

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: October 9, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Starkist Co.
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Serial No. 85765644
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David V. Radaack of Eckert Seamans Cherin & Mellot LLC, for Starkist Co.

Bridgett G. Smith, Trademark Examining Attorney, Law Office 115 (John Lincoski, Managing Attorney).
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Before Quinn, Ritchie, and Kuczma,
Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Starkist Co. (“Applicant”) filed an application to register on the Principal Register the mark INTERNATIONAL SELECTS¹ in standard character format for goods identified as “seafood,” in International Class 29. The Examining Attorney has refused registration of the application under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that it is merely descriptive of the goods. When the refusal was made final,

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¹ Application No. 85765644, filed October 29, 2012, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use in commerce.

Applicant filed an appeal. The Examining Attorney and Applicant each filed briefs. Upon careful consideration of the relevant arguments and evidence, we affirm the refusal to register.

Section 2(e)(1)

A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used. *See In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012), *citing In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a term 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 those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Moreover, 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); *See also In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re*

Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985).

The Examining Attorney argues that “the proposed mark is a combination of descriptive terms that immediately conveys to the consumer a feature of applicant’s goods, namely, seafood of a high or premium quality likely of international origin or to be marketed internationally.” (EA’s brief at unnumbered 8 of 10).

The Examining Attorney submitted definitions of the terms “international” and “select,” included in relevant part as follows:

International: 3. Active, known, or reaching beyond national boundaries.
Merriam-Webster.com (2012)

Select: 2. Of special quality or value; choice; *select peaches*.
Thefreedictionary.com (2012)

The Examining Attorney further submitted six third-party registrations for “seafood” that include the term “SELECT” or “SELECTS” in the mark and that either disclaim the term or that are registered on the Supplemental Register, as well as one owned by Applicant itself, as follows:

1. CASCADE SELECT (Registration No. 3376786) for “seafoods as a food product,” disclaiming “SELECT.”
2. RUBY SELECT (Registration No. 2850891) for “seafood,” disclaiming “SELECT.”
3. SOLO SELECTS (Registration No. 3346142) for “frozen seafood” disclaiming “SELECTS.”

4. DON'S SELECT, (Registration No. 3970171 for "seafood," disclaiming "SELECT."
5. DIVERS SELECT (Registration No. 3783047) for "seafood, namely, scallops," on the Supplemental Register.
6. DINER SELECTS, (Registration No 4156004) for "combination meal consisting primarily of meat, seafood, poultry or vegetables for consumption on or off the premises" on the Supplemental Register.
7. STARKIST SELECTS² (Registration 3955725) for "seafood", disclaiming "SELECTS."

This evidence tends to show that third parties -- as well as Applicant -- believe the term "SELECT/S" as applied to "seafood" to be descriptive.

Applicant argues that its applied-for mark is not merely descriptive of its goods because the mark "could indicate numerous different products, not specifically seafood." (June 17, 2013 Response to Office Action). This, however, is not the legal test. As noted above, we must not consider the mark in a vacuum, but rather how consumers would view the mark in relation to the identification of goods. *In re Tower Tech Inc.*, 64 USPQ2d at 1316-17. Applicant also argues that the Examining Attorney does not consider the mark "as a whole" (appl's appeal brief at unnumbered 2 of 2). However, it is clear that the applied-for mark, when viewed as a whole, conveys information

² Registered by Applicant May 3, 2011, with attorney of record David V. Radack.

about the goods. We have no doubt that a consumer would understand “INTERNATIONAL SELECTS,” used in connection with Applicant’s goods, as directly conveying information about them, namely, that they are intended to reference a “select” or choice brand of seafood, that either may be among the best of their class internationally and/or that may be imported. *See In re Tower Tech Inc.*, 64 USPQ2d at 1316-17; *see also In re Conductive Services, Inc.*, 220 USPQ 84, 86 (TTAB 1983). Therefore, we find that the mark is merely descriptive of the identified goods, and we affirm this refusal to register.

Decision: The refusal to register is affirmed, and registration to Applicant is refused.