

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: June 6, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re MerchSource, LLC

Serial No. 77713799
Filed April 14, 2009

Jennifer H. Hamilton, Connie P. Limperis, and Anna M.
Vradenburgh of The Eclipse Group LLP for MerchSource, LLC.

Colleen Kearney, Trademark Examining Attorney, Law Office
113 (Odette Bonnet, Managing Attorney).

Before Bucher, Zervas, and Wolfson, Administrative
Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

MerchSource, LLC has filed an application for the
standard character mark THE BLACK SERIES for "Electric
massage appliances, namely, hand-held massagers, massage
mechanism for chairs, and foot spa massagers" in
International Class 10, on the basis of applicant's bona
fide intent to use the mark in commerce. The Trademark
Examining Attorney refused registration of applicant's mark
under the provisions of Section 2(e)(1) of the Trademark

Act, 15 U.S.C. § 1052(e)(1), on the ground that "applicant's massage devices feature the color BLACK and therefore the term is descriptive of the goods."¹ When the refusal was made final, applicant appealed. In the alternative, applicant has requested that the mark THE BLACK SERIES be allowed on the Supplemental Register "if on appeal the Board determines that either the term BLACK SERIES or THE BLACK SERIES is merely descriptive..."² The appeal has been fully briefed. We affirm.

Section 2(e)(1) of the Act, 15 U.S.C. § 1052(e)(1), prohibits the registration of a mark which is merely descriptive of the applicant's goods. A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered to be merely descriptive; rather, it is sufficient that the term

¹ *Examining Attorney's Brief*, (unnumbered) p. 4.

² *Applicant's Appeal Brief*, p. 21; see also *Applicant's Request for Reconsideration*, p. 10 (unnumbered).

describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with the goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use; that a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

To support the refusal, the Trademark Examining Attorney submitted the following evidence:

1. Copies of dictionary definitions for the terms "black" and "significant."

black: 1. Being of the color black, producing or reflecting comparatively little light and having no predominant hue.³

significant: important or noticeable⁴

³ Houghton Mifflin at <http://education.yahoo.com/reference/dictionary/entry/black>, printed on June 30, 2009.

⁴ *Cambridge Dictionaries Online* at http://dictionary.cambridge.org/dictionary/british/significant_1, printed on May 23, 2011.

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2. Copies of web pages from Amazon.com and from applicant's website showing advertisements for applicant's "The Black Series Heated Handheld Massager" and "Black Series 1628894 Massager Back Cushion," as well as illustrations demonstrating both products,⁵ purporting to show that applicant's products are of the color black.

3. Six third-party registrations in which the term "series" has been disclaimed.

Applicant argues that because its goods are not all black in color, the mark THE BLACK SERIES is not merely descriptive:

As a preliminary matter, the goods are not 'clearly black in color' as the Office claims. Although one product (a vibrating back cushion) is shown in black in two of the images, the other two images show a handheld massager that is a combination of gray and light gray colors.⁶

Applicant further argues that because the word "black" is used to designate high quality, it has a double entendre and therefore the mark is suggestive only.

In the context of applicant's goods, the term BLACK is suggestive of the quality of the goods, i.e., elegant design and premium quality. Applicant selected this mark to create an image of elegance and sophistication for its electric massage appliances.

⁵ The massager back cushions are listed in the identification of goods as "massage mechanism for chairs."

⁶ *Applicant's Brief*, p. 10.

...

Accordingly, as seen from these advertisements, consumers in the marketplace do not immediately associate color with the term BLACK, but rather, perceive the term BLACK in association with a product or services as a metaphor for upscale quality, prestige or elegance. In this context the term BLACK in the mark THE BLACK SERIES is suggestive of the qualities of luxury, elegance, distinction and style.⁷

To show that consumers recognize the word "black" as meaning high in quality, applicant submitted the following evidence:

1. Copies of several dictionary definitions of the term "black tie:"

black tie: semiformal clothing <gentlemen in *black tie* for the banquet>⁸

black tie: 1. A black bow tie worn with a tuxedo. 2. Semiformal evening wear typically for men, usually requiring a tuxedo.⁹

black tie: 1. (Clothing & Fashion) a black bow tie worn with a dinner jacket 2. (*modifier*) denoting an occasion when a dinner jacket should be worn Compare *white tie*¹⁰

2. Copies of web pages from the websites www.mercedes-amg.com, www.luxist.com, www.blackcard.com, www.beautyrestblack.com, BLACK.CO.UK, and <http://gold.chipotle.com/wrapwhatyoulove>, purporting to

⁷ *Applicant's Brief*, pp. 10-11.

⁸ *Id.*

⁹ *The American Heritage Dictionary of the English Language* (4th ed. 2009), at www.thefreedictionary.com.

¹⁰ *Collins English Dictionary - Complete and Unabridged* (2003), at www.thefreedictionary.com.

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show that the term "black" is understood to mean a level of luxury and elegance.

3. Copies of web pages from www.amazon.com, purporting to show that massagers come in all different colors, not just black.¹¹

4. Copies of six registrations for marks including the word "black," issued on the Principal Register without a disclaimer to the term "black" for goods that are of the color black.

5. Copies of the packaging used for the following goods sold by applicant under the mark THE BLACK SERIES: the handheld back massager, twelve-point foot massager, memory foam slippers, compact fabric steamer, upright fabric steamer, and table top air hockey game. The actual products have been photographed next to the packaging for all but the upright fabric steamer and the table top game, and in all cases the packaging displays a picture of the product on the box.

Applicant also submitted copies of other third-party registrations for the first time in its appeal brief. The Trademark Examining Attorney objected to this evidence as

¹¹ At www.amazon.com, advertising the following products: The Black Series Heated Handheld Massager, the Homedics PM-50 Hand Held Mini Massager, the Wahl 4196-1001 Heat Therapy Heated Therapeutic Massager, and the Wahl 4120-200 All-Body Massage Powerful Therapeutic Massager.

being untimely. These registrations, and the arguments relating thereto, have been given no consideration. See Trademark Rule 2.142(d) (the record in the application should be complete prior to the filing of an appeal); TBMP § 1208.02 (3d ed. 2011) and authorities cited in that section.

Turning to the merits of this case, we first address applicant's argument that the mark THE BLACK SERIES is not merely descriptive of a significant feature of the goods but rather "is suggestive of the qualities of luxury, elegance, distinction and style."¹² In support of this argument, applicant has submitted copies of web pages from www.mercedes-amg.com that advertise the "Mercedes SL 65 AMG Black Series" under the tag line: *The Elements of Black*. The website also advertises the "CLK 63 AMG Black Series" automobile; the ad copy includes: *the latest in our exclusive Black Series of high performance concept cars*.

Applicant has further submitted pages from the website www.luxist.com/2011/01/23/infiniti-ex-black-premium-edition/. This website defines itself as "a web site dedicated to covering the best the world has to offer on a variety of luxury and fine living topics."¹³ On the

¹² See *infra*, n. 5.

¹³ At www.luxist.com/about.

website, there is an advertisement for the "Infiniti EX Black Premium Edition" automobile. The ad copy includes the teaser *"Is black the new gold? It may very well be if credit cards (like the Visa Black card or Centurion by American Express) are anything to go by."* One reader of this page commented that he "love[s] my Black Amex."¹⁴

As has been shown, the color "black" as it relates to automobiles signifies elegance, and with credit cards a hierarchical system of service levels and exclusivity. These connotations are underscored by the fact that the goods and services are expensive to procure, in contrast to applicant's massagers, which sell at far lower price points.¹⁵

Finally, applicant submitted a copy of a page from the website www.beautyrestblack.com, wherein Simmons Bedding Company advertises the mark BEAUTYREST BLACK for a mattress touted as *The World's Finest Beautyrest™*. The advertisement reads: *"Simmons® Beautyrest Black® Collection. This Sort of Pedigree Can't be Bought. It*

¹⁴ Nothing in the web page indicates whether the Black Amex card is of the color black. Applicant has also submitted a copy of a page from the website www.blackcard.com/ that advertises the VISA Black Card as *"The World's Most Prestigious and Versatile Credit Card."* In this case, the Visa card is black in color, and therefore, the reference to "black" may refer to color only and not carry a connotation of elegance or luxury. Accordingly, this reference is of little to no probative value.

¹⁵ Applicant's back cushion is shown as selling for \$26.23 on amazon.com. Office action, November 17, 2010.

Must be Earned." There is a press release included on the website, dated February 9, 2009, and headlined "Beautyrest Black® continues to define the luxury category with new innovations."¹⁶ Again, mattresses are generally more expensive than handheld or foot massagers or back cushion massagers, and any exclusivity in this field does not carry over to applicant's goods.

Reviewing the evidence of third-party use of the term "black" in these contexts, we are not persuaded that consumers have come to recognize the word "black" as denoting an overall premium quality of merchandise. The use of the word "black" in these fields is of such limited scope that it would be overstating the impact of the concept of "black" as an indicator of premium quality. Even were the evidence sufficient to show that the use of "black" in the automobile and credit card field, and with

¹⁶ Applicant also included copies of pages from the website BLACK.CO.UK. This website appears to be directed to visitors from the U.K., and there is no evidence that anyone from the United States has visited this website. Accordingly, we have accorded this reference no probative value.

Applicant further submitted a copy of several pages from <http://gold.chipotle.com/wrapwhatyoulove/> that explains a promotion Chipotle Mexican Grill restaurant ran in April 2011, in which contestants competed for the best artistic rendition of something "wrapped in gold foil." During the promotional period, according to a display placard, the public could purchase gold gift cards. The display placard's tag line is *Gold is the New Black*, but it is speculation to say that this shows "black" means luxury or premium quality, and not just that Chipotle's gift cards used to be black and are now gold. Thus, this evidence is also of little or no probative value.

respect to a mattress, carries such connotations, these fields are entirely unrelated to massage devices.

We next turn to applicant's argument that because its goods are not all black, the mark is not merely descriptive of the color of the goods. Reviewing the copies of the packaging, we agree that only the massager back cushion appears to be entirely in black;¹⁷ the handheld massagers appear to be shades of light and dark gray, and the foot massager appears to be silver and gray.¹⁸ It is, however, well settled that where a mark is merely descriptive of one or more items identified in the description of goods but may be suggestive or even arbitrary as applied to other items, registration is properly refused if the mark sought to be registered is descriptive of any of the goods. *In re Canron, Inc.*, 219 USPQ 820, 821 (TTAB 1983); *Electro-Coatings, Inc. Precision National Corporation*, 204 USPQ 410, 420 (TTAB 1979); *In re Brain Research Foundation*, 171 USPQ 825, 826 (TTAB 1971). *Cf. In re Right-On Co., Ltd.* 87 USPQ2d 1152, 1155 (TTAB 2008) (registration refused for all clothing items on grounds that blue-and-gold stitching

¹⁷ The specimen submitted with the application shows a remote control device for the back massager that is black. See also the exhibit to the initial Office action of April 23, 2010, which illustrates the massager back cushion.

¹⁸ See Exhibits to *Applicant's October 25, 2010 Response*.

design mark was merely ornamental and failed to function as a mark for jeans).

Applicant further argues that "although color may be an attribute of a good, it is not necessarily a 'significant' feature of that good."¹⁹ In support of its argument, applicant has submitted six third-party registrations for marks that include the word "black" for products that are black in color. Applicant has also submitted a dictionary definition of the word "significant."

We first examine the six registrations submitted by applicant to show that color is not a significant feature of the goods. These six registrations are:

Reg. No. 2857989 for the mark **BLACK DIAMOND** for "plastic combs for the professional hairdressing industry";²⁰

Reg. No. 3755442 for the mark **BLACK TIE** for "decorative display items, namely, vases, stemware and bowls; decorative display items of crystal, namely, vases, stemware, bowls and figurines; glassware, namely, beverageware, bowls and stemware; glassware of crystal, namely, beverageware, bowls and stemware; figures, figurines, sculptures, statues, statuettes, kitchen containers and drinking glasses, all of crystal";²¹

Reg. No. 3610879 **BLACK GRANITE** for "camping cookware, namely, pots, pans, kettles, plates,

¹⁹ *Request for Reconsideration*, p. 5 (unnumbered).

²⁰ Registered June 29, 2004; Section 8 accepted.

²¹ Registered March 2, 2010.

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mugs, serving sets, namely, servingware for serving food, coffee pots, mess kits, namely, mess tins";²²

Reg. No. 3695503 **BLACK WIDOW** for "golf cleat brushes";²³

Reg. No. 2968269 **BLACK LETTER LINES** for "beverageware";²⁴ and

Reg. No. 3023344 for the mark **BLACK MAGIC** for "automobile cleaners, waxes and polishes, namely car washes, namely detergents for automobiles, automobile waxes, automobile waxes in liquid and paste forms, tire cleaners, automobile interior polishes and cleaners for leather upholstery and automobile polishes for engines; accessory products for cleaning, treating, waxing and polishing vehicles namely, sponges, buckets, wheel brushes, and cleaning and polishing cloths."²⁵

None of the registrations include a disclaimer to the word "black," but the specimens of use (photocopies of which have been included with the registrations) for these marks show that the goods are black in color. However, these marks each have a unique, nondescriptive meaning as a whole. Although the Trademark Examining Attorney failed to attach any dictionary entries to his June 7, 2011, denial of applicant's request for reconsideration, we can take judicial notice of dictionary definitions, and do so based on our own research. See *University of Notre Dame du Lac*

²² Registered April 28, 2009.

²³ Registered October 13, 2009.

²⁴ Registered July 12, 2005; Section 8 accepted and section 15 acknowledged.

²⁵ Registered December 6, 2005; Section 8 and 15 received.

v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

In this connection, we first note the dictionary definitions of "black tie" above, and take notice of the following definitions of "black diamond," "black widow," "black letter," "black magic," and "black granite":

black diamond: dense black hematite²⁶

black widow: a venomous New World spider²⁷

black letter: a heavy angular condensed typeface used especially by the earliest European printers and based on handwriting used chiefly in the 13th to 15th centuries; also : this style of handwriting²⁸

black magic: a type of magic in which people communicate with evil spirits and use evil powers²⁹

black granite: a diabase, diorite, gabbro, or other rock that is dark gray to black when polished, and which is used as a commercial 'granite.'³⁰

We agree with the Trademark Examining Attorney that these terms are arbitrary in relation to the goods, despite the fact that the goods involved may be black. When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on the question of whether the combination of terms evokes a new and unique

²⁶ From *Merriam-Webster.com*.

²⁷ *Id.*

²⁸ *Id.*

²⁹ From MacMillan Dictionary at www.macmillandictionary.com.

³⁰ *Lapidus, Dictionary of Geology and Geophysics* 1987.

commercial impression. If the combination creates a suggestive term, the fact that one or both of the components of the mark may be merely descriptive does not make the mark as a whole merely descriptive. See, e.g., *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (when combined and used on bakery goods SUGAR & SPICE is not merely descriptive); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE is not merely descriptive of a snow removal hand tool); and TMEP Section 1209.03(d) (8th ed. 2011).

Each set of two words has a meaning as a compound phrase wherein the word "black" has taken on a significance that transcends its meaning as a designator of color. The pair of words forms a unitary term that identifies a specific object. Even "black diamond" and "black granite" refer to specific types of diamond or granite that have unusual properties. A "black widow" spider is a type of arachnid; "black magic" signifies witchcraft.³¹ Thus, these registrations are not analogous to the case at hand. In the mark THE BLACK SERIES, the word "black" retains its primary meaning of "the color black."

³¹ See TMEP 1213.05 "Unitary" Marks (8th ed. 2010) (citing "black magic" as an unitary term with a distinct meaning of its own as a whole).

We next consider the dictionary definition of the word "significant" that applicant has submitted. Applicant argues that the color black is not a significant feature of the goods. The definition is:

significant: 1. having meaning; *especially* : suggestive <a significant glance> **2a** : having or likely to have influence or effect : important <a *significant* piece of legislation>; also : of a noticeably or measurable large amount <a *significant* number of layoffs> <producing *significant* profits> **b**: probably caused by something other than mere chance <statistically *significant* correlation between vitamin deficiency and disease>³²

We note that one of the meanings of "significant" is "having meaning" and another is "important." The fact that applicant's back massager is all black is likely to have meaning to consumers, as the fact that black is a neutral color that matches any other color is important, and may influence the purchasing decision of customers looking to purchase compatible color combinations.³³ Cf. *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir.1994) (use of color black on outboard motors considered functional in part because black is compatible with a wide variety of other colors).

We next turn our attention to the word "series" in the mark. Applicant claims that "series" is not descriptive,

³² Merriam-Webster (2011), www.merriam-webster.com/dictionary/.

³³ The evidence shows that the back massager is not a stand-alone item, but attaches to a chair for support.

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relying on a printout from the website www.bmwusa.com that refers to cars sold by BMW North America as a "BMW 5 Series," and the following dictionary definition:

series: **1a:** a number of things or events of the same class coming one after another in spatial or temporal succession <a concert *series*> <the hall opened into a *series* of small rooms> **b:** a set of regularly presented television programs each of which is complete in itself ... **3b:** a group of postage stamps in different denominations ... **6:** a group of chemical compounds related in composition and structure³⁴

Applicant contends that the above shows that the term "series" is commonly understood to mean a group of things coming in spatial or temporal succession one after another, and not merely a grouping of items, such as the three massage devices identified in its application. However, the word "series" also refers to a group, as shown by definition numbers 3b and 6. Moreover, the Trademark Examining Attorney has submitted the following registrations that tend to show that the Office requires a disclaimer to the word "series" in connection with massage therapy services and related goods:

Reg. No. 3776618 for the mark SOULSTICE SEMINAR SERIES for "training manuals for peri-operative massage therapy," "seminar series" disclaimed;³⁵

³⁴ Id.

³⁵ Registered April 20, 2010.

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Reg. No. 3556369 for the mark FETISH FANTASY SERIES for a variety of goods, including "massage apparatus," "fetish" and "series" disclaimed;³⁶

Four registrations owned by the same company for the marks EARTH SERIES (Reg. No. 3965168), METAL SERIES (Reg. No. 3965169), WOOD SERIES (Reg. No. 3965170), and FIRE SERIES (Reg. No. 3965171)³⁷ for, *inter alia*, "education services, namely, providing workshops in the fields of yoga, fitness, health, and massage therapy," "series" disclaimed.

This evidence supports the Trademark Examining Attorney's position that the word "series" in the mark is merely descriptive of applicant's electric massage appliances. Moreover, the word "series" retains its merely descriptive significance in relation to the goods when combined with the remainder of the mark THE BLACK SERIES, and the composite is itself merely descriptive. *See, e.g., In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002) (SMARTTOWER merely descriptive of commercial and industrial cooling towers); and *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely

³⁶ Registered January 6, 2009.

³⁷ All four marks were registered May 24, 2011.

descriptive of computer programs for use in development and deployment of application programs).

For the foregoing reasons, the mark THE BLACK SERIES is merely descriptive of a group of massagers that are black in color. Inasmuch as applicant's identification of goods implicitly includes goods that are all black in color, and the composite mark does not create a unique, nondescriptive meaning, the mark THE BLACK SERIES is merely descriptive under Section 2(e)(1) of the Trademark Act.

Decision: The refusal to register the mark THE BLACK SERIES under Section 2(e)(1) is affirmed.

In view of applicant's amendment of this application to the Supplemental Register, contingent upon our decision that the mark is merely descriptive, applicant's amendment to the Supplemental Register is approved and the mark will register on the Supplemental Register in due course.