



September 4, 2012

Federal Circuit Clarifies What is “Merely Descriptive” for Trademark Purposes

Intellectual Property Client Alert

This Alert provides only general information and should not be relied upon as legal advice. This Alert may be considered attorney advertising under court and bar rules in certain jurisdictions.

For more information, contact your Patton Boggs LLP attorney or the authors listed below.

Scott A. Chambers, Ph.D.
schambers@pattonboggs.com

Matthew J. Laskoski
mlaskoski@pattonboggs.com

WWW.PATTONBOGGS.COM

The Federal Circuit, in *DuoProSS Meditech Corp. v. Inviro Medical Devices Ltd.*, recently ruled that a trademark’s validity must be assessed by taking into account the impression of the mark as a whole.

In this case, Inviro petitioned to cancel a Duopross application for a design mark used with a safety syringe. Duopross counterclaimed for cancellation of several Inviro trademark registrations. The Trademark Trial and Appeal Board canceled three Inviro registrations, but found that registrations for “SNAP!” and “SNAP SIMPLY SAFER” were not merely descriptive of the underlying snap-off safety syringes.

On appeal to the Federal Circuit, the decision of the Trademark Trial and Appeal Board was overturned, with the Federal Circuit ruling that both remaining marks were merely descriptive. For the “SNAP!” mark, the Federal Circuit held that the Trademark Trial and Appeal Board should have looked at the mark as a whole and not separated the word “snap” from the exclamation point. Imparting the distinctiveness of the exclamation mark to the word “snap” was not proper. For the “SNAP SIMPLY SAFER” mark, the Federal Circuit held that there was a lack of evidence that the alliteration was enough to consider the mark more than merely descriptive. The Federal Circuit held there was not sufficient evidence to show that the marks were more than merely descriptive of the action of snapping off of the safety syringes.

In particular, the Federal Circuit stated, “The board should have considered whether the entire mark, composed of the exclamation point and the descriptive word ‘snap,’ conveys a commercial impression that is merely descriptive to a consumer. ... The board failed to do so.”

With this recent clarification of what the Federal Circuit considers merely descriptive, trademark applicants, trademark owners and anyone in the process of creating a new trademark should consider whether the mark could be considered merely descriptive and what evidence could be presented to overcome this presumption. For existing marks that are considered merely descriptive by the Trademark Office, it is possible to present evidence that the merely descriptive mark has acquired distinctiveness and obtain a trademark registration through submission of evidence.

A copy of the decision can be found [here](#).

This Alert provides only general information and should not be relied upon as legal advice. This Alert may also be considered attorney advertising under court and bar rules in certain jurisdictions.