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THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Paper No. 8

TJQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Shell Oil Company

Serial No. 75/629,489

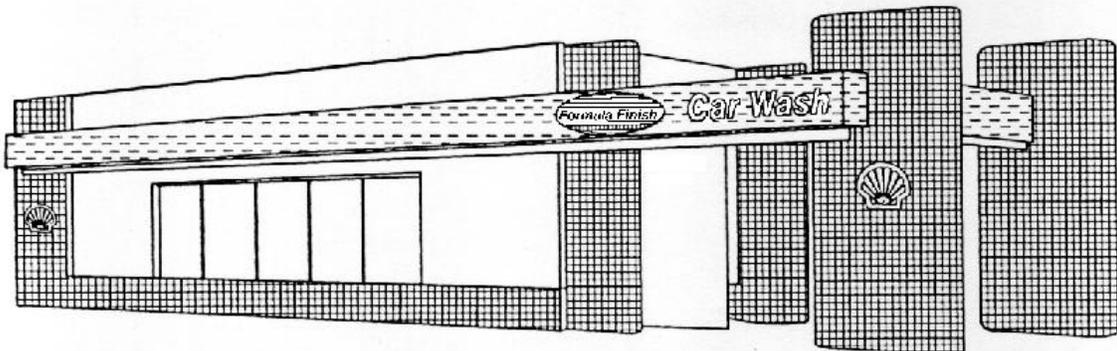
Beverlee G. Steinberg for applicant.

Alicia P. Collins, Trademark Examining Attorney, Law Office
115 (Tomas Vlcek, Managing Attorney).

Before Quinn, Hairston and Drost, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Shell Oil Company to
register the mark shown below



for "vehicle cleaning services."¹ Applicant has disclaimed the words "Car Wash" apart from the mark as shown.

The Trademark Examining Attorney has refused registration under Sections 1, 2, 3 and 45 of the Trademark Act on the grounds that the mark sought to be registered is not inherently distinctive and, therefore, does not function as a service mark. Registration also was refused due to applicant's failure to comply with two requirements, namely to submit a description of the proposed mark, and to claim ownership of prior registrations.

When the refusal and the requirements were made final, applicant appealed. Applicant and the Examining Attorney submitted briefs. An oral hearing was not requested.

OWNERSHIP OF PRIOR REGISTRATIONS

The Examining Attorney made final the requirement that applicant claim ownership of seven prior registrations. The Examining Attorney has explained that the requirement herein is "a basic, fundamental element" of ex parte examination, citing to Trademark Rule 2.36 and TMEP § 812.

¹ Application Serial No. 75/629,489, filed January 28, 1999, alleging first use anywhere and first use in commerce on December 1, 1997. Prior to October 30, 1999, an applicant who wanted to show color in a mark was required to use the Office's color lining system as set forth in Trademark Rule 2.52(e). The color lining system has been deleted from the rules. However, until further notice, the Office will continue to accept drawings that show color by using the color linings. TMEP § 807.09(b).

The Examining Attorney states that "[I]f ownership of prior registrations is not claimed in an application at the time of filing, the examining attorney should request that the applicant claim ownership of prior registrations (even if ownership appears obvious on the face of the registrations), if the examining attorney determines that the prior registrations would be proper reference and basis for refusal under Trademark Act Section 2(d) if not owned by the applicant." (brief, p. 9).

Applicant, in response, has asserted that "to its knowledge there is only one Shell Oil Company doing business in the world and to state a claim of ownership, in exacting wording and in no other way, to marks OBVIOUSLY issued in the name of Shell Oil Company is beyond its comprehension." (brief, p. 1)[emphasis in original].

Applicant also charged that the requirement "is almost harassing in nature." (brief, p. 2). Applicant asserted that "it is Shell Oil Company, the owner of Shell Oil Company marks," and requests that the Examining Attorney "use some form of judgment and not harass applicants for answers to questions which are obvious on their face." (brief, p. 2). Nevertheless, applicant finally claimed that it "is the one and same Shell Oil Company that is the owner of Registered marks 1,760,295; 1,716,511; 2,074,433;

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2,152,597; 2,152,598; 2,177,440; 2,290,133 and, in fact, ALL other marks registered in the United States Patent and Trademark Office in its name, Shell Oil Company." (brief, pp. 1-2)[emphasis in original].

Trademark Rule 2.36 provides that "[p]rior registrations of the same or similar marks owned by the applicant should be identified in the application." TMEP § 812 states that the rule "does not precisely define when an applicant should claim ownership of prior registration(s)" and that the Examining Attorney "may exercise discretion in invoking the rule." This section further states that "[t]he main purpose of the rule is to provide the examining attorney with information necessary for proper examination." The TMEP goes on to indicate that "[t]he information does not have to be given in any specific form."

The Examining Attorney's requirement that applicant claim ownership of the prior registrations is reasonable inasmuch as the registrations of the Pecten design and the words FORMULA FINISH are potential Section 2(d) bars to registration in the event applicant did not own them. Thus, we find that the requirement is justified, and we are surprised at applicant's obstinate responses thereto. We find, however, that applicant's ownership statement in its

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appeal brief, albeit at a late juncture, sufficiently complies with the requirement. Accordingly, the application is deemed to be amended to include a claim of ownership of the specified registrations.

In view of the above, the requirement for identification of the prior registrations owned by applicant is rendered moot.

DESCRIPTION OF THE MARK

The Examining Attorney made final a requirement to submit a concise description of the mark, citing Trademark Rule 2.35 and TMEP § 808. The Examining Attorney suggested the following description:

The mark consists of the overall design of a building where the services are rendered, including the wording FORMULA FINISH and CAR WASH and two pecten designs. The side of a rectangularly shaped building contains a large viewing window and the entrance of the building is connected to two large yellow columns. The drawing is lined for the colors yellow, gray, blue, and red. The applicant claims both the building and pecten designs including the colors yellow, gray, blue, and red as illustrated.

Applicant's response to the first Office action was entirely silent on this point. Further, no request for reconsideration was filed in response to the finality of the requirement. Remarkably, applicant, in its brief, does

not directly address this issue. The closest applicant comes to setting forth a description of the mark is in the "Facts" section of the brief wherein applicant sets forth the following:

The trade dress incorporates a distinctive fascia and decorative guideposts. The fascia consists of two towering, Shell Yellow columns at both the entrance and exit. Shell's trademarked Pecten logos are affixed to each of the towering pillars. The decorative guideposts incorporate Shell's trademarked Pectens with blue banners illustrating beads of water in the background.

At two other points in the brief, applicant states that the mark sought to be registered is "inherently distinctive with its towering, bright Shell Yellow, rectangular columns positioned at both at the entrance and exits, Shell Red and Shell Yellow Pectens affixed to the four columns, and royal blue decorative guide posts with water beads in the background" and that the "design has a fascia made of towering, Shell Yellow columns positioned at the entrance and exit, decorative guideposts, and a long viewing window." (brief, pp. 3-4).

Trademark Rule 2.37 provides the following:

A description of the mark, which must be acceptable to the Examiner of Trademarks, may be included in the application, and must be included if

required by the examiner. If the mark is displayed in color or a color combination, the colors should be described in the application.

TMEP § 808.01 states that the Examining Attorney should require a description of the mark if, among other things, a significant element of a mark is unclear or ambiguous, the mark is three-dimensional, or a configuration of the goods or packaging, or the mark includes color. TMEP § 808.02 indicates that "the description should state accurately what the mark comprises and should not create a misleading impression by either positive statement or omission." This section also states that a "description cannot be used to restrict the likely public perception of a mark" and that a "mark's meaning is based on the impression actually created by the mark in the minds of consumers, not on the impression that the applicant states the mark is intended to convey." Lastly, the section provides that the description of the mark "should be concise."

We find that the requirement for an accurate description of the mark is justified. Given the nature of the mark, it is important that the composition of the mark be set forth in clear terms so that substantive matters involving the mark, as for example, whether the mark is inherently distinctive, can be handled in a proper fashion.

In the present case, in the absence of an accurate and concise description of the specific mark applicant seeks to register, we are simply unable to render a meaningful decision on the substantive issue in the case.

The validity of the requirement of an accurate description and the importance of such description in assessing inherent distinctiveness in this case is highlighted by the discrepancy between the drawing and the description proffered by applicant in its brief and cited above. In this connection, it should be noted that "[t]he decorative guideposts incorporat[ing] Shell's trademarked Pectens with blue banners illustrating beads of water in the background" do not even appear in the drawing of the mark sought to be registered. To incorporate this additional matter into the present drawing clearly would constitute a material alteration of the mark. See: *In re Thrifty, Inc.*, 274 F.3d 1349, 61 USPQ2d 1121 (Fed. Cir. 2001).

In view of the above, the requirement for an accurate description of the mark is affirmed.

INHERENT DISTINCTIVENESS

The Examining Attorney maintains that the mark sought to be registered is not inherently distinctive and, thus, does not function as a service mark to identify and

distinguish applicant's vehicle cleaning services. In support of the refusal, the Examining Attorney submitted three photographs taken by her of competitors' car washes.

Applicant contends that the mark sought to be registered is inherently distinctive product packaging.²

As indicated above, we simply are unable to pass judgment on the registrability of applicant's mark in the absence of an accurate description of what exactly applicant claims to be its mark. We would be determining inherent distinctiveness based on our own speculation as to what comprises the mark, something we decline to do. See: *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989) ["Prescience is not a required characteristic of the board. Thus the board need not devine [sic] all possible afterthoughts of counsel..."].

Decision: The refusal to register is affirmed.

² In the penultimate paragraph of its brief, applicant states, for the first time, that "[a]lternatively, the [proposed mark] possesses secondary distinctiveness." Suffice it to say that, to the extent that applicant has attempted to interject acquired distinctiveness into the case, the alternative claim is untimely.