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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Shirts Illustrated, L.L.C.

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Serial No. 75/708,751

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Alan S. Nemes and Sherry Gunn Hanlon of Blackwell Sanders  
Peper Martin for Shirts Illustrated, L.L.C.

Ann E. Sappenfield, Trademark Examining Attorney, Law  
Office 112 (Janice O'Lear, Managing Attorney).

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Before Seeherman, Quinn and Rogers, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Shirts Illustrated, L.L.C. has applied to register  
TINY TEDDY TEES on the Principal Register for "clothing not  
sold as wearing apparel, but for stuffed and plush toy  
animals and toy figures, namely, miniature shirts,  
miniature t-shirts, screen printed miniature t-shirts, and

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custom printed miniature t-shirts.<sup>1</sup> The application is based on an asserted bona fide intention to use the mark in commerce. After the Examining Attorney refused registration pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that the mark is merely descriptive of the identified goods, applicant, while maintaining that the mark is inherently distinctive, asserted, in the alternative, that the mark had acquired distinctiveness. The Examining Attorney refused to accept this claim, and the refusal of registration was made final. This appeal followed.

Applicant and the Examining Attorney filed appeal briefs; an oral hearing was not requested.

A mark is merely descriptive if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods or services with which it is used. **In re Gyulay**, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). The question of whether a particular term is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the significance that the mark is likely to have to the average purchaser as he encounters goods bearing the mark in the marketplace.

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<sup>1</sup> Application Serial No. 75/708,751, filed May 18, 1999.

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See **In re Abcor Development Corp.**, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); **In re Engineering Systems Corp.**, 2 USPQ2d 1075 (TTAB 1986).

In support of the Examining Attorney's position that TINY TEDDY TEES is merely descriptive of a feature or quality of applicant's goods, the Examining Attorney has asked us to take judicial notice of dictionary listings for the individual words in the mark, as follows:

Tiny--Extremely small; minute.  
Teddy--A teddy bear.  
Tee Shirt--Variant of T-shirt.<sup>2</sup>

The Examining Attorney has also pointed to the fact that applicant owns a registration on the Supplemental Register for TINY TEES<sup>3</sup> and one for the same mark which was registered on the Principal Register under Section 2(f), with a disclaimer of TEES.<sup>4</sup> The Examining Attorney asserts that such registrations are an acknowledgement by applicant

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<sup>2</sup> The American Heritage Dictionary of the English Language, 3d ed. © 1992. The Board may take judicial notice of dictionary definitions. **University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.**, 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

<sup>3</sup> Registration No. 1,266,680.

<sup>4</sup> Registration No. 2,554,581. This registration issued on April 2, 2002, after the appeal was filed. However, applicant advised the Examining Attorney, during the prosecution of the application, that the then-pending application had been published for opposition, and that a registration was expected to issue shortly. The registration had issued at the point that applicant filed its appeal brief, and the registration was discussed in that brief, and was also discussed by the Examining Attorney in her brief. We therefore deem the registration to be of record.

of the descriptive nature of the words TINY TEES, and of the generic nature of TEES.

Applicant does not really contend that the individual elements of its mark are not descriptive. Rather, applicant asserts that when these words are combined in the mark TINY TEDDY TEES, they create an "eye-catching and memorable" phrase which is "unfamiliar in ordinary parlance." Brief, p. 6. Applicant apparently bases this assertion on the mark's alliteration, rhyme and cadence, due to the fact that each word begins with a "T" sound and ends with an "EE" sound. Applicant relies on **In re Kraft**, 218 USPQ 571, 573 (TTAB 1983), which found that LIGHT N' LIVELY "has an alliterative lilting cadence which encourages persons encountering it to perceive it as a whole."

Applicant's reliance on Kraft is misplaced. The Board found that LIGHT N' LIVELY was a unitary mark that consumers would not break down into its individual components, as a result of which the individually descriptive word LIGHT did not have to be disclaimed. The present case, however, does not involve the question of whether any of the individual words must be disclaimed, but whether the mark as a whole is merely descriptive. We find that it is. The words TINY TEDDY TEES do not lose their

descriptive significance because of the alliteration of the "T's" and the assonance of the "EE's". Consumers will still immediately understand, upon seeing the mark in connection with the goods, that the goods are tiny T-shirts for teddy bears. Moreover, as the Examining Attorney has stated, applicant has acknowledged the descriptive nature of the phrase TINY TEES (which has a similar alliteration and assonance) by registering it, in one instance, on the Supplemental Register and, in the other, pursuant to the provisions of Section 2(f). The addition of the word TEDDY to TINY TEES, as TINY TEDDY TEES, does not change that merely descriptive significance.

This brings us to applicant's alternative claim that its mark is registrable under Section 2(f) of the Act. Although applicant's application is based on an intention to use the mark, and there is no indication that the mark is yet in use, applicant relies upon the existence of its two registrations for TINY TEES to show that TINY TEDDY TEES has acquired distinctiveness.

Trademark Rule 2.41(b) provides, *inter alia*, that, "in appropriate cases, ownership of one or more prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as *prima facie* evidence of distinctiveness." By the plain language of

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this rule, applicant's Supplemental Register registration for TINY TEES is of no benefit to show acquired distinctiveness.

In addition, neither registration is for "the same mark," as required by Rule 2.41(b). Applicant asserts that TINY TEDDY TEES and TINY TEES are "very closely related," brief, p. 7, and argues that under the holding of **In re Dial-A-Mattress Operating Corp.**, 240 F.3d 1347, 57 USPQ2d 1807 (Fed. Cir. 2001), that is sufficient to show acquired distinctiveness.

In the Dial-A-Mattress case, the Court stated, at 57 USPQ2d 1812:

A proposed mark is the "same mark" as previously-registered marks for the purpose of Trademark Rule 2.41(b) if it is the "legal equivalent" of such marks. A mark is the legal equivalent of another if it creates the same, continuing commercial impression such that the consumer would consider them both the same mark.

We do not consider TINY TEDDY TEES to be the legal equivalent of TINY TEES. TINY TEDDY TEES does not create the same commercial impression; a consumer would not consider it to be the same mark as TINY TEES. Although the word TEDDY in the mark is descriptive, it still has some commercial impact, being a third word which separates the words TINY and TEES, as opposed to the marks in the

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Dial-A-Mattress case, in which the applied-for mark 1-888-M-A-T-R-E-S-S differed from the registered mark (212) M-A-T-T-R-E-S only in the minor misspelling of "mattress" and a substitution of one area code for another, changes which would not make a difference to the overall commercial impressions of the marks.

Decision: The refusal on the basis of Section 2(e)(1) of the Act is affirmed; the rejection of the claim of acquired distinctiveness is also affirmed.