

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

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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 James Stanfield and Associates

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Serial No. 76657021

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Leon D. Rosen of Freilich, Hornbaker & Rosen for James  
Stanfield and Associates.

Susan R. Stiglitz, Trademark Examining Attorney, Law Office  
109 (Dan Vavonese, Managing Attorney).

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Before Seeherman, Grendel and Drost, Administrative  
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register  
of the mark DIETGEAR (in standard character form) for goods  
identified in the application, as amended, as "electronic

machine that helps control eating by indicating when a person should and should not eat," in Class 9.<sup>1</sup>

At issue in this appeal is the Trademark Examining Attorney's final refusal to register applicant's mark on the ground that it is merely descriptive of the goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1).

The appeal is fully briefed. We have carefully considered the evidence and arguments submitted by the Trademark Examining Attorney, but we are not persuaded that applicant's mark is merely descriptive of its goods. We therefore reverse the refusal to register.

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an 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). A term is deemed to be suggestive, not merely descriptive (and thus not barred from registration under Section 2(e)(1)), if it does not immediately inform

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<sup>1</sup> Serial No. 76657021, filed March 21, 2006. The application is based on applicant's asserted bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b).

the purchaser of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services, but instead conveys such information only after giving the purchaser mental pause, requiring the exercise of thought or imagination in order to determine the significance of the term as applied to the goods or services. See *In re Shutts*, 217 USPQ 363 (TTAB 1983). Any doubts as to the mere descriptiveness of a term are to be resolved in applicant's favor and in favor of publication of the mark for opposition. See *In re Grand Forest Holdings Inc.*, 78 USPQ2d 1152 (TTAB 2006); *In re Grand Metropolitan Foodservice Inc.*, 30 USPQ2d 1974 (TTAB 1994).

In its brief, applicant describes its goods [the numerical references are from applicant's patent on the device, which is of record] as:

a small specialized timer that an eater can place on a table beside his plate as he eats. After he takes a bite, he must push a push button switch 42 that turns on a red light 22. So long as the red light 22 is on as timed by the "machine," he is not supposed to take another bite. After a period of time has passed as determined by the "machine" the red light 22 goes off and a green light 20 comes on. This means that the eater can now take another bite.

(Brief at 6.) Applicant further explains: "Presumably they [eaters] will eat less if they slow down." (Brief at 7.)

In support of her mere descriptiveness refusal, the Trademark Examining Attorney relies on the following pertinent dictionary definitions (from the online dictionary [encarta.msn.com](http://encarta.msn.com)). "Diet" is defined as "controlled intake of food and drink designed for weight loss, for health or religious reasons, or to control or improve a medical condition." The sixth and seventh (of ten) entries for "gear" define that term as "a piece or system of machinery with a particular function," and as "the equipment that is needed for a particular activity (informal) - *hiking gear*."

Based on these dictionary definitions, the Trademark Examining Attorney contends that applicant's goods comprise "gear," i.e., "equipment that is needed for a particular activity," and that in this case the "particular activity" to which the applicant's "gear" is directed is dieting. Therefore, she contends, "the goods consist of diet gear."

We are not persuaded. Although applicant's product might be deemed to be "gear" to the extent that it comprises "equipment," we cannot conclude on this record that dieting, like the "hiking" example given in the dictionary definition, would be readily thought of as an "activity" for which gear would exist or be necessary.

The Trademark Examining Attorney also has submitted and relies on numerous third-party registrations of marks which contain the word GEAR, in which the term is disclaimed, is registered under Section 2(f), or is registered on the Supplemental Register. She contends that these third-party registrations demonstrate that the "USPTO has routinely found the term 'gear' to be merely descriptive, if not generic, of equipment used in the course of a variety of activities, including diet and other health and physical fitness activities."

We are not persuaded. The third-party registrations cover a wide variety of goods including physical fitness products, but none of them involves diets or dieting except for two registrations covering a fitness magazine column "in the field of recreational equipment and supplies, health, fitness, diet, exercise and lifestyle." This evidence does not establish that dieting, per se, would be perceived or expected to be an activity for which "gear" exists.

The Trademark Examining Attorney also has submitted excerpts of articles retrieved from the NEXIS database by her search for "diet gear." However, the only appearance of the term "diet gear" in these excerpts is in an article stating that "[t]hose who purchase the pills, herbs, videos

and other diet gear are losing a lot of money but rarely much weight." We find that this single reference to "diet gear" is de minimis, and that it fails to establish that purchasers would immediately understand the term to describe applicant's device.

The Trademark Examining Attorney also has submitted other NEXIS excerpts. First, she relies on ten excerpted articles retrieved by her search for forms of the word "diet" within five words of "gear," representative examples of which are: "What makes Skipper's TV show different than the average infomercials that promote exercise gear and diet pills is that her show has news value"; "On the local front, a man in Ridgeway asked his 'Biggest Loser' party guests to bring workout gear, bottled water and their favorite diet and exercise tips"; "The operative word during the final few weeks before a marathon is 'continuity.' This is not a time to make major changes to your diet or running gear"; "... and funding her training supplies, like workout gear, transportation, massage and chiropractic services and dietary supplements"; and "The program will prepare participants physically and mentally by offering weekly coaching on mileage, pace, stretching, strengthening, diet, injury prevention, training gear and problems with overtraining."

Second, the Trademark Examining Attorney relies on two excerpted articles retrieved by her search for "gear" within ten words of "health equipment," and on five excerpted articles retrieved by her search for "gear" within ten words of "fitness equipment." Representative examples are: "Continua plans to develop standards to enable home health equipment makers to develop gear that works with that of other companies"; and "Home-fitness equipment and gear became a \$4.3 billion market in 2002..."

Third, the Trademark Examining Attorney relies on three excerpted articles retrieved by her search for "gear" within ten words of "diet plans," which state: "The Fitness and Active Living Pavilion, sponsored by Fitness magazine, will exhibit apparel, gear and accessories, home exercise equipment and techniques, sports vehicles, fitness foods, diet plans, sports drinks and workout videos"; "As a country, we spend more on health care than just about anything else, and the bill doesn't include what people fork over for health clubs, diet plans and fitness gear"; and "With the steady drumbeat of diet plans, health foods, body shops and exercise gear assaulting kids from Day One of consciousness, it is no wonder that the weight obsession is now reaching into the schoolyard."

The Trademark Examining Attorney argues that these articles demonstrate "wide usage of the term 'gear' in relation to many activities, including dieting, nutrition and physical fitness. ... the term 'gear' is commonly and widely used to refer immediately to equipment, machines and devices used in the course of diets and diet plans."

We are not persuaded. These articles refer variously to "fitness gear," "exercise gear," "training gear" and the like, but not to "diet gear" or "dieting gear." The fact that "gear" is merely descriptive as applied to exercise or fitness equipment does not suffice to establish that "gear" likewise is merely descriptive of diet products in general or as applied to applicant's goods specifically. This is so, notwithstanding the fact that a person may use both exercise gear and a diet plan as part of an overall weight loss or fitness program.

For the reasons discussed above, we find that the combination of "diet" and "gear" in applicant's mark results in a composite which is sufficiently unusual and incongruous to make the mark suggestive rather than merely descriptive as applied to applicant's goods. Dieting is not an activity which normally would be understood or expected to involve or utilize "gear." The resulting mental pause that would be required in order to understand

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the significance of the mark as applied to the goods precludes a finding of mere descriptiveness.

Decision: The refusal to register is reversed.