

This Opinion is not a
Precedent of the TTAB

Mailed: March 31, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Retail Royalty Company

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Serial No. 86283205

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

Yat Sye I. Lee, Trademark Examining Attorney, Law Office 107,
J. Leslie Bishop, Managing Attorney.

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Before Taylor, Wellington and Masiello,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Retail Royalty Company (“Applicant”) seeks registration on the Principal Register of the mark AMERICAN BEAGLE OUTFITTERS (in standard characters) for “pet apparel, pet clothing, pet collars, leashes for animals” in International Class 18.¹ In

¹ Application Serial No. 86283205 was filed on May 16, 2014, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. On March 16, 2015, during prosecution of the application, Applicant filed an Amendment to Allege Use (“AAU”), which was accepted on March 19, 2015. In the AAU, Applicant asserts November 2014 as the date of first use of the mark anywhere and in commerce.

its application, Applicant claims ownership of U.S. Registration Nos. 2994962, 3462217, 4018551, and others.

The Trademark Examining Attorney has finally refused registration pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), based on Applicant's failure to comply with the requirement to disclaim the word OUTFITTERS on the ground that it is merely descriptive of Applicant's goods within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1).²

We affirm the refusal of registration in the absence of a disclaimer.

An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6(a). Merely descriptive terms are unregistrable, under Trademark Act Section 2(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); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (CCPA 1975); *In re Ginc UK Ltd.*, 90 USPQ2d 1472 (TTAB 2007); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977); and *In re Pendleton Tool Industries, Inc.*, 157 USPQ 114 (TTAB 1968).

A term is deemed to be merely descriptive of goods, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality,

² The Examining Attorney initially refused registration pursuant to Trademark Act Section 2(e)(2), 15 U.S.C. § 1052(e)(2), on the ground that the applied-for mark is primarily geographically descriptive of the origin of Applicant's goods, but that refusal was withdrawn in an Office Action dated October 2, 2014. The disclaimer requirement was made in that same Office Action.

characteristic, feature, function, purpose or use of the goods. *See, e.g., In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods. *See In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Applicant, in traversing the refusal, argues that the term "Outfitters" in its AMERICAN BEAGLE OUTFITTERS mark is at most suggestive of the identified goods. Applicant explains that

The common meaning of the word OUTFITTERS – the meaning understood by the consuming public – is someone who deals in equipment and supplies for expeditions and camping trips. There is no evidence in the record, and the Examining Attorney has not carried her burden to show, that OUTFITTERS is commonly used to describe pet products or someone who deals in products for pets. Thus, because OUTFITTERS is not a common descriptive name for someone that deals in such goods, the Examining Attorney's refusal to register the AMERICAN BEAGLE OUTFITTERS mark, and requirement that the word OUTFITTERS be disclaimed, should be reversed.

The Examining Attorney, conversely, maintain that "Outfitters" merely describes the provider of the recited goods, which are types of clothing and equipment for pets. He further explains:

In the context of the identified "Pet apparel, pet clothing, pet collars, leashes for animals," the term "OUTFITTERS" describes a business that provides equipment, supplies, or clothing, especially for outdoor activities. Applicant is an establishment and shop that sells clothing and equipment for various purposes, including clothing for pets, and

articles or implements such as collars and leashes used in outdoor activities such as dog walking. ... Given that “OUTFITTERS” describes the provider of clothing and equipment for specific purposes and outdoor activities, which would include dog walking, a disclaimer of “OUTFITTERS” should be required.

The Examining Attorney has supported the refusal with the following:

A. Definitions of “outfitter”³ and “equipment”:

Outfitter

a business that provides equipment, supplies, and often trained guides for activities such as hunting, hiking, etc,⁴

An establishment that sells clothing, equipment, and services, especially for outdoor activity⁵

a shop that provides equipment for some specific purpose⁶

Equipment

“the set of articles or physical resources serving to equip a person or thing” or “the implements used in an operation or activity.”⁷

³ Applicant attached to its brief “full” definitions of the term “outfitter” apparently to supplement those previously made of record by the Examining Attorney, as well as additional definitions of the word “outfitters.” We take judicial notice of those additional definitions. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010).

⁴ The definition was taken from the on-line Merriam-Webster Dictionary (<http://www.merriam-webster.com/dictionary/outfitter>), attachment to the October 2, 2014 Office Action.

⁵ www.oxforddictionaries.com/us/definition/american_english/outfitter, attachments to the Office Action dated March 12, 2015.

⁶ <http://www.vocabulary.com/dictionary/outfitter>, attachments to the Office Action dated March 12, 2015.

⁷ (<http://www.merriam-webster.com/dictionary/equipment>), attachment to the March 12, 2014 Final Office Action.

B. Internet materials from the websites of various establishments showing the terms “outfitter” and “outfitters” used by them in connection with the sale of pet clothing, products, collars and leashes.⁸ An excerpted sampling of the materials is shown below:

- Cat Nap & Lazy Dog Pet Outfitters - shows the wording “But Cat Nap is a *‘pet outfitter’*. We provide for the needs of companion animals who live in or vacation in the Algonquin East area...Cat Nap is loaded with quality treats, toys, clothing, accessories...We’ll help fit a collar, consult on a leash...” (www.catnaplazydog.com)
- Henry & Rumble Canine Outfitters - shows the wording “...retail store that is dedicated to promoting a healthy and active lifestyle for dogs and cats. We’ve researched and scoured the market for top notch food, gear, treats, beds, and more...You can find cleaning, grooming, crates, carriers, jackets and so much more...” (<http://henryandrubble.com/about>)
- HuntinDawg.com Outfitter for the Sporting Dog - shows the shopping categories, “Collars and Leashes” and “Dog Coats.” (www.huntindawg.com)
- Pooch Outfitters - product list includes “Coats/Jackets,” “Deco Collars,” and “Harness.” (<https://www.poochoutfitters.com/aboutus.cfm>)
- Urban Diggs, - shows a product list at the top of the webpage “Dog Tees,” “Dog Coats,” “Dog Fleece,” “Dog Rain Coat,” “Dog Shirts,” “Dog Polos,” “Dog Sweaters”; and at the bottom of the page, “U Fashion-savvy outfitter for dogs of all sizes” (www.urbandiggs.com)
- McCall Pet Outfitters & Supply, who have been “serving top quality pet food, treats, supplements, toys, clothing, and gear since 2006” (http://www.mccallpet.com/home_page.html)

⁸ Attachments to the Final Office Action dated March 12, 2015.

The webpages from PET OUTFITTERS and Philomena London Pet Outfitters have not been considered in this decision because they do not include the URLs. *See Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031 (TTAB 2010).

- Ruff Life Pet Outfitters - shows goods which include jackets, rain shells, coats, vests, sweaters, harnesses, collars, and leashes. (<http://www.rufflifepet.com/apparel>)
- Two Salty Dogs Pet Outfitters - shows the wording “Dog Clothing,” photographs of dog clothing, as well as icons for various brands of dog collars and dog leashes. (<http://www.twosaltydogs.net/dog-clothing.html>)

C. Internet materials from the websites of four (4) retail establishments that use the term “outfitter(s) in connection with the sale of clothing and outdoor equipment for people, in addition to collars, leashes and apparel for pets.”⁹

- HTO Hudson Trail Outfitters, LTD (<http://www.hudsontrail.com/catalogsearch/?g=dogs>)
- Half-Moon Outfitters (<http://www.halfmoonoutfitters.com/dogs/Search>)
- Alpine Outfitters: showing the sale of dog collars, leashes and booties (<http://www.alpineoutfitters.net>)
- Cabela’s World’s Foremost Outfitter (<http://www.cabelas.com/product>)

C. Third-party registrations covering services featuring pet-related goods similar to those of Applicant, wherein the term “Outfitter(s)” is disclaimed or otherwise treated as descriptive matter.¹⁰ The chart below is taken from the Examining Attorney’s brief.

⁹ Attachments to the Final Office Action dated March 12, 2015.

¹⁰ Attachments to the Office Actions dated October 2, 2014 and March 12, 2015.

Reg. No.	Mark	Goods/Services	Register/Disclaimer
1878621	THE DOG'S OUTFITTER (typed drawing)	"mail order services in the field of pet supplies and gifts for pets and their owners."	Principal 2(f), with "OUTFITTER" disclaimed
3425676	CRITTER OUTFITTER (with design)	in relevant part, "Retail pet stores."	"OUTFITTER" disclaimed
3933239	EST. 1920 THE ORIGINAL OUTDOOR OUTFITTER (with design)	in relevant part, "CATALOG ORDERING SERVICE FEATURING CLOTHING... PET PRODUCTS...; RETAIL STORE AND ON-LINE RETAIL STORE SERVICES FEATURING CLOTHING... PET PRODUCTS..."	2(f) as to "THE ORIGINAL OUTDOOR OUTFITTER" with "OUTDOOR OUTFITTER" disclaimed
3115540	HORSE AND HOUND OUTFITTERS (standard characters)	in relevant part, "Mail order catalogue and telephone shop-at-home services featuring clothing, ...pet...supplies"	Supplemental Register with "OUTFITTERS" disclaimed
3240919	AMERICA'S RURAL OUTFITTER (standard characters)	in relevant part, "Retail stores featuring ...pet supplies"	Supplemental Register with "OUTFITTER" disclaimed
3332300	STOCKDALE'S AMERICA'S RURAL OUTFITTER (with design)	in relevant part, "Retail stores featuring...pet supplies"	"AMERICA'S RURAL OUTFITTER" disclaimed
4021909	MISSION OUTFITTERS (with design)	in relevant part, "Mail order, retail store services and on-line retail store service featuring ...dog gear"	"OUTFITTERS" disclaimed
4340769	OUTDOOR OUTFITTERS (with design)	in relevant part, "Retail store services, on-line retail store services, mail order catalog services, telephone order services and facsimile order services, all of the foregoing featuring...dog supplies"	"OUTDOOR OUTFITTERS" disclaimed
2098477	COMPLETE OUTFITTERS FOR MAN & BEAST (typed drawing)	"retail stores, services featuring clothing, footwear, tack and pet supplies"	Supplemental Register
4270046	ANIMAL OUTFITTERS (standard characters)	in relevant part "Retail pet store and gift shop featuring pet supplies in the nature of feeding bowls, pet collars and leashes, pet clothing, pet toys"	Supplemental Register

D. Third-party registrations for marks owned by Applicant for clothing items and/or gear and accessories and retail store services featuring, *inter alia*, clothing

items and/or gear and accessories wherein the word “outfitters” is disclaimed.¹¹ The registrations include, by way of example,

Registration No.	Mark	Goods/Services	Disclaimer
2086693	AMERICAN EAGLE OUTFITTERS	Various clothing items	OUTFITTERS
2191681	AMERICAN EAGLE OUTFITTERS	Nonprescription sunglasses	AMERICAN and OUTFITTERS
2050115	AMERICAN EAGLE OUTFITTERS	Footwear, slippers, leather boot and rubber boots, and insoles	OUTFITTERS
4018551	AMERICAN EAGLE OUTFITTERS	Book bags, duffle bags, gym bags, travel bags, messenger bags, tote bags ... wallets and leather key chains	OUTFITTERS
4219223	AMERICAN EAGLE OUTFITTERS	Earbuds	OUTFITTERS
4206398	AMERICAN EAGLE OUTFITTERS OFF CAMPUS	Retail store and on- line retail store services featuring clothing, clothing accessories, headwear, footwear, sunglasses, fragrances, jewelry, watches, headphones, bags, backpacks, umbrellas, wallets, purses and key chains	OUTFITTERS in connection with retail and on-line retail services featuring clothing, clothing accessories, headwear, footwear, sunglasses, bags, backpacks, umbrellas, wallets, purses and key chains

The evidence submitted by the Examining Attorney convinces us that the term “OUTFITTERS” in Applicant’s applied-for AMERICAN BEAGLE OUTFITTERS

¹¹ Attachments to the Final Office Action dated March 12, 2015.

mark, when used in connection with Applicant's identified "pet apparel, pet clothing, pet collars, [and] leashes for animals," merely describes Applicant as a supplier of those goods. Put another way, the record makes clear that, in the context of the identified pet apparel, pet clothing, pet collars, leashes for animals, the term "OUTFITTERS" describes a type of business that provides equipment, supplies, or clothing, especially for outdoor activities, and that the businesses may refer to themselves descriptively as "outfitters." Contrary to Applicant's position that the term "outfitters" only refers to suppliers of clothing and equipment for people, the evidence shows that the term is used descriptively in connection with establishments that provide clothing and supplies for both people and their pets.

Applicant's arguments to the contrary are not persuasive. First, Applicant argues that because the dictionary definitions of record show that the word "OUTFITTERS" has no particular meaning related to pet products, the disclaimer requirement was imposed by the Examining Attorney in error. We find this contention unavailing because the definition of "outfitter" as "an establishment that sells clothing, equipment, and services, especially for outdoor activity" covers the sale of pet clothing, such as sweaters and jackets, and equipment, such as leashes, and not just clothing and/or equipment for people. Applicant points particularly to alternate definitions of "outfitter," such as "one that outfits," "haberdasher," or "one who supplies, sells, or makes outfits," but these are more traditional definitions that do not accurately reflect the current context in which the term is used. Descriptiveness is considered in relation to the relevant goods and/or services. *DuoProSS Meditech*

Corp. v. Inviro Med. Devices, Ltd., 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). “That a term may have other meanings in different contexts is not controlling.” *In re Franklin Cnty. Historical Soc’y*, 104 USPQ2d 1085, 1087 (TTAB 2012) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)); TMEP §1209.03(e). Here, the more expansive definitions relied on by the Examining Attorney more accurately reflect the contextual framework within which to view Applicant’s mark. This is shown by the common use by third-parties of the term “OUTFITTERS” in connection with at least ten establishments which supply pet clothing and products, as well as the multiple establishments which employ that term (in combination with other matter) in connection with the offering of not only pet clothing and supplies, but clothing and supplies for people. Moreover, even if Applicant were the first and only user of the term OUTFITTERS in connection with pet clothing and supplies, it would not justify registration here, where the significance conveyed by the term is merely descriptive. *See e.g., In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983).

Applicant similarly also argues that “consumers would not understand the word “OUTFITTERS” to describe pet products or a store that sells pet products.” Applicant’s Brief, p. 5. As the Examining Attorney aptly points out:

The question is not whether someone presented only with the mark could guess what the goods and/or services are, but “whether someone who knows what the goods and [/or] services are will understand the mark to convey information about them.” *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)); *In re*

Franklin Cnty. Historical Soc’y, 104 USPQ2d 1085, 1087 (TTAB 2012). Contrary to the applicant’s arguments, the term “OUTFITTERS” does not have an abstract meaning in relation to the applicant’s identified pet products. A consumer who knows that the goods are pet apparel, pet clothing, pet collars, and animal leashes will understand that the wording “OUTFITTERS” conveys information about the provider of the goods—i.e., that the provider is an establishment that sells clothing and equipment for outdoor activities or for some specific outdoor purpose, such as dog walking.

We also find unpersuasive Applicant’s contention that the third-party use and the third-party registration evidence relied on by the Examining Attorney is deficient. With particular regard to the third-party registration evidence, Applicant asserts that the registrations in which the term “OUTFITTERS” was disclaimed also recite goods that are not pet-related. Third-party registrations featuring goods and services the same as or similar to Applicant’s goods and/or services are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on acquired distinctiveness, or registered on the Supplemental Register. *See Inst. Nat’l des Appellations D’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 1581-82, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006). Here, we have reviewed the third-party registrations and considered them only to the extent that they show that the designation “outfitters” has been disclaimed in connection with retail and online retail store services that feature pet clothing and supplies, such as leashes. We add that even if those registrations are not considered, our decision would be the same.

Applicant similarly questions the probative value of the evidence demonstrating third-party use of the word “OUTFITTERS,” arguing that the number of uses provided is insufficient. We find this argument unpersuasive since our finding of mere descriptive is not based solely on this evidence, but on the entirety of the record.

Finally, Applicant references an earlier Board decision reversing requirements to disclaim the word “OUTFITTERS” in two of Applicant’s prior applications.¹² Those applications matured into U.S. Registration No. 4053474 (application Serial No. 77791067) for the mark TRUE AMERICAN EAGLE OUTFITTERS (stylized with rectangle carrier) for “perfume and body lotion and U.S. Registration No. 4017672 (application Serial No. 77979784) for the mark AMERICAN EAGLE OUTFITTER (standard characters) for “retail store services and online retail store services in the field of fragrances, cosmetics and personal care products, and jewelry.” Unlike the “perfume and body lotion” identified in U.S. Registration No. 4053474 and the featured “fragrances, cosmetics and personal care products, and jewelry” identified in U.S. Registration No. 4017672, the goods in the instant case are types of clothing and equipment for animals. Moreover, it is settled that each case must be decided on its own facts. *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.”); and *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828

¹² Applicant submitted a copy of that non-precedential decision for the record as Exhibit 1 to its February 13, 2015 Response to Office Action.

F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987). In view of the foregoing, we are obligated to assess the registrability of Applicant's mark in the absence of a disclaimer on its own merits, and not based on a decision issued in a prior proceeding involving different marks and different goods and services.

After careful consideration of all of the evidence and arguments presented, including evidence and arguments not specifically discussed herein, we conclude that when applied to Applicant's goods, the term OUTFITTERS immediately describes the provider of Applicant's identified "pet apparel, pet clothing, pet collars, [and] leashes for animals."

Decision: The refusal to register based on the requirement for a disclaimer of the word OUTFITTERS is affirmed. However, if Applicant submits the required disclaimer of OUTFITTERS to the Board within thirty days of the mailing date of this decision, the decision will be set aside as to the affirmance of the disclaimer requirement.¹³ See Trademark Rule 2.142(g), 37 C.F.R. § 2.142(g).

¹³ The standard printing format for the required disclaimer text is as follows: "No claim is made to the exclusive right to use OUTFITTERS apart from the mark as shown." TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") Section 1213.08(a)(i) (October 2015).