

Mailed:
Oral Hearing Date:
July 29, 2003

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

September 9, 2003
Paper No.18
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re K2, Inc.

Serial No. 75/916,474

Richard G. Martin of MacMillan, Sobanski & Todd, LLC for K2, Inc.

John T. Lincoski, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Hohein, Bottorff and Drost, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

K2, Inc. has filed an application to register the mark "STORM BOARD" for "weather-resistant exterior wall board constructed from directionalized wood fiber pressure laminated

in treated plies sold for use in the construction of pre-fabricated or manufactured housing."¹

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, when used in connection with applicant's goods, the mark "STORM BOARD" is merely descriptive of them.

Applicant has appealed. Briefs have been filed and an oral hearing was held. We reverse the refusal to register.

It is well settled that a term is considered to be merely descriptive of goods, within the meaning of Section 2(e)(1), if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods for which registration is sought, the context in which it is being

¹ Ser. No. 75/916,474, filed on February 11, 2000, which is based on an allegation of a bona fide intention to use the mark in commerce.

used on or in connection with those goods and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985). Instead, it is well established that the determination of mere descriptiveness must be decided on the basis of the identification of goods as set forth in the application. See, e.g., In re Allen Electric & Equipment Co., 458 F.2d 1404, 173 USPQ 689, 690 (CCPA 1972).

On the other hand, a mark is suggestive if, when the goods are encountered under the mark, a multi-stage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods the mark indicates. See, e.g., In re Abcor Development Corp., supra at 218, and In re Mayer-Beaton Corp., 223 USPQ 1347, 1349 (TTAB 1984). As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See, e.g., In

re Atavio, 25 USPQ2d 1361 (TTAB 1992) and In re TMS Corp. of the Americas, 200 USPQ 57, 58 (TTAB 1978). The distinction, furthermore, is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. See In re George Weston Ltd., 228 USPQ 57, 58 (TTAB 1985).

Applicant, referring to the sales literature which it made of record, sets forth the following in its brief (as it has throughout the prosecution of its application) by way of background information about its goods:

The literature shows the goods being installed to form the wall of a manufactured home. The wall is then covered with exterior siding which faces the elements. The applicant's goods do not form the actual exterior of the structure. The designation "exterior" is used to differentiate the goods from "interior" materials such as drywall.

The applicant's wall panel is described in the sales literature as a "moisture protection building product". All such products used in the construction of manufactured or pre-fabricated housing provide some level of moisture protection. Not all such products are specifically designed for use as protection against storms.

Further noting that its "sales literature makes no mention of storms or protection from storms" and that, in fact, its goods are not "sold or used in connection with protection from storms," applicant maintains that the mark "STORM BOARD" is not

merely descriptive of its weather-resistant exterior wall boards which are sold for use in the construction of pre-fabricated or manufactured housing. Instead, according to applicant, it selected such mark because it "suggests strength and durability."

Applicant additionally contends in its brief that, "[a]pparently, the Examining Attorney assumed from the description of goods [set forth in the application] that the mark STORM BOARD was descriptive because the [wall boards or] panels are weather-resistant." Applicant asserts that in light of such assumption, the Examining Attorney impermissibly concluded that the mark merely describes a significant feature, function or characteristic of its goods, based principally upon the following evidence which he made of record:

In the first Office Action, the Examining Attorney cited articles from the Lexis/Nexis® News/Curnws Research Database to show that "storm boards" are boards commonly used to protect buildings and structures from damage from hurricanes and storms. The Examining Attorney also cited a printout from the Federal Emergency Management Agency which advises homeowners to protect and reinforce their homes with boards when inclement weather threatens.

Applicant insists it is error for the Examining Attorney to rely upon such evidence when, in the final refusal, he conceded that "the applicant's goods do not appear to be used as storm boards in the generic sense" of boards used to protect buildings and

structures from storm damage. Moreover, while noting that the Examining Attorney also made of record with the final refusal copies of several third-party registrations of marks in which the term "STORM" has been disclaimed as descriptive with respect to weather-resistant goods, applicant argues that such evidence is not relevant because "[a] review of the STORM marks cited by the Examining Attorney reveals that most of the cited marks are used on goods that are specifically intended to provide protection from storms."

Applicant urges, therefore, that:

The record establishes the following with respect to the applicant's goods: The goods are structural panels used in the construction of pre-fabricated housing or manufactured housing. The panels are not intended or sold for use as protection for storms. The goods are full-sized structural panels which are used to form the structural portion of the outside wall of the pre-fabricated or manufactured housing. The applicant's panels are not used to nail over windows or doors as protection in advance of a storm.

The applicant's STORM BOARD goods will not be sold through retail channels to consumers. The STORM BOARD structural panels will be sold through wholesale distribution channels to manufacturers of pre-fabricated or manufactured housing. The manufacturing purchasers use the STORM BOARD structural panels to build the housing structures in a factory setting. The STORM BOARD goods are weather-resistive because they form part of the walls of the structures.

Applicant contends, in view thereof, that "purchasers of exterior engineered structural panels used in the construction of pre-fabricated or manufactured housing do not describe or call for such goods as 'storm boards'" and concludes that:

The composite mark STORM BOARD does not give any reasonably accurate or tolerably distinct knowledge of the characteristics of the applicant's engineered structural panels for use in the construction of pre-fabricated or manufactured housing. The goods are not boards used as protection from storms. Any information about the goods given by the term STORM BOARD is indirect or vague. As a result, the mark is arbitrary or suggestive, rather than [merely] descriptive.

The Examining Attorney, on the other hand, argues in his brief that applicant's mark is merely descriptive of its goods because the term "'storm board' clearly describes a board with weather-resistant properties." In support thereof, the Examining Attorney made of record definitions from The American Heritage Dictionary of the English Language (3d ed. 1992) which, in relevant part, define "storm" as "1. An atmospheric disturbance manifested in strong winds accompanied by rain, snow, or other precipitation and often by thunder and lightning" and "board" as "2. A flat piece of wood or similarly rigid material adapted for a special use." In addition, although not previously made of record, the Examining Attorney submitted with his brief definitions from the same dictionary which list "storm

door" as "[a]n outer or additional door added for protection against inclement weather" and "storm window" as "[a] secondary window attached over the usual window to protect against the wind and cold."²

In view of such definitions, the Examining Attorney further asserts that (footnotes omitted):

The use of "storm" to modify a noun has long been recognized to describe the weather-resistant nature of goods. As shown in the commonly used terms "storm windows" and "storm doors," the term "storm" describes that which the goods protect against. Consumers viewing the terms instantly recognize that they describe windows and doors with the capacity to protect against inclement weather such as that brought on by storms. The mark in this case is no different.

² The Examining Attorney also notes that such dictionary sets forth definitions of "fire door" as "[a] door made of fire-resistant material that can be closed to prevent the spread of fire"; "firewall" as "[a] fireproof wall used as a barrier to prevent the spread of fire"; and "raincoat" as "[a] water-resistant coat," while Webster's Third New International Dictionary defines "weatherboard" as both a noun meaning "CLAPBOARD, SIDING" and as a verb signifying "to nail boards upon (a roof or wall) so as to lap one over another to exclude and shed rain."

Although he "acknowledges that these definitions have not yet been made of record in this case," the Examining Attorney requests that the Board take judicial notice thereof. Such request is granted, and the additional definitions have been considered, inasmuch as it is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 n. 7 (TTAB 1981).

Likewise, the Examining Attorney points out, "the terms 'fire door,' 'fire wall[,] 'raincoat' and 'weatherboard' all describe goods that resist fire, rain and weather[,] respectively."

Moreover, as to the third-party registrations which he made of record,³ the Examining Attorney contends that "a review of the Office records ... indicates a tradition of treating the term 'storm' as descriptive when the goods in question are weather-resistant." Furthermore, with respect to applicant's assertion that its goods are not intended to protect against hurricanes and other storms, the Examining Attorney states that (*italics in original*):

The examiner does not challenge this contention; however, the goods in question do not need to protect against hurricanes [and other storms] for the mark to be [merely] descriptive. The fact remains that a salient feature of the goods is *their weather-resistant nature*. The goods need not be nailed over doors or windows as suggested in the Federal Emergency Management Agency literature attached to the

³ Such registrations are for the marks "STORM POWER" (with "STORM" disclaimed) for "wind resistant suits"; "STORM SHIELD SYSTEMS" and design" (with "STORM SHIELD SYSTEMS" disclaimed) for "non-metal removable panels to protect windows and doors of buildings and residences from damage from hurricanes"; "FORTRESS STORM SECURITY BRACE" (with "STORM SECURITY BRACE" disclaimed) for "metal garage door bracing hardware"; "STORM SMART" (with "STORM" disclaimed) for "metal protective and security shutters"; "LIQUID STORM WINDOW" (with "STORM WINDOW" disclaimed) for a "storm window sealant in the nature of caulk"; and "CMS STORM SHIELD" and design (with "STORM" disclaimed) for "weatherstripping kits," all of which are registered on the Principal Register, and the mark "STORM SHIELD SYSTEMS" (with "SHIELD SYSTEMS disclaimed) for "non-metal removable panels to protect windows and doors of buildings and residences from damage from hurricanes," which is registered on the Supplemental Register.

first action. They only need to perform a weather-resistant function for the mark to be [merely] descriptive.

Accordingly, based on all of the evidence submitted, including the statement in applicant's sales literature which refers to its goods as "another fine moisture protection product," together with the fact that such goods are identified in the application as being "weather-resistant," the Examining Attorney maintains that (footnote omitted):

First, storms are a significant source of moisture, particularly in the form of wind-driven rain. Second, the use of the term "STORM" in connection with goods is understood to describe weather-resistance.

Clearly, the applicant's goods are intended to block moisture. Regardless of the type or severity of the storms, these weather disturbances can reasonably be expected to provide the moisture applicant's goods block. Moreover, analyzing the descriptiveness of the mark in connection with hurricane-related uses overstates the case because the applicant's goods need not stop flying debris. They need only function as advertised to stop moisture brought by any storm, even a summer rainstorm.

The applicant argues that a "mental leap" is required when considering the descriptiveness of the mark. Much as no mental leap is required to realize that "storm doors" and "storm windows" are weather-resistant goods, no such mental gymnastics are required to realize that "STORM BOARD" refers to boards with weather-resistant properties.

The applicant also asserts that the combination of the two terms results in a

composite ... that is non-descriptive. However, a combination of descriptive terms (i.e., "STORM" and "BOARD") remains merely descriptive if the individual descriptive character of these terms is not lost or obscured in the unitary term they create. See *Hunt-Wesson Foods Inc. v. Riceland Foods Inc.*, 201 USPQ 881, 886; *In re Entenmann's Inc.*, 15 USPQ[2d] 1750 (TTAB 1990).

In this case, the juxtaposition of the two merely descriptive words comprising the mark does not convey a commercial impression that is different from the words taken separately. The combination of the terms, STORM and BOARD[,] merely describes to consumers that applicant's goods are boards for use in connection with storms. No additional meaning or connection is created.

Therefore, much as "storm door" and "storm window" are generally considered descriptive with regard to doors and windows with weather-resistive properties, the mark "STORM BOARD" is [merely] descriptive with regard to the goods in this case.

Upon consideration of the evidence and arguments presented, and while admittedly a close question, we agree with applicant that the mark "STORM BOARD" is suggestive rather than merely descriptive of its "weather-resistant exterior wall board constructed from directionalized wood fiber pressure laminated in treated plies sold for use in the construction of pre-fabricated or manufactured housing." Obviously, when considered separately, the word "board" merely describes applicant's product, which is identified as a "weather-resistant exterior wall board," while the word "storm" plainly denotes a kind of

weather phenomenon characterized by wind and rain, snow, or other precipitation as a source of moisture. Literally, however, the combination of such words to form the mark "STORM BOARD" does not merely describe applicant's goods in the sense of the ordinary meaning of those words when combined. As previously noted, the Examining Attorney has conceded, and we concur, that "the applicant's goods do not appear to be used as storm boards in the generic sense," which as shown by the "NEXIS" excerpts, are boards which are used to protect buildings and structures from storm damage. Instead, applicant's goods have a more generalized function or purpose, which is to provide weather resistance by forming a barrier to protect against moisture when installed as the backing for exterior walls of pre-fabricated or manufactured housing. Such goods therefore are not, to reiterate, "boards for use in connection with storms," as asserted by the Examining Attorney, which the record shows is the ordinary or common meaning for the term "storm board." Hence, the mark "STORM BOARD" is ambiguous and incongruous when used in connection with applicant's goods.

As to the Examining Attorney's contention that, like such generic terms as "storm door" and "storm window," the mark "STORM BOARD" immediately connotes "boards with weather-resistant properties," we find the analogy to be slightly misplaced since, unlike applicant's goods, both storm doors and

storm windows are directly exposed to the weather and thus are designed and intended specifically to offer protection against the effects of storms. Applicant's goods, by contrast, are not meant just to protect against storms but are designed and intended to provide weather resistance against moisture in general, irrespective of whether the source thereof is, for instance, precipitation from a storm, water vapor from fog or condensation from high humidity. Moreover, unlike storm doors and storm windows, applicant's goods are an "exterior" product only in the sense that they are structural panels which are used in forming the walls to which siding is applied as the exterior finish for a pre-fabricated or manufactured house.⁴ It consequently is the siding, instead of applicant's weather-resistant exterior wall board, which faces the elements and thereby constitutes the actual exterior of the structure. Applicant's goods therefore do not directly provide protection against storms; rather, they help protect against any moisture which seeps through gaps in or damage to the exterior siding.

⁴ As counsel for applicant explained at the oral hearing, the term "exterior" in the identification of applicant's goods is a term of art in the housing industry which refers to a product suitable for an outer or external use but not necessarily an outside or outdoor use. In this case, he indicated, applicant's goods are a lightweight material which takes the place of plywood, but such goods are not for use in boarding up a structure as protection therefor prior to the onslaught of a severe storm.

Accordingly, to the sophisticated and technically astute purchasers of applicant's goods, namely, buyers of building materials for manufacturers of pre-fabricated housing, the mark "STORM BOARD" would be suggestive of the strength or durability of applicant's weather-resistant exterior wall board rather than merely descriptive of the weather-resistant feature or characteristic of such a board. Simply put, there is insufficient evidence on this record to support the Examining Attorney's assertion that "the use of the term 'STORM' in connection with goods is understood to describe weather-resistance." We judicially notice, in this regard, that The American Heritage Dictionary of the English Language (4th ed. 2000) at 1948 defines "weather" in pertinent part as "1. The state of the atmosphere at a given time and place, with respect to variables such as temperature, moisture, wind velocity, and barometric pressure. **2a.** Adverse or destructive atmospheric conditions, such as high winds or heavy rain: *encountered weather five mile out to sea.* **b.** The unpleasant or destructive effects of such atmospheric conditions: *protected the house from the weather.*" While the word "storm," in light of the previously noted definition thereof, is clearly a type of "weather," it is not synonymous therewith, such that something which is described as "weather-resistant" is necessarily resistant to storms. To us, the Examining Attorney's

contention, in essence, that because moisture is produced by a storm which in turn is a form of weather, a weather-resistant board which protects against storm produced moisture is merely described as a "storm board," is the kind of multi-stage reasoning which actually is indicative of a suggestive mark. Plainly, inasmuch as applicant's goods are not boards which are used to protect buildings and other structures from storm damage, the mark "STORM BOARD" requires customers for applicant's goods to expend imagination in order to reach any definitive conclusion about the nature, purpose or use of the goods. It therefore creates a new and different commercial impression and is not merely descriptive. See, e.g., In re Colonial Stores Inc., 394 F.2d 549, 157 USPQ 382, 384-85 (CCPA 1968).

Our conclusion that applicant's mark is suggestive, rather than merely descriptive, inasmuch as it constitutes an ambiguous and incongruous term which does not possess any definitive meaning as to any characteristic, function, feature, purpose or use of applicant's goods, is bolstered by the fact that there is no evidence of others using the term "storm board" in connection with weather-resistant building materials such as wall boards. See, e.g., In re Wells Fargo & Co., 231 USPQ 116, 119 (TTAB 1986) ["the absence from this record of evidence of any descriptive use of the term 'Express Savings' by others in

the field of banking reinforces our view that the Examining Attorney's mere descriptiveness holding is in error"]. None of the excerpts made of record by the Examining Attorney from the "NEXIS" database indicates any third-party use of the term "storm board" in relation to weather-resistant wall boards or similar building materials.

Nonetheless, given its undeniable similarity to such commonly known generic terms as "storm door" and "storm window," we note that to the extent there may be any doubt as to our conclusion that the mark "STORM BOARD" is suggestive rather than merely descriptive of applicant's goods, we resolve such doubt, in accordance with the Board's practice, in favor of the publication of applicant's mark for opposition. See, e.g., In re Stroh Brewery Co., 34 USPQ2d 1796, 1797 (TTAB 1994); In re Conductive Systems, Inc., 220 USPQ 84, 86 (TTAB 1983); In re Morton-Norwich Products, Inc., 209 USPQ 791, 791 (TTAB 1981); and In re Gourmet Bakers, Inc., 173 USPQ 565, 565 (TTAB 1972).

Decision: The refusal under Section 2(e)(1) is reversed.