

THIS DISPOSITION IS NOT CITABLE AS  
PRECEDENT OF THE TTAB                      JULY 31, 97

Paper No. 10  
EWH/HLJ

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **Sunset Publishing Corporation**

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Serial No. 74/**602,744**

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**Robert T. Scherer** of Time Warner Inc. for **Sunset Publishing Corporation**.

**Meryl L. Hershkowitz**, Trademark Examining Attorney, Law Office 103 (**Michael Szoke**, Managing Attorney).

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Before **Hanak**, **Quinn** and **Hohein**, Administrative Trademark Judges.

Opinion by **Hanak**, Administrative Trademark Judge:

Sunset Publishing Corporation (applicant) seeks registration of SUNSET CREATIVE COOKING LIBRARY for "a series of recipe books." The application was filed on November 23, 1994 with a claimed first use date of October 1994. The application contained no disclaimer.

In the first office action, the examining attorney stated that "the applicant must disclaim the descriptive

wording CREATIVE COOKING LIBRARY part from the mark as shown. Trademark Act Section 6." Attached to this office action were excerpts of stories from the NEXIS database wherein the term "creative cooking" appeared. The examining attorney also pointed out that one definition of the word "library" is "a series of related books issued by a publisher," citing Webster's Ninth New Collegiate Dictionary (1992).

In response, applicant offered to disclaim "the words COOKING and LIBRARY apart from the mark as shown." However, applicant refused to disclaim the word CREATIVE. Applicant contended "that the word CREATIVE is -- at most -- suggestive of its goods and therefore is registrable on the Principal Register, without disclaimer, since consumers receive no definite information, but only a vague suggestion, about applicants goods from the term CREATIVE." Moreover, applicant included a list of marks registered with the United States Patent and Trademark Office which contained the word CREATIVE, but which did not have a disclaimer of said word.

In the second office action, the examining attorney stated she did not agree with applicant that as applied to applicant's goods, the term CREATIVE was suggestive and not merely descriptive. As for the list of third-party registrations, the examining attorney did not object to the fact that applicant submitted but a mere list, instead of actual copies of said registrations. Rather, the examining

attorney argued the merits of this list, noting that none of the over 80 registrations "used 'creative' in conjunction with 'cooking'...[and that] third-party registrations are not conclusive on the question of descriptiveness."

In response to this second office action, applicant maintained its view that the term CREATIVE in its mark was not merely descriptive, but rather was simply suggestive of its goods. However, applicant also offered an alternative course to avoid "further delay" and "appeal to the TTAB" by providing the following disclaimer: "No claim is made to the exclusive right to use the separate words CREATIVE, COOKING and LIBRARY apart from the mark as shown."

In the third and final office action, the examining attorney stated that "applicant's amendment disclaiming CREATIVE, COOKING and LIBRARY separately is unacceptable." The examining attorney concluded by stating "that the requirement that applicant disclaim CREATIVE COOKING LIBRARY apart from the mark as shown is [made] final."

Subsequently, applicant appealed to this Board. Applicant and the examining attorney filed briefs. Applicant did not request a hearing.

A review of the NEXIS Excerpts attached to office actions nos. 1 and 2 reveals that the term "creative cooking" has no specific meaning, unlike such terms as "Italian cooking," "microwave cooking" or "French cooking." Moreover, a review of the list of third-party registrations of marks containing the word CREATIVE where said word was

not disclaimed further supports the conclusion that this word is somewhat ambiguous. In order for a term to be held descriptive and subject to disclaimer, the term must convey an immediate idea about the ingredients, qualities or characteristic of applicant's goods or services with a "degree of particularity." In re TMS Corp. of the Americas, 200 USPQ 57, 59 (TTAB 1978); In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd 90-1495 (Fed. Cir. February 13, 1991). Because the term CREATIVE in applicant's mark simply fails to convey information about applicant's goods with the required "degree of particularity," we find that this term is not descriptive of applicant's good and hence need not be disclaimed.

Nevertheless, we are "affirming" the refusal to register because applicant's initial disclaimer reads as follows: "No claim is made to the exclusive right to use the words COOKING and LIBRARY apart from the mark as shown." The phrase COOKING LIBRARY is unitary in nature, and thus the entire phrase must be disclaimed. See In re Wanstrath, 7 USPQ2d 1412, 1413 (Comm'r Pats. 1987).

**Decision:** The refusal to register is "affirmed." However, applicant is allowed thirty days from the mailing date of this decision to submit an appropriate disclaimer, which should read as follows: "No claim is made to exclusive right to use COOKING LIBRARY apart from the mark as shown." Upon the receipt of this appropriate disclaimer,

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this decision will be set aside and applicant's will be passed to publication. See In re Interco Inc., 29 USPQ2d 2037, 2039 (TTAB 1993).

E. W. Hanak

T. J. Quinn

G. D. Hohein  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board