

On My Mind Blog

Differentiating Merely Descriptive Marks from Suggestive and Unitary Marks

08.01.2024 By [William M. Borchard](#)



Is WHOLESALHOME merely descriptive of a “cloth for wiping or dusting” sold at wholesale through the internet, or is it registrable with a meaning distinct from its elements?

Is the word DAILY a merely descriptive component of the service mark DAILY MIND for “mental health services” offered with a daily frequency, or is DAILY MIND a registrable unitary mark with a meaning distinct from its elements?

The decision that WHOLESALHOME is not a registrable unitary mark may be compared to the decision that DAILY MIND is a registrable unitary mark. These decisions by different panels of Trademark Administrative Judges were issued one day apart.

Background

A “merely descriptive” term immediately conveys information concerning a feature, quality, or characteristic of the goods or services for which registration is sought. It is unregistrable in the U.S. unless it acquires distinctiveness as a source designation. When such a term is a component of a composite mark for which registration is sought, registration may be refused unless the applicant disclaims the exclusive right to use that component apart from the mark as a whole.

In contrast, a “suggestive” term requires imagination, thought, or perception to arrive at a conclusion as to the nature, qualities or characteristic of the goods or services. It is registrable without needing acquired distinctiveness, and no disclaimer is required.

A “unitary” mark that has a distinct nondescriptive meaning of its own independent of the merely descriptive meaning of its constituent elements is registrable and no disclaimer is required. On the other hand, if a unitary mark does not have a distinctive nondescriptive meaning of its own but retains the meaning of its merely descriptive elements, it is not registrable without acquired distinctiveness.

WHOLESALEHOME Case

Ababoo LLC filed a use-based application to register WHOLESALHOME for “cloth for wiping or dusting.” The Trademark Examining Attorney refused registration on the ground that this mark was merely descriptive of the wholesale means through which the goods are sold.

The Applicant appealed to the Trademark Trial and Appeal Board (TTAB), which affirmed the refusal to register the mark WHOLESALHOME.

The Examining Attorney submitted evidence of third parties who sell home goods at wholesale via the internet just like Applicant does. This evidence showed that no imagination or analysis was needed for a relevant consumer to understand that WHOLESALHOME refers to a store that sells home goods at wholesale.

The TTAB found that the mark described something about the means of sale, and that the connection between the proposed mark and Applicant’s business was sufficiently direct and specific that consumers familiar with the goods would be likely to understand that the mark describes Applicant’s store or business.

The TTAB stated that the combination of the terms WHOLESAL and HOME did not result in a unitary mark with a separate, nondescriptive meaning. Rather, each component retained its descriptive significance in relation to the goods such that the combination was descriptive. Finally, the lack of a space in the mark did not obviate the finding of descriptiveness.

Accordingly, the TTAB affirmed the refusal to register WHOLESALHOME on mere descriptiveness grounds.

[*In re Ababoo LLC, Application No. 9087452 \(T.T.A.B. July 11, 2024\).*](#)

DAILY MIND Case

SonderMind Inc [*sic*] filed an intent to use application to register DAILY MIND for “mental health services.” The Trademark Examining Attorney refused registration after the Applicant failed to comply with a requirement to disclaim the word DAILY, which the Examining Attorney viewed as a merely descriptive unregistrable component.

The Applicant appealed to the TTAB, which reversed the refusal to register the mark DAILY MIND.

The Examining Attorney and Applicant both recognized that the dictionary definition of DAILY is “occurring, made, or acted upon every day.” The Examining Attorney also pointed to six third-party uses of the term “daily therapy.” However, the Applicant argued that DAILY MIND is a unitary mark, consumers would not single out the word “DAILY” as describing the frequency of

the services, and the Examining Attorney had improperly dissected the mark into separate components.

The TTAB sided with the Applicant. It found that DAILY adjectivally modifies MIND and conveys various suggestive messages, such as “a mood that occurs every day” or “that Applicant’s services will help consumers create positive intentions they can focus on every day.” This suggestiveness was missing from the third-party uses of the phrase “daily therapy.” The TTAB held that DAILY was inseparable from the entire mark DAILY MIND, which had a distinct nondescriptive meaning independent of its elements.

Accordingly, The TTAB reversed the refusal to register DAILY MIND unless the word DAILY was disclaimed.

[In re SonderMind Inc, Application No. 97005621 \(T.T.A.B. July 12, 2024\).](#)

Author’s Note:

It can be a challenge to distinguish between an unregistrable merely descriptive term lacking acquired distinctiveness and a registrable suggestive term.

It also can be difficult to decide whether or not a composite mark has a unitary meaning different from its components.

If you are adopting a new unitary mark with merely descriptive elements, you might consult our [previous article](#) (about a case in a case in which the TTAB rejected a disclaimer requirement for the word “BARK” in the mark BIG BARK for “tree care services”). There, we listed examples of possibly registrable unitary marks having various characteristics including, among other things, a well-known or common meaning, third party uses, alliteration, suggestive significance, telescoped wording (ORDERRECORDER), hyphenation (TIRE-X), an attention-getting slogan (HAIRCOLOR SO NATURAL ONLY YOUR HAIRDRESSER KNOWS FOR SURE), verbal amalgamation (TAKE THIS MEDICINE), or a relationship indication (MANGOES FOR THE EARTH).

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Bill has handled domestic and international trademark and copyright matters at the highest level for over 60 years. He has counseled and represented clients on domestic and international trademark matters concerning clearance, registration, proper use, licensing, contested administrative proceedings and infringement claims. He became Senior Counsel in January 2024 and is now focusing on providing guidance and advice to other lawyers within our firm and writing informative and engaging articles on intellectual property law developments.