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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Robert Brownlee

Serial No. 76/027,847

George J. Netter, Esq. for Robert Brownlee.

Tricia McDermott Thompkins, Trademark Examining Attorney,
Law Office 114 (K. Margaret Le, Managing Attorney).

Before Chapman, Bucher and Bottorff, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On April 17, 2000, Robert Brownlee (an individual)
filed an application to register the mark CLAY DOG DESIGNS
on the Principal Register for goods amended to read
"decorative art objects, sculptures and figurines made of
ceramics" in International Class 21. The application is
based on applicant's assertion of a bona fide intention to
use the mark in commerce. Applicant, upon requirement of

the Examining Attorney, disclaimed the word "designs."

The Examining Attorney refused registration on the ground that applicant's mark, CLAY DOG DESIGNS, is merely descriptive of applicant's goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

When the refusal was made final, applicant appealed to this Board. Both applicant and the Examining Attorney have filed briefs; an oral hearing was not requested.

The Examining Attorney contends that the words, "clay," "dog," and "designs" are common English words, with readily understood meanings; that applicant's identification of goods specifies that the decorative art objects, sculptures and figurines are made of ceramics, which are defined as being made from fired clay; that applicant will make clay decorative art objects in at least the shape of dogs, and even if he makes such art objects in designs other than dogs, it is enough that the mark describes one significant attribute; that "applicant's ceramic goods are made of clay and are in the shape of dogs" (brief, unnumbered p. 4), and thus the phrase CLAY DOG DESIGNS merely describes an ingredient and feature of applicant's goods; and that these combined descriptive words do not create a unique or incongruous mark with a separate non-descriptive meaning.

In support of the descriptiveness refusal, the Examining Attorney has made of record the following definitions (as well as others) from The American Heritage Dictionary of the English Language (Third Edition 1992)¹:

- (1) "clay n. 1. a fine-grained, firm earthy material that is plastic when wet and hardens when heated, consisting primarily of hydrated silicates of aluminum, and is widely used in making bricks, tiles and pottery....,"
- (2) "dog n. 1. a domesticated carnivorous mammal....,"
- (3) "design v. 5. to create or execute in an artistic or highly skilled manner..."; and
- (4) "ceramic n. 1. any of various hard, brittle, heat-resistant and corrosion-resistant materials made by shaping and then firing a nonmetallic mineral, such as clay, at a high temperature. 2a. an object, such as earthenware, porcelain, or tile, made of ceramic. b. ceramics (used with a sing. verb). The art or technique of making objects of ceramic, especially from fired clay."

Applicant's arguments throughout the prosecution of this application consist solely of the following: that his

¹ The Examining Attorney submitted additional dictionary definitions with her brief on appeal, and she requested that the Board take judicial notice thereof. Her request is granted. See *The University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). See also, TBMP §712.01.

line of art objects to be sold under this mark will include a wide range of art objects, including, but not limited to, those in the shape of dogs; that applicant does not specialize in making dog figurines or "clay dogs" as the Examining Attorney suggests; and that the relation of "clay" to "ceramic" is fanciful or suggestive, but is not descriptive, and "CLAY DOG DESIGNS" is also fanciful or at least suggestive, but is not descriptive of the goods.

The test for determining whether a mark is merely descriptive is whether the term or phrase immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used or is intended to be used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Eden Foods Inc.* 24 USPQ2d 1757 (TTAB 1992); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). 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 or is intended to be 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). Rather, the question is whether someone who knows what the goods or services are will understand the term or phrase to convey information about them. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990).

The dictionary listings for these three particularly familiar English words establish their everyday commonly understood meanings in the English language. They also establish that clay is the usual mineral used to make ceramic objects. It is clear that purchasers would immediately understand that applicant's ceramic goods are art objects made of clay, and are made in the shape of dogs. The fact that applicant intends to and may make objects that are not in the shape of dogs does not detract from the fact that the term "dog" describes art objects which are made in the shape of dogs. Applicant's identification of goods is not limited in any way as to what the objects will be, and thus, ceramic figurines and

sculptures made in the shape of dogs are certainly encompassed therein. Moreover, applicant has made clear that he intends to make art objects in the shape of dogs.² Inasmuch as this application is based on applicant's asserted bona fide intention to use the mark in commerce, we do not have the benefit of a specimen of actual use.

Nonetheless, when we consider the phrase CLAY DOG DESIGNS as a whole, and in the context of applicant's goods ("decorative art objects, sculptures and figurines made of ceramics"), we find that the phrase immediately informs consumers that applicant's goods are objects made of clay and presumably appear in the shape of dogs.³ That is, the purchasing public would immediately understand the main ingredient/feature of applicant's goods.

Although not argued by applicant, we agree with the Examining Attorney that the combination of these words does not create an incongruous or unique mark. Rather, applicant's mark, CLAY DOG DESIGNS, when used in connection with applicant's identified goods, immediately describes,

² Specifically, applicant stated "[he] does not intend to confine [his] designs to those of dogs, although [he] will not exclude dog designs from [his] line if considered otherwise desirable." (April 5, 2001 response to first Office action, p. 2).

³ If applicant's goods will not be made in the shape of dogs, then perhaps the Examining Attorney might have considered holding the mark deceptively misdescriptive under Section 2(e)(1), 15 U.S.C. §1052(e)(1).

without need of conjecture or speculation, the main ingredient/feature of applicant's goods, as explained above. Nothing requires the exercise of imagination or mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's goods to readily perceive the merely descriptive significance of the phrase CLAY DOG DESIGNS as it pertains to applicant's goods. 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).

Inasmuch as the phrase clearly projects a merely descriptive connotation, we believe that competitors have a competitive need to use this phrase. See *In re Tekdyne Inc.*, 33 USPQ2d 1949, 1953 (TTAB 1994); and 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:18 (4th ed. 2001).

Decision: The refusal to register on the ground that the mark is merely descriptive under Section 2(e)(1) is affirmed.