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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Retail Royalty Company

Serial Nos. 77791067 and 77979784

Theodore R. Remaklus of Wood, Herron & Evans for Retail Royalty Company.

Aaron Brodsky, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney) for Serial No. 77791067.

Cory Boone, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney) for Serial No. 77979784.

Before Quinn, Kuhlke and Taylor, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Retail Royalty Company filed applications to register the mark AMERICAN EAGLE OUTFITTERS (in standard characters) for "retail store services and online retail store services in the field of fragrances, cosmetics and personal care

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products, and jewelry" in International Class 35;¹ and the mark shown below



for "perfume, cologne, body wash, body lotion and shave balm" in International Class 3.²

The trademark examining attorney refused registration in each application due to applicant's failure to comply with a requirement to disclaim the term "outfitters" apart from the mark as used in connection with applicant's goods and services. According to the examining attorney, the term is merely descriptive of applicant's goods and services.

When the requirement was made final, applicant appealed. Applicant and the examining attorney filed briefs.³

¹ Child application Serial No. 77979784, filed February 26, 2009, alleging first use anywhere in 1977, and first use in commerce in May 1998.

² Application Serial No. 77791067, filed July 28, 2009, alleging a bona fide intention to use the mark in commerce.

³ Applicant, in its brief, objected to the dictionary definitions attached to the final refusal because it is the Board's policy to not take judicial notice of online definitions that are not available in print format. Applicant's objection is not well taken. The situations relied upon by applicant pertain to online

The examination of the applications was handled by two different examining attorneys. The evidentiary records adduced by the examining attorneys are similar, but not identical. The appeals involve common issues of law and fact, and we will consider the cumulative evidence introduced by the different examining attorneys in making our determination regarding the disclaimer requirement in each application.⁴ A consideration of all of the evidence together will result, we believe, in a more complete analysis. Accordingly, we will issue our decision in this single opinion.

The Arguments

Applicant argues that the common meaning of the term "outfitters" is someone who deals in equipment and supplies for expeditions and camping trips. According to applicant,

dictionary evidence that is submitted *after* the appeal when judicial notice is required. See Trademark Rule 2.142(d). In the present case, however, the online dictionary evidence properly was made of record during examination, and judicial notice is not required. See *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); and TBMP §1208.04 (2d ed. rev. 2004). Accordingly, the objection is overruled and the additional definitions made of record with the final refusal are part of the record on appeal, and this evidence has been considered in reaching our decision. Applicant also objected to the online dictionary definitions submitted for the first time with the examining attorney's brief. Inasmuch as the dictionaries also appear in a printed form, the objection is overruled, and they have been considered in making our decision.

⁴ We see no reason to designate any evidence by the serial number of the application in which it was filed, or to identify the specific examining attorney who introduced the evidence.

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the evidence fails to establish that the term is merely descriptive of the particular goods and services offered by it. More specifically, applicant contends that the definitions of record show that the term "outfitter" identifies a retailer that deals in clothing, equipment, supplies and services for expeditions, camping trips or outdoor activities, and that the term does not have a descriptive meaning when used in connection with the personal care goods and services related thereto listed in the involved applications. Applicant states that the examining attorney is asking the Board to base a decision not on the identified goods and services, but rather on all of the goods and services sold by applicant. Applicant essentially argues that the examining attorney has expanded the meaning of the term "outfitter" by parsing dictionary definitions so as to encompass the type of goods and services offered by applicant. As for applicant's prior registrations that include a disclaimer of "outfitters," applicant contends that each application must be considered on its own merits, and that registrations issued "years ago" should not be controlling now, especially inasmuch as applicant's consent to those disclaimers was "erroneous." In support of its position, applicant submitted dictionary definitions of the term "outfitter," and copies of some of

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its own registrations, as well as third-party registrations, showing that there are no disclaimers of the term "outfitters" apart from the registered marks.

The examining attorney maintains that a term that names the type of establishment from which goods come is merely descriptive. More specifically, the examining attorney asserts that the term "outfitters" is descriptive because an "outfitter" is a commercial establishment that sells clothing, equipment, supplies, furnishings and other requisites. In this connection, the examining attorney states that perfume, body lotion and the like could be considered equipment, supplies, requisites, accessories or furnishings. According to the examining attorney, the term "outfitter" contemplates an establishment that sells more than clothing and equipment for camping trips; instead, the term "outfitter" contemplates an establishment that sells a broader category of clothing, accessories, and related items. While the term "outfitter" may have more specific connotations with clothing and haberdashery, or supplies and equipment particularly relevant to outdoor activities, the definitions of record, the examining attorney contends, are not necessarily so limiting. In support of the refusal the examining attorney relies upon dictionary definitions of the terms "outfitter" and others, as well as copies of

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some of applicant's prior registrations, and third-party registrations showing disclaimers of "outfitter(s)." The examining attorney also submitted examples retrieved from the Internet of third parties using the term "outfitter(s)" in connection with their business or store names.

At the outset, it is noted that application Serial No. 77979784 is a "child" application. The "parent" application is application Serial No. 77679197. Pursuant to the applicant's request to divide, the following services remained in the "parent" application: "retail store services and online retail store services in the field of clothing, clothing accessories, footwear and headwear, and bags" in International Class 35. In that application, applicant agreed to disclaim the term "outfitters" apart from the mark. The application matured into Registration No. 3888496 on December 14, 2010.

With respect to the division of the service mark application and its impact on his continued requirement for a disclaimer, the examining attorney found "this distinction to be illusory in the first place because the latter items travel [in] the same channels of trade as the clothing items, as the applicant acknowledges in its most recent response. Thus, there is little fundamental difference between the parent and child applications

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because the term 'outfitters' applies to the applicant's retail store services as a whole, single channel of trade, and not piecemeal to the particular items it provides."

(Final Refusal, 8/23/10). The examining attorney maintains that "the services in this [child] application are essentially the same as in the parent application," concluding that "[i]n other words, the applicant's divisional request only serves to create an artificial distinction where no real difference truly exists."

(Brief, p. 8).

The Evidence

Several dictionary definitions are of record. Dictionary definitions of the word "outfitter" include "one that outfits, as a haberdasher; a dealer in equipment and supplies for expeditions or camping trips; a machinist who installs the machinery and mechanical equipment of ships" (Webster's Third New International Dictionary of the English Language (unabridged ed. 1963)); "one who supplies, sells, or makes outfits" (Webster's New Twentieth Century Dictionary (2d ed. 1983)); "a business providing equipment, supplies, and often trained guides (as for hunting trips)" (www.merriam-webster.com); "a store that sells equipment and supplies for outdoor leisure activities such as camping or hunting" (www.encycarta.msn.com); "a person who furnishes,

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sells or makes outfits; a business that provides equipment and supplies for fishing trips, hunting expeditions, etc." (www.yourdictionary.com); and "one who furnishes or makes outfits; one who furnishes the necessary means or equipments for a voyage, journey, or expedition; in general, one who provides the requisites for any business." (www.wordnik.com). The record includes other dictionary listings for the term "outfitter," and all are consistent in setting forth the meaning as follows: "a shop that provides equipment for some specific purpose"; "an outfitter provided everything needed for the safari"; someone who sells men's clothes."⁵ One dictionary indicates that the term "outfitter" has two distinct meanings: "AMERICAN a store that sells clothes and equipment for activities such as camping and hunting; BRITISH OLD-FASHIONED a store that sells clothes, especially men's clothes." (www.macmillandictionary.com). One dictionary indicates that the term is "chiefly British." (www.wiktionary.com). Another dictionary indicates that the context is "mostly UK", defining the term as "a person or shop that sells men's clothes or other specialized

⁵ See, e.g., www.freedictionary.com, www.lookwayup.com, www.mnemonicdictionary.com; and www.rhynezone.com.

clothes or equipment." (www.allwords.com). Wikipedia describes an "outfitter" as

a shop or person that sells men's clothes. More specifically, it is a company or individual who provides or deals in equipment and supplies for the pursuit of certain activities. The term is most closely associated with outdoor activities such as rafting, hunting, fishing, canoeing, hiking and trail riding using pack stations... Furthermore, many retail stores and chains that sell outdoor sports gear are sometimes branding or calling themselves "outfitters"...

The examining attorney also submitted a definition of "haberdasher": "*British*: a dealer in notions; a dealer in men's clothing and accessories." The examining attorney further introduced definitions, retrieved from www.merriam-webster.com, of the words "equipment," "supplies," "requisite," "accessory" and "furnishing." In this connection the examining attorney contends that perfume, cologne, body wash, body lotion and shave balm can be considered as equipment, supplies, requisites, accessories or furnishings. The definitions include the following:

Equipment: the set of articles or physical resources serving to equip a person or thing.

Supplies: the quantities of goods or services offered for sale at a particular time or at one price.

Requisite: essential; necessary.

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Accessory: an object or device not essential in itself but adding to the beauty, convenience, or effectiveness of something else.

Furnishing: an article or accessory of dress, usually used in plural.

Applicant owns several subsisting registrations of the mark AMERICAN EAGLE OUTFITTERS, including two that cover goods in International Class 3: Registration No. 2344282 for "soap; moisturizing body lotion; and shower gel"; and Registration No. 2393861 for "perfume." In each instance, the term "outfitters" is disclaimed.

Applicant also owns the following registrations for the mark AMERICAN EAGLE OUTFITTERS: Registration No. 1597199 for "compasses and portable personal thermometers for measuring environmental temperature; flashlights; and travel diaries"; Registration No. 1916360 for "jewelry, namely, necklaces, earrings, and wristwatches"; Registration No. 2086693 for "clothing" and "retail clothing services"; Registration No. 2191681 for "nonprescription sunglasses"; and Registration No. 3490875 for "cosmetic bags sold empty." As set forth above, Registration No. 3888496 recently issued for "retail store services and online retail store services in the field of clothing, clothing accessories, footwear and headwear, and

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bags." In each instance, there is a disclaimer of "outfitters."

Other registrations for AMERICAN EAGLE OUTFITTERS owned by applicant include the following: Registration No. 1893331 for "credit card services"; Registration No. 3534042 for "toys, namely plush toys"; and Registration No. 3660634 for "financial services, namely, issuing stored value cards that may be redeemed for the purchase of goods." In each instance, there is no disclaimer of the term "Outfitters."

Also of record are numerous third-party registrations of marks that include the term "Outfitter(s)" as a portion thereof. The vast majority of the registrations covers clothing and footwear, and/or retail store services featuring clothing and related goods. Most of the registrations include a disclaimer of the term "outfitters." There are several other third-party registrations, however, that do not include a disclaimer when the term is included in a mark covering goods that are not clothing or services related to clothing. (See, e.g., ADVANCED FURNITURE OUTFITTERS, BATTERY OUTFITTERS, SLEEP OUTFITTERS, INTELLIGENCE OUTFITTERS, INDOOR OUTFITTERS, and DEVICE OUTFITTERS).

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The examining attorney submitted excerpts of a few third-party websites showing use of the term "Outfitter(s)" in connection with a variety of retail businesses. (See, e.g., URBAN OUTFITTERS, BARGAIN OUTFITTERS, and THE SWIMMER'S OUTFITTER).

The Law

The examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Section 6 of the Trademark Act, 15 U.S.C. §1056. This section of the statute was amended in 1962 to allow the exercise of greater discretion by examining attorneys in determining whether a disclaimer is necessary. See TMEP §1213.01(a) (7th ed. 2010). Merely descriptive or generic terms are unregistrable under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), and therefore are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); and *In re Box Solutions Corp.*, 79 USPQ2d 1953 (TTAB 2006).

The examining attorney bears the burden of showing that a term is merely descriptive of the relevant goods and/or services. *In re Merrill, Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir.

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1987). A term is descriptive if it "forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [and/or services]." *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 765 (2d Cir. 1976) (emphasis added). See *In re Abcor Development Corp.*, 616 F.2d 525, 200 USPQ 215 (CCPA 1978). Moreover, in order to be descriptive, the term must immediately convey information as to the qualities, features or characteristics of the goods and/or services with a "degree of particularity." *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199, 1204-1205 (TTAB 1981). See *In re Diet Tabs, Inc.*, 231 USPQ 587, 588 (TTAB 1986); *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949, 952 (TTAB 1981); *In re TMS Corp. of the Americas*, 200 USPQ 57, 59 (TTAB 1978); and *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

The Board has noted on a number of prior occasions that there is a thin line of demarcation between a suggestive and a merely descriptive designation. To the extent that any of the evidence and arguments based thereon raise doubts about the merely descriptive character of applicant's mark, such doubts are to be resolved in applicant's favor and the mark should be published, thus allowing a third party to file an opposition and develop a

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more comprehensive record. See e.g., *In re Box Solutions*, 79 USPQ2d at 1955; *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992); and *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981).

The Analysis

Based on the evidence of record, we find that the term "outfitters," when used in connection with applicant's personal care products, fragrances, cosmetics, and retail store services featuring such goods, as well as jewelry, is just suggestive. The examining attorney urges that "soap and sunscreen are personal care products that have definite utility in supplies for outdoor activities and camping," and "watches are kinds of jewelry useful in many types of activities like hiking and camping." However, only in the broadest and most general sense does the term "outfitters" even approach being descriptive for the *specific* goods and services identified in the involved applications. We agree with applicant's assessment of this case: "The Examining Attorney resorts to submitting definitions of words appearing in those definitions, and even definitions of definitions of words appearing in the definitions, to cobble together an abstract meaning that, in its broadest sense, could encompass Applicant's goods." (Reply Brief, p. 4). We are not persuaded by the fact that, as stated by

the examining attorney, "applicant does not operate different retail stores, some of which operate as an outfitter of clothing and outdoor goods and some of which feature fragrances, cosmetics, personal care products, and jewelry"; rather, applicant "offers all of these goods in the same stores under the same essential retail services."

(Brief, p. 8).⁶ Be that as it may, mere descriptiveness is determined on the basis of the specific identification of goods and/or services set forth in an application. *In re Allen Electric and Equipment Co.*, 458 F.2d 1404, 173 USPQ 689, 690 (CCPA 1972); *In re Vehicle Information Network Inc.*, 32 USPQ2d 1542, 1544 (TTAB 1994); and *In re Datatime Corporation*, 203 USPQ 878, 879 (TTAB 1979).

⁶ The examining attorney's remarks hint that applicant somehow is impermissibly "carving out" certain services in an attempt to circumvent the disclaimer requirement. Although not cited by the examining attorney, see *In re Reed Elsevier Properties Inc.*, 77 USPQ2d 1649, *aff'd*, 482 F.3d 1376, 82 USPQ2d 1376 (Fed. Cir. 2007); and *In re DNI Holdings Ltd.*, 77 USPQ2d 1435 (TTAB 2005). We do not view the present situation to be similar to the tactics employed by the applicants in those cases in connection with their recitations of services. TMEP §1213 (7th ed. 2010) indicates that "[a] disclaimer may be limited to pertain to only certain classes, or to only certain goods or services." In the present case, applicant originally could have filed two applications setting forth the recitations of services now set forth respectively in the parent and child applications. That this instead was accomplished through a divisional request does not taint applicant's position regarding the specific services now at issue on appeal. Contrary to the gist of the examining attorney's contention, we find that the division of the original application presents a meaningful distinction in terms of the mere descriptiveness of the term "outfitters" for the type of specific services set forth in the child application.

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We have considered the evidence of third-party registrations and uses. Case law recognizes that registrations can be used as a form of a dictionary definition to illustrate how a term is perceived in the trade or industry. *In re J.M. Originals Inc.*, 6 USPQ2d 1300, 1302-03 (TTAB 2001). As indicated above, however, the majority of the third-party registrations that include a disclaimer of "outfitter(s)" covers clothing, footwear and/or services featuring such goods. This evidence is simply outweighed by the other evidence showing that the term is only suggestive for the specific goods and services involved herein. Further, the third-party uses are minimal in number, and most are in connection with clothing.

An interesting twist in the present applications is brought out by applicant's ownership of several prior registrations. As indicated earlier, applicant's previously issued registrations of the mark AMERICAN EAGLE OUTFITTERS present a mixed bag, that is, some include disclaimers of "outfitters" while others do not. In considering the merits of registration herein of the same mark for "perfume, cologne, body wash, body lotion and shave balm," and "retail store services and online retail store services in the field of fragrances, cosmetics and personal care products, and jewelry," we have paid

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particular attention to the fact that in Registration No. 2344282 for "soap; moisturizing body lotion; and shower gel," and in Registration No. 2393861 for "perfume," applicant disclaimed the term "outfitters." Further, Registration No. 1916360 for, *inter alia*, "jewelry" includes a disclaimer of "Outfitters."

Section 6(b) of the Trademark Act, 15 U.S.C. §1056(b), provides that "No disclaimer...shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter be or shall have become distinctive of his goods or services." TMEP §1213.11 (7th ed. 2010) reads, in pertinent part, as follows:

It is now clear that, aside from generic matter, disclaimed matter is not forever barred from registration, and it can subsequently be considered for registration on either the Principal or Supplemental Register. When an application is filed seeking registration of matter previously disclaimed, it should be examined in the same matter as other applications. See *Quaker Oil Corp. v. Quaker State Oil Refining Corp.*, 161 USPQ 547 (TTAB 1969), *aff'd*, 453 F.2d 1296, 172 USPQ 361 (CCPA 1972); *Victor Tool & Machine Corp. v. Sun Control Awnings, Inc.*, 299 F.Supp. 868, 162 USPQ 389 (E.D. Mich. 1968), *aff'd*, 411 F.2d 792, 162 USPQ 387 (6th Cir. 1969).

Whether or not previously disclaimed matter has become eligible of registration depends on the circumstances and the evidence adduced in the examination process. *Helena Rubinstein, Inc. v. Ladd*, 219 F.Supp. 259, 138 USPQ 106 (D.D.C. 1963), *aff'd*, 141 USPQ 623 (D.C. Cir. 1964); *Roux Distributing Co., Inc. v. Duart Mfg. Co. Ltd.*, 114 USPQ 511 (Comm'r Pats. 1957).

Trademark rights are not static, that is, such rights do not remain constant over time. As the late Judge Rich observed: "Rights in this field do not stay put. They are like ocean beaches; they shift around. Public behavior may affect them." Rich, "Trademark Problems As I See Them-- Judiciary," 52 Trademark Rep. 1183, 1185 (1962). The state of the register, including applicant's own portfolio of marks, shows that the perception of "outfitter(s)" has varied over time. Notwithstanding the status and treatment of the term "outfitters" in the past, the dictionary evidence herein demonstrates that the term is only suggestive when used in connection with personal care products, fragrances, and cosmetics, and retail store services featuring these goods, as well as jewelry.

Moreover, each case must be decided on its own facts, based on the evidence that is presented in the record before us. We are not privy to the files in applicant's prior registrations inasmuch as the file histories are not

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part of the record. See *In re Thomas Nelson Inc.*, 97 USPQ2d 1712, 1713 (TTAB 2011). Thus, it is unknown whether the prior disclaimers in applicant's Registration Nos. 2344282 and 2393861 were made pursuant to the examining attorney's requirement, or rather were made voluntarily. See *In re MCI Communications Corp.*, 21 USPQ2d 1534 (Comm'r Pats. 1991). Given applicant's argument that the prior disclaimers were "erroneous," we suspect that they were made to comply with a requirement. So as to be clear, however, we cannot be certain in the absence of the file histories. In any event, although consistency in examination and the register are commendable goals, we are not bound by the prior actions of examining attorneys. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("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."). See also *In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (although Board is "somewhat troubled" by applicant's prior Supplemental Register registrations of the same or similar marks, genericness still found based on the clear evidence of record). Given that trademark rights are not static, we do not view applicant's prior disclaimers, even when the same

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mark and the same goods/services are involved, as preventing applicant from now claiming that the disclaimed term is not merely descriptive.

We have considered applicant's disclaimers in its prior registrations "as merely illuminative of shade and tone in the total picture confronting the decision maker." *See Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978). "Under no circumstances, may a party's opinion, earlier or current, relieve the decision maker of the burden of reaching his own ultimate conclusion on the entire record." *Id.* *See also Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ 1633, 1640 (TTAB 1999).

Considering the totality of the evidence, we find that the record supports a finding that a disclaimer of the term "outfitters" is not required in either application. We conclude that the term "outfitters" is not merely descriptive as used in connection with applicant's specific goods and services identified in the involved applications. Any doubt has been resolved in applicant's favor.

Decision: The refusal to register based on the failure to comply with a disclaimer requirement is reversed in each application.