 1983) (brackets in original) (Stylized drawing of

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compressed gas tank used in diving is merely descriptive of travel tour services involving underwater diving).

In addition, a picture of a satellite dish was held to be merely descriptive of an applicant's association services promoting the interest of the earth station industry. In re Society for Private and Commercial Earth Stations, 226 USPQ 436 (TTAB 1985).

I agree with the majority that there is little doubt that the average purchaser would view the term BUILT GREEN as descriptive of certain goods or services provided by developers, contractors, builders, and manufacturers. Applying the principles discussed above to the facts of this case, I would also find that the term BUILT GREEN would immediately convey significant information about the members of the association in addition to their goods and services. The record shows that the term "built green" is often used to describe environmentally friendly homes. Here, members of applicant's association are "builders ... who are environmentally friendly." To use the term BUILT GREEN in relation to builders who are environmentally friendly would immediately convey that these builders have built environmentally friendly or green homes.

Since I have no real doubt that the term BUILT GREEN for indicating membership in an association of

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environmentally friendly builders immediately conveys information about a feature or characteristic of the association, I would affirm the decision of the Trademark Examining Attorney.