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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re JPI Colorworkshop, Inc.

Serial No. 78107577

Larry B. Miller of Feder, Kaszovitz, Isaacson, Weber, Skala, Bass
& Rhine, LLP for JPI Colorworkshop, Inc.

Laura G. Kovalsky, Trademark Examining Attorney, Law Office 110
(Chris A.F. Pedersen, Managing Attorney).

Before Seeherman, Hohein and Walsh, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

JPI Colorworkshop, Inc., by an assignment from P&M
Products Ltd., is the owner of an application which has been
filed to register the term "STRIPE WRITER" on the Principal
Register for "pens, namely[,] coloring pens, writing pens,
drawing pens and felt tip markers" in International Class 16.¹

Registration has been finally refused under Section
2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the
ground that, when used in connection with applicant's goods, the
term "STRIPE WRITER" is merely descriptive thereof.

¹ Ser. No. 78107577, filed on February 8, 2002, which is based on an
allegation of a bona fide intention to use such term in commerce.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We reverse the refusal to register.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, 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 that the term would have to the average purchaser of the goods or services because of the manner of such use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Thus, "[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).

However, a mark is suggestive if, when the goods or services are encountered under the mark, a multi-stage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See, e.g., In re Abcor Development Corp., supra at 218, and In re Mayer-Beaton Corp., 223 USPQ 1347, 1349 (TTAB 1984). As has often been 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. See, e.g., In re Atavio, 25 USPQ2d 1361 (TTAB 1992); and In re TMS Corp. of the Americas, 200 USPQ 57, 58 (TTAB 1978). The distinction, furthermore, is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. See In re George Weston Ltd., 228 USPQ 57, 58 (TTAB 1985).

Applicant, while notably not citing to any specific dictionary, asserts in its initial brief that "the mark STRIPE WRITER is suggestive of Applicant's products, arguing that:

The word "writer" ... [is] a noun formed from the verb to write, which in most dictionaries is defined as forming letters, words or symbols or numbers on a surface such as paper with an instrument such as a pen. The word ["]stripe["] on the other hand has long been defined as a long narrow band distinguished as by color or texture from the surrounding material or surface; a textile pattern of parallel bands or lines on a contrasting cloth or braid, etc. No native speaker of English would refer to writing stripes, unless using the words tropically. Indeed, the incongruity of the combination of the words "stripe" and "writer" is such that prospective purchasers would be forced to

pause and reflect on the significance of the combined term "STRIPE WRITER" in order to impart any meaning to the combination as applied to pens, so that they would recognize the words STRIPE WRITER as the source of the goods and not as describing any ingredient, quality, characteristic, feature, function, purpose or use of the product.

....

Here the Examining Attorney cannot point to anything in the goods ... that would show this compound mark as descriptive of the products. There is absolutely no evidence with any degree of certainty that the proposed mark forthwith conveys an immediate idea of the subject matter or any quality, characteristic, function or feature of Applicant's products; and the linguistic analysis above weighs against such a probability.

Applicant adds, however, that any doubt as to whether its mark is suggestive instead of merely descriptive should be resolved in its favor.

The Examining Attorney, on the other hand, contends in her brief that there is evidence which supports "finding the proposed mark [is] merely descriptive of the 'pens' and 'markers' identified in the application." Specifically, the Examining Attorney notes that the record shows that (emphasis in original):

Attached [to the first Office action] were copies of four [third-party] trademark registrations, [three] each for "pens" [and one for "markers and pens"] and for marks comprising [in part] the term "WRITER," which was disclaimed in each registration. In addition, an inquiry was made as to the significance of STRIPE WRITER in the relevant trade or industry or as applied to the applicant's goods.

The applicant responded informally with an electronic communication ..., stating that **"the pen with which the mark is intended for**

use will feature a dual color effect." In a subsequent electronic communication ..., the applicant stated that **"the pen will feature striped ink."**

In addition, citing definitions of the words "stripe" and "writer" from The American Heritage Dictionary of the English Language (3rd ed. 1992),² the Examining Attorney observes that:

As defined, the word "STRIPE" means "a. A long narrow band distinguished, as by color or texture, from the surrounding material or surface; b. A textile pattern of parallel bands or lines on a contrasting background." As defined, the word "WRITER" means "One who writes, especially as an occupation."

While also noting that "a definition of 'pen' is 'writer,'" the definition which the Examining Attorney has made of record from the same dictionary lists the word "pen" as a noun meaning:

1. An instrument for writing or drawing with ink or similar fluid, especially: a. A ballpoint pen. b. A fountain pen. c. A pen point. d. A penholder and its pen point. e. A quill. 2. An instrument for writing regarded as a means of expression. 3. A writer or an author: a *hired pen*.

Based upon the above, the Examining Attorney maintains that "the term STRIPE WRITER refers to both a writing instrument that produces striped writings and one who writes in stripes or using stripes. With either interpretation, the mark merely

² The Examining Attorney, in her brief, requests that the Board "take judicial notice of the above definitions, pursuant to TBMP §1208.04." Inasmuch as it is settled that the Board may properly take judicial notice of dictionary definitions, the request is approved and consideration has been given thereto. *See, e.g.,* Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852, 860 n. 7 (TTAB 1981).

describes the goods." In particular, the Examining Attorney insists that:

Here, the mark STRIPE WRITER will immediately inform prospective consumers that the goods on which this mark is used are either writing instruments that produce stripes or are intended for use by writers who wish to write using stripes. Both potential meanings are considered merely descriptive under federal trademark law. The fact that two different interpretations are possible--both descriptive--does not obviate the refusal. Clearly, the wording STRIPE WRITER, when used in connection with these goods, tells the prospective consumer that if he purchases this product, he will be able to write in stripes. No imagination is required.

The Examining Attorney also relies on applicant's statements, specifically, that "the pen will feature striped ink" and that "the pen with which the mark is intended for use will feature a dual color effect," as "clearly supporting the argument that the mark is descriptive in relation to the goods for which registration is sought." Moreover, while conceding that the record contains no examples of third-party use of the term "STRIPE WRITER," the Examining Attorney, citing *In re Acuson*, 225 USPQ 790 (TTAB 1985) and *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983), contends that "[t]he fact that an applicant may be the first and sole user of a merely descriptive designation does not justify registration where the record shows that the term is merely descriptive of the identified goods."

Applicant, in its reply brief, reiterates its various contentions that its mark is suggestive, urging that (*italics in original*):

With respect to the meaning of the composite mark STRIPE WRITER, the Examining Attorney's argument fails to distinguish between word usage that is normal or veritative [sic] and word usage that is extended or metaphorical (tropical). In this case, the Examining Attorney argues that the mark "tells the prospective consumer that if he purchases this product, *he will be able to write in stripes.*" No dictionary of the English Language and no native speaker of the English/American language would ever use the expression "write in stripes" in common every day language, and, it is doubtful that any such person would know what that expression means ... because people write words, not (in) stripes. People draw stripes, they do not "write in stripes," unless that expression is used in a very loose and metaphorical way, i.e., a mode of thinking that requires imagination, thought, or intellection, such as is the property of a suggestive mark. Indeed, the Examining Attorney's [sic] further argues that the word "pen" is a definition of the word "writer", as if any English speaker ... would at once see the word "writer" [as] meaning author and think of the word "pen" in the sense of writing instrument, as opposed to "pen" in the extended sense of "author" as in "pen name".

Likewise, applicant renews its assertion that "[t]here is nothing in the goods ... that indicates that the 'pen will feature striped ink' or that 'the pen with which the mark is intended for use will feature a dual color effect.'" We note, however, that applicant has indeed made the following statements (emphasis added) in e-mail communications which form part of the record herein:

"Although the pen with which the mark is intended for use will feature a dual color effect, it can also achieve a single color effect"; and

"'Stripe' is not normally used in the context of lines made by pens and is not generic to lines made by marker pens.

It is our view the 'line' marker is more generic than 'stripe.' All pens can draw a line but until now we do not believe writing instruments have been associated with the word stripe. Whilst **the pen will feature striped ink**, it is not a feature that is recognized or associated with pens, markers[,] etc. This marker is new and innovative and [we] are looking to register a mark that the consumer will associate with this pen."

Upon consideration of the evidence and arguments presented, we agree with applicant that, when considered in its entirety, the mark "STRIPE WRITER" is suggestive rather than merely descriptive of applicant's "coloring pens, writing pens, drawing pens and felt tip markers." Although the term "WRITER," as shown by the disclaimer of such term in the third-party registrations which are of record, has on occasion been regarded as merely descriptive of pens and markers, it nonetheless is plain from the definition of such term that in common parlance it generally refers to a person who writes, especially as an occupation, rather than to a thing or instrument for writing. Similarly, while it is obvious, in light of the definition of the word "STRIPE," that any pen or marker with a broad enough tip, or one which featured "striped ink" or "a dual color effect," could be used to write or draw a relatively long, narrow band of a different or distinguishing color or texture, pens and markers are typically used to communicate, by writing or drawing, rather than to produce stripes per se. Thus, combining the words "STRIPE" and "WRITER" to form the term "STRIPE WRITER" results in

a suggestive mark since, as persuasively argued by applicant, in ordinary discourse users of pens and markers, and such writing instruments themselves, would not be considered "stripe writers" except, perhaps, through the exercise of a multi-stage reasoning process or the utilization of imagination, thought or perception.

Finally, to the extent that we may have any doubt as to whether applicant's mark immediately conveys significant information about a characteristic, feature or other attribute of its goods or their nature or use, we resolve such doubt, in accordance with the Board's settled practice, in favor of the publication of applicant's mark for opposition. See, e.g., In re Rank Organization, Ltd., 222 USPQ 324, 326 (TTAB 1984); In re Conductive Systems, Inc., 220 USPQ 84, 86 (TTAB 1983); In re Morton-Norwich Products, Inc., 209 USPQ 791, 791 (TTAB 1981); and In re Gourmet Bakers, Inc., 173 USPQ 565, 565 (TTAB 1972).

Decision: The refusal under Section 2(e)(1) is reversed.