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TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Isaac Daniel Group, Inc.

Serial No. 77885250

Carol N. Green, Esq. for Isaac Daniel Group, Inc.

Tina Brown, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Quinn, Mermelstein and Kuczma,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Isaac Daniel Group, Inc. filed, on December 3, 2009, an intent-to-use application to register the term COVERT ALARM LOCATOR APPARATUS for "shoes, footwear, t-shirts, sports shirts, sports jerseys, sports jackets, sports pants, sports fleece pullovers" in International Class 25.

The trademark examining attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that applicant's proposed mark, when applied to the goods, is merely descriptive thereof.

When the refusal was made final, applicant appealed. Both applicant and the examining attorney filed briefs, and both appeared at an oral hearing.

Applicant argues that the examining attorney's refusal is "premature" inasmuch as the application is based on an intention to use the mark in commerce. Further, applicant contends that the examining attorney impermissibly dissected applicant's mark rather than considering the mark in its entirety which, applicant urges, results in a combination of terms that creates a unitary mark with a unique, non-descriptive meaning. According to applicant, its mark is, at worst, just suggestive of applicant's goods; prospective customers would be required to engage in a multi-step thought process or use his/her imagination to discern a feature or characteristic of the footwear and wearing apparel: "Consumers must go through an additional mental step of recognizing that, as applied to Applicant's goods, 'COVERT ALARM LOCATOR APPARATUS' does not refer to a secret warning or security device for use in finding someone or something but rather clothing, shoes or other wearing apparel that may include a hidden device with a GPS locator apparatus." (Brief, p. 8).

The examining attorney maintains that the proposed mark is a combination of merely descriptive terms that creates a merely descriptive composite mark in its entirety. According to the

examining attorney, the combination indicates that applicant's goods feature a secret warning or security device for use in finding someone or something. In support of the refusal the examining attorney introduced dictionary definitions of each of the terms in the proposed mark, as well as other terms; excerpts of applicant's website; excerpts of applicant's patent that covers the technology featured in applicant's goods; and excerpts of third-party websites showing the use of similar technology that is covertly embedded in clothing.

We first turn to dispose of applicant's argument that the examining attorney prematurely refused registration because the involved application is based on an intention to use.

Applicant's argument is not persuasive. An examining attorney will examine, to the fullest extent possible, an intent-to-use application for registrability under the appropriate statutory sections, including Section 2(e)(1), according to the same procedures and standards that apply to any other application. Given the examining attorney's evidence relating to applicant's goods and the use of similar technology by third parties, the examining attorney clearly was in a position to effectively examine the application and make a substantive refusal based on the evidence. TMEP § 1102.01 (Oct. 2012) ("The examining attorney should investigate all possible issues regarding registrability through all available sources.").

With respect to the substantive refusal, a mark is deemed to be merely descriptive of goods or services, within the meaning of 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. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828 (TTAB 2007); and *In re Abcor Development*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A mark need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; rather, it is sufficient that the mark describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a mark is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with the goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services because of the manner of its use. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). It is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to

convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002).

When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. *See, e.g., In re Petroglyph Games, Inc.*, 91 USPQ2d 1332 (TTAB 2009) (BATTLECAM is merely descriptive of computer game software); *In re Tower Tech Inc.*, 64 USPQ2d at 1317 (SMARTTOWER is merely descriptive of commercial and industrial cooling towers); and *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS is merely descriptive of computer programs for use in development and deployment of application programs).

The examining attorney introduced dictionary definitions of each term appearing in applicant's proposed mark as follows:

COVERT: secret: not intended to be known, seen, or found out;

ALARM: warning device: a device for giving a warning of danger; security device: a security device fitted to property;

LOCATOR: finding aid: a device that helps somebody locate something; and

APPARATUS: equipment: a piece of machinery, a tool, or a device used for a specific purpose.

Encarta World English Dictionary (North American Ed. 2009). The record also shows that the abbreviation "GPS" means "global positioning system: a system for finding exactly where you are anywhere in the world using satellites."

(www.macmillandictionary.com).

The record includes excerpts of applicant's patent (No. 7265666 for an invention entitled "Footwear covert alarm and locator apparatus") claiming the technology embedded in applicant's footwear:

An **alarm** apparatus comprising: (a) an article of footwear comprising a sole and a boot connected to said sole; (b) an **alarm** circuit for generating an **alarm** signal, said **alarm** circuit being positioned within, and concealed by, said sole of said footwear, said **alarm** circuit including means for determining the location of said **alarm** apparatus and means for encoding said location in said **alarm** signal; (c) a **covert** activation switch for selective activation by the wearer of said footwear, said **covert** activation switch being positioned on an exterior surface of said boot and electrically connected to said **alarm** circuit, said **covert** activation switch being hidden from view; and (d) means for transmitting said **alarm** signal, said means for transmitting being connected to said **alarm** circuit, wherein upon activation of said **covert** activation switch, said **alarm** signal is generated by said **alarm** circuit and said **alarm** signal, including said encoded location, is transmitted by said transmitting means for receipt at a remote location thereby notifying a remote user that a local user is in distress and simultaneously notifying said remote user of the location of said **alarm** apparatus.

The present invention relates generally to footwear and, more specifically, to footwear having an **alarm** circuit that can be selectively engaged by the user to transmit a coded

signal to a monitoring authority. The **alarm** circuit is comprised of circuit board, battery, processor, switch and wiring. The **alarm** circuit further includes a global positioning system (GPS) for sending location data to the monitoring authority. The **alarm** circuit is selectively operable via a covered switch for preventing false **alarms**. The cover can serve as camouflage rendering switch location variable and **covert**.

An improved **covert alarm locator apparatus** comprising: (a) a removable electronics module, said removable electronics module comprising: (1) location determining circuitry; (2) communications circuitry; (3) logic and control circuitry; and (4) means for interconnecting said location determining circuitry, said communications circuitry, and said logic and control circuitry to one another and to an external connector; (b) a wearable or carryable article selected from the group consisting of apparel and carryable items, said article comprising: (1) a receptacle for receiving said removable electronics module; (2) connection means for making electrical connection to said external connector; and (3) a **covert** activation switch for selectively initiating the transmission of an **alarm** signal by said communications circuitry, said **alarm** signal being encoded with the location of said **covert alarm locator apparatus** as determined by said location determining circuitry; and (c) power supply means for powering said circuitry within said removable electronics module, wherein said location determining circuitry is a GPS receiver which is combined with said communications circuitry in a single cellular phone based unit, whereby the initial fix for said location determining circuitry is based on the location of the nearest cell phone towers, whereby the initial fix can be rapidly and accurately determined. (emphasis added by the examining attorney).

As shown by the above patent excerpts, applicant uses the terminology "covert alarm locator apparatus" in a descriptive, if not generic manner, in two of its patent claims. "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same..." 35

U.S.C. § 112.¹ See Manual of Patent Examining Procedure (MPEP) § 608.01(k) (Aug. 2012). Applicant's type of use of the applied-for mark in its claims is antithetical to the definition and purpose of a trademark. In this regard we also note that a trademark may be used in patent specifications "if [the trademark] is distinguished from common descriptive nouns by capitalization." MPEP § 608.01(v). Patent examiners are instructed to inform applicants to "capitalize each letter" of the trademark or "include a proper trademark symbol, such as ™ or ® following the word." In its patent, applicant did not identify COVERT ALARM LOCATOR APPARATUS as a trademark, nor did the examiner request applicant to do so.

The examining attorney also introduced excerpts of applicant's website describing applicant's goods and the technology associated therewith:

There's No Hiding with **GPS Shoes**... Be careful of that new pair of shoes the significant other gives you as a Christmas present: **they could be used to monitor your location**. The latest pair in Isaac Daniel's spouse-locating footwear--the Compass and Blue **GPS shoes**--now includes Bluetooth that is capable of talking to a Bluetooth-capable phone... As reported here by Navigadget, Isaac Daniel's original **GPS shoes used the Covert Alarm Locator to broadcast the user's location in case of an emergency**.

¹ This section was amended in 2012, but the revision does not apply to applicant's patent which issued in 2007.

Isaac Daniel develops and commercializes visionary and practical fashion and sports technology solutions based on **embedded Global Positioning Systems (GPS) technology and Location-Based Services (LBS)** for use by individuals and organizations... Highly secure, Isaac Daniel **products transmit positioning at the wearer's demand and authorization**, ensuring total user privacy while providing quality and convenience for real-life situations.

Isaac Daniel is an inventor and designer of high-tech products who has created a full line of **wearable technology delivered in fashionable accessories**... The original inventor of **GPS embedded shoes**, Isaac Daniel introduced the first line of **footwear designed for consumers that offered embedded technology for personal security via human logistics. These products provided a way to track a wearer's location**, yet was fully customizable - leaving privacy controls in the owner's hands to add or restrict information sharing.

Fashionable footwear from Nike and Adidas may deliver style and prestige, but they haven't got what Isaac Daniel's Compass™ shoes deliver - peace of mind, thanks to an **embedded microcomputer and GPS device**... The Compass™ brand **incorporates a GPS module allowing authorities to locate a missing or endangered loved one -within a yard's distance -** - almost immediately, using the patented Quantum Satellite Technology (QST) and a monitoring service called ID Conex. Unlike cell-phone based GPS tracking devices, the **GPS technology utilized by Compass™ shoes** locks out unauthorized users from knowing the location of a loved one - information only trained ID Conex employees at one of their global monitoring stations are authorized to access and pass on to law enforcement agencies.

The first sneakers in the world to contain a 'Covert Alarm Locator Apparatus' in the form of a tiny GPS chip. This chip can do lots of things like monitoring your heart rate speed and body temperature, **acting as a location beacon to help people find you.** The sneakers also have a wireless Bluetooth mic and speaker embedded, so you can call for help or otherwise look rather strange talking to your shoes... **This hi-tech shoe comes with Quantum Satellite Technologies, GPS enabled devices located in a hidden part of the shoes.** (emphasis added by the examining attorney).

It is clear from the above that applicant offers goods featuring "embedded GPS (Global Positioning System) technology." Indeed, applicant indicated that it "intends that the goods identified by the mark 'COVERT ALARM LOCATOR APPARATUS' will include a GPS locator device that will allow monitoring of the device and ultimately the wearer." (Response, 03/31/2011).

We acknowledge applicant's argument that purchasers would not necessarily associate or expect GPS technology in clothing and footwear. This argument is belied, however, by additional evidence of record showing a trend in the industry to embed GPS technology in such goods, and by applicant's own promotion of its goods with such a feature. Examples of such use by third parties include the following:

For many people, GPS is still a new gadget for outdoor enthusiasts and the military, but GPS technology is actually becoming integrated into everyday life. There is no better example of this than GPS clothing... GPS clothing isn't particularly different from the clothes you are wearing now. It simply has a GPS transponder sewn into them. (www.gps.toptenreviews.com)

Lightning GPS has come up with easy-to-use covert devices which can give you the peace of mind that keeps you awake at night....Lightning GPS works hard to develop the best Child Tracking GPS devices available on the market today....GPS Jackets, GPS Strollers, GPS Clothing, GPS backpacks all use Lightning GPS hardware built into their design. (www.lightninggps.com)

Solar-powered GPS-trackable clothing...Covert Asset Tracking Systems, a company based in the UK, has just announced plans for producing a solar-powered GPS-trackable clothing range...The wearer of the clothes can be located from almost anywhere in the world and from any internet connection. The clothing is also waterproof, machine-washable, and solar-powered so that it never has to be recharged.
(www.slashgear.com)

If a newborn baby has a covert GPS tracking system in their clothing and was taken from the hospital nursery parents could easily locate their missing child.
(www.tracking-system.com)

Based on the evidence of record, we agree with the examining attorney's assessment that the proposed mark is a combination of merely descriptive terms that, when combined, form a merely descriptive mark as a whole. The proposed mark merely indicates that applicant's goods feature a secret warning or security device for use in finding someone or something. The combination of merely descriptive terms does not evoke a new and unique commercial impression. Rather, each component of the composite mark retains its merely descriptive significance in relation to applicant's goods, thus resulting in a composite that is itself merely descriptive. *DuoProSS Meditech Corp. v. Inviro Medical Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753 (Fed. Cir. 2012) (SNAP SIMPLY SAFER is merely descriptive for "medical devices, namely, cannulae; medical, hypodermic,

aspiration and injection needles; medical, hypodermic, aspiration and injection syringes"); and *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004) (PATENTS.COM is merely descriptive of computer software for managing a database of records that could include patents for tracking the status of the records by means of the Internet). No imagination is required by a prospective purchaser or user to discern that applicant's clothing and footwear feature a covert alarm apparatus to locate someone or something.

Although applicant asserted that its proposed mark has a separate unitary meaning, applicant never indicated what this separate, unitary, incongruous or otherwise non-descriptive meaning is in relation to the identified goods. Further, the fact that applicant may be the first and only user of the specific combination "covert alarm locator apparatus" is not dispositive, where, as here, the evidence shows that the composite mark as a whole is merely descriptive. *See, e.g., In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001).

Decision: The refusal to register is affirmed.