

Test for descriptiveness clarified in *URBANHOUSING Case*

United States - **Silverberg Goldman & Bikoff**

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Examination/opposition
National procedures

In *In re Carlson* (Case 78752616, June 9 2009), in a precedential opinion, the [Trademark Trial and Appeal Board](#) (TTAB) has affirmed a decision of the US [Patent and Trademark Office](#) (USPTO) in which the latter had refused to register the mark URBANHOUSING in standard character format for “real estate brokerage, real estate consultation and real estate listing” services under Section 2(e)(1) of the [Lanham Act](#).

Before the TTAB, the applicant argued that:

- the mark is a composite mark with the letter 'Z' substituted for the letter 'S' and, as such, the commercial impression of the mark in its entirety is inherently distinctive; and
- the suffix 'zing' means "enthusiasm" or "speed or vitality; zip", and thus creates a double entendre suggesting that the applicant's real estate brokerage services are provided with speed and enthusiasm.

Not surprisingly, the TTAB found that:

- despite the compression of the words 'urban' and 'housing' into a single term, “consumers would recognize the mark as consisting of the separate elements”;
- the mere misspelling of the descriptive word 'housing' was insufficient to turn the term 'urbanhousing' into an inherently distinctive mark because there was virtually no distinction with respect to visual impression, meaning or phonetic identity; and
- the 'Z' in the mark did not project the impression of the separate word 'zing' because it was not emphasized and would be perceived as only a misspelling of the descriptive word 'housing'.

The TTAB cited *In re Bayer Akiengesellschaft*, in which the US Court of Appeals for the Federal Circuit had affirmed the TTAB's finding that ASPIRINA and the merely descriptive word 'aspirin' were sufficiently close in appearance, sound and meaning that the mere addition of the letter 'A' was insufficient. The TTAB also reiterated that a double entendre must be readily apparent from the mark itself rather than the applicant's specimens of use.

The noteworthiness of this appeal derives from the applicant's reliance on, and the TTAB's treatment of, the three descriptiveness tests discussed in *No Nonsense Fashions Inc v Consolidated Food Corp*.

According to *McCarthy on Trademarks and Unfair Competition* (Sections 11(66) to 11(70) (Fourth Edition 2009)), in *No Nonsense Fashions* the TTAB adopted a three-part test for descriptiveness that considers competitors' need, competitors' use and the degree of imagination. In the present case, the applicant argued that:

- “[c]ompetitors simply need not use URBANHOUSING to describe their projects when they are free to use URBAN HOUSING”;
- “evidence of record is completely devoid of [...] competitors in the real estate brokerage

services industry using URBANHOUSING or even HOUSING as a descriptive reference”;
and

- “as neither URBAN nor HOUSING obviously conveys meaning of either enthusiasm or speed, imagination is required of the consumer to intuit the specific attributes of the applicants’ services”.

However, the TTAB clarified that the *No Nonsense Fashion* tests were set out in an *inter partes* case concerning whether use of a term by third parties on their packaging detracted from the plaintiff’s trademark. The TTAB thus held that “to the extent that the applicant is suggesting that the [USPTO] must prove all three points, the applicant is incorrect”.

The TTAB concluded that:

“[s]ince [No Nonsense Fashions] issued in 1985, there have been numerous decisions from the Court of Appeals for the Federal Circuit and the [TTAB] making clear that the test for descriptiveness is whether a term ‘immediately conveys knowledge of a quality, feature, function or characteristic of the goods or services with which it is used’”.

This ruling should help quell any actual confusion over the *No Nonsense Fashions* tests for descriptiveness.

James L Bikoff, Silverberg Goldman & Bikoff, Washington DC, with the assistance of Phillip V Marano

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