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**THIS DISPOSITION
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Paper No. 11
EWH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Paul Markowitz

Serial No. 75/793,263

Donald C. Simpson for Paul Markowitz.

Hannah Fisher, Trademark Examining Attorney, Law Office 107
(Thomas Lamone, Managing Attorney).

Before Cissel, Hanak and Hohein, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Paul Markowitz (applicant) seeks to register TACKLE-
RACK in typed drawing form for "fishing tackle boxes." The
intent-to-use application was filed on September 13, 1999.

Citing Section 2(e)(1) of the Trademark Act, the
Examining Attorney has refused registration on the basis
that applicant's mark is merely descriptive of his goods.
When the refusal to register was made final, applicant
appealed to this Board. Applicant and the Examining
Attorney filed briefs. Applicant filed a request for an
oral hearing, and subsequently withdrew such request.

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As has been stated repeatedly, "a term is merely descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods." In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) (emphasis added); Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976). Moreover, the immediate idea must be conveyed forthwith with a "degree of particularity." In re TMS Corp. of the Americas, 200 USPQ 57, 59 (TTAB 1978); In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd 90-1495 (Fed. Cir. February 13, 1991).

At page 2 of her 3 page brief, the Examining Attorney argues that applicant's mark TACKLE-RACK is merely descriptive of fishing tackle boxes because "the average purchaser is likely to understand that a tackle rack is something which holds fishing equipment, the use for which applicant's boxes are designed." There is a basic flaw in the reasoning of the Examining Attorney. The mere descriptiveness of a term is not judged in the abstract, but rather is judged in connection with the goods for which registration is sought. Abcor Development, 200 USPQ at 218. Thus, the mere descriptiveness of applicant's mark TACKLE-RACK is not judged in the abstract, but rather is judged in connection with "fishing tackle boxes."

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Obviously, fishing tackle boxes are boxes which hold fishing equipment. Indeed, the Examining Attorney attached to her brief a photocopy of a page from the Random House Compact Unabridged Dictionary showing that one definition of the word "tackle" is "equipment ... especially for fishing: fishing tackle."

In short, consumers seeing applicant's mark TACKLE-RACK would be already aware that this mark is used in connection with fishing tackle boxes. The Examining Attorney has simply failed to identify any quality or characteristic of fishing tackle boxes which applicant's mark TACKLE-RACK specifies with the required "degree of particularity."

To be clear, the Examining Attorney attached a second excerpt from the Random House Compact Unabridged Dictionary to her brief where the word "rack" is defined as "a framework of bars, wires, or pegs on which articles are arranged or deposited: a clothes rack; a luggage rack." At page 2 of her brief, the Examining Attorney then speculates that "apparently, applicant's boxes contain or are composed of such a framework on which fish hooks, lures and other small items can be placed for the sake of organization." However, the Examining Attorney presented absolutely no evidence showing that any fishing tackle box has bars,

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wires or pegs, items that would only cause fishing hooks, lures and the like to become tangled. Moreover, while this is an intent-to-use application, the Examining Attorney never requested that applicant provide product literature (if he had any) in an effort to show that applicant's fishing tackle boxes had a "framework of bars, wires or pegs."

The burden of proving that a mark is merely descriptive of the goods for which registration is sought rests with the Examining Attorney. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). In this case, the Examining Attorney has simply failed to meet this evidentiary burden. To the contrary, the very dictionary definition of the word "rack" relied upon by the Examining Attorney undercuts her contention that the mark TACKLE-RACK is merely descriptive of fishing tackle boxes.

We recognize that there is a very fine distinction between marks which are merely descriptive and marks which are simply suggestive. However, to the extent that there are doubts on whether a mark is merely descriptive or instead is simply suggestive, said doubts are resolved in favor of the applicant. In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972).

Decision: The refusal to register is reversed.

Hohein, Administrative Trademark Judge, dissenting:

I would affirm the refusal to register inasmuch as the term "TACKLE-RACK" merely describes a function or use of applicant's "fishing tackle boxes." It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of

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the manner of its use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Applying the law to the facts at hand, I fail to discern the "basic flaw in the reasoning of the Examining Attorney," as does the majority. Instead, I concur with the Examining Attorney that, based upon the relevant dictionary definitions of the words "tackle" and "rack" which are of record, "combining the descriptive terms 'tackle' and 'rack' fails to produce any incongruity or inventive meaning" for the term "TACKLE-RACK," as applied to applicant's goods, and that "[t]he average purchaser is likely to understand that a tackle rack is something which holds fishing equipment, the use for which applicant's [fishing tackle] boxes are designed." (Brief at 2.)

The majority, in particular, faults the Examining Attorney for failing "to identify any quality or characteristic of fishing tackle boxes which applicant's mark TACKLE-RACK specifies with the required 'degree of particularity,'" pointing out that "the Examining Attorney presented absolutely no evidence showing that any fishing tackle box has bars, wires or pegs, items that would only

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cause fishing hooks, lures and the like to become tangled." To the majority, the Examining Attorney has failed to meet her burden of proving that applicant's goods are literally a tackle rack because "the very dictionary definition of the word 'rack' relied upon by the Examining Attorney undercuts her contention that the mark TACKLE-RACK is merely descriptive of fishing tackle boxes." I respectfully disagree.

I see no reason on this record why fishing tackle boxes could not contain a framework of, for example, a series of short pegs from which fishing tackle, such as hooks and lures, could be hung for the sake of organization and storage. Such a tackle rack would certainly be a significant and desirable feature of a fishing tackle box and is clearly described, with particularity, by the term "TACKLE-RACK." No evidence other than the ordinary dictionary meanings of the words comprising such term is or should be necessary. Nonetheless, even assuming that for the reason expressed by the majority, such a tackle rack would be impractical due to tangling problems, it is still plausible to envision a fishing tackle box which functions as if it were a tackle rack, in which case the term "TACKLE-RACK" would still be merely descriptive of applicant's goods. For instance, instead of a framework of

bars, wires or pegs on which fishing tackle is arranged or deposited, a fishing tackle box featuring a series of beveled notches around the perimeter or in individual compartments would conveniently arrange and store fishing lures and hooks in a tangle-free manner. Such a fishing tackle box would thus function as a tackle rack in the sense of providing a framework on which fishing tackle is arranged or deposited while stored and/or transported.

Accordingly, even if applicant's goods are not literally a "tackle rack" within the meaning of the dictionary definitions of record or other definitions of the word "rack" which may properly be judicially noticed,¹ it is still the case that the term "TACKLE-RACK" conveys forthwith, without mental gymnastics or the gathering of

¹ In this regard, Webster's Third New International Dictionary (1976) at 1870 defines "rack" in pertinent part as "5 a framework, stand, or grating on or in which articles are placed (as for keeping or for display) <clothes ~> <cake ~> <bottle ~>: as : ... **b** : a series of bins or compartments into which items may be sorted <mail ~> **c** : any compartmented container for holding type cases, galleys, forms, leads, or furniture" Similarly, The American Heritage Dictionary of the English Language (4th ed. 2000) at 1441 lists such term in relevant part as connoting "**1a**. A framework or stand in or on which to hold, hang, or display various articles: a *trophy rack*; a *rack for baseball hats* ..., a *drying rack for laundry*." It is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 (TTAB 1981) at n. 7.

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further information, a significant purpose or function of applicant's fishing tackle boxes. I therefore respectfully dissent.