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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Mata Dolores

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Serial No. 85309094

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Mata Dolores, *pro se*.

Gina Hayes, Trademark Examining Attorney, Law Office 103
(Michael Hamilton, Managing Attorney).

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Before Quinn, Kuhlke and Ritchie,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Mata Dolores filed, on April 30, 2011, an intent-to-use application to register the mark POCKET HAT (in standard characters) ("HAT" disclaimed) for "hats" in International Class 25.

The 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 mark, when applied to applicant's goods, is merely descriptive thereof.

When the refusal was made final, applicant appealed. Applicant and the examining filed briefs.

Applicant states that his product is a "preformed hat that fits in a preformed pocket pouch and is sold as one item" and that "[p]eople interested in hats would understand the mark [POCKET HAT] for what it stands for as popularized by the applicant." (Brief, p. 5). Applicant contends that his mark is not merely descriptive. In support thereof, applicant relies upon two third-party registrations, essentially to support the point that similar marks have not been held to be merely descriptive.[1]

The examining attorney maintains that the proposed mark is merely descriptive of hats that are specifically designed to fit into a pocket pouch. In support of the refusal the examining attorney submitted dictionary definitions, and excerpts of third-party websites.

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

[1] Applicant just listed the registrations, and the examining attorney, in the final refusal dated September 16, 2011, indicated that the mere submission of a list is insufficient to make such registrations part of the record. In her appeal brief, however, the examining attorney considered the registrations as if properly made of record. Likewise, we have treated the registrations to be of record and have considered them in reaching our decision.

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. In the present case, applicant already has disclaimed the term "HAT" apart from the mark. 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).

As noted above, the question of mere descriptiveness must be decided on the basis of the identification of goods in the application. In the present case, the identification reads "hats." Thus, the broadly worded identification encompasses hats of all kinds, including hats with a pocket or hats designed to fit into a pocket. Lest there be any doubt about the specific nature of applicant's goods, applicant admits that his product is a "preformed hat that fits in a preformed pocket pouch and is sold as one item."

The record includes a dictionary definition showing that "pocket" means "a small bag that is sewed or inserted in a garment so that it is open at the top or side." The term "pouch" means "a bag of small or moderate size for storing or transporting goods." (www.merriam-webster.com).[2]

The record includes the following examples of third-party uses of "pocket hat" in a descriptive manner:

> Sunny Things
> "The Original Pocket Hat"
> The Pocket Hat
> The Sunshade That Fits In Your Pocket
>
> Pocket Hat
> Ingenious hat folds up so small it can be carried in a pocket or purse.
>
> Pocket hats in 3 lengths

Based on the evidence of record, we find that the proposed mark POCKET HAT is merely (if not highly) descriptive of a significant characteristic or feature of applicant's type of hat. No imagination is required by a purchaser or user to discern that the mark, when applied to the goods, describes a hat that fits into a pocket or is made with a pocket.

We have considered applicant's main argument based on two third-party registrations, both expired, of the marks POCKET HAT and POCKETHAT for hats. Applicant points out that neither mark

[2] Pursuant to the examining attorney's request, we take judicial notice of the dictionary definition of "pouch." *See In re Jonathan Drew, Inc.*, 97 USPQ2d 1640, 1642 n.4 (TTAB 2011).

was found to be merely descriptive, but rather registered on the Principal Register; applicant contends that its mark is entitled to similar treatment.

Third-party registrations are not conclusive on the issue of mere descriptiveness. Each case must stand on its own merits, and a mark that is merely descriptive must not be registered on the Principal Register simply because other such marks appear on the register. *In re International Taste Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000); and *In re Scholastic Testing Service, Inc.*, 196 USPQ 517, 519 (TTAB 1977). *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.").

We conclude that applicant's proposed mark POCKET HAT for hats is merely descriptive of a preformed hat that fits in a preformed pocket pouch.

Decision: The refusal to register is affirmed.