

THIS DECISION IS NOT
A PRECEDENT OF THE TTAB

Mailed: March 27, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Walletshots, LLC

Serial No. 78641291

Deborah S. Shepherd of Knobbe, Martens, Olson & Bear for applicant.

Robert J. Struck, Trademark Examining Attorney, Law Office 109 (Dan Vavonese, Managing Attorney).

Before Seeherman, Mermelstein, and Bergsman, Administrative Trademark Judges.

Opinion by Mermelstein, Administrative Trademark Judge:

Walletshots, LLC seeks registration on the Principal Register of the mark WALLETSHOTS¹ (standard characters) for "durable photographic prints in the form of cards and durable photographic prints in the form of cards containing magnets," in International Class 16 (as amended).

Registration has been finally refused on the ground that the mark as used on the identified goods is merely descriptive. Trademark Act § 2(e)(1); 15 U.S.C.

¹ Serial No. 78641291, filed June 1, 2005, alleging a *bona fide* intention to use the mark in commerce.

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§ 1052(e)(1). Applicant and the examining attorney have filed briefs. We affirm.

I. Applicable Law

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the goods with which it is used. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the products for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the issue is whether someone who knows what the products are will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002); *In re Patent & Trademark Serv. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Ass'n of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

"On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the

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term indicates, the term is suggestive rather than merely descriptive." *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978); see also *In re Shutts*, 217 USPQ 363, 364-365 (TTAB 1983); *In re Universal Water Sys., Inc.*, 209 USPQ 165, 166 (TTAB 1980). Even where individual terms are descriptive, combining them may evoke a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods, without the combination of terms creating a unique or incongruous meaning, then the resulting combination is also merely descriptive. *In re Tower Tech.*, 64 USPQ2d at 1317-1318.

II. Record on Appeal

The examining attorney submitted the following evidence:

- Web pages indicating use of the term "wallet shots":

1. Reader comment:

"Are you getting paid well enough for your talents? I just don't think you are because of your \$15 wallet shots. Correct me if I am wrong."

Marilyn Jenett, Ryze Business Networking, www.ryze.com (Aug. 7, 2006).

2. Her Voice, Cover Story, Brittany Wylie, [From Moo-Claw to the Fur Ball](#)

"She lists Abbey's tricks and her talent for sensing Hoch's moods, and flips through wallet

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shots of Abbey at professional sittings like she's showing off her fifth child."

www.hervoicenebraska.com/stories/090104/cov_-mooclawgal01.shtml (Aug. 7, 2006).

3. Advertisement for Andrea Hazel Photography, Charleston, SC:

"100 - color wallet shots of bride and groom to include in your thank-you notes (one pose)...."

URL not provided.

- Definition of "shot":
 12. a. A photographic view or exposure: *got a good shot of that last model.*
 - b. A developed photographic image.

AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (4th ed. 2000) (online version).

- Copies of pages from applicant's website.
<http://walletshots.ecommerce-checkout.com> (Feb. 6, 2007).

Applicant submitted the following evidence in support of registration:

- Yahoo search results (first 30 out of approximately 133 "hits") from a search for the phrase "wallet-sized photographs."
- Pages from applicant's web site generally discussing the identified goods.
- Dictionary Definitions:
 - o **wal·let** ... **1**: a bag for carrying miscellaneous articles while traveling
 - 2 a**: a folding pocketbook with compartments for personal papers and usually unfolded paper money ... **b**: a container that resembles a money

wallet: as (1): a usually flexible folding case fitted for carrying specific items (as tools or fishing flies) (2): FOLDER

- o **shot ... 1a:** an action of shooting **b:** a directed propelling of a missile... **c:** a stroke or throw in an attempt to score points in a game ...
 - 2 a:** something propelled by shooting ... **b:** a metal sphere of iron or brass that is heaved in the shot put
 - 3 a:** the distance that a missile is or can be thrown **b:** RANGE, REACH
 - 4:** a charge to be paid ...
 - 5:** one that shoots ...
 - 6 a:** ATTEMPT, TRY **b:** GUESS, CONJECTURE **c:** CHANCE **d:** a single appearance as an entertainer
 - 7:** an effective remark
 - 8a:** a single photographic exposure; *especially:* SNAPSHOT **b:** a single sequence of a motion picture or television program shot by one camera without interruption
 - 9:** a charge of explosives
 - 10 a:** a small measure or serving ...
 - 11 shot plural:** SPRINKLES, JIMMIES ...

The Merriam-Webster On-line Dictionary was cited as the source for both dictionary definitions submitted by applicant in its response to the first Office action. Although applicant did not supply copies of the definitions in question, the examining attorney did not object to them, and in fact relies on them. We accordingly treat them as part of the record.

Applicant included an image of its product in its brief. This material was not submitted prior to appeal, and will not be considered. Trademark Rule 2.142(d).

III. Descriptiveness under Trademark Act § 2(e) (1)

The examining attorney's position is simple:

The term WALLET is defined as "a folding pocketbook with compartments for personal papers and usually unfolded paper money." The term WALLET is commonly used to describe a size of photographs intended to be stored in a person's wallet or pocketbook. The term SHOT is commonly defined as "A photographic view or exposure" or "A developed photographic image."

Here it is logical to conclude that the applicant is using the combination of terms to inform potential customers that it is selling developed photographic images that are intended to be stored in a person's wallet. Indeed, the applicant's advertising states, "Slides right into your wallet...."

Ex. Att. Br at 3-4.

In response, applicant argues that

[c]learly, applicant's goods are not "used to display and/or hold wallet-sized photographs"^[2] which have a clearly recognized size and shape of approximately 2x3 inches and are printed on photographic paper.

As mentioned above, the standard wallet-sized photograph is approximately 2 inches by 3 inches. Applicant's goods are neither wallet-sized nor are they printed on photographic paper.

² Applicant focuses here on an argument made by the examining attorney earlier in prosecution, prior to applicant's adoption of its current identification of goods. At the time, the identification included "pouches for holding photographic cards." The examining attorney argued that "applicant's goods are used to display and/or hold wallet-sized photographs, or 'wallet shots.'" Final Office Action at 3. That line of argument appears to have been abandoned after applicant adopted the current identification and provided pages from its website. See Office Action, Feb. 26, 2007 (accepting amendment but continuing § 2(d) refusal) ("refusal is maintained because the goods are in fact, wallet shots as stated in the mark").

Rather, Applicant's goods are credit-card sized photographic cards, which are much larger than wallet-sized photographs. Moreover, Applicant's photographic cards have a thickness similar to that of a credit card. Applicant's goods can also be larger to be used as a luggage tag. In short, Applicant's goods are photographic cards which are thick and hard, not wallet-sized photographs printed on very thin photographic paper. Applicant's goods are clearly not wallet-sized photographs. As such, the mark WALLETSHOTS cannot be considered merely descriptive of Applicant's goods.

Appl. Br. at 2-3.

The evidence submitted by the examining attorney (and by the applicant) demonstrates that a "wallet" is, among other things, a small purse commonly carried to hold money, cards, and other papers and that the word "shot" can be used to refer to a photographic print. While both words have a number of other meanings, it is well-settled law that the meaning or connotation of a trademark must be judged with reference to the identified goods, and not in a vacuum. In this context, "wallet" and "shot" have meanings of particular significance to these goods, and it is therefore those meanings which are relevant to our analysis.³

³ Applicant's rhetorical questions on the meaning of the mark ("[W]hat exactly are WALLETSHOTS? ... Are they actual pictures of a wallet? Is it a new type of game? Is it related to a jigger or a shot of alcohol? Does it relate to the use of a gun? Is it a compact pocketbook?" Response to Office action June 23, 2006) are irrelevant because they assume the point of view of one with no idea of what the goods are. As noted above, the question is

Applicant's argument that its mark is not descriptive because it does not refer to "wallet-sized photographs" is misplaced. Applicant contends that a "wallet-sized photograph" has a specific meaning in the field of photography, namely that they are photographs with "a clearly recognized size and shape of approximately 2 x 3 inches and are printed on photographic paper."

To begin with, applicant's mark is WALLETSNOTS, not "wallet-sized," and the question at hand is whether applicant's mark has a descriptive meaning with respect to the identified goods, and not with respect to any other goods such as the kind of photographs which are traditionally made to be carried in wallets. As applicant notes, its goods are a new product, unlike traditional wallet photographs in many respects. Thus, applicant's argument that photographers often use terms like "wallet-sized photographs" to refer to these traditional products,⁴ and that there is a strict industry-standard format for

not what a mark might mean to someone in isolation, but what the mark may mean in connection with the goods.

⁴ Applicant apparently relies on its Yahoo search engine results list for this proposition. Such lists are of very little probative value. They do not necessarily reflect the way a term is used on the webpage itself, nor do they show use of a particular term in meaningful context. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828 (Fed. Cir. 2007); *In re Fitch IBCA Inc.*, 64 USPQ2d 1058, 1060 (TTAB 2002).

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such photographs,⁵ are beside the point. To the extent that the examining attorney has used "wallet sized" or similar terms to describe applicant's goods, we understand that reference to mean nothing more than that applicant's goods are of a size which will easily be fit into a wallet.

The evidence from applicant's website is instructive. As can be seen from applicant's advertising, applicant's goods are described as cards approximately the shape and thickness of a credit card onto which photographs are printed or affixed. The result is a durable picture which not only can, but is *intended* to fit inside of a wallet.



WalletShots™

Photocards Home | Products

Durable, Credit-Card Sized Photocards

You want to share a photo of your family with a friend. You reach into your wallet or purse...but the photo is bent, torn, ripped, or lost.

Traditional wallet-sized photos just aren't durable enough to be kept in your wallet or purse.

This won't happen again with a WALLETSHOTS photocard, a new patent pending product.

MAKE THE MEMORIES LAST

- Approximate size and thickness of a credit card and equally as durable
- Slides right into your wallet with your other credit cards
- Vivid color and clarity
- Order photocards of your children, family, friends, or pets
- Order magnetized cards and create a photo gallery on your refrigerator
- Great gift for family and friends

Order Now! **Only \$3.99 each** (discounts for multiple cards)

The relevance of the word "wallet" to applicant's goods could hardly be clearer, given a picture on the web page of an open wallet in which a number of cards have been placed, including what appears to be a card-sized photograph of two attractive children. It is in light of this

⁵ Applicant argues that its goods are "much larger" than a standard wallet-sized photograph, which applicant argues is 2" x 3". In fact, applicant's web site indicates that its goods are not that much larger: 2 $\frac{1}{8}$ " x 3 $\frac{3}{8}$."



understanding of the nature of the goods that we must consider whether the mark is descriptive.

While "wallet"

clearly has other meanings in different contexts, we agree with the examining attorney that the term wallet would be readily understood to refer to a "pocketbook with compartments for personal papers and usually unfolded paper money," as defined in the record. Most adults - including applicant's potential purchasers - are undoubtedly familiar with such an item, and likely carry one on a daily basis. Likewise, "shot" is a common term for a photograph or a photographic print. It takes no leap of imagination or multi-stage reasoning to conclude, as the examining attorney argues, that "the applicant is using the combination of terms to inform potential customers that it is selling developed photographic images that are intended to be stored in a wallet."

Applicant points out that "walletshots" is not in the dictionary, and that the examining attorney has provided only two examples (there were actually three) of use of the term "wallet shots" by the public, arguing that "[t]his is not sufficient evidence to show that consumers in general

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would recognize this term to mean a wallet-sized photograph." We agree that this evidence might be insufficient if the examining attorney were required to show that the term "wallet shot" or "walletshot" is currently understood and in wide use by the relevant public. But there is no such requirement. While evidence of widespread use of a descriptive term provides strong support for a refusal, the mere fact that there are few - or no - other users of a term does not require reversal if the evidence shows that the mark will be understood as descriptive of the goods. *In re Nat'l Shooting Sports Found. Inc.*, 219 USPQ 1018, 1020 (TTAB 1983).

Likewise, the fact that a compound word mark is not found in the dictionary does not mean that it is not descriptive, *In re Orleans Wines, Ltd.*, 196 USPQ 516, 517 (TTAB 1977), or even generic, *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987) (compound word may be found generic based on dictionary definitions of its elements).

Here, the examining attorney contends that the combination of "wallet" and "shots" is no less descriptive than its descriptive constituents, and we agree. The combined term WALLETSHOTS would readily be perceived by consumers as merely the words "wallet" and "shots" run

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together. This mark immediately tells consumers that the goods are shots or photographs of a size that can be put in a wallet. The fact that the mark does not also convey information about other characteristics of the goods – e.g., that the photographs are on plastic – is of no moment. A mark need not describe every characteristic of a product in order to be found merely descriptive.

V. Conclusion

After careful consideration of the evidence and argument of record, we conclude that applicant's mark, WALLETSNOTS, is merely descriptive of a feature, function, or characteristic of "durable photographic prints in the form of cards and durable photographic prints in the form of cards containing magnets." Registration is accordingly barred under Trademark Act § 2(e)(1).

Decision: The refusal to register is accordingly affirmed.