

THIS DISPOSTION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB      JULY 18, 2000

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**Trademark Trial and Appeal Board**

---

In re **North South Publications, LLC**

---

Serial No. 75/447,252

---

**Carolyn J. Fairless** of Otten, Johnson, Robinson, Neff &  
Ragonetti, P.C. for North South Publications, LLC.

Irene D. Williams, Trademark Examining Attorney, Law Office  
**112** (Janice O'Lear, Managing Attorney).

---

Before **Cissel**, Hanak and Hohein, Administrative Trademark  
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On March 9, 1998, applicant applied to register the  
mark "ROCK & ICE" on the Principal Register for what were  
subsequently identified by amendment as "paper goods and  
printed matter, namely magazines about climbing," in Class  
16. The basis for filing the application was applicant's  
claim of use in interstate commerce since March 1, 1984.  
Copies of the February, 1998 issue of the magazine bearing  
the mark were submitted as specimens.

The Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act on the ground that the mark is merely descriptive of applicant's magazines.

In addition to resolving some of the informalities raised by the Examining Attorney in the first Office Action, applicant responded to the refusal to register with argument that its mark is at most suggestive, and hence it is registrable on the Principal Register without a claim of distinctiveness under Section 2(f) of the Act.

The Examining Attorney was not persuaded by applicant's arguments, and made the refusal to register based on descriptiveness final in the second Office Action. Attached to the final refusal to register were copies of excerpts from articles retrieved from the Nexis® database of periodical publications. The articles do not show the term sought to be registered, but they do show that ice climbing and rock climbing are popular outdoor activities in the mountains.

Applicant filed a Notice of Appeal from the final refusal to register. Applicant then filed a brief on appeal, the Examining Attorney filed her brief, and applicant filed a reply brief, but applicant did not request an oral hearing before the Board. We have

accordingly resolved this appeal based upon the written record and arguments before us.

After careful consideration of the issue on appeal in light of these materials, the statute and legal precedent with the respect to mere descriptiveness under the Lanham Act, we hold that the refusal to register is improper in this case because the term sought to be registered is suggestive, rather than descriptive, of the goods set forth in the application.

The test for descriptiveness under the Act is well settled. A term is merely descriptive within the meaning of the Lanham Act if it immediately and forthwith conveys information about a significant characteristic or feature of the goods in connection with which it is used. In re MetPath Inc., 223 USPQ 88(TTAB 1984); In re Bright-Crest, Ltd., 204 USPQ 591(TTAB 1979). It is the position of the Examining Attorney that the excerpts retrieved from the Nexis® database show that "Rock and Ice is [sic] part of the subject matter of the applicant's magazine..." (First Office Action), and that, as such, the mark "ROCK & ICE" is merely descriptive of applicant's magazine because the words identify the subject matter of the magazine. In her second and final Office Action, she refines this explanation further by stating that "rock and ice are an

(sic) ingredient, or feature of rock and ice climbing, the subject matter of the magazine."

That statement from the final refusal to register highlights the problem with the Examining Attorney's analysis of this application. In accordance with the test for descriptiveness noted above, if the subject matter of the magazine were rock and ice, the mark applicant seeks to register, "ROCK AND ICE," would be merely descriptive of the magazine, and hence unregistrable the Principal Register in the absence of evidence of acquired distinctiveness under Section 2(f) of the Act. It is abundantly clear from the application and specimens of use submitted with it, however, that rock and ice are not the subjects of applicant's magazine. As the Examining Attorney stated in her final refusal, rock and ice climbing is the subject of the magazine. Rock and ice are the surfaces on which such climbing is done, but rocks and ice are not themselves subjects of the magazine; rather, climbing is.

If a mark does not immediately and directly convey descriptive information about the product in connection with which it is used, but instead, some sort of reasoning, imagination or further thought is required in order to understand the relationship between the mark and the goods

in question, then the mark is said to be suggestive, rather than merely descriptive, of the goods. In re Tennis in the Round Inc., 199 USPQ 496(TTAB 1978).

This is clearly the situation in the instant case. Because rock and ice are two of the kinds of surfaces on which the sport of climbing is conducted, rather than the subjects of applicant's magazine, which is climbing, the mark "ROCK AND ICE" is not merely descriptive of the goods.

The line of demarcation between a suggestive term and one which is merely descriptive has been described as a thin one, and a consequence of this fact is that decisions on this issue are frequently somewhat subjective in nature. As triers of fact, however, we must attempt to determine the impact of the mark sought to be registered on the purchasing public. In re Quick-Print Copy Shop, Inc., 203 USPQ 624 (TTAB 1979), aff'd, 205 USPQ 505 (CCPA 1980). In the case at hand, doing this has lead us to conclude that applicant's mark is suggestive, rather than merely descriptive, of applicant's magazine.

Ser No. 75/447,252

Accordingly, the refusal to register under Section 2(e)(1) of the Act is improper and must be reversed.

R. F. Cissel

E. W. Hanak

G. D. Hohein  
Administrative Trademark Judges  
Trademark Trial and Appeal Board

Ser No. 75/447,252