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Hearing: February 16, 2006

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Davis

Serial No. 75690413

Michael R. Friscia of McCarter & English for Robert Kent Davis.

Katherine Stoides, Trademark Examining Attorney, Law Office 101 (Ronald R. Sussman, Managing Attorney).

Before Hohein, Hairston and Walters, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Robert Kent Davis has filed an application to register on the Principal Register the mark ROBOT GLADIATORS in standard character form for "entertainment services, namely, the production of demonstrations and shows featuring fights between human and robot performers rendered live and through the

media (sic) of television," in International Class 41.[1] The application includes a disclaimer of ROBOT apart from the mark as a whole.

The examining attorney has issued a final refusal to register, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive when used in connection with his services.

Applicant has appealed. Both applicant and the examining attorney have filed briefs, and an oral hearing was held.

Before beginning our consideration of the issue of descriptiveness, we note that one of applicant's main arguments is that this refusal is procedurally inappropriate. Prior to publication for opposition, the examining attorney issued and then withdrew a refusal to register on the ground that the mark is merely descriptive. Following publication and issuance of a notice of allowance, applicant submitted his statement of use and a specimen of use. During the subsequent examination, the examining attorney issued a refusal to register on the ground that the mark is

[1] Serial No. 75690413, filed May 20, 1999, based on an allegation of a bona fide intention to use the mark in commerce. A statement of use was filed on August 4, 2004, alleging a date of first use as of October 14, 1999, and use in commerce as of October 20, 2003.

merely descriptive. This refusal was made final and it is the subject of this appeal. In regard to the refusal to register based on the ground of descriptiveness, applicant argues there was no change of circumstances between the time of the initial examination and the examination that occurred after applicant filed his statement of use. The *Trademark Manual of Examining Procedure (TMEP)* addresses the question of whether an examining attorney may raise a new ground of refusal when examining the statement of use. "The examining attorney may not issue a refusal under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), unless the refusal is dictated by changed circumstances from the time of initial examination, or the failure to issue such a refusal would be a clear error." *TMEP* § 1109.08. Applicant disputes whether there was a change of circumstances between the time of the initial examination and the examining attorney's Office action after the statement of use was filed. If an applicant is dissatisfied with the procedural actions concerning an examining attorney's refusal, he can seek relief by way of a petition to the Director. 37 CFR § 2.146(a)(3); and *TMEP* § 1201.05. However, "[o]n appeal, the Trademark Trial and Appeal Board will review only the correctness of the underlying

substantive refusal of registration." *TMEP* § 1109.08. Accord *In re Sambado & Sons Inc.*, 45 USPQ2d 1312, 1314 (TTAB 1997) (expanded panel) ("Board's determination on appeal is to be limited to the correctness of the underlying substantive refusal to register"). Therefore, we will only consider the merits of the examining attorney's refusal and not whether the examining attorney properly applied the standard for raising a refusal after the filing of a statement of use.

Turning, therefore, to the issue before us on appeal, the examining attorney contends that "ROBOT GLADIATORS immediately identifies a feature of the applicant's services – robot fighters, or in other words 'robot gladiators' are the featured performers" (brief, unnumbered p. 3); and that the term GLADIATORS is not incongruous in connection with performances featuring fighting. The examining attorney submitted definitions from *The American Heritage Dictionary of the English Language* (3rd ed. 1992) of the terms "robot" and "gladiator" as noted, in pertinent part, below:

> Robot: 1. A mechanical device that sometimes resembles a human being and is capable of performing a variety of often complex human tasks on command or by being programmed in advance.

> Gladiator: 2. A person engaged in a controversy or debate, especially in public; a disputant. 3. *Sports.* A professional boxer.

We also take judicial notice of the definition of "gladiator" in *Merriam Webster's Collegiate Dictionary* (11th ed. 2003) as follows:

> 1. A person engaged in a fight to the death as public entertainment for ancient Romans. 2. A person engaging in a public fight or controversy. 3. A trained fighter, *esp.* a professional boxer.

Applicant contends that that his mark ROBOT GLADIATORS is not merely descriptive because "it is an unnatural use of the term 'gladiators' to refer to robot performers," and it does not "give a consumer an immediate impression that the services rendered thereunder relate to human and robot performers engaging in fights" (brief, p. 3).

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark is merely descriptive,

that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

In addition to the dictionary definitions herein, applicant's specimens of use consist of an excerpt from his website and a copy of a press release. The website excerpt includes the following statements:

> For the first time in history, human opponents challenge computer-controlled robots in physical combat.
>
> Main Event: One qualifying combat round.

The press release includes the following statements:

> For the first time in history, a human opponent will fight a computer-controlled robot in no-holds-barred physical combat.
>
> . . .
>
> The intimidating "Robot Fighter™" punches with the strength of a trained boxer, stands 9 feet tall and weighs 1,000 pounds. To maximize the fights intensity, the robot is also equipped with two computer-guided tentacles tipped with 600,000-volt police stun guns.
>
> . . .

> The robot wins by incapacitating the human through electric shock or physical blows or by forcing the human to retreat from the ring.

Reviewing this evidence, it is clear that the identified entertainment services involve public fights between two fighters consisting of a robot and a human. It is equally clear that the term "gladiator" merely describes the robot that is programmed, i.e., "trained," to, and engages in, the fight. There is absolutely nothing incongruous with the use of the term "gladiator" in the context of applicant's identified services.

When applied to applicant's services, the term ROBOT GLADIATORS immediately describes, without conjecture or speculation, a significant feature or function of applicant's services, namely, that applicant's publicly displayed events involve a robot that is trained, or programmed, to fight. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's services to readily perceive the merely descriptive significance of the term ROBOT GLADIATORS as it pertains to applicant's services.

Decision: The refusal under Section 2(e)(1) of the Act is affirmed.