

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE T.T.A.B.**

Mailed: March 24, 2008

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Burlen Corporation

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Serial No. 78737709  
(filed October 21, 2005)

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Michael D. Hobbs, Jr. of Troutman Sanders LLP for Belen Corporation.

Irene D. Williams, Trademark Examining Attorney, Law Office 112 (Angela Wilson, Managing Attorney).

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Before Grendel, Rogers and Wellington,  
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Applicant, Burlen Corporation, has applied to register the mark GIRL BOXER (in standard character form) on the Principal Register for underwear in International Class 25.<sup>1</sup>

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<sup>1</sup> Application Serial No. 78737709 was filed October 21, 2005, based upon applicant's assertion of its bona fide intent to use the mark in commerce. Applicant filed an amendment to allege use on October 2, 2006, alleging a date of first use in commerce on May 5, 2006.

The trademark examining attorney refused registration of the mark under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark is merely descriptive of applicant's goods.

After the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs. After careful consideration of the evidence of record and the arguments, we affirm the refusal to register.

It is well settled that a term is considered to be merely descriptive of goods and/or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods and/or services. See Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052; see also *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods and/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 feature about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods and/or services

for which registration is sought. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). Thus, "[w]hether consumers could guess what the product is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985). Rather, the issue is whether someone who knows what the goods 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 Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990).

Before we apply the aforementioned principles to the case at hand, we provide the following discussion of the relevant evidence of record.

The following definitions, taken from The American Heritage Dictionary of the English Language (4<sup>th</sup> ed. 2000), are of record:<sup>2</sup>

- "Girl":           A female child.
- "Boxer":           1. *Sports* One who fights with the fists as a sport.  
                    2. *boxers* Boxer shorts

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<sup>2</sup> The Board may take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). More than one definition is in the record for the term "boxer"; the definition provided in this decision is representative of those.

"Boxer  
Shorts": Men's underwear shorts characterized by  
loose fit.

The examining attorney has also made of record five  
NEXIS database article excerpts containing references to  
women (or young women) wearing boxer shorts.<sup>3</sup> These  
excerpts include:

... time around, madras plaids are popping onto store  
racks in micro-mini skirts, hippie-chic peasant tops  
and boxer shorts &#x2013; in the young women &#x2019;s  
departments, not on the Father&#x2019;s Day gift  
table.

[from The News Journal (Wilmington, DE), March 19,  
2006]<sup>4</sup>

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... a little more traditional, but today's briefs are  
looking very sexy, with some mimicking a short, tight  
version of boxer shorts. A lot of younger women are  
even moving over to the practical and sexy briefs.  
The real answer of course, is to wear something that  
feels comfortable and looks good. What do YOU ...

[from Palm Beach Post (Florida), November 5, 2005]

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<sup>3</sup> Attached to November 22, 2006 Office Action. Applicant's  
objection to one of the article excerpts (from Circle Publishing  
Ltd.'s *Geographical*) is well-taken inasmuch as that article  
appears to emanate from a foreign publication without any  
evidence of circulation in the United States. *In re Wilcher  
Corp.*, 40 USPQ2d 1929, 1931 (TTAB 1996) (in absence of evidence  
establishing substantial circulation of foreign publications in  
U.S., they are not competent to show significance of term to  
general American public). Accordingly, that article excerpt was  
not given consideration.

<sup>4</sup> It appears the extra alphanumeric characters in this excerpt  
were somehow inserted when the excerpt was retrieved by the NEXIS  
system. When these characters are ignored, the excerpt remains  
easily readable.

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The examining attorney also made of record screenshots from two online retail websites advertising boxer shorts for girls.<sup>5</sup> They appear as follows:



[appearing on www.walmart.com on February 7, 2007]

and

http://www.gabbys.net/zencart/index.php/main\_page=product\_info&products\_id=98&zenid=f6619846d1d93d97e002759fde  
c0d139 02/07/2007 01:36:35 PM



[appearing on www.gabbys.net on February 7, 2007].

Applicant argues that these two website advertisements constitute "infringement of [applicant's] mark" and

<sup>5</sup> Attached to February 7, 2007 Office Action.

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applicant is "in the process of addressing the infringement." Brief, pp. 17-18. And, in its reply brief, applicant states that these "infringing uses have been addressed, and the sites no longer [make] any reference to Applicant's mark." Reply brief, p. 3.

We find that the phrases "Girls' Boxer Shorts, 2 pack" and "Girl's Boxer Shorts" on the respective websites are being used descriptively or generically to refer to the type of product being sold and not as a source identifier. Specifically, the former website clearly shows the source of the goods as "mary-kate and ashley brand" and the latter website has language under the image of the goods stating "Manufactured by: Gabby's." Thus, it is clear from these advertisements that the goods are being described as girl's (or girls') boxer shorts. Regardless of whether these uses of the terms remain on the respective websites, mere cessation of use would not dictate a conclusion that the uses were abandoned because they were infringing; and there is nothing in the record to indicate that the uses, if they have stopped, were stopped because the users acknowledged them to be infringing. The uses, if stopped, may have been stopped merely to avoid conflict between applicant and the users.

Applicant identified sixteen third-party registrations for marks containing, in part, the terms "boxer" or "girl" for use on underwear without requiring a disclaimer of either term or a showing of acquired distinctiveness.<sup>6</sup> Brief, p. 11. Applicant argues that these registrations are evidence that "the PTO has consistently recognized that by their commonly understood definitions, the words 'girl' and 'boxer' are vague, require imagination to connect with underwear, and do not describe underwear with the immediacy characteristic of descriptive marks." Brief, p. 12.

Third-party registrations may be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade or industry. *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987). However, it has been held by our principal reviewing court that even "if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court." *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

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<sup>6</sup> TARR database printouts were attached as an exhibit to applicant's response (filed October 2, 2006) response to an Office Action. Applicant also identified several applications, but these have no probative value. *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002).

Here, it only takes a cursory review of the third-party registrations to realize that applicant's reliance thereon and the conclusions it draws from their existence are not well-founded. All of the cited registered marks containing the term "boxer" or "girl" are also accompanied by suggestive or other non-descriptive matter making the respective marks, each considered as a whole, non-descriptive. In some cases, the additional matter in the marks changes the overall commercial impression or connotation of the marks. For example, the mark JOE BOXER connotes the name of a person and the marks COCKYGIRL, SUPERGIRL, and PARTY GIRL have other connotations such as, respectively, a type of girl who is very confident, a superhero, and a party-goer. It may be that the additional non-descriptive matter or different (non-descriptive) connotation created by the various combinations "carried" the marks and may explain why they are on the Principal Register without a disclaimer or showing of acquired distinctiveness.

Based on all of the evidence of record and the arguments presented, we find that the examining attorney has met her burden of establishing that the mark GIRL BOXER is merely descriptive of the identified goods, i.e., underwear. We agree with the examining attorney that

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applicant's mark, when used in connection with underwear, is merely descriptive because "the term BOXER describes the goods and GIRL designates the audience for which the goods are intended." Brief, p. 5. While the dictionary definitions of record make it clear that boxers are an underwear style for men, the NEXIS evidence of record establishes that boxers or boxer-style underwear may be worn by and marketed to younger women, i.e., girls. Indeed, the first article excerpt identified above demonstrates this in describing madras plaid-pattern boxer shorts which may be found in the young women's clothing department. The second article excerpt also illustrates that even if women aren't wearing the same boxer shorts as men, they are wearing boxer-style underwear. In particular, the article highlights a current fashion, "but today's briefs are looking very sexy, with some mimicking a short, tight version of boxer shorts. A lot of younger women are even moving over to the practical and sexy briefs..." The online advertisements take the level of descriptiveness a step further by using the terms "girls' boxers" or "girl's boxers" to describe the genus of goods. Taken together, the evidence is sufficient for purposes of establishing that boxers or boxer-style underwear are being marketed to younger women or "girls." Applicant's

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identification of goods, "underwear," is definitely broad enough to cover all types of underwear, including boxers or a boxer-style underwear for younger women, i.e., girls.

We are not persuaded by applicant's argument that because "boxer" is defined as a style of underwear worn by men, an incongruity results when the term is combined with "girl," as in applicant's mark. To the extent that any incongruity lies within the combination of the terms "girl" and "boxer", it does not rise to such a level as to create ambiguity in the meaning of applicant's mark when viewed in connection with underwear. Applicant's mark does not require any exercise of mental processing in order to readily perceive the descriptive significance of the mark as it relates to underwear. Rather, consumers will immediately understand applicant's mark as describing a "boxer" type of underwear to be worn by girls. We do not find the combination of the terms to be so unusual as to negate or diminish the descriptive nature of the mark. In fact, any possible incongruity would not arise unless a prospective consumer of underwear, upon considering applicant's proposed mark, first concluded that the underwear was for girls and were boxer shorts. At that point, consumers unaware of an emerging market for such goods might very well find the terms somewhat incongruous;

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but such prospective consumers would already have been immediately provided with information about significant characteristics of underwear for girls that are either boxers or in the style of boxers, without any further need of thought or imagination to discern the nature of the goods. Such is the essence of descriptive words. Moreover, consumers looking for boxers for girls, because already aware of their existence would not perceive any incongruity at all.

In summary, we are persuaded that when applied to applicant's goods, the mark GIRL BOXER immediately describes, without conjecture or speculation, applicant's goods, i.e., underwear. No exercise of imagination, cogitation, or mental processing is required in order for prospective consumers of applicant's goods to readily perceive the merely descriptive significance of the mark as it pertains to applicant's goods.

Decision: The refusal to register is affirmed.