

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Mailed:
January 28, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Trex Company, Inc.

Serial No. 76506970

Patrick J. Coyne, B. Brett Heavner and Naresh Kilaru of
Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P. for
Trex Company, Inc.

Stacy B. Wahlberg, Trademark Examining Attorney, Law Office
113 (Odette Bonnet, Managing Attorney).

Before Seeherman, Hohein and Holtzman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

On April 4, 2003 Trex Company, Inc. applied to
register the mark DECKSCAPES for "magazine containing
design ideas for decks" (Serial No. 76506970.) The
application was based on an asserted bona fide intention to
use the mark. Applicant subsequently amended the
application to allege first use and first use in commerce

as early as April 7, 2003. The amendment to allege use was accepted by the Examining Attorney on June 1, 2004.

The Examining Attorney issued a final refusal of registration pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that DECKSCAPES is merely descriptive of applicant's goods because it describes the subject matter of applicant's publication.

Applicant has appealed the refusal. Both applicant and the Examining Attorney have filed appeal briefs. Applicant did not request an oral hearing.

A mark is merely descriptive, and thus prohibited from registration by Section 2(e)(1) of the Trademark Act, if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods or services with which it is 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 the abstract, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the significance that the mark is likely to have, because of the manner in which it is used, to the average purchaser as he encounters goods bearing the mark in the marketplace. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); see also, *In re*

Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

In support of the refusal of registration, the Examining Attorney has submitted a dictionary definition of "scape" as meaning "a scene; a view. Often used in combination: *seascape; mindscape*."¹ The Examining Attorney has also submitted excerpts² from several articles taken from the NEXIS database, as well as pages from various websites, including the following (emphasis added):³

Decorating a deck for the holidays can be as simple as hanging roping and lights. Doing it for interest year-round is a lot more involved. Some call it "**deckscaping**."

Deckscaping, or landscaping over, on and around a deck, gives the structure

¹ The American Heritage Dictionary of the English Language, 3d ed. © 1992.

² Some of the articles were subsequently submitted in their entirety by applicant. We have also quoted from these portions.

³ Applicant has questioned the probative value of certain additional materials submitted by the Examining Attorney. For example, one article is from a Canadian newspaper, while in another article "deckscapes" refers to a ship. Because it is not clear that consumers in the United States have been exposed to the article in the Canadian paper, we have not considered it in making our determination. Similarly, we have not considered the article in "Timber Wood Products," which appears to be a trade publication in the United Kingdom. Nor do we find "The New York Times" article using "deckscapes" to refer to the look of a ship's deck probative of the descriptiveness of "deckscapes" for the goods at issue herein. Applicant has also pointed out that two of the websites are foreign. Although such websites are clearly accessible to consumers in the United States, we agree that they do not necessarily reflect how the term "deckscape" is perceived by consumers in this country. Thus, although we do not say that they do not have probative value, we have not relied on them in reaching our decision herein.

extra ornamental appeal and makes it a useful addition as a transition between the house and the outdoors. It could be something as simple as being surrounded by woods to give a treehouse effect or as involved as planting a combination of container sizes and styles with colorful mixed flowers, foliage, shrubs, trees and perennials. Patios are accented in this same manner, but you often have the luxury of creating beds to landscape around a patio. When you are 10 feet off the ground on a deck, the horticultural enhancement is a little more challenging. So as soon as you get the deck plans decided, begin your **deckscape** design.

Your greatest landscape design challenge will be creating privacy for decks high above the ground. In these cases, I like to work with vines and lattice.

...

Planters on the deck can provide visual interest and at least implied screening. If you want to plant containers with shrubs and trees...

...

"Deckscaping: Gardening and Landscaping on and Around Your Deck," by Barbara W. Ellis (Storey Books, 2002, \$19.95), is excellent for everyone as a landscape design book. It is devoted exclusively to the design and planting around a deck in every way. If you want how-to planting and design ideas for your deck, patio or even your balcony, this book is a must.

"The Washington Post," December 7, 2002

Plan an exquisite garden or **deckscape** with our plants, herbs and gorgeous garden accents featuring pieces by Virginia Metalcrafters.

(showing an address in Old Saybrook,
CT)
[www.lighthousemaps.com/Saybrook/Herbery
.htm](http://www.lighthousemaps.com/Saybrook/Herbery.htm)

Deckscares

We photograph your deck or patio area
with your favorite planters and urns.
We design plant groupings for your
approvals as the new planters are re-
arranged on your space. Some new
planters, urns, or arbors may be
suggested in our 3-Dimensional designs.

Finally, we offer an update service to
refresh your planters throughout the
seasonal changes.

www.floweringfield.com/serv02/htm

Start with a big, fat list of
everything you want to do in your
garden this year. Would you like a
dazzling **deckscape**, some new raised
beds, a stone wall, or perhaps a water
garden?

[http://garden.garden.org/regional/
report/arch/inmygarden/659](http://garden.garden.org/regional/report/arch/inmygarden/659)

We are skilled in a wide range of areas
and can provide the following:

...

Sod

Shrubs

Deckscares

Fences

Decorative Stones

(showing an address in Rahway, NJ)

www.hpmlandscape.com/skills

*

Building dreams for homeowners since
1958, Coleman-Bright Ideas For Your
Home! Is Texas' oldest and largest
"one-stop" backyard provider of custom
in-ground pools, Garden Rooms™,
portable spas, **deckscares**, outdoor
furniture, pool and spa chemicals and
accessories.

(showing an address in Fort Worth, TX)
www.integritypublishing.com/ex_ftw_
pages/coleman.html

It is clear from the materials of record that "deckscape" has become a recognized term for landscaping involving decks, so much so that in many of the website pages the companies/authors have believed there was no need to further define the term, and have used it in the same manner as generic terms such as "garden" or "landscape" or "shrubs." It also appears from the articles and website materials that "deckscape" refers to the plantings both on and around decks. See, for example, the "Washington Post" article, which refers to "deckscaping" as "landscaping over, on and around a deck."

Moreover, the specimen submitted with applicant's amendment to allege use gives tips such as "built-in planters filled with bright blooms add beautiful color to stair landing or corners of a deck" p. 5; and "you might consider putting the focus on your garden by using the same color of Trex® decking for all the elements—deck, railing, benches and pergola. Using one material creates a uniform look and turns the deck into a neutral backdrop to the gorgeous plants, trees and flowers." P. 16. Another article, entitled "flowerpower," discusses creating a deck near a garden, and enjoying garden views from the deck.

When the term DECKSCAPES is used in connection with a "magazine containing design ideas for decks," as applicant's goods are identified, we find that it immediately conveys to consumers that the magazine presents information about designing or decorating decks. The mark is therefore merely descriptive of the goods.

Applicant has argued that the word "deck" has multiple meanings in the English language, including a part of a ship or a pack of playing cards, and therefore one would not know from the mark whether DECKSCAPES is being used, for example, for a cruise industry magazine showing views available from cabins on different decks, or by a gaming industry magazine depicting various card playing tips. This argument, however, ignores the fact that applicant's goods have been identified as a "magazine containing design ideas for decks."

Applicant also asserts that "scape" is generally used only in connection with geographic terms (e.g., landscape, cityscape) and therefore DECKSCAPES has an incongruous meaning. This argument, however, is belied by the evidence, which shows that "deckscares" has a recognized meaning in connection with decks and deck design. For this reason, applicant's reliance on third-party registrations for marks containing the element SCAPES (e.g., FLOORSCAPES

for wholesale and retail store services in the field of carpets and floor coverings, PATIOSCAPES for furniture and accessories for patios) is misplaced.

Applicant further asserts that the evidence submitted by the Examining Attorney does not establish that the term has been so frequently used by competitors that it is merely descriptive of applicant's goods. Although use of a term by competitors is evidence of the descriptiveness of a mark, the Office is not required to show such use in order to establish that a term is merely descriptive. It is well established that a mark may be descriptive even if the applicant is the first or only user of the mark. In this case, of course, there are several uses of "deckscape" by authors and business entities. Applicant also claims that the references are insufficient to demonstrate the descriptiveness of the term "when one considers that the NEXIS® computer database and the Internet cover entries from a massive number of documents stretching back many years, and that these documents collectively incorporate billions of terms." p. 13. Obviously, since the database and Internet do incorporate billions of terms and refer to a countless number of subjects, one would expect that, compared to the billions of terms, the number that include "deckscape" would be comparatively low. On a more

practical level, the Board has repeatedly advised that it discourages both Examining Attorneys and applicants from submitting large numbers of articles or webpages that may be retrieved from a search of the NEXIS database or of the Internet. In this case, the Examining Attorney's submissions are adequate to establish that "deckscapes" is used in a descriptive manner by various entities.

Finally, with respect to applicant's argument that even if DECKSCAPES is registered to applicant, competitors still have "a variety of terms to refer to the qualities or characteristics of such a magazine," applicant is reminded that Section 2(e)(1) prohibits the registration of a mark that merely describes the goods. See *Roselux Chemical Co., Inc. v. Parsons Ammonia Col, Inc.*, 299 F.2d 855, 132 USPQ 627 (CCPA 1962). Because we have found applicant's mark to be merely descriptive of its identified magazine, the fact that applicant is able to suggest marks for third parties to use on such a magazine is irrelevant.

Decision: The refusal of registration is affirmed.