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August 4, 2004
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Home Builders Association of Metropolitan Denver

Serial No. 75759314

Neil L. Arney of Lathrop & Gage L.C. for Home Builders
Association of Metropolitan Denver.

Tricia L. Sonneborn, Trademark Examining Attorney, Law
Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Quinn, Walters, and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On July 26, 1999, Home Builders Association of
Metropolitan Denver (applicant)¹ applied to register the
mark BUILT GREEN, in typed form, on the Principal Register
for goods and services ultimately identified as:

Printed publications, namely magazines and newsletters
containing articles and information on designing and

¹ The application was originally filed by John Kurowski and
subsequently assigned to applicant. Reel/Frame No. 2620/0596.

constructing homes and buildings using environmentally friendly techniques in International Class 16

Business information and on-line business directory of information pertaining to services for companies and manufacturers in the construction industry that are environmentally friendly in International Class 35

Building construction, renovation, and repair in International Class 37.²

The application was originally based on the applicant's allegation of a bona fide intention to use the mark in commerce. On August 1, 2003, applicant filed with its appeal brief an amendment to allege use setting out a date of first use and first use of the mark in commerce at least as early as June 1997.

The examining attorney refused to register applicant's mark on the ground that the mark is merely descriptive of applicant's goods and services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). Because applicant's appeal brief included a statement that its mark had become distinctive of the goods and services in the application along with the amendment to allege use, the board remanded the application. Subsequently, the examining attorney accepted applicant's claim that its mark had acquired distinctiveness. See Office Action dated May 21, 2004.

² The application originally also included goods in International Class 25. On January 16, 2001, applicant filed a request to divide the application, which was granted. That application subsequently issued as Registration No. 2,742,673.

The application is now before the board to consider whether the mark is merely descriptive of applicant's remaining goods and services, i.e., magazines and newsletters, business information and on-line business directory of information services, and building construction services.

A mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information regarding a function, purpose, or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). See also In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) (A "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service"). We look at the mark in relation to the goods or services, and not in the abstract, when we consider whether the mark is descriptive, because the test is not whether prospective purchasers can guess what the goods or services are after seeing applicant's mark alone. Abcor, 200 USPQ at 218 ("Appellant's abstract test is deficient - not only in denying consideration of evidence

of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as required by statute").

The examining attorney argues (Brief at 4-5, footnote omitted) that:

[I]t is clear that the mark is descriptive when used in conjunction with the goods and services listed in the application. The term BUILT is the past tense of BUILD, which is defined as "to form by ordering and uniting materials by gradual means into a composite whole: CONSTRUCT." *Merriam Webster Collegiate Dictionary* (10th ed. 1996), page 150. In the context of this application, the term GREEN is most aptly defined as "environmentally sound or beneficial." *Random House Webster's Unabridged Dictionary* (2d ed. 1998).³

Applicant responds to the examining attorney's arguments by maintaining that:

[I]f the mark BUILT GREEN is used in connection with a magazine (Class 016), the examining attorney would assert that the only conclusion that an ordinary purchaser or reader could reach when seeing the magazine for the first time is that the magazine relates to environmentally friendly building[s]. There simply is no support for such an assertion, and the examining attorney presents none. In reality, the ordinary purchaser is just as likely, if not more likely, to conclude that the magazine relates to making things that are green in color. In addition,

³ As requested by the examining attorney, we take judicial notice of the dictionary references. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). The examining attorney had previously made of record similar definitions of "green" as "relating to the protection of the environment" (Office action dated July 14, 2000) and "a supporter of a social and political movement that espouses global environmental protection, bioregionalism, social responsibility, and nonviolence" (Office action dated November 9, 1999).

since the word "green" also refers to money, an ordinary purchaser who sees the mark "BUILT GREEN" in connection with a magazine for the first time, could just as likely conclude that the magazine relates to building financial security or investing in construction, etc. This same analysis applies equally to the specified services, namely a directory of services (Class 035) and construction services (Class 037).

Reply Brief at 3 (emphasis omitted).

We agree with the examining attorney that the term "green" would be readily perceived in the context of applicant's goods and services as meaning environmentally sound or beneficial. Again, the test is not what the term "green" would mean in the abstract but what it would mean in the context of "magazines and newsletters containing articles and information on designing and constructing homes and buildings using environmentally friendly techniques." It is almost inconceivable that prospective purchasers would believe that applicant's BUILT GREEN magazine was actually a magazine about "making things that are green in color" as applicant argues.⁴ Similarly, when applied to business information services pertaining to a directory of companies and manufacturers in the

⁴ Applicant also points out that "green" can mean "covered with foliage, mildness, unripeness, freshness, pleasantness, youthfulness, affected by emotion, not fully processed, everything in order, or not fully qualified." Applicant's Brief at 8. It is not clear why prospective purchasers would associate any of these meanings with applicant's goods and services related to environmentally friendly building techniques.

construction industry that are environmentally friendly and building construction services, prospective purchasers would not understand the term "green" to mean anything other than "environmentally sound or beneficial."

In addition, the term "built" is the past tense of "build," meaning "to construct."⁵ It certainly is not without descriptive significance when applied to applicant's magazine about designing and constructing environmentally friendly buildings to the extent that it identifies the subject of its articles as referring to construction projects that are built with green or environmentally friendly techniques. Similarly, "built" would also have descriptive significance in the building construction services and information services involving a directory of companies that are building with environmentally sound or beneficial practices.

However, the question in this case is not whether the individual terms are descriptive of applicant's goods and services but whether the combined term "BUILT GREEN" is merely descriptive of its goods and services. Applicant

⁵ 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'").

argues that the terms in its mark have "arbitrarily selected disparate meanings" and that the examining attorney has not "considered the commercial effect of the entire unitary mark." Applicant's Brief at 8. However, the examining attorney properly viewed the mark in its entirety and considered the appropriate meaning the combined term would have in context of the goods or services. We find that applicant's combined term is even more descriptive than the individual terms because together the terms clearly describe the content of the magazines and the subject matter of the services as involving "constructing" or "building" with "green" or "environmentally friendly" techniques. For magazines involving constructing homes and buildings using environmentally friendly techniques and information services involving companies in the construction industry and building construction services, the examining attorney's definition of "built" to mean "construct" is appropriate. Also, applicant's selection of this term is hardly arbitrary. As noted above, the term "green" for magazines and services involving "environmentally friendly" techniques is not only not arbitrary but it is perhaps the most appropriate term to succinctly describe

environmentally friendly building techniques.⁶ In addition, combining the terms "Built" and "Green" leads to a term that describes applicant's magazines, business information services, and construction services concerning builders using environmentally friendly techniques.

When the term is viewed in the context of applicant's identified goods and services, nothing is left to the imagination. "BUILT GREEN" for applicant's magazines and newsletters simply describes the fact that the publication contains articles concerning constructing buildings using environmentally friendly techniques. Similarly, it describes the fact that the companies on applicant's business directory have "built green" homes and that its building construction services involve building green homes. Accord In re Manco Inc., 24 USPQ2d 1062, 1066 (TTAB 1992) ("[R]ather than being regarded as an indicator of source, the term 'THINK GREEN' would be regarded simply as a slogan of environmental awareness and/or ecological consciousness"). Therefore, we agree with the examining

⁶ While applicant's services in Class 37 are not limited to building construction, renovation, and repair services involving environmentally friendly techniques, they include building construction services involving those techniques. Furthermore, the specimen supports the conclusion that these services involve using environmentally friendly techniques.

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attorney that applicant's mark is merely descriptive for the goods and services in the application.

Decision: The refusal to register under Section 2(e)(1) of the Trademark Act is affirmed. Inasmuch as applicant's amendment to seek registration under Section 2(f) of the Trademark Act has been accepted by the examining attorney, the application will be forwarded to publication on that basis in due course.