ESTTA Tracking number: **ESTTA395368**
Filing date: **02/28/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77837943
Applicant	Professional Bull Riders, Inc.
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Attachments	Appeal Brief.pdf (14 pages)(1140437 bytes)
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TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:	)	
	)	T.M. Law Office: 107
Professional Bull Riders, Inc.	)	
	)	Examining Attorney: Nelson B. Snyder III
Serial No.: 77/837,943	)	
	)	
Filing Date: September 30, 2009	)	
	)	
Mark: WOOL WARRIORS	)	
	)	
Atty. File No.: 5999-60	)	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

APPLICANT'S APPEAL BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

APPLICANT'S APPEAL BRIEF

Applicant appeals to the Trademark Trial and Appeal Board from the final refusal of registration for the mark "WOOL WARRIORS" in International Class 25 for "clothing, namely, shirts, sweatshirts, baseball style caps, knit caps and jackets."

Applicant is appealing the Examining Attorney's refusal of registration under Trademark Act Section 2(a), 15 U.S.C. Section 1052(a) on the basis that the Applicant's mark "WOOL WARRIORS" is deceptive when used in connection with "clothing, namely, shirts, sweatshirts, baseball style caps, knit caps and jackets." Specifically, the Examining Attorney indicates that Applicant's mark fulfills the criteria used to determine deceptiveness because the mark "WOOL WARRIORS" misdescribes the goods identified in the instant application, purchasers are likely to believe the misdescription, and the misdescription would materially affect their decision to

purchase Applicant's goods. *See In re Budge Manufacturing Co. Inc.*, 8 USPQ2d 1259 (Fed. Cir. 1988); TMEP § 1203.02.

SUMMARY OF PROCEEDINGS BELOW

Application Serial No. 77/837,943 for the mark "WOOL WARRIORS" was filed on September 30, 2009. On December 29, 2009, the Examining Attorney issued his first office action requesting amendments to the identification of goods, information as to whether or not Applicant's goods specified in Class 25 were made of wool and, if so, requesting wool be disclaimed and, if not, refusing registration in Class 25 under Trademark Act Section 2(a) on the basis that the mark is deceptive in relation to the specified goods. Applicant filed its response to this first office action on June 18, 2010 indicating Applicant's goods identified in Class 25 were not made of wool, that wool was not being disclaimed and submitting arguments against the deceptiveness refusal. On July 10, 2010, the Examining Attorney issued a Final Refusal of the application under Section 2(a) maintaining the refusal to register the mark "WOOL WARRIORS" in Class 25 on the basis that the word "WOOL" was deceptive in relation to Applicant's Class 25 clothing goods. On September 30, 2010, Applicant submitted an Amendment to Allege use for all Classes 16, 25 and 41 identified in the application. Concurrently with the Amendment to Allege Use, Applicant submitted a Request to Divide the application moving Classes 16 and 41 to a new daughter application, now registered under Registration No. 3,918,891, and keeping the instant application pending in Class 25 under final refusal. Applicant's Amendment to Allege Use and Request to Divide were accepted on October 26, 2010. Applicant submitted a Request for Reconsideration on December 13, 2010. The examining Attorney denied the Request for Reconsideration on January 4, 2011 adhering to

refuse registration of applicant's mark in Class 25 based on deceptiveness. Applicant filed the Notice of Appeal on January 4, 2011.

ARGUMENT

Applicant notes that all three criteria as set forth in *In re Budge, supra,* must be met in order for Applicant's mark to be found deceptive and maintains that none of the three *Budge* criteria have been met by Applicant's mark for the following reasons: (1) Applicant's mark is not misdescriptive as a whole, (2) the mark in its entirety would not be perceived by prospective purchasers as indicating that Applicant's goods contain wool, and (3) use of the term "WOOL" as a part of the mark "WOOL WARRIORS" would not affect a significant portion of the relevant consumers' decision to purchase Applicant's goods.

The test for determining deceptiveness of a mark is specifically stated in *In re Budge* is as follows:

1. Is the term misdescriptive of the character, quality, function, composition or use of the goods?
2. If so, are prospective purchasers likely to believe that the description actually describes the goods?
3. If so, is the misdescription likely to affect a significant portion of the relevant consumers' decision to purchase?

Id. at 1260 (emphasis added). The Applicant's mark was examined within these criteria too narrowly and in the abstract. The fact that Applicant's mark is used in connection with clothing that promotes Applicant's entertainment services in the nature of children's sheep riding events was not taken properly into consideration. Moreover, the mark was not considered in its entirety; as a result, the Examining Attorney has concluded that because it is possible that

clothing can be made from wool, and Applicant's clothing is not made from wool, the mark "WOOL WARRIORS" is deceptive. The underlined portions of the *Budge* test noted above were disregarded. An examination of the Applicant's mark within the full parameters of the *Budge* test reveals that the mark "WOOL WARRIORS" in its entirety and as used in the marketplace is not deceptive.

1. <u>"WOOL WARRIORS" is Not Misdescriptive</u>

A misdescriptive *term* is one that immediately conveys an idea of an ingredient, quality characteristic, function or feature of the goods but is untrue, although plausible. TMEP §1209.03. A misdescriptive *mark*, therefore, is one that, as a whole, likewise immediately conveys an idea as to the nature of the goods, but is untrue, although plausible. While the term "WOOL" could describe the fabric from which clothing is made, use of "WOOL" with "WOOL WARRIORS" produces a different meaning. Applicant's mark, when viewed in its entirety, does not immediately convey an idea as to an untrue quality of the Applicant's goods because "WOOL" modifies and describes "WARRIORS," not the clothing fabric. Consumers recognize that Applicant's goods can/cannot be made of "WOOL WARRIORS" or that "WOOL WARRIORS" can/cannot be a feature or function of the Applicant's goods. Instead, consumers will realize that "WOOL" describes "WARRIORS" and that the only plausible connotation of the complete mark is as a reference to the Applicant's sheep riding competitions for children commonly known as "mutton bustin'." *See* Exhibit A of Applicant's June 18, 2010 response.

The Examining Attorney focuses solely on the word "WOOL" stating that Applicant has admitted its clothing goods are not made of wool thus making the term "WOOL" misdescriptive. The Examining Attorney then concludes that Applicant's complete mark is deceptive by indicating per TMEP § 1203.02 and case law cited therein that Section 2(a) prohibits registration

of deceptive matter, not merely a deceptive mark. However, TMEP § 1203.02(a) also states that "marks containing a term identifying a material, ingredient, or feature should not be refused registration under Section 2(a) if the mark in its entirety would not be perceived as indicating that the goods contained that material or ingredient." Consumers would not view the Applicant's mark and isolate the word "WOOL." Rather, consumers would view the mark in its entirety, and "WOOL WARRIORS" as noted above, does not describe a quality, characteristic of feature of the Applicant's goods in any readily understood manner. *See In re Seats, Inc.*, 225 USPQ 364 (Fed. Cir. 1985) (noting all circumstances which may relate to the consumers' perception of the mark must be considered in answering the first two questions of the Budge test).

There is no reason for the Examining Attorney to focus on the word "WOOL" alone. The term is not dominant or used in a different font or style such that it is emphasized apart from the word "WARRIOR." Furthermore, Applicant's type of clothing goods are not typically made wool in today's world.

Applicant's mark as whole is suggestive of the goods of the applicant. A suggestive mark is one that, when applied to the goods or services at issue, requires imagination, thought or perception to reach a conclusion as to the nature of those goods or services. TMEP § 1209.01(a); *See In re Shutts*, 217 USPQ 363 (TTAB 1983). A suggestive mark does not immediately convey the nature of the goods or services so it is not descriptive and by extension, cannot be misdescriptive. Applicant's mark is suggestive because "WOOL WARRIORS" does not immediately convey that Applicant's goods are clothing, namely, shirts, sweatshirts, baseball style caps, knit caps and jackets. Instead, it takes consumers some thought or perception to determine that "WOOL WARRIORS" is an alliterative spoof on Applicant's sheep riding competitions for children whereby children grab onto and ride a sheep for as long as they can. "WOOL," as the Examining Attorney pointed out, is material that is derived from sheep. The

word "WOOL" in the Applicant's mark is suggestive of the sheep ridden by the children in the competition, and the word "WARRIOR" is suggestive of the children riding the sheep. The word "WOOL" with the word "WARRIOR" simply makes no other sense than as a suggestion of the Applicant's sheep riding competitions for children. There is no reason to assume that consumers would be viewing and evaluating the word "WOOL" alone, without the word "WARRIOR" out of context in which it is used by the Applicant on its goods, namely, in connection with its children's sheep riding competitions. In this regard, the first prong of the *Budge* test is not met.

2. Prospective Purchasers Are Not Likely to Believe that the Mark "WOOL WARRIORS" Describes Applicant's Goods

A prospective purchaser viewing Applicant's mark would not believe that Applicant's products contain wool. The "question of deceptive misdescriptiveness cannot be an exercise that takes place in the abstract, but "must be considered in conjunction with the goods and services as seen in the marketplace" *In re Alp Of South Beach Inc.*, 79 USPQ2d 1009, 1012 (TTAB 2006) (emphasis added). How the Applicant's mark is used on the clothing goods in the marketplace was not adequately considered. Prospective purchasers would not believe that the Applicant's products were made of wool just because it is possible for clothing to be made of wool. Rather, how the mark "WOOL WARRIORS" is used in the marketplace on clothing use to promote children's sheep riding competitions should be considered. Consumers are not likely to believe that Applicant's goods are made of wool and will realize that the clothing is sold to promote Applicant's sheep riding competitions.

Specifically, Applicant uses the mark "WOOL WARRIORS" on the clothing goods in the marketplace to both identify the source of such goods and to promote its related children's

sheep riding competitions. The mark is used with a design mark of a child riding a sheep, and the mark is often used in connection with a cartoon character sheep and phrases such as "GOT WOOL?", "WOOL GONE WILD" and "TOUGHEST SPORT ON WOOL. *See* Exhibits A and B of Applicant's December 13, 2010 response. As used in this manner in the marketplace, it is inescapable that the mark "WOOL WARRIORS" is a reference to Applicant's sheep riding competition for children.

Also relevant but not evaluated is the fact that the second element of the *Budge* deceptiveness test requires that "prospective" purchasers be the ones that must be likely to believe the Applicant's goods are made of wool. The word "prospective" means that the consumers are potential, likely or expected purchasers and therefore presupposes familiarity with the goods or the source of the goods to be purchased. Accordingly, prospective purchasers of Applicant's goods will either be familiar with the Applicant and its children's sheep riding competition or familiar with Applicant's product line promoting the sheep riding competitions. Such prospective purchasers will view Applicant's mark "WOOL WARRIORS" as a reference to the sheep riding competitions. In light of how the mark is used by the Applicant in commerce, it is nonsensical that a prospective purchaser of the Applicant's goods would separate the mark into two parts and believe Applicant's products are made of wool.

Additionally, just because clothing can be made of wool does not mean prospective purchasers would believe the word describes the material of the Applicant's clothing. *In re the Stroh Brewery Co.*, 34 USPQ2d 1796 (TTAB1994) (fact that the term is descriptive of certain types of goods, e.g., nonalcoholic "bloody mary," does not mandate finding of descriptiveness for other goods, even if related). Applicant's goods are made of cotton as are the majority of casual clothes. *See* Exhibit D of Applicant's December 13, 2010 response. Consumers seeking casual clothing such as offered by the Applicant know that the majority of such clothing like t-

shirts and sweatshirts are made of cotton, which makes it improbable that a consumer would believe Applicant's t-shirts and other identified casual clothing are made of wool. *See Id.* The Examining Attorney's evidence demonstrates only that clothing can be and is made of wool, not that the prospective purchasers of the Applicant's goods will believe Applicant's clothing is made of wool.

In the analogous case, *In re Robert Simmons, Inc.*, 1952 USPQ 331, 333 (TTAB 1976), the Board held that the mark "WHITE SABLE" was not deceptive when used on paint brushes because consumers merely contemplating the goods would be able to draw the correct conclusion that they were not made of sable. *See also e.g.*, *In re Kernoghan Brune Ltd.*, WL 1766320 (TTAB 2002) (BLUE RUBY as a whole deemed not deceptive although the word "RUBY" in the mark described Applicant's jewelry because consumers would not believe when viewing the complete mark "BLUE RUBY" that Applicant's jewelry contains blue rubies because blue rubies do not exist.) Similarly, consumers of Applicant's casual clothing products will immediately understand that the products are made of cotton and draw the conclusion that the mark was a reference to the Applicant's sheep riding competitions and not a reference to the composition of the goods.

Making it even more unlikely that prospective purchasers would believe Applicant's goods are made of wool is the fact that Applicant's products can be purchased only on-line at its website or at its actual sheep riding events. *See* Exhibit C of Applicant's December 13, 2010 response. The marketplace in which the deceptiveness of Applicant's mark must be analyzed, therefore, is quite limited and very clearly tied to Applicant's sheep riding competitions for kids. Consumers coming across Applicant's goods labeled with the "WOOL WARRIORS" mark would see that the mark is used on clothing with sheep drawings and other references to sheep and would also see that such clothing is offered in connection with Applicant's sheep riding

competition because these goods are advertised and available only on-line at Applicant's website or at the actual sheep riding events. The context of how the mark is used and the market in which the goods labeled with the mark are sold make it highly unlikely that the prospective purchasers would construe the mark in any other manner than as a reference to Applicant's sheep riding competitions.

3. The Mark "Wool Warriors" is Not Likely to Affect A Significant Portion of the Relevant Consumers' Decision to Purchase Applicant's Goods

Even if consumers were to believe erroneously that the mark "WOOL WARRIORS" describes the Applicant's clothing good, this would still not affect a significant portion of the relevant consumer's decision to purchase Applicant's goods. The relevant consumers of Applicant's clothing goods are (1) seeking casual clothing and (2) are familiar with the Applicant and its sheep riding competitions for children. These relevant prospective purchasers would understand that the "WOOL" in "WOOL WARRIORS" does not describe/misdescribe Applicant's goods.

The Examining Attorney concludes that the erroneous belief by consumers that Applicant's goods are made of wool would materially affect the decision to purchase such goods based on the fact that wool may be considered to be "a superior and desirable fiber for clothing." In this case, wool is unlikely to be a superior and desirable fiber. A person seeking in-expensive, casual, light-weight and non-insulating clothing such as a t-shirt would not find wool to be a superior and desirable fabric. *See* Examining Attorney's evidence submitted with the July 10, 2010 action; properties of wool. Consequently, a belief that wool was used in the Applicant's goods will not affect the relevant consumer's decision to purchase the casual clothing offered by the Applicant.

In *In re Lyphomed Inc.*, 1 USPQ2d 1430 (TTAB 1986), the Board held that the letters P.T.E. stood for "parathyroid extract" and were misdescriptive but that the mark was not deceptive because the only prospective purchasers for the product were knowledgeable doctors and pharmacists who, in view of the medicinal use of the product, would not believe that the goods had parathyroid extract. In reviewing whether or not the mark "POWER STEP" was deceptive as applied to golf clubs, the Board in *Northwestern Golf Company v. Acushnet Company*, 226 USPQ 240, 243 (TTAB 1985) concluded the mark was not deceptive and that "it is very difficult to see how purchasers could be deceived by the mark into believing that the shaft has but one step when even a quick glance at the golf club will reveal that it has a multi-step shaft construction, and purchasers are not likely to purchase golf clubs without looking at them first." Similarly, in *In re Econoheat, Inc.*, 218 USPQ 381, 383 (TTAB 1983), the Board held that SOLAR QUARTZ, as applied to electric space heaters, was neither deceptively misdescriptive nor deceptive stating that "inasmuch as the probable reaction of the public is the key issue and since even a casual perception of Applicant's heaters reveals that they operate just like any other electrical appliance [designed to be plugged into an electrical outlet], we do not believe that the public would be deceived into believing Applicant's goods are solar-powered." Similar to the cases above, use of "WOOL WARRIORS" will not lead the relevant prospective purchasers to believe the goods are made of wool. Consumers easily can view the goods, will be familiar with sheep riding competitions and will know that "WOOL WARRIORS" is a reference to the sheep riding competitions.

CONCLUSION

In conclusion, Applicant's mark was not adequately or fully examined under the three deceptiveness criteria established in *In re Budge*. Specifically, the mark was not evaluated in its entirety, was not examined in terms of how the mark is used in the marketplace and the

perception of a significant portion of the relevant consumers was not analyzed properly. A complete analysis of Applicant's mark under *Budge*'s specifically stated deceptiveness criteria shows that the mark "WOOL WARRIORS" is not deceptive because (1) the mark in its entirety is suggestive and not misdescriptive; (2) prospective purchasers of the Applicant's clothing goods would not believe the Applicant's products were made of wool because of the manner and marketplace in which the mark is used; and (3) a significant portion of the relevant consumers of Applicant's clothing goods would not be affected by the use of "WOOL" as a part of the mark because consumers seeking casual clothing on-line at Applicant's website or at Applicant's sheep riding competitions, would not believe that "wool" described the material of the Applicant's clothing and would not want the material to be wool.

In view of the foregoing, application respectfully requests the reversal of the Examining Attorney's decision.

Date: February 28, 2011

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