

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Hearing:
October 27, 2005

Mailed: January 26, 2006
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Truck-Lite Co., Inc.

Serial No. 76532510

Byron A. Bilicki of The Bilicki Law Firm, P.C. for Truck-Lite Co., Inc.

Richard F. White, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Hairston, Walters and Walsh, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Truck-Lite Co., Inc. has filed an application to register the mark SUPER (in standard character form) for:

lighting products for vehicles, namely, headlights; tail lights; marker lights; clearance lights; identification lights; stop lights; turn lights; lighting kits comprised of lamps, grommets, plugs, and flanges; license plate lights; back-up lights; interior and utility

lights; snow plow lights; fog and driving lights; daytime running lights; and flashing lights.¹

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that, when used in connection with applicant's goods, the mark SUPER is merely descriptive of them.

Applicant has appealed. Briefs have been filed, and an oral hearing was held.

Applicant argues that the mark is at most suggestive, and does not convey, with any degree of particularity an immediate idea or characteristic about the goods. Applicant asserts that the word "super" has multiple definitions. Applicant states that the term is not normally associated with lighting products for vehicles, and that others in the field neither have used the term nor have a competitive need to use the term in connection with similar goods.

The examining attorney maintains that the mark SUPER merely describes that applicant's vehicle lighting products "are of higher quality or are superior to similar products on the market." (Brief, p. 3.) The examining attorney relies upon a dictionary definition of the word "super."

¹ Serial No. 76532510, filed on July 28, 2003, which alleges a bona fide intention to use the mark in commerce.

Also offered in the support of the refusal are third-party registrations for marks that include the term SUPER. These registrations contain a disclaimer of SUPER, or have been registered only on the Supplemental Register, or on the Principal Register upon a showing of acquired distinctiveness.

The examining attorney is not persuaded by the fact that the term "super" has several meanings given that the determination of mere descriptiveness must be made on the basis of the term's meaning when applied to the specified goods listed in the application.

The term "super" is defined as, inter alia, "[a]n article or a product of superior size, quality, or grade. The American Heritage Dictionary of the English Language (Third edition 1992). The examining attorney relies on this definition in arguing that the mark will convey to consumers that applicant's lighting products are of higher quality or are superior to similar vehicle lighting products on the market.

It is well settled that a mark is considered to be merely descriptive of the goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys

information regarding the nature, function, purpose or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a mark 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 mark describes a significant attribute or idea about them. Moreover, whether a mark 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 on or in connection with those goods or services and the possible significance that the mark would have to the average purchaser of the goods or services because of the manner of its use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).

On the other hand, a mark is suggestive if, when the goods or services are encountered under the mark, a multistage reasoning process, or imagination, thought or perception, is required in order to determine what attribute of the goods or services the mark indicates. See *In re Abcor Development Corp.*, *supra* at 218. To the extent that there is any doubt in drawing the line of demarcation between a suggestive mark and a merely descriptive mark,

such doubt is resolved in applicant's favor. In re Atavio, 25 USPQ 1361 (TTAB 1992).

In urging reversal of the refusal to register, applicant relies heavily on In re Ralston Purina Co., 191 USPQ 237, 238 (TTAB 1976) in which the term SUPER in the mark RALSTON SUPER SLUSH (SLUSH disclaimed) was held suggestive of a "concentrate to make a slush type soft drink" since the term "is used as mere puffery ... to connote a vague desirable characteristic or quality;" and In re Occidental Petroleum Corp., 167 USPQ 128 (TTAB 1970) in which the Board held that SUPER IRON suggestive of "soil supplements" since "it takes some roundabout reasoning to make a determination ... that the product contains a larger amount of iron than most soil supplements or that this iron ... ingredient ... is superior in quality to iron found in other soil supplements."

The examining attorney relies on In re U.S. Steel Corp., 225 USPQ 750, 751 (TTAB 1985) in which the Board held SUPEROPE merely descriptive of wire rope "since combination of the word 'SUPER' with the apt descriptive term 'ROPE' results in a term which would be perceived as nothing more than the name of the goods modified by a laudatory adjective indicating the superior quality of appellant's wire rope"; and In re General Tire & Rubber

Co., 194 USPQ 491, 495 (TTAB 1977) in which the Board held SUPER STEEL RADIAL merely descriptive of tires since the term conveys "one or both of two ideas"; the first is that "the goods are superior grade steel radial tires" and the second is that the goods are "large size steel radial tires."

What we distill from the cases relied on by applicant and the examining attorney, as well as other Board decisions, is that, in general, if the word "super" in a mark is combined with the generic name of the goods, or if the goods come in various grades or sizes, then the mark is merely descriptive rather than suggestive.

In this case, the mark sought to be registered is simply SUPER; it is not combined with the generic name of the goods. Moreover, there is no evidence of record to suggest that lighting products for vehicles come in various sizes or grades, or that "super" has been used as a descriptive designator for vehicle lighting products.

We find that the mark SUPER, when applied to applicant's goods, is suggestive and not merely descriptive. There is a certain ambiguity about the mark and no information about any quality or characteristic of the goods is conveyed with a degree of particularity. Some thought or imagination would be required on the part of

prospective purchasers in order to perceive any significance of the mark as it relates to applicant's goods.

Although we have considered, of course, the third-party registrations introduced by the examining attorney, we are not persuaded to reach a different result in this appeal. We readily concede that they tend to show that in the past the Trademark Examining Operation has viewed the term "super" to be merely descriptive for certain goods and services. However, we note that that none of the third-party registrations cover goods of the type involved in this appeal. Furthermore, while uniform treatment under the Trademark Act is an administrative goal, our task in this appeal is to determine whether this particular applicant's mark is registrable on the Principal Register. As the Board has often stated, each case must be decided on its own facts, and we are not privy to the file records of the registrations submitted by the examining attorney.

Finally, to the extent that there is any doubt in this case, we have resolved that doubt in applicant's favor so as to permit publication of the mark. In re Atavio, supra.

Decision: The refusal to register is reversed.