

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

Hearing:
June 24, 2004

Mailed: 9/14/04

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Myron Stuart Hurwitz

Serial Nos. 78017859 and 78017877

Myron Stuart Hurwitz, pro se.

Nancy Clarke, Trademark Examining Attorney, Law Office 102
(Thomas Shaw, Managing Attorney).

Before Quinn, Chapman and Bucher, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Applications were filed to register the marks EDGING
CONTROL and EDGING FRICTION CONTROL for "in-line skates and
skateboards, and downhill in-line skates and skateboards,
all featuring slow-down and braking wheel assemblies."¹

The trademark examining attorney refused registration
in each application under Section 2(e)(1) of the Trademark

¹ Application Serial Nos. 78017859 and 78017877, respectively.
Both applications were filed on July 21, 2000, and each is based
on applicant's allegation of a bona fide intention to use the
mark in commerce.

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Act, 15 U.S.C. § 1052(e)(1), on the ground that applicant's mark, when applied to the goods, would be merely descriptive of them.

When the refusal was made final, applicant filed a request for reconsideration and a notice of appeal. The request for reconsideration was denied, and the appeal proceeded. Applicant and the examining attorney filed briefs.² An oral hearing was held before the Board.³

The Board, in an order dated October 7, 2003, granted applicant's request to consolidate the appeals, indicating that the appeals involve common issues of law and fact. Accordingly, the Board will issue a single opinion in these consolidated appeals.

The examining attorney maintains that the marks sought to be registered are merely descriptive of a feature or function of the goods. According to the examining attorney, skate wheels have edges and, further, the term

² Applicant's request for an extension of time to file his reply brief is granted, and the reply brief is considered timely filed. The reply brief, at thirty-five pages in length, exceeds the twenty-five page limit set forth in Trademark Rule 2.142(b)(2). If an applicant files a brief that exceeds this limit without prior leave of the Board, the brief will not be considered. TBMP § 1203.01 (2d ed. rev. 2004). In the present case, however, the Board is exercising its discretion, and applicant's reply brief has been considered.

³ The examining attorney who argued the case at the oral hearing was Cheryl Clayton. Applicant represented himself at the oral hearing.

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"edging" is commonly used in connection with in-line skating to refer to a type of tilting movement that can be used by a skater to control speed. Thus, the examining attorney argues, applicant's goods allow skaters to control their movement by using an edging maneuver, resulting in friction of the wheels against a friction band surface, thereby slowing down the skater's forward momentum. In support of the refusals, the examining attorney submitted dictionary definitions, and several excerpts of articles taken from the Internet and from printed publications retrieved from the NEXIS database.

Applicant contends that his marks are "totally incongruous" and only suggestive of the methodology of his goods. Rather than paraphrase or summarize applicant's theory of why the refusal should be reversed, we specifically refer to his argument:

Using the terms "edge," "edging" and "friction control" in reference to controlling and braking function for recreational In-Line Skates (suggestive of the control methodology used in skiing and ice skating) is not only unprecedented it is totally incongruous. In-Line recreational state-of-the-art skate wheels do not have an edge nor is there an edging friction component within the skate boot or frame. To imply an EDGING CONTROL [or EDGING FRICTION CONTROL] braking feature in reference to In-Line Skates would be bewildering to anyone

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familiar with those skates....Using the term "edge" to turn on In-Line Skates is a metaphor that is used instead of the more literal term of "angling" or "canting" the skates to "turn" one way or the other. When instructors use the metaphorical terms of edge or edging to turn one way or the other on In-Line Skates, they are using those teaching terms descriptively. There is nothing in the use of those descriptive terms that in any way implies an unprecedented functional control and braking mechanism. (Brief, p. 10).

Applicant has submitted a variety of exhibits, including his issued patent covering the involved goods, in connection with his arguments.

Before turning to the merits of this appeal, an additional comment is in order relating to applicant's evidence. The record in the application should be complete prior to the filing of an appeal. Trademark Rule 2.142(d). Both applicant's appeal brief and reply brief are accompanied by several exhibits. Exhibits attached to a brief that were not made of record during examination are untimely, and generally will not be considered. See *In re Fitch IBCA, Inc.*, 64 USPQ2d 1058, 1059 n. 2 (TTAB 2002). To the extent that any of these exhibits were not made of

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record during examination, they have not been considered in our determination of the merits of the appeals.⁴

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an 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). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services, and the possible significance

⁴ We note that the examining attorney, in her brief, specifically objected to exhibits A and F attached to applicant's appeal brief as untimely under Trademark Rule 2.142(d).

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that the term would have to the average purchaser of the goods or services because of the manner of its use or intended use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). It is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods and services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); see also *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985). Stated another way, as the Board has explained:

....the question of whether a mark is merely descriptive must be determined not in the abstract, that is, not by asking whether one can guess, from the mark itself, considered in a vacuum, what the goods or services are, but rather in relation to the goods or services for which registration is sought, that is, by asking whether, when the mark is seen on the goods or services, it immediately conveys information about their nature.

In re Patent & Trademark Services Inc., 49 USPQ2d 1537, 1539 (TTAB 1998).

When two or more descriptive terms are combined, the determination of whether the composite mark also has a

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descriptive significance turns on the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive. See, e.g., *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) [SMARTTOWER merely descriptive of commercial and industrial cooling towers]; *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) [AGENTBEANS merely descriptive of computer programs for use in development and deployment of application programs]; *In re Putnam Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) [FOOD & BEVERAGE ONLINE merely descriptive of news information services for the food processing industry]; and *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) [SCREEN FAX PHONE merely descriptive of facsimile terminals employing electrophoretic displays].

In order to more fully understand the nature of applicant's goods, we first look to applicant's issued patent (captioned "Generation of in-line skates and skateboards with safety 'edging friction control.TM.'") covering the goods listed in the applications. The abstract of Patent No. 6,637,827 B2 reads, in its entirety, as follows:

The frame of an in-line skate supports a wheel, allowing a skater to effectively slow down and stop, using an athletic stance that skiers and ice skaters on ice use. The wheel has a hub, allowing a wheel to rotate around the axle vertically and at an inclination. The hub has axle roller bearings. The wheel includes friction band surfaces on the sides of the wheel. When rotating at an inclination the wheel's friction surface contacts a friction surface, inside the wheel well or an axle friction surface or a combination thereof to slow or brake the wheel. The wheel assembly includes self-aligning springs. Individual parts can be technically designed to allow various model solutions that will satisfy the abilities of a beginner to an expert. The wheel assembly frame can be attached to an in-line skate, an in-line skateboard, a downhill in-line ski and a downhill in-line skateboard.

In the patent, applicant sets forth four initial, fundamental concepts of his invention. These concepts, as partially set forth in applicant's patent, include the following:

The in-line skate wheels not only had to conventionally rotate vertically around a fixed axle, but also had to rotate at an inclined angle around the fixed axle, to cause friction contact ("EDGING CONTROL") within the wheel-wells of the skate frame. That interactive contact by friction...would in essence be comparable to ice skate edges "scoring" ice and ski edges "scoring" ice and snow to effectively control speed or to abruptly stop....Once EDGING force was applied, (as in a side to side

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"striding" motion) and then released, would the wheel(s) return to the vertical axis plane ("coasting") position?

While we have consulted applicant's patent covering the goods identified in these applications, we also look to applicant's own description of his invention.

To fully understand the totally suggestive trademarks of "EDGING CONTROL" and "EDGING FRICTION CONTROL" in reference to a PATENTED control and braking system for In-Line Skates; as opposed to the descriptive terms of "edge" or "edging" (figuratively meaning "cant" or "angle") In-Line Skate boots to turn to the right or left: a detailed explanation of the Patented control and braking system for In-Line Skates is warranted.

The applicant's invention (now patented) relates to a specific classification of "roller type" skates identified as "In-Line Skates" generally having 4-5 wheels in tandem, held [in] place by a wheel frame to which a boot is attached.

The state-of-the-art method of control and braking for In-Line Skates is by a rubber heel pad typically attached to the back of either the right or left boot and wheel frame. This difficult method of slowing down or braking control is initiated by leaning back and extending one leg forward with the skate toe raised, applying heel pressure to engage the rear rubber brake pad against a concrete or asphalt surface. Moving forward and leaning back with one leg extended forward with the boot toe up is not only an awkward, unbalanced position; it is also an

ineffective (one skate) method of braking control and the prime cause for frequent injuries.

The applicant's invention resolves [sic] an uncomplicated novel means (realistically) adhering to prior art dimensions and parts, which is activated by assuming a more natural physical and method of control and braking, comparable to the method and stance that skiers and ice skaters use to edge skis and ice skate blades into snow and ice.

The essence of the invention is: a) to use a modified standard size In-Line Skate wheel that has a two element dynamic core (instead of a static state-of-the-art core, which core contains two prior art, roller ball bearings (for minimal friction rotation); and, b) the wheel having a plastic hub (aluminum hub for the prototype) that has a moderate concave recess on each side of the wheel hub, housing an ultra thin rubberized, radial "spring." (Brief, pp. 8-9) (emphasis in original).

As shown by the dictionary definitions, the term "edging" has a specific meaning relative to the sport of skiing: "to tilt (a ski or both skis) in such a way that an edge or both edges bite into the snow." *The American Heritage Dictionary of the English Language* (3d ed. 1992).⁵ Likewise, there is no question but that edging is a control

⁵ The examining attorney also introduced a third-party registration of the mark PERIMETER EDGE CONTROL for snow skis, in which the words "Edge Control" are disclaimed.

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maneuver performed on in-line skates and skateboards. Thus, contrary to applicant's remarks, there is nothing incongruous or bizarre or unique about the use of the term "edging" in connection with in-line skating. A review of representative articles and web sites, retrieved from the NEXIS database and the Internet, respectively, introduced by the examining attorney makes this clear.

Like skis, skate wheels have an inside and an outside edge. Many of the skills common to both sports, such as steering, edging, crossing over, and upper-body control, are directly transferable from pavement to snow.
(*Skiing*, March 1994)

With in-line skate practice, they will be more fit and also have had edging practice.
(*STN, Skiing Trade News*, August 1990)

Technique: Discover the Skater's Edge. Edging is one of the four fundamentals of inline skating, along with pressure, balance and rotation. Edging is based on the concept that your skates each have three sets of wheel "edges" on which you roll. An instructor's reference to using the "inside edge" indicates one or both skates are tipped inward toward the center of the body. Reference to the "outside edge" means the skate is tipped away from the midline. The "center edge" is in play when the wheels are upright....Extreme edging combined with the proper balance, timing and angle actually results in the hockey stop you see on the ice....learn corresponding edge turning.
(www.getrolling.com)

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Edging becomes effortless! The ultra-low profile noticeably reduces ankle and foot fatigue and provides for exceptional and instant edge control.
(www.miller-sports.com)

The better you learn to edge, the better you skate.
(www.parabolics.com)

The term "control" is defined, in relevant part, as "to exercise authoritative or dominating influence over; direct." The term "friction" means "the rubbing of one object or surface against another." *The American Heritage Dictionary of the English Language* (3d ed. 1992).

Applicant himself has stated that "[w]hen the wheel is canted (in the friction edging position) and the edging force is released, the urethane 'spring' return the wheel back to the vertical spinning position." (Brief, p. 6) (Emphasis in original). And, applicant also has asserted that "any method of 'braking' from time immemorial relies on friction" and "[m]y invention is no exception." (Response, April 6, 2001, p. 3).

Based on the record before us, we find that the proposed marks, EDGING CONTROL and EDGING FRICTION CONTROL, are merely descriptive as applied to "in-line skates and skateboards including downhill in-line skates and skateboards, all featuring slowdown and braking

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assemblies." That is to say, each mark merely describes a feature or function of the goods. Nothing in the marks is incongruous, ambiguous or suggestive, nor is there anything which would require the exercise of imagination, cogitation or mental processing or necessitate the gathering of further information in order for the merely descriptive significance of the marks to be readily apparent to consumers of applicant's goods.

Based upon the totality of this record, it appears likely that the in-line skater having applicant's invention installed in his or her in-line skates would be able more easily to slow down or stop completely by "edging" than would be the case with conventional in-line skates. Nonetheless, when our trademark precedent on the question of mere descriptiveness is applied to the specific facts of this case, this difference in degree is not determinative of a different result on the trademark issues herein.

EDGING CONTROL merely describes the fact that applicant's in-line skates and skateboards have an assembly allowing a skater to control his or her speed by performing a skating maneuver called "edging." Thus, the mark EDGING CONTROL immediately informs, without speculation or conjecture, prospective customers that applicant's goods

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have a feature allowing for control by edging, that is, "edging control."

Likewise, EDGING FRICTION CONTROL merely describes the fact that the speed of applicant's in-line skates and skateboards is controlled by edging which results in friction; a skater edges, resulting in friction, thereby controlling speed.

The combination of the three descriptive words EDGING FRICTION CONTROL, just as in the case of the combination of the two words EDGING CONTROL, does not result in a new and unique commercial impression of the mark. Rather, each individual component, "edging," "control" and "friction" retains its descriptive significance in relation to applicant's goods, and the combinations result in composite marks which are themselves descriptive.

The fact that applicant may be the first and only user of the merely descriptive terms herein does not justify registrations thereof on the Principal Register. In re National Shooting Sports Foundation, Inc., 219 USPQ 1018 (TTAB 1983). Further, the fact that applicant's invention is novel enough to be the subject of an issued patent is irrelevant to the question of whether applicant's applied-for trademarks are registrable under the Trademark Act.

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Decision: The refusal to register is affirmed in each application.