

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

Hearing: November 8, 2011

Mailed: May 18, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Quicksilver, Inc.

Serial No. 77734610

Jeffrey Van Hoosear of Knobbe, Martens, Olson & Bear, LLP
for Quicksilver, Inc.

Dominick Salemi, Trademark Examining Attorney, Law Office
106 (Mary I. Sparrow, Managing Attorney).

Before Cataldo, Taylor and Wellington,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Quicksilver, Inc. has applied to register the mark
SURF COUTURE in standard characters on the Principal

Register for the following goods:

Optical goods, namely, eyewear, sunglasses,
spectacles and goggles for sports; recorded
materials, namely, digital video discs and CD-
ROMs featuring sports, recreational activities,
music and fashion

in International Class 9;

Travel bags, luggage, carry-all bags, handbags,
beach bags, tote bags, bath bags, namely, bags
used to carry goods used in the bath, sports

Ser. No. 77734610

bags, backpacks, purses, wallets, satchels, brief cases, attaché cases, suitcases, key cases, valises; umbrellas

in International Class 18; and

Clothing, footwear, headgear, namely, undershirts; wetsuits, swimwear, singlets, t-shirts, shirts and casual tops with long and short sleeves; sweat suits; sweat tops, sweat hooded parkas; pullovers; jackets; coats, jumpers, shorts, board shorts, walking shorts, volley shorts, long pants, trousers, jeans; boxer shorts; swim trunks for the beach; overalls, dresses, skirts, sarongs; jerseys; pajamas, nightwear; bathrobes, underwear; socks, vests, belts; mittens, gloves, scarves, ear muffs, bandannas, headbands; hats, visors, caps, slippers, boots, shoes, thonged and strapped sandals, athletic shoes, surfboard boots

in International Class 25.¹

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

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs on the issue under appeal. In addition, applicant's request for an oral hearing was granted; and an oral hearing was held as scheduled on November 8, 2011.

¹ Application Serial No. 77734610 was filed on May 12, 2009, based on applicant's assertion of a bona fide intent to use the mark in commerce on the goods. During prosecution of the application, applicant disclaimed COUTURE.

Evidence of Record

In support of its position that SURF COUTURE is not merely descriptive of its recited goods, applicant submitted dictionary definitions of the terms comprising its mark. According to these definitions, SURF is defined as "the swell of the sea that breaks upon the shore" or "to ride the surf."² COUTURE is defined as "the business of designing, making, and selling fashionable custom-made women's clothing" or "the clothes created by couture."³ Applicant further made of record printed copies of third-party registrations for the following marks:

DIRTY COUTURE (COUTURE disclaimed) for clothing, namely, shirts, skirts and pants;⁴ and

CAMPUS COUTURE (COUTURE disclaimed) for hats, shirts, T-shirts, tank tops, knit shirts, sweat shirts, boxer shorts, belts, slippers, flip flops, sweaters, jackets, scarves.⁵ In addition, applicant submitted the results of a search of the Google search engine for the term "surf high fashion" and a Wikipedia entry for the term "haute couture."

² Merriam-webster.com

³ *Id.*

⁴ Registration No. 3104014 issued on the Principal Register on June 13, 2006.

⁵ Registration No. 3560330 issued on the Principal Register on January 13, 2009.

In support of the refusal to register, the examining attorney submitted with his brief additional dictionary definitions of the terms comprising applicant's mark.⁶ According to these definitions, SURF is defined as "the mass or line of foam formed by waves breaking on a seashore or reef" or "ride on the crest of a wave, typically toward the shore while riding on a surfboard."⁷ COUTURE is defined as "the occupation of a couturier, dressmaking and designing;" "fashion designers or couturiers, collectively;" "the clothes and related articles designed by such designers;" and "the business establishments of such designers, especially where clothes are made to order."⁸

In addition, the examining attorney made of record the following excerpted articles retrieved from the Nexis computer database:

The evening will feature seven design categories, including Swim-surf, Couture, Kids, and Bridal, as well as the Student, Rising Star and Supreme awards. ...

⁶ We hereby take judicial notice of these definitions. The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002). See also *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).

⁷ Oxforddictionaries.com, retrieved from Oxford English Dictionary, Oxford University Press (2011).

⁸ Dictionary.reference.com. retrieved from The Random House Dictionary, Random House, Inc. (2011).

The Sunday Mail (Queensland, Australia April 5, 2009);

The preliminary judging continues today with Fashions on the Field, Gold Coast Swim-Surf and Couture categories, followed by an exclusive appearance by celebrated designer and guest NRA Awards judge Wayne Cooper.

The Gold Coast Bulletin (Australia March 13, 2008);

Remember those Japanese exchange students? Take their style and pin it up alongside the explosion of skateboard, snowboard and surf couture and Vancouver's also got a thriving street apparel industry that cannot be ignored.

The Vancouver Sun (British Columbia October 21, 2003);

Swimsuits for kids include flotation gear. ... Customers can pick their fabrics, and the shorts will be made to their measurements. Think of it as surf couture.

Orange County Register (California July 14, 1995); and

PET PARAPHERNAILA GOES SURF COUTURE
BAD DOGS, COOL CATS? LIFE'S A BEACH
... since Coco Kennel: a surfer's wet suit and this year's must-have accessory, a neon orange flea collar. Surf couture has captured the hearts of dog dudes and fancy felines.
The Miami Herald (August 24, 1991).

The examining attorney submitted further articles from the Nexis database displaying the term "surf fashion" used in various contexts. In addition, the examining attorney made of record printed copies of third-party registrations for marks containing the term SURF or COUTURE in which such terms are disclaimed and identifying, *inter alia*, various clothing items.

Doctrine of Foreign Equivalents

For the first time in his brief, the examining attorney argues that we should apply the doctrine of foreign equivalents in our determination of the refusal to register. Specifically, the examining attorney asserts that COUTURE is the French language equivalent of "fashion." However, we agree with applicant that the doctrine of foreign equivalents is inapplicable in this case. As demonstrated by the dictionary definitions discussed above, COUTURE has a recognized meaning in the English language. Furthermore, there is no evidence of record that the ordinary American consumer would stop and translate COUTURE into English. *Cf. Palm Bay Import, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). Accordingly, the examining attorney's arguments, and those of applicant, relating to the doctrine of foreign equivalents will be given no further consideration.

Mere Descriptiveness

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).

In the instant case, the evidence made of record by the examining attorney is insufficient to support a finding that, as applied to applicant's goods, the mark SURF COUTURE would immediately describe, without conjecture or speculation, a significant characteristic or feature thereof, namely, that they are surf clothing and related items made by fashion designers. We agree with the examining attorney that excerpts from articles taken from

the Nexis database may be competent evidence in an *ex parte* proceeding of how a mark may be perceived by the public. See *In re Shiva Corp.*, 48 USPQ2d 1957 (TTAB 1998); and *In re Fitch IBCA, Inc.*, 64 USPQ2d 1058 (TTAB 2002).

In this case, however, two of the five instances in which SURF COUTURE appear are articles from Australian publications. There is nothing in the record to indicate either that the products discussed therein are available in the United States or that consumers in the United States are familiar with the term SURF COUTURE as applied to clothing in general or applicant's goods in particular. See, for example, *In re Consolidated Cigar Corp.*, 13 USPQ2d 1481 (TTAB 1989). Further, and more importantly, these two Australian articles feature the terms SURF and COUTURE as different clothing categories in the context of award programs. Simply put, these articles do not display SURF COUTURE used as a term to describe a type of clothing, but rather display SURF and COUTURE in the context of two different types of clothing among several others. For these reasons, we find this evidence to have no probative value on the issue of mere descriptiveness.

Of the three remaining Nexis articles, one uses SURF COUTURE to discuss what appear to be accessories for pets, namely, dogs and cats, which goods are not among those

recited in the involved application. The mere two Nexis articles that discuss SURF COUTURE as applied to clothing, from Vancouver, British Columbia and Orange County, California, are insufficient to make a prima facie case that consumers in the United States view SURF COUTURE as merely descriptive of a feature or characteristic of applicant's goods.

Further, the dictionary definitions made of record by applicant and the examining attorney point to a relatively vague meaning for applicant's mark. At best, the submitted definitions support a finding that SURF COUTURE may be defined somewhat incongruously as high fashion clothing and related goods designed for surfers and surfing. In that regard, we do not agree with the examining attorney that COUTURE may be defined as "fashion." Rather, the dictionary definitions excerpted above indicate that COUTURE may be defined as high fashion designers and the clothing they create. Such a definition, incongruity aside, may perhaps suggest a characteristic of applicant's goods, namely, that they are considered highly fashionable by those embracing a surfer lifestyle. However, SURF COUTURE does not immediately describe such a characteristic or feature thereof. Thus, the dictionary definitions, even viewed in the context of the Nexis and other evidence, fail

to support a finding that SURF COUTURE merely describes the identified goods.

The third-party registrations submitted by applicant and examining attorney are of little help in determining the registrability of the mark at issue in this case. The registrations demonstrate that in the context of various marks, the term SURF or COUTURE has been disclaimed for goods including clothing items. We note, however, that none of the third-party registrations contain both the terms SURF and COUTURE and, thus, are of limited usefulness in evaluating whether the mark SURF COUTURE merely describes the recited goods. Further, and as often noted by the Board, each case must be decided on its own set of facts, and we are not privy to the facts involved with these registrations. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if 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.") *See also In re Best Software Inc.*, 58 USPQ2d 1314 (TTAB 2001).

Viewed as a whole, the evidence submitted by the examining attorney falls short of demonstrating that SURF COUTURE merely describes a feature or characteristic of

applicant's clothing items, optical goods, and bags and cases.

Finally, if doubt exists as to whether a term is merely descriptive, it is the practice of this Board to resolve doubts in favor of the applicant and pass the application to publication. See *In re Gourmet Bakers Inc.*, 173 USPQ 565 (TTAB 1972). In this way, anyone who believes that the term is, in fact, descriptive, may oppose and present evidence on this issue to the Board.

Decision: The examining attorney's refusal of registration is reversed. Accordingly, the involved application will be forwarded for registration in due course.