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OF THE TTAB

JULY 9, 1997

Hearing:
November 13, 1996

Paper No. 16
TJQ

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Rug Doctor, L.P.*

Serial No. 74/457,278

Richard Browne and Alexandra Kostiw of Winston & Strawn for applicant.

Richard A. Straser, Trademark Examining Attorney, Law Office 104 (Sidney Moskowitz, Managing Attorney).

Before Rice, Hanak and Quinn, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Rug Doctor, L.P. to register the designation WITH THE VIBRATING BRUSH for "machines for extracting dirt and foreign matter from rugs, carpets, and the like."¹ Applicant claims that the applied-for designation has acquired distinctiveness as provided by Section 2(f) of the Act.

¹Application Serial No. 74/457,278, filed November 9, 1993, alleging dates of first use of May 10, 1978.

The Trademark Examining Attorney has issued a final refusal under Sections 1, 2 and 45 of the Act on the ground that WITH A VIBRATING BRUSH is purely an informational slogan that does not function as a mark to identify and distinguish applicant's goods.² The Examining Attorney further contends that even assuming that the slogan does function as a mark, the Section 2(f) evidence of record is insufficient to demonstrate that applicant's slogan has come to distinguish its goods from those of others.

When the refusal was made final, applicant appealed.³ Applicant and the Examining Attorney filed briefs and both were present at an oral hearing held before the Board.

²Registration originally was refused under Section 2(e)(1) on the ground that the slogan was merely descriptive when applied to the goods. The Examining Attorney, as he indicates in his appeal brief, subsequently changed the ground of refusal.

³A review of the file shows that applicant's response to the April 4, 1994 Office action refusing registration under Section 2(e)(1) was transmitted to the Office by facsimile on October 4, 1994. The Office action dated November 7, 1994, refusing registration for the first time under Sections 1, 3 and 45, issued in response to applicant's communication. The next paper in the file is the original copy (including the declaration and the exhibits to the declaration) of the papers which applicant earlier had submitted by way of facsimile. The original copy bears a PTO mail room date stamp of October 4, 1994. The Examining Attorney then issued another Office action on January 25, 1995. This Office action, which includes the final refusal under Sections 1, 3 and 45, essentially is the Examining Attorney's second Office action in response to the very same evidence. That is to say, applicant never had an opportunity to respond to the Sections 1, 3 and 45 refusal before it was made final. Nonetheless, applicant's request for reconsideration of the final refusal addressed the merits of the Sections 1, 3 and 45 refusal, and applicant has never raised any objection that the final refusal dated January 25, 1995 appeared to be premature. In view of applicant's request for reconsideration which addressed the merits of the final refusal, and since applicant has raised no concerns relating to the final refusal's being premature, the Board sees no reason to delay a decision at final hearing.

Applicant argues that there is no prohibition in the Trademark Act against the registration of informational slogan marks. Applicant contends that informational phrases may also function as trademarks and, in this connection, applicant has submitted a claim of acquired distinctiveness based on substantially exclusive and continuous use since 1978. In support of the Section 2(f) claim, applicant has relied upon the declaration of Tim Davidian, an officer of applicant. Mr. Davidian attests to applicant's use for over sixteen years of the designation sought to be registered, with cumulative total sales of carpet cleaning machines bearing the designation in excess of \$50 million. The carpet cleaning machines bearing the designation have been advertised in newspapers and brochures, at trade shows, on national television, on radio and in point-of-purchase literature. Advertising expenditures since 1978 exceed \$7 million. Mr. Davidian's declaration is accompanied by exhibits, including advertising brochures, an instruction manual and a decal-label which is affixed to applicant's machines. Also made of record is a one-page excerpt from the Official Gazette and applicant's request for an extension of time to oppose the published mark shown in the excerpt.⁴

⁴The Examining Attorney, in his brief (unnumbered p. 4), objects, in part, to this evidence, essentially on the basis of untimeliness. Inasmuch as this evidence was submitted with applicant's timely request for reconsideration, the evidence properly forms part of the record for appeal. Trademark Trial and Appeal Board Manual of Procedure, § 1204. Thus, we have considered it in reaching a final decision.

The Examining Attorney maintains that applicant's slogan is merely an information phrase which highlights a significant feature of applicant's carpet cleaning machines. The Examining Attorney points to applicant's various uses of WITH A VIBRATING BRUSH, concluding that the consuming public would not perceive the slogan as an indication of source.

The term "trademark", as defined in relevant part in Section 45 of the Trademark Act, means "any word, name, symbol, or device, or any combination thereof used by a person to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." Clearly, not every word or combination of words which appears on an entity's goods functions as a trademark. In re Remington Products Inc., 3 USPQ2d 1714 (TTAB 1987). Thus, the mere fact that applicant's informational phrase appears on the specimens and on other materials does not make it a trademark. To be a mark, the phrase must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods. Mere intent that a word or combination of words functions as a trademark is not enough in and of itself to make the word or combination of words a trademark. Id.

A critical element in determining whether a term is a trademark is the impression the term makes on the relevant public. In the type of case presently before us, the

inquiry becomes a question of whether the slogan would be perceived as a source indicator or, rather, as merely an informational slogan.

Based on the evidence of record, we find that the designation WITH A VIBRATING BRUSH is merely an informational slogan that would not be perceived as a trademark. We need look no further than applicant's own uses of the designation to reach this result. The designation appears on labels in subordinate fashion underneath the mark RUG DOCTOR. In an informational brochure about applicant's products, applicant states that "[w]hat makes these machines special is the **innovative vibrating brush** that loosens dirt in the carpet so the powerful vacuum can take it away." (emphasis in original) Additional uses include "The Carpet Care Machine With The Original Vibrating Brush", "Rug Doctor features the original Vibrating Brush...", and "Introducing the New EZ-1--One Piece Unit with the Vibrating Brush!" Applicant's uses convince us that the designation WITH THE VIBRATING BRUSH is nothing more than an informational slogan which gives consumers an immediate idea about a significant feature of applicant's carpet cleaning machines. As such, we believe that consumers are not likely to view applicant's slogan as a trademark. In re Melville Corp., 228 USPQ 970 (TTAB 1986); In re Manco Inc., 24 USPQ2d 1938 (TTAB 1992); and In re Superba Cravats, Inc., 149 USPQ 852 (TTAB 1966).

Even assuming that applicant's slogan does function as a mark, it is so nondistinct and purely informational in nature that the evidence of record of acquired distinctiveness is insufficient to demonstrate that the slogan distinguishes applicant's goods from those of others. *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988); and *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). See also: Restatement (Third) of Unfair Competition (1993), Section 13, comment e ["The sufficiency of the evidence offered to prove secondary meaning should be evaluated in light of the nature of the designation. Highly descriptive terms, for example, are less likely to be perceived as trademarks and more likely to be useful to competing sellers than are less descriptive terms. More substantial evidence of secondary meaning thus will ordinarily be required to establish their distinctiveness."].

In finding that the evidence of acquired distinctiveness is insufficient for registration, we recognize that applicant has enjoyed success with its products. The sales figures, however, do not demonstrate that the slogan has acquired distinctiveness. Similarly, applicant's pertinent advertising expenditures are merely indicative of its efforts to sell its goods, but are not determinative of whether the efforts have resulted in recognition of WITH THE VIBRATING BRUSH as a trademark.

Simply put, the record does not include any direct evidence that the purchasing public has come to recognize applicant's slogan as a trademark identifying applicant's goods.

Finally, applicant attaches significance to the adoption by an alleged competitor of a mark, which includes the phrase "WITH A VIBRATING BRUSH", for the rental of carpet cleaning machines. Applicant contends that this shows an "intentional copying" which is probative in establishing its claim of acquired distinctiveness. Applicant also contends that the publication in the Official Gazette of the competitor's mark shows that the Office considers the phrase to be capable of registration.

With respect to applicant's arguments, we would point out that the phrase "WITH A VIBRATING BRUSH" in the published mark was disclaimed. Thus, applicant's reliance on this evidence is misplaced. Further, each case must be decided on its own set of facts. In sum, this evidence has little probative value to the present appeal.

Both applicant's and the Examining Attorney's briefs have made and debated, and we have considered, arguments other than those we have discussed above, the majority of which we find irrelevant and all of which we find unnecessary to comment on.

Ser No. 74/457,278

Decision: The refusal to register is affirmed.

J. E. Rice

E. W. Hanak

T. J. Quinn
Administrative Trademark Judges
Trademark Trial and Appeal Board

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