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Paper No. 10
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tomorrow International, Inc.

Serial No. 75/897,698

John Christopher of Christopher & Weisberg, P.A. for
Tomorrow International, Inc.

Rudy R. Singleton, Trademark Examining Attorney, Law Office
109 (Ron Sussman, Managing Attorney).

Before Cissel, Walters and Drost, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On January 18, 2000, applicant, a British Virgin
Islands company, filed the above-referenced application to
register the mark "THE TRACK & FIELD STORE" for "athletic
clothing," in Class 25. The basis for filing the
application was applicant's assertion that it possessed a
bona fide intention to use the mark in commerce in
connection with the identified goods.

The Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. Section 1052(e)(1), on the ground that the proposed mark merely describes the goods specified in the application. Submitted in support of the refusal to register was a dictionary definition of the term "track and field" as "athletic events performed on a running track and in the field associated with it." The Examining Attorney took the position that prospective purchasers of applicant's clothing marketed under the mark "THE TRACK & FIELD STORE" would immediately understand that the goods were intended to be used in connection with track and field events, and that the word "store" would not function as a source indicator, but rather would merely indicate "the nature of applicant's entity."

Several other informalities were also discussed in the first Office Action. The Examining Attorney required applicant to provide a more definite identification-of-goods clause, a designation of a domestic representative, and a signed declaration, in that the original application submitted had not been properly executed.

In response, applicant amended the application to identify the goods with which it intends to use the mark as follows: "athletic clothing, namely, shorts, jerseys,

jackets, swimsuits, t-shirts, tights, pants, vests, tanks, hip-pockets, and tops," in Class 25. Applicant also submitted the required signed declaration, including a power of attorney designating said attorney to prosecute the application and receive the certificate of registration.

Applicant then presented arguments that the refusal to register based on descriptiveness is not well taken. In essence, applicant argued that the mark is suggestive, rather than merely descriptive, of the goods listed in the application, as amended, because the average consumer would be "required to use a significant amount of imagination and reasoning to arrive at the nature of the goods in question..." and the goods specified in the application have multiple uses. Some of the goods, such as swimsuits, do not necessarily relate to track and field, but applicant conceded that "the only significance of the proposed mark as it relates to the goods is that the goods may be used in connection with a sport identified by the proposed mark: track and field." Applicant contended that because the goods could also be used in connection with other activities in addition to track and field, the mark "is not merely descriptive of the goods, but instead is incongruous and arbitrary as applied to the goods."

The Examining Attorney accepted the substitute declaration, but made final the refusal under Section 2(e)(1) of the Act and the requirement for a more definite identification-of-goods clause.

Submitted in support of the refusal to register were excerpts from articles retrieved from the Nexis automated database of publications. The Examining Attorney argued that this evidence shows "track and field" used to describe athletic clothing used for track and field activities. For example, the April 27, 2000 edition of the New York Post referred to "a stretchy blue track-and-field v-neck T-shirt and shorts." The June 4, 1999 edition of THE PRESS ENTERPRISE (Riverside, California), stated that "[s]ome high school track and field athletes choose the longer shorts over the traditional, shorter models." The April 16, 1999 edition of the Pittsburgh Post-Gazette noted that "[t]he usual track and field attire-- tank tops and running shorts-- will be accompanied today at the Butler Invitational by an assortment of sweatshirts, sweat pants and probably a few ear muffs to fend off the unseasonable wintry weather in the forecast." The September 3, 1994 edition of the Los Angeles Times noted that the Olympic committee of a small African country was unable to provide its athlete "with anything other than a track and field

singlet, shorts and a warm-up suit for the recent Commonwealth Games."

Although the Examining Attorney stated that "the requirement for a definite identification of goods is continued and made FINAL," he did not provide any discussion of why the amended identification-of-goods clause applicant had submitted did not satisfy this requirement. The previously made requirement for an appointment of a domestic representative was not even mentioned.

Applicant timely filed a Notice of Appeal, followed by its appeal brief.¹ The Examining Attorney then filed his brief on appeal, but applicant did not file a reply brief or request an oral hearing before the Board. Applicant did, however, file a substitute power of attorney and appointment of domestic representative, thus satisfying the requirement which had been made in the first office action, but had not been brought up since then.

We note that the Examining Attorney did not mention

¹ Included in applicant's brief was a list of trademarks which applicant contends are registered in twenty-five third-party registrations. The Examining Attorney properly objected to our consideration of this late-filed evidence because Trademark Rule 2.142(d) sets forth the procedure an applicant must follow in order to be allowed to submit evidence after the Notice of Appeal is filed, but applicant did not follow this procedure. Accordingly, the Board has not considered this evidence.

in his brief the requirement for amendment to the identification-of-goods clause in the application. We have no idea why the second Office Action specifically continued and made final this requirement, but we interpret the lack of mention of this issue in the Examining Attorney's brief as an acknowledgment that the amended language submitted by applicant satisfied the requirement made in the first Office Action.

The sole issue before us in this appeal is thus whether or not "THE TRACK & FIELD STORE" is barred from registration by Section 2(e)(1) of the Lanham Act because it is merely descriptive of "athletic clothing, namely, shorts, jerseys, jackets, swimsuits, t-shirts, tights, pants, vests, tanks, hip-pockets, and tops."

The test for determining whether a word is merely descriptive is well settled. A mark is merely descriptive under Section 2(e)(1) of the Act if it immediately and forthwith conveys information concerning a significant quality, characteristic, feature, function, purpose or use of the goods. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods in order for it to be considered to be merely

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descriptive of them; rather, is sufficient if the term describes any significant attribute or characteristic of them. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods for which registration is sought, the context in which is being used (or is intended to be used) in connection with the goods and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use. See: In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). A mark is suggestive, rather than merely descriptive, if, when the goods are encountered under the mark, a multi-stage reasoning process, or the use of imagination, thought or perception is required in order to determine what attributes of the goods the mark indicates. In re Mayer-Beaton Corp., 223 USPQ 1347 (TTAB 1984).

When the facts presented by the instant application are considered in view of these legal principles, we find that "THE TRACK & FIELD STORE" is merely descriptive of the clothing products specified in the amended application. The materials submitted by the Examining Attorney in support of the refusal to register establish that the proposed mark is a combination of merely descriptive terms

that together describe features or attributes of the goods in connection with which applicant intends to use it.

The dictionary definition of "track and field" and the excerpted articles show that the term "track and field" is used to describe athletic clothing products worn during track and field competitions. As noted above, applicant concedes that some of the specific items of apparel listed in the application can be worn when competing in track and field events. "TRACK & FIELD" is thus descriptive of these goods because it identifies the purpose or intended use of them. That all of the listed goods are not necessarily used for this purpose and that many of them are suitable for other uses in addition to track and field competition is not determinative of the registrability of this term for these goods. It is sufficient if the proposed mark is descriptive of a purpose or intended use of any of them. Moreover, one does not have to be able to speculate or guess correctly what the goods are by considering the mark by itself. As noted above, the question is whether, when the mark is considered in connection with the goods, the mark conveys information about their characteristics, purposes or the uses to which they may be put.

Applicant does not contend that the word "THE" adds source-identifying significance to this combination of

terms, but applicant provides an elaborate argument that the word "STORE" is an arbitrary term which serves as a source identifier and somehow makes the combination of these descriptive words suggestive in connection with the specified products.

We cannot adopt applicant's conclusion. The Examining Attorney provided with his brief a dictionary definition of the term "store" as "a place where merchandise is offered for sale; a shop." The Board may take judicial notice of this definition. Given that "STORE" has this meaning, we agree with the Examining Attorney that prospective purchasers of clothing who encounter the term as part of the mark applicant seeks to register would understand it to indicate the physical place from which applicant's goods emanate. They would understand the combined term "THE TRACK & FIELD STORE," if it were used as a mark on the clothing items specified in the amended application, to be an indication that the goods are provided by a store offering track and field products.

Contrary to applicant's argument, they would not consider the term "STORE" as an arbitrary source indicator. In *In re Martin's Famous Pastry Shoppe, Inc.*, 221 USPQ 364 (TTAB 1984); *aff'd on other grounds*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984), the Board, in affirming the

Examining Attorney's requirement for a disclaimer of "PASTRY SHOPPE," found (at p. 367) that the term "conveys a clear and immediate impression of the character of applicant's baked goods as products likely to emanate from a pastry shop." In the case at hand, the term "STORE" functions in a similar sense, i.e., it immediately and forthwith indicates that the products on which it is used emanate from a store. Applicant's attempt to distinguish the Martin's Pastry Shoppe case is not well taken. Applicant misconstrues the Board's discussion regarding source distinction as relating to the issue of descriptiveness, when in fact it was presented in the context of determining whether confusion was likely. The Board found the word "SHOPPE" to be merely descriptive of the goods.

In summary, the mark applicant seeks to register is unregistrable under Section 2(e)(1) the Lanham Act because if it were used in connection with the apparel items listed in the application, it would immediately convey significant information about them, namely, that they are track and field clothing which comes from a store.

DECISION: The refusal to register is affirmed.