Mailed: September 10, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

Trademark Trial and Appeal Board

_____

In re Scott McKeever

_____

Serial No. 78919885

_____

Susan M. Natland of Knobbe, Martens, Olson & Bear, LLP for Scott McKeever.

Mark F. Pilaro, Trademark Examining Attorney, Law Office 104 (Chris Doninger, Managing Attorney).[1]

_____

Before Grendel, Kuhlke and Walsh, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Scott McKeever, applicant, has filed an application to register the mark MY HORSE PLAYER (in standard character form) on the Principal Register for "computer software, namely, software for use in connection with handicapping of races and horse races" in International Class 9, "providing information via a global computer network relating to handicapping of races and horse races" in International

[1] The application was reassigned to the above-noted examining attorney for the preparation and the filing of the brief.

Class 41, and "application service provider services, namely, providing computer software applications for use in handicapping of races and horse races" in International Class 42.[2]

The examining attorney has refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark is merely descriptive of his goods and services. After the examining attorney made the mere descriptiveness refusal final, applicant requested reconsideration and filed this appeal. On January 3, 2008, the examining attorney denied the request for reconsideration and the appeal was resumed. Both applicant and the examining attorney have filed briefs. We reverse the refusal to register.

As a preliminary matter, we address the examining attorney's contention that the Board should give weight to applicant's offer to disclaim HORSE PLAYER during the prosecution of this application and consider it a concession that HORSE PLAYER is merely descriptive. In response to the first Office Action the applicant included the following statement:

[2] Application Serial No. 78919885, filed on June 29, 2006, under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), alleging a bona fide intention to use the mark in commerce.

> With respect to the Section 2(e)(1) refusal, Applicant is willing to disclaim HORSE PLAYER apart from the mark as shown, but for the following reasons Applicant respectfully disagrees that the mark as a whole is merely descriptive.

June 1, 2007 Response p. 1.

Applicant further invited the examining attorney to contact applicant to enter an Examiner's Amendment with the disclaimer if the examining attorney agreed to withdraw the refusal. Id. n. 1. Applicant in his request for reconsideration and his brief contends that this statement was not a concession as to the mere descriptiveness of HORSE PLAYER and should not be construed as such.

The examining attorney argues that applicant's offer to disclaim matter is analogous to an applicant's amendment to seek registration based on acquired distinctiveness under Section 2(f), which would be a concession that the matter is merely descriptive.

While a claim of acquired distinctiveness under Section 2(f) may be construed as a concession, if an applicant instead argues that its mark is inherently distinctive but claims, in the alternative, that the matter sought to be registered has acquired distinctiveness under Section 2(f), this does not constitute a concession that the matter is merely descriptive. Compare In re Cabot

Corp., 15 USPQ2d 1224, 1229 (TTAB 1990) with In re E S Robbins Corp., 30 USPQ2d 1540, 1542 (TTAB 1992). See also TMEP Sections 1212.02(b) and 1212.02(c) (5th ed. 2007). Thus, to the extent that there is an analogy, the disclaimer was clearly made in the alternative and cannot serve as a concession.

We now turn to consider the refusal under Section 2(e)(1). "A mark is merely descriptive if it 'consist[s] merely of words descriptive of the qualities, ingredients or characteristics of' the goods or services related to the mark." In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004), quoting, Estate of P.D. Beckwith, Inc. v. Commissioner, 252 U.S. 538, 543 (1920). See also In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003). "Whether a given mark is suggestive or merely descriptive depends on whether the mark 'immediately conveys ... knowledge of the ingredients, qualities, or characteristics of the goods ... with which it is used,' or whether 'imagination, thought, or perception is required to reach a conclusion on the nature of the goods.'" In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987) citing In re Qwik-Print Copy Shops, Inc., 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980).

See also In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

The mere combination of descriptive words does not necessarily create a nondescriptive word or phrase. In re Associated Theatre Clubs Co., 9 USPQ2d 1660, 1662 (TTAB 1988). 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. In re Oppedahl & Larson LLP, supra. However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, nondescriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods. See In re Colonial Stores Inc., 394 F.2d 549, 157 USPQ 382 (CCPA 1968); In re Shutts, 217 USPQ 363 (TTAB 1983); and TMEP Section 1209.03(d).

It is the examining attorney's position that MY HORSE PLAYER is comprised of merely descriptive components, which retain their merely descriptive significance when combined. Specifically, he argues that HORSEPLAYER is defined as "one who regularly bets on horse races." The American Heritage Dictionary of the English Language (4th ed. 2000), retrieved from Bartleby.com. Based on this definition, the examining attorney concludes that HORSE PLAYER is merely descriptive

of the intended users of the goods and services. The examining attorney also argues that HORSE PLAYER may refer to a provider of the goods or services.

Further, the examining attorney argues that the separate components HORSE and PLAYER are merely descriptive of a feature of the goods and services. Specifically, the word HORSE is merely descriptive of the goods and services in that "all the goods and services are expressly used in connection with horse races," (Br. p. 6), and the word PLAYER is descriptive of the goods and services inasmuch as they are used in connection with betting on horse races, and "in the context of horse races, 'play' means 'to participate in betting' or 'gamble'." Id. citing The American Heritage Dictionary of the English Language (4th ed. 2006).[3] Thus, according to the examining attorney, together, the terms HORSE and PLAYER "have the meaning of something used in playing horses, just as a record player is a thing used to play records. As both the services and goods here are used to play horses, the wording HORSE

[3] The Board may take judicial notice of dictionary definitions. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). Applicant objected to the examining attorney's reference to an online dictionary definition in its brief, and the Board has obtained a definition from a resource that has a printed counterpart. In re CyberFinancial.Net Inc., 65 USPQ2d 1789, 1791 n.3 (TTAB 2002) and In re Total Quality Group Inc., 51 USPQ2d 1474, 1476 (TTAB 1999).

PLAYER is [merely] descriptive of a feature, specifically the nature, of the goods and services." Id.

In support of his position that MY HORSE PLAYER is not merely descriptive, applicant submitted 37 third-party registrations on the Principal Register that include the term MY with disclaimed matter. See, e.g., Reg. No. 3226788 for MY WEB, WEB disclaimed, for inter alia, software for browsing the global computer network; Reg. No. 2800457 for MY ARABIC TEACHER, ARABIC TEACHER disclaimed, for arabic language tutoring software; and Reg. No. 2555241 for MY TRADER, TRADER disclaimed, for computer software for analyzing and evaluating financial information for securities transactions that may be downloaded from a global computer network. The examining attorney responded with 40 third-party registrations where MY is combined with descriptive or generic terms and is on the Supplemental Register, or disclaimed or registered under Section 2(f) based on acquired distinctiveness on the Principal Register. See, e.g., Reg. No. 1947753 on the Supplemental Register for MY FIRST KEYBOARD for learning styled computer keyboard; and Reg. No. 3109083 for MYREGISTRY.COM and design, MYREGISTRY.COM disclaimed, for global online gift registry.

We do not find any of these third-party registrations to be determinative in this case. It is well established that we must determine each case on its own record and prior decisions by examining attorneys are not binding on the Board. In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Moreover, given the number of third-party registrations supporting each position, the only conclusion we may draw is that sometimes "MY" marks have been found to be descriptive and sometimes they have not.

In response to applicant's contention that the combination of MY with HORSE PLAYER is incongruous, the examining attorney argues:

> [MY] serves only as the possessive pronoun identifying the particular customer's chosen 'horse player,' or mode of assistance in handicapping a horse race, be it applicant's goods and services, another firm's software or 'tip sheet,' information services provided through online means, contact with a betting service, or live discussion with another race attendant. Because all of these other sources of assistance can perfectly accurately be described by the customer as 'my horse player,' inclusion of the term MY alone does not indicate the source of the horse player goods or services as applicant or any other provider. ... As such, the significance of the term MY is only as a possessive adjective, and not as a source identifier.
> ... [T]he term MY, in combination with HORSE PLAYER indicates the perfectly congruous meanings of "this is my horse player, or the horseplayer with which I have some relationship, or the horse

> player which I use in playing horses." Applicant's second view, that the mark would be incongruous unless viewed from a third person perspective is also based on much too limited a view of the descriptive significance of the term HORSE PLAYER, as discussed above. The perspective becomes irrelevant for such term, if referring not to horseplayers as individual people, but rather as a good or service used to play horses, since the term is an object. As such, it will always be referred to in the third person, as an object has no perspective. Thus viewing HORSE PLAYER as an object results in no incongruity based on the perspective of the consumer. Indeed, the incongruity claimed by the applicant would likely immediately indicate to that consumer that HORSE PLAYER is used to describe a thing, rather than a person, especially in relation to the goods and services offered under the mark.

Br. pp. 9-10, 17-18.

The last sentence sums it up. The term HORSE PLAYER means a person who places bets on horses, but is used here in connection with a thing that can be used by a horseplayer to assist in betting choices. There are at least two mental steps that one seeing the mark must make to connect it with a significant feature of the goods or services: 1) the viewer must understand that the mark does not refer to the user, that the goods or services are a software program or online service; and 2) the goods or services do not allow a user to place bets or play horses, but assist in handicapping or deciding how to place bets on horses. As for the examining attorney's position that the

mark describes the intended user of the handicapping goods and services, this might be the case if the mark were just HORSE PLAYER. See In re Planalytics, Inc., 70 USPQ2d 1453 (TTAB 2004) (GASBUYER merely descriptive of intended user of risk management services in the field of pricing and purchasing natural gas, evidence of record shows term gas buyer applied to purchasers of natural gas supplies). However, in this case, combining it with MY, turning the user into the mechanism, creates a unitary phrase with sufficient incongruity to require some thought in divining the nature of the goods and services and, thus, the mark does not immediately convey that information.

To the extent the examining attorney is arguing that HORSE PLAYER may also mean a third party hired to place a bet rather than the person handing over the money, there is nothing in the record to support this meaning. Rather, the record clearly establishes that a horseplayer is a person who bets on horses for himself and not a person for hire to take other people's money to bet on horses or to advise other people or handicap races for other people.

In making this determination, we are not finding that the inclusion of the word MY will always make an otherwise merely descriptive mark inherently distinctive. Whether or not the term MY merely describes or only suggests "the

personal or customized nature of particular goods or services, i.e., that the goods or services provided are owned, chosen, customized, personalized or provided by order of a particular user," (Br. p. 10), must be determined on the basis of the particular facts of each case.

"It has been recognized that there is but a thin line of distinction between a suggestive and a merely descriptive term, and it is often difficult to determine when a term moves from the realm of suggestiveness into the sphere of impermissible descriptiveness." In re Recovery, Inc., 196 USPQ 830, 831 (TTAB 1977). Moreover, it is well established that any doubt must be resolved in favor of the applicant. See In re Merrill Lynch, Pierce, Fenner, and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987), citing In re Aid Laboratories, Inc., 221 USPQ 1215, 1216 (TTAB 1983); In re Intelligent Medical Systems, Inc., 5 USPQ2d 1674 (TTAB 1987); and In re Gracious Lady Services, Inc., 175 USPQ 380 (TTAB 1972). In view thereof, we find that the mark MY HORSE PLAYER is not merely descriptive for these goods and services.

Decision: The refusal to register under Section 2(e)(1) is reversed.