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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Donell, Inc.**

Serial No. 75527923

Leslye B. Davidson of Davidson, Davidson & Kappel, LLC for
Donell, Inc.

Brian D. Brown, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before Walters, Chapman and Holtzman, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by Donell, Inc. to register
the mark BOO BOO CREAM for the following goods, as amended:¹

"a topical wound healing agent in the form of a cream for
skin wounds, insect bites and other skin irritations" in
International Class 5.

The trademark examining attorney refused registration on the
ground that the mark is merely descriptive of the goods under
Section 2(e)(1) of the Trademark Act.

¹ Application Serial No. 75527923, filed July 30, 1998, based on an
allegation of a bona fide intent to use the mark in commerce. The word
"cream" is disclaimed.

When the refusal was made final, applicant appealed.² Applicant and the examining attorney have filed briefs. An oral hearing was not requested.

The examining attorney argues that BOO BOO CREAM is merely descriptive of a cream that is applied to an injury or scratch to the skin. According to the examining attorney, there is nothing novel or unique about the mark or any significance other than a descriptive one in relation to applicant's goods. In support of his position, the examining attorney has relied on two dictionary listings for "boo boo," one defining the term as "a usually trivial injury (as a bruise or scratch)—used especially by or of a child," and the other defining the term as "a slight physical injury, such as a scratch." We take judicial notice of another

² By way of background, the examining attorney previously assigned to this application had refused registration under Section 2(d) of the Trademark Act based on Registration No. 1603369 for the mark BOO BOO STRIPS (STRIPS disclaimed) for adhesive bandages. Applicant ultimately filed an appeal from that refusal and at that point the application was reassigned to the present examining attorney to write the brief. After briefs were filed, the appeal was suspended by the Board pending possible cancellation of the cited registration under Section 8 of the Trademark Act. The Board dismissed the appeal as moot once the registration was cancelled and the file was returned to the examining attorney "for appropriate action." The action taken by the new examining attorney was to issue a refusal to register under Section 2(e)(1) of the Act, and this appeal ensued. Once on appeal, the Board noticed that applicant's brief contained an objection to the propriety of the new ground for refusal, whereupon the Board suspended the appeal and allowed applicant time to file a Petition to the Commissioner from the examining attorney's action. The petition to the Commissioner was filed and subsequently denied. Accordingly, the Board resumed this appeal and allowed applicant time to file a supplemental brief on the 2(e)(1) issue, if desired, but applicant did not do so.

dictionary definition of "boo boo" as "a minor injury [*baby talk*]." ³

In arguing that BOO BOO CREAM is only suggestive of its goods, applicant points to the existence of five third-party registrations containing the term "BOO BOO"; BOO BOO STRIPS for adhesive bandages (the previously cited registration), BOO BOO ZAP for medicated facial lotion, BOO BOO GOO for typewriter correction fluid, and two marks containing "BOO BOO" for clothing items. ⁴ Applicant claims that "BOO BOO" is not disclaimed in any of these registrations.

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods with which it is used or intended to be used. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). The question of whether a particular term is merely descriptive must be determined not in a vacuum or on the basis of speculation, but in relation to the

³ *Webster's Encyclopedic Unabridged Dictionary of the English Language* (1996).

⁴ Although applicant submitted only a listing of these registrations, the examining attorney has not objected to the list as being unsupported by copies of the registrations. Therefore, this evidence will be treated as if properly of record and considered for whatever probative value it may have. Applicant also made reference to three third-party applications. However, third-party applications are of no probative value.

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goods for which registration is sought. See *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986).

On the other hand, a term is suggestive if, in the context of the goods, a purchaser must use imagination, thought, or some type of multi-stage reasoning to understand the term's significance. See *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633 (TTAB 1999). As is often 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 and with any doubt on the matter being resolved in applicant's favor. See *Plyboo America Inc. v. Smith & Fong Co.*, *supra*. See also, e.g., *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992); and *In re TMS Corp. of the Americas*, 200 USPQ 57 (TTAB 1978). Moreover, the determination is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. See *Plyboo America Inc. v. Smith & Fong Co.*, *supra*.

We find that the mark BOO BOO CREAM, when considered in relation to topical wound healing agents, falls on the suggestive side of the line. There is an element of incongruity between the meaning of a "boo boo" and its use in connection with applicant's products. While a "boo boo" may broadly connote a minor injury, the commercial impression of this term is something more than, or

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other than, simply a minor injury. As the dictionary definitions make clear, "boo boo" is "baby talk"; it is the language used by a child to refer to an injury (or perhaps by an adult to a child in referring to an injury). The term is unique and inventive in the sense that it is a child's term used to denote a sophisticated product. From a child's perspective, you do not "heal" a boo boo, you "make it better" which in that child's mind has nothing to do with "topical wound healing agents."

Therefore, we cannot find based on the dictionary definitions that "boo boo" does nothing more than merely describe applicant's goods. We find instead that BOO BOO CREAM would be perceived as a source-identifying term, and that a request by a consumer for BOO BOO CREAM would result in a sale of applicant's product rather than an inquiry as to which brand of a topical wound healing cream the purchaser desired.

While it is true, as the examining attorney indicates, that third-party registrations are not conclusive on the issue of descriptiveness, the treatment of "BOO BOO" marks by the Office coupled with the fact that the previous examining attorney did not refuse registration on this ground, are factors which raise further doubts as to the merely descriptive nature of this term. Moreover, this is not a situation, as suggested by the examining attorney, where a once arbitrary or suggestive term has lost its capacity to distinguish source through use in a descriptive sense

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over a period of time. Contrary to the examining attorney's apparent contention, nothing has occurred in the recent past to now warrant the treatment of "boo boo" as a merely descriptive term in the context of applicant's goods. The definition of "boo boo" has not changed over time⁵ nor is there any evidence that the term has been used in other than an origin denoting manner.

In view of the foregoing, and resolving doubt in favor of applicant, as we must, we find that BOO BOO CREAM is suggestive rather than merely descriptive of applicant's goods.

Decision: The refusal to register is reversed.

⁵ In this regard, we note that a 25-year old dictionary contains the same definition of "boo boo" as the more recent dictionaries cited by the examining attorney. See *Webster's New Collegiate Dictionary* (1979).