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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hartmetall-Werkzeugfabrik Paul Horn GmbH

Serial No. 76544519

Mark S. Bicks of Roylance, Abrams, Berdo & Goodman for
Hartmetall-Werkzeugfabrik Paul Horn GmbH.

Linda Blohm, Trademark Examining Attorney, Law Office 110
(Chris Pedersen, Managing Attorney).

Before Hairston, Drost and Zervas, Administrative Trademark
Judges.

Opinion by Hairston, Administrative Trademark Judge:

Hartmetall-Werkzeugfabrik Paul Horn GmbH, a German
Corporation has filed an application to register the mark
SUPERMINI for "power tools with carbide cutting edges for
machining of metals and supports and tool holders for such
tools."¹

¹ Serial No. 76544519, filed on September 12, 2003, which alleges
a bona fide intention to use the mark in commerce. Applicant
asserted a second basis for filing, namely a right of priority
under Section 44 of the Trademark Act based on a German
application.

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 on applicant's goods, the mark SUPERMINI is merely descriptive of them.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested.

The examining attorney maintains that the mark merely describes a feature of applicant's goods, namely that the power tools, tool supports and tool holders are "extremely small, extremely miniature." (Brief, p. 4). The examining attorney relies upon dictionary definitions of "super" ("very large, great, or extreme") and "mini" (small, miniature"). The American Heritage Dictionary of the English Language (Third edition 1992). Also, the examining attorney submitted hits from a Google search which contain references to "mini(-)tools." Examples are shown below:

Bosch Mini Tools and Tool Sets
Boys activity toys make ideal gifts, they will love Bosch mini toolsets and workstations, perfect miniature replicas of bosch tools and accessories...
www.the-toybox.com

Micro and Mini-Tools
Micro and Mini-Tools. Standard Micro-Tool Set - Assorted Sets. A Special Lab Set 6X. A Special ... 286, Mini-Tool Set.
www.emsdiasum.com

MiniWorking Tools Set
Mini Working Tools Set
 A truly wonderful
gift for a Master Mason... Mini Working Tools Set.
www.lostword.safeshopper.com

In addition, the examining attorney submitted a page downloaded from the website www.manufacturingtalk.com which contains an article titled "Ultra-mini tools turn in confined spaces;" and a page downloaded from the website www.epinions.com which contains a product review for the "Craftsman Stand for Mini-Tools Drill 61319."

Applicant, in urging reversal of the refusal to register, argues that SUPERMINI is not merely descriptive of the identified goods; and that the word "super," in particular, is mere trade puffery. Also, applicant maintains that "'super,' in connoting large, creates an incongruous and non-descriptive combination with 'mini' having an opposite connotation.'" (Brief, p. 3).

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).

Applying these principles to the evidence of record, we conclude that SUPERMINI, as a whole, has not been proven to be merely descriptive of the identified goods. The examining attorney has submitted some evidence of use of "mini" in connection with power tools and accessories. Further, applicant does not dispute the descriptive significance of this term. However, the record is devoid of any evidence of use of "super" in connection with the identified goods. Moreover, the ultimate question in this case is whether the combined term SUPERMINI will immediately inform prospective purchasers of a feature, characteristic, or quality of the goods, which in this case are power tools, tool supports and tool holders. The limited evidence of record simply does not support this conclusion.

We find that the mark SUPERMINI, as a whole, is suggestive. There is a certain incongruity about the combination of SUPER (large/extreme) and MINI (small). Some thought or imagination on the part of prospective purchasers would be required in order to perceive any significance of the mark SUPERMINI as it relates to the identified goods. To the extent that there is any doubt in this case, we have resolved that doubt in applicant's favor

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so as to permit publication of the mark. In re Atavio,
supra.

Decision: The refusal to register is reversed.