

Hearing:
March 31, 1998

Paper No. 14
SIMMS/md

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB DEC. 16, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Trim-A-Lawn Corporation

Serial No. 75/101,885

Glen L. Gross of Shlesinger, Arkwright & Garvey for Trim-A-Lawn Corporation.

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

Before Simms, Hanak and Wendel, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Trim-A-Lawn Corporation has appealed from the final refusal of the Trademark Examining Attorney to register the mark shown below (in reduced form)

for power lawn trimmers.¹

The Examining Attorney has refused registration of the mark under Sections 1, 2 and 45 of the Trademark Act, 15 USC §§1051, 1052 and 1127, on the ground that applicant's asserted mark does not function as a trademark for its goods. The Examining Attorney has also made final requirements for disclaimers of the design of the hand-carried lawn trimmer and the international prohibition symbol (the circle and slash mark). Applicant has appealed, and applicant's attorney and the Examining Attorney have submitted briefs. No oral hearing was requested.

With respect to the refusal that applicant's mark does not function as a mark, it is the Examining Attorney's position that the asserted mark, displayed by means of a hang tag on applicant's wheeled powered trimmers (shown below), is merely informational and devoid of any origin-indicating significance.

¹ Application Serial No. 75/101,885, filed May 9, 1996, based upon use in commerce since on or before March 28, 1996. In the

In this regard, the Examining Attorney initially contended that the asserted mark will be seen by potential purchasers as a warning that they should not carry a lawn trimmer, ostensibly because it may cause back problems. The Examining Attorney later suggests that the asserted mark may be seen as a warning that carrying a power trimmer may be dangerous.

In support of his refusal and the requirement for disclaimers, the Examining Attorney has made of record an undated copy of a portion of what appears to be an examination guideline which, among other things, discusses

amended application, it is indicated that the mark is lined for the color red but that no claim is made to color.

the registrability of marks containing the so-called international prohibition symbol.² That guideline provides in part:

The International Prohibition Symbol... often presents a descriptiveness issue, whether it be 2(e)(1) or simply a disclaimer requirement. The problematic areas here are determining whether the use is literal (descriptive) or cute or facetious (non-descriptive) and the degree to which the universal prohibition symbol is incorporated into the rest of the mark...

A. EXAMINER'S REVIEW OF THE PROHIBITION SYMBOL

1. Does the symbol clearly act as the design equivalent of the commands "NO!" or "NONE!" or "DO NOT!"? Or, is the use facetious?
2. Is the design such an integral part of the mark that it should be considered unitary?

B. ACTION TO BE TAKEN

1. If the symbol clearly indicates "NO!" or "NONE!" or "DO NOT!" and the symbol is not an integral part of the mark disclaim the symbol or refuse under section 2(e)(1)

² The Examining Attorney has not cited, nor could we find, similar material in the Trademark Manual of Examining Procedure. We do not know if this guideline still governs examination practice nor whether it has been superseded by the TMEP. Suffice it to say that we have considered this material as outlining Office policy and practice for Examining Attorneys at some undetermined point of time. It is not binding on the Board.

if the whole mark is
descriptive

2. If the symbol is an integral part of a mark which is distinctive overall, no refusal and no disclaimer - even if the symbol indicates "NO!" or "NONE!" or "DO NOT!"

With respect to the refusal that the asserted mark does not function as a mark, it is applicant's position that, when the asserted mark is displayed on a walk-behind lawn trimmer, the mark would suggest to purchasers that applicant's product is a substitute for the hand-carried lawn trimmer shown in the mark. Applicant's attorney maintains that the asserted mark is not conveying information about back problems.

Concerning the refusal that the asserted mark does not function as a mark to identify and distinguish applicant's goods, it is clear to us that if the asserted mark were the image of, say, an international prohibition symbol over a lighted cigarette, the asserted mark would only inform potential purchasers or operators that smoking was not permitted around the machine. Such use of the symbol would, of course, not function as a mark. However, we agree with applicant that its use of the international prohibition symbol is not of this nature. Rather, as used in connection with applicant's walk-behind trimmers, it

expresses the point of view that one should not purchase or use a hand-carried lawn trimmer but rather should purchase and use applicant's wheeled lawn trimmer. Such use is not cautionary or one of a warning. Rather, it is a somewhat fanciful or humorous way of informing purchasers that they should not purchase a hand-carried lawn trimmer. An analogous use might be that of a manufacturer of casual slacks using the prohibition symbol over the image of a man wearing shorts as an indication that the potential purchaser should purchase the slacks rather than a pair of shorts. Or, more germane to this case, a manufacturer of wheeled luggage might use the prohibition symbol over the image of a person carrying a piece of luggage, suggesting that one should buy the wheeled version over the hand-carried alternative. Suffice it to say that we believe that applicant's asserted mark does indeed function as a mark to identify and distinguish its goods from those of others.

In this regard, we note the published third-party mark depicted below, one of several that applicant has made of record. In our view, and although not determinative of the outcome here, we believe that the present applicant is using the prohibition symbol in a manner similar to that previously allowed by this Office.

With respect to the disclaimer issues, the Examining Attorney argues that the international prohibition symbol is an unregistrable component of the mark and informs consumers not to handle goods in a certain way. Applicant, on the other hand, argues that the symbol is so merged with other elements of the mark that it is an integral feature thereof. Applicant argues that Office policy requires a disclaimer only if the symbol is used in such a manner that it is not an integral part of the mark.

Because we believe that applicant's use of this symbol is not in the nature of a warning symbol advising people to avoid certain behavior but is rather telling purchasers, in a somewhat novel way, that applicant's products are preferable to those depicted in the mark, we do not believe

that the prohibition symbol is being used in the nature of an advisory or warning that may warrant a disclaimer. Accordingly, we believe that, as used by applicant, the use of the prohibition symbol is only "suggestive" and need not be disclaimed. (We also note that the third-party mark depicted above contains no disclaimer of the prohibition symbol.)

Finally, concerning the required disclaimer of the hand-carried lawn trimmer, the Examining Attorney argues that it is deceptively misdescriptive of applicant's wheeled trimmers. Applicant, on the other hand, argues that when consumers see the asserted mark with respect to applicant's walk-behind trimmers, it becomes readily apparent that applicant's goods are not hand-carried trimmers and that the image of the hand-carried trimmer is not deceptively misdescriptive of applicant's goods.

We agree. First, as used on applicant's goods, we do not believe that the image of a man carrying a power trimmer misdescribes applicant's walk-behind trimmers. One seeing the prohibition symbol superimposed over this image is not likely to believe any misrepresentation allegedly conveyed by the mark. That is to say, as used on applicant's goods, no one is likely to believe that applicant's goods are hand-carried trimmers. See, for

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example, In re Automatic Radio Mfg. Co., Inc., 160 USPQ 233 (CCPA 1969)(AUTOMATIC RADIO not deceptively misdescriptive when used on air conditioners an ignition system or an antenna); Bass Buster, Inc. v. Gapen Manufacturing Co., Inc., 191 USPQ 315 (W.D. Mo. 1976)(BEETLE for fishing lures which are clearly visible to purchasers is not deceptive); In re Perfect Fit Industries, Inc., 223 USPQ 92, 93 (TTAB 1984)(COTTAGE CRAFTS not deceptively misdescriptive of bedspreads, quilts and similar products); and In re Econoheat, 218 USPQ 381 (TTAB 1983)(SOLAR QUARTZ not deceptively misdescriptive of electrically, not solar, operated space heaters). Moreover, we believe that the lawn trimmer, carried by a man shown in silhouette, is unitary because it is so merged with that figure that it cannot be separated therefrom. See TMEP § 1213.06. See also In re Texsun Tire and Battery Stores, Inc., 229 USPQ 227 (TTAB 1986)(design of the outline of the state of Texas surrounded by a tire is not primarily geographically descriptive but is rather a unitary composite mark). Here, it is clear that applicant is making no misrepresentation concerning its goods. Therefore, even if it were a separable element in the mark, we do not believe that a disclaimer is in order.

Decision: The refusal to register and the requirements for disclaimers are reversed.

R. L. Simms

E. W. Hanak

H. R. Wendel
Administrative Trademark
Judges, Trademark Trial and
Appeal Board

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