

SEARS WINS FIGHT AGAINST TRADEMARK DISCLAIMER REQUIREMENT

In re Sears Brands, LLC Decided: December 20, 2010

In *In re Sears Brands, LLC*. (App. Ser. No. 77/558,337 (TTAB Dec. 20, 2010)), the Applicant filed an application to register the service mark SEARS BLUE SERVICE CREW, in standard character form. The Applicant identified the services as "retail department store services; retail store services featuring appliances, electronics, lawn and garden equipment" in Class 35. The U.S. Patent and Trademark Office (USPTO) Trademark Examining Attorney issued a final requirement for disclaimer of the term "Service Crew" as being merely descriptive of the Applicant's services. The Trademark Examining Attorney relied upon websites for different consumer products which referred to service crews. For example, the Harley-Davidson website used the term to identify the employees who repair and maintain motorcycles.

The Applicant challenged the requirement on two basic grounds. First, the Applicant argued that "Service Crew" is not descriptive of the particular services identified in the application. Second, the Applicant argued that the term "Blue Service Crew" is unitary, and therefore cannot be dissected.

The USPTO Trademark Trial and Appeal Board (Board) agreed with both of the Applicant's arguments. With respect to the non-descriptiveness argument, the Board noted that "[w]hether a particular term is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork" (citing *In re Abcor Development Corp.*, 200 USPQ 215 (CCPA 1978) and *In re Remacle*, 66 USPQ2d 1222 (TTAB 2002)). The Board also noted that incongruity is a strong indication that the mark is suggestive rather than merely descriptive.

The Board found that the term "Service Crew" was incongruous because the term calls to mind services other than the identified retail department store services. As shown by the Examiner's own evidence, the term "Service Crew" is generally used in connection with installation or repair services. In contrast, personnel who provide retail sales services are commonly referred to as "sales staff" or "sales team." Thus, a consumer would experience a momentary confusion because the actual services would not correspond to the expected services.

With respect to the Applicant's second argument, the Board found the term "Blue Service Crew" to be unitary. The Board (relying upon *In re Magic Muffler Service*, 184 USPQ 125 (TTAB 1974)) reviewed specimens of use in order to determine how the average purchaser would encounter the mark. In the specimens, the terms "Blue" and "Crew" were quite large as compared to the term "Service." The Board noted that the term "Service Crew" was not separated from the rest of the wording. The Board also noted that the terms "Blue" and "Crew" rhymed, which further tied these terms together.

Thus, the Board reversed the USPTO Examining Attorney and found the requirement of disclaimer of the term "Service Crew" unnecessary.