

**THIS DISPOSITION
IS NOT CITABLE AS
PRECEDENT**

Paper No. 13

GFR

9/18/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Royal Appliance Mfg. Co.**

Serial No. 75/165,479

Sandra M. Koenig of **Fay, Sharpe, Fagan, Minnich & McKee, LLP** for **Royal Appliance Mfg. Co.**

Jason Turner, Trademark Examining Attorney, Law Office 108
(**David Shallant**, Managing Attorney)

Before **Bucher, Bottorff and Rogers**, Administrative
Trademark Judges.

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

Applicant seeks registration of SWIVEL CASTERS on the
Supplemental Register for goods identified as "electric
vacuum cleaners for domestic use," in Class 7.¹ The

¹ Serial No. 75/165,479, filed based on applicant's allegation of bona fide intention to use SWIVEL CASTERS as a mark in commerce, and seeking registration on the Principal Register. The application was later amended to allege use in commerce as of April 1, 1997 and to seek registration on the Supplemental Register. In addition, the identification of goods initially included electric vacuum cleaners for commercial use, but was restricted when the amendment to allege use was filed.

Examining Attorney has refused registration "in accordance with Trademark Act Section 23, 15 U.S.C. 1091, on the ground that the proposed mark is generic for the identified goods and incapable of identifying the applicant's goods and distinguishing them from others."

When the refusal of registration was made final, applicant appealed. Briefs were filed, but an oral hearing was not requested. We affirm.

Applicant, in its brief on appeal, alleges that the final refusal of registration was premature, in that the Examining Attorney's action immediately prior to the final did not clearly refuse registration on the Supplemental Register.² In contrast, the Examining Attorney correctly observes both that the third office action clearly stated "the mark can not be registered on the Supplemental Register," and that the applicant acknowledged the basis for the refusal in its subsequent response. In any event, we agree with the Examining Attorney that applicant should have raised the issue prior to filing its brief on appeal.

The Examining Attorney argues that the "class or genus of the 'central characteristic' of the applicant's goods"

² Applicant amended its application to seek registration on the Supplemental Register after the Examining Attorney had made final a refusal of registration on the Principal Register, on the ground that SWIVEL CASTERS is descriptive of a feature of applicant's goods.

is its swiveling casters. The Examining Attorney asserts that this is the "most distinctive characteristic" of applicant's vacuums, so that the goods "could be defined as 'swivel caster' vacuum cleaners." Under this theory, the Examining Attorney views SWIVEL CASTERS as generic for a class of vacuum cleaners with the "central characteristic" of swiveling casters. In the alternative, the Examining Attorney argues that even if "swivel caster" vacuums is not considered a distinct class of vacuums, the applicant has conceded that it uses the term in conjunction with a line of vacuums, not a specific vacuum, and that the specimens of use show that, for machines in this line, the term is used not as a mark but to indicate that the vacuums utilize swiveling casters. Finally, the Examining Attorney argues that the general consumers who would purchase electric vacuums for domestic use would not perceive the terms "swivel" and "casters," as used by applicant, to have any more significance than their normal dictionary meanings, and that the combination of the terms would be no more capable of distinguishing applicant's goods.

Applicant argues that the Office has previously registered numerous "'swivel' formative trademarks on the Principal Register for goods that include rotating actions"; that "the mark itself does not describe vacuum

cleaners"; that the mark has a "strong cadence" when spoken and occupies a "prominent position" on its vacuum cleaner bodies so that it "possesses a sufficient modicum of variation from the ordinary to demonstrate a potential for distinctiveness"; that the Examining Attorney's Internet evidence is incompetent because it evidences use of swivel casters in a descriptive sense only for commercial vacuums or, in one instance, a high-end residential machine costing at least four times the price of applicant's machines; that the Examining Attorney's NEXIS evidence shows use of casters in a descriptive sense for goods other than residential vacuums; that the Examining Attorney "failed to produce a single example where the overall mark SWIVEL CASTERS is used generically or descriptively in connection with a vacuum cleaner"; and that its mark "is an incongruous word combination that reminds consumers of movable carts."

In assessing the merit of these arguments, we have considered dictionary definitions of "swivel" and "caster"; applicant's specimens of use; a copy of a page from a catalog featuring applicant's goods and a color copy of the front panel from a carton for the goods, both provided by applicant; NEXIS articles made of record by the Examining Attorney; and printouts of Internet web pages made of

record by the Examining Attorney. We have not, however, considered the third-party registrations which applicant has referenced. Applicant first listed the marks and registrations in a response to an office action, and attached copies of a search service report listing information about the registrations. The Examining Attorney objected and noted that mere lists of registrations or search service reports are not sufficient to make third-party registrations of record. The applicant, however, did not thereafter make proper copies of the registrations of record and merely repeated the list in its brief. The Examining Attorney again objected and we find the objection well taken.

The relevant definition of "caster" is "a small wheel on a swivel, set under a piece of furniture, a machine, etc., to facilitate moving it." The Random House College Dictionary 210 (Revised Ed. 1982). The relevant definition of "swivel" is "a fastening device that allows the thing fastened to turn round freely upon it." The Random House College Dictionary 1330 (Revised Ed. 1982).

That these are the relevant meanings for these terms, when considered in conjunction with applicant's goods, is borne out by applicant's specimens. Photographs of applicant's vacuums show that the phrase "EASY-PUSH Swivel

Casters" is printed across the front of the base of these upright machines and that at the rear of the base, above each caster, is the phrase "Swivel Caster" encircled in curved arrows that point to location of the caster. Neither use includes a TM designation.

The page from applicant's catalog portrays three machines, two of which feature casters. These machines are touted with the following: "2 Rear Swivel Casters allow for easy maneuvering on all types of floors." Also, the list of features for each machine reads as follows: "SPECIAL FEATURES: MAXIMUM VACUUM POWER, MOTORGUARD SYSTEM, CARRYING HANDLE, 2 REAR SWIVEL CASTERS, POWER EDGER, QUICK CORD RELEASE."³ Again, we note that no TM designations are used.

Only the carton panel includes any indication that applicant claims trademark rights in "SWIVEL CASTERS." The carton panel, under a photograph showing a caster, displays the following: "*PATENTED SWIVEL CASTERS™ allow for effortless maneuvering around furniture."

The Examining Attorney's Internet evidence reveals ubiquitous use of "swivel casters" in connection with commercial vacuums, but also reveals use of the designation by the Miele company in conjunction with its machines for

³ In addition, the list of features for one of the machines includes "FULL BAG INDICATOR, HEADLIGHT."

home use. Applicant argues that the Miele 434i White Pearl FullSize Vacuum, with a \$749 retail price, is more akin to a commercial machine than one for home use, but the Internet evidence reveals that Miele uses "swivel casters" on vacuums other than its self-proclaimed "top of the line" machine. In addition, the Examining Attorney's NEXIS evidence reveals that upright vacuums for home use can cost up to \$1500, albeit when packed with features not found on lesser-priced models. Thus, it is clear that vacuums for domestic use vary widely in price and features. Since applicant's identification of goods is not limited in any way, we must read it to be inclusive of all such vacuums. Moreover, the important point to note is that even at different price points vacuums for domestic use may include swiveling casters as a feature.

The NEXIS stories made of record by the Examining Attorney include a description of applicant's Royal Swivel Ultra Glide model: "Hard-bodied upright with increased hose suction, rear swivel casters; height adjustment, on-board tools..." The Plain Dealer, April 7, 1997 (Headline: Descriptions of Uprights, Specialty Products From Cleveland-Area Companies). Applicant argues that the newspaper erred in not treating the designation as a trademark. This is not, however, the only reference to

Ser. No. 75/165,479

applicant's machines that uses "swivel casters" as a generic designation for a feature of applicant's vacuums. The Examining Attorney also made of record the following: "Dirt Devil's [applicant's] Ultra Swivel Glide upright vacuum has swivel casters, making it easy to maneuver." The Florida Times-Union, November 21, 1998. Even if these publications have misused the term, the stories contribute to our conclusion on how consumers will perceive "SWIVEL CASTERS." Moreover, there are other references to the use of casters and swiveling casters on cleaning machines used in or around the home: "Besides the usual work of sucking up sawdust, dirt, and liquids, many shop vacs have accessories now for cleaning gutters and grooming animals, inflating air mattresses and vacuuming the car. ...They are found in 25 to 30 percent of American households... All of these vacs roll on wheels or casters." The Christian Science Monitor, February 17, 1999; "This water broom attaches to a garden hose and can be pushed in any direction on its two wheels with swivel casters. Price: \$29.95." Chicago Tribune, August 30, 1991.

It is well settled that a designation must be capable of serving as an indicator of source to be registrable on the Supplemental Register. Whether a designation has the capacity necessary for registration on the Supplemental

Ser. No. 75/165,479

Register is determined by considering the meaning thereof as applied to the goods or services, the context in which it is used on the specimens filed with the application, and the likely reaction thereto by the average customer upon encountering the designation in the marketplace. See In re Cosmetic Factory, Inc., 208 USPQ 443, 447 (TTAB 1980). "The test is not whether the mark is already distinctive of the applicant's goods, but whether it is capable of becoming so." In re Bush Brothers & Co., 884 F.2d 569, 12 USPQ2d 1058, 1059 (Fed. Cir. 1989), *citing* In re Simmons Co., 278 F.2d 517, 126 USPQ 52, 53 (CCPA 1960).

A generic designation, as noted in H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., 728 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986), is incapable of registration on either the Principal Register or the Supplemental Register. The Examining Attorney argues that terms that are generic designations for, or highly descriptive of, a central characteristic or feature of goods or services, also may be found incapable. We agree.

Highly descriptive terms, such as those that name the type, or a distinctive characteristic, of a product or service may also be found incapable of serving a trademark function. See, e.g., Miller Brewing Co. v. G. Heileman

Ser. No. 75/165,479

Brewing Co., 561 F.2d 75, 195 USPQ 281, 285, *cert. denied*, 434 U.S. 1025, 196 USPQ 592 (1978) ("The fact that 'light' is an adjective does not prevent it from being a generic or common descriptive word."); In re Helena Rubinstein, Inc., 410 F.2d 438, 161 USPQ 606 (CCPA 1969) (PASTEURIZED and PASTEURIZED FACE CREAM SPECIAL for face cream held so highly descriptive of applicant's goods as to be incapable of registration on Supplemental Register); In re Hask Toiletries, Inc., 223 USPQ 1254 (TTAB 1984) (HENNA 'N' PLACENTA held unregistrable on the Supplemental Register for hair conditioner); and, In re Harcourt Brace Jovanovich, Inc., 222 USPQ 820 (TTAB 1984) (LAW & BUSINESS held unregistrable on Supplemental Register for arranging and conducting seminars). See also, In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991) (MULTI-VIS held unregistrable for "multiple viscosity motor oil"; "...we conclude that consumers and prospective customers of applicant's goods would not regard the term 'MULTI-VIS' as a trademark but, instead, would attribute to such term the ordinary, straightforward meaning provided by its component parts and manner of use-namely, multiple viscosity. The term, therefore, should remain available for use by applicant's competitors since it primarily signifies and aptly describes multiple viscosity motor oil.").

In this case, we find no support for the Examining Attorney's argument that "swivel casters" is generic for a class of vacuum cleaners.⁴ In contrast, we find that "swivel casters" is a generic designation for a prominent feature of applicant's goods and that, as the designation is used by applicant, it would only be perceived as such by consumers.⁵ We are not persuaded otherwise by applicant's argument that "SWIVEL CASTERS" is an incongruous composite.

We acknowledge that the *Bush Brothers* case, on which applicant relies, alludes to policy considerations which militate in favor of registering a mark on the Supplemental Register. See *Bush Brothers, supra*, 12 USPQ2d at 1059. In the case at hand, however, "SWIVEL CASTERS" is not amorphously laudatory, as DELUXE was held to be in *Bush Brothers*, when used for canned pork and beans. Rather, applicant's proposed mark directly and primarily signifies a prominent feature of applicant's goods.

We also acknowledge that this Board has, in the past, resolved doubts in favor of registration. See In re Volvo

⁴ The Examining Attorney's evidence shows that "canister," "upright" and other terms are recognized classes of vacuums, but reveals no class of "swivel caster" vacuums.

⁵ We rely on the nature of applicant's use of "SWIVEL CASTERS," as illustrated by its specimens, catalog and carton, and on public familiarity with casters in general and swiveling casters in particular on cleaning machines used in or around the home.

White Truck Corp., 16 USPQ2d 1417, 1421 (TTAB 1990)

(INTEGRAL SLEEPER allowed on Supplemental Register despite grave doubts of panel therein as to whether designation was apt descriptive or generic term for trucks with a sleeper integrated into the cab). In this case, unlike the case presented to the panel in *Volvo*, we have no doubt.⁶

Under the circumstances in this case, as in the *Pennzoil* case, the designation sought to be registered is incapable of designating source and should remain available for use by applicant's competitors.

Decision: The Examining Attorney's refusal to allow registration on the Supplemental Register is affirmed.

D. E. Bucher

C. M. Bottorff

G. F. Rogers

Administrative Trademark
Judges, Trademark Trial
and Appeal Board

⁶ This case is also unlike *Volvo* because, in *Volvo*, there was no evidence of generic use of INTEGRAL SLEEPER when the applicant therein adopted it for its goods and, after adoption, applicant aggressively policed use of the designation.