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- EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86283205

MARK: AMERICAN BEAGLE OUTFITTERS



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Retail Royalty Company

CORRESPONDENT'S REFERENCE/DOCKET NO:

RVI-1491 / 1

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the trademark examining attorney's refusal to register the trademark AMERICAN BEAGLE OUTFITTERS for "Pet apparel, pet clothing, pet collars, leashes for animals" on the Principal Register. Registration was refused under 15 U.S.C. §§1052(e)(1), 1056(a) on the grounds that the

wording “OUTFITTERS” is merely descriptive of the identified goods and, therefore, must be disclaimed apart from the mark as shown.

FACTS

On May 16, 2014, the applicant, Retail Royalty Company, filed an intent-to-use trademark application seeking registration on the Principal Register of the mark AMERICAN BEAGLE OUTFITTERS for “*Pet apparel, pet clothing, pet collars, leashes for animals*” in International Class 18.

In an Office Action issued on June 20, 2014, the examining attorney refused registration of the mark under Section 2(e)(2) of the Trademark Act on the grounds that the applied-for mark is primarily geographically descriptive of the origin of applicant’s goods. The examining attorney also required applicant to provide a written statement specifying where the goods would come from or originate. In its Response to Office Action dated August 21, 2014, the applicant argued against the refusal under Section 2(e)(2) of the Trademark Act. In addition, the applicant stated that the goods would be manufactured in a number of countries but designed in the United States and sold in its retail stores and through its Internet website.

Having considered the applicant’s arguments, the examining attorney issued a Non-final Office Action on October 2, 2014 withdrawing the Section 2(e)(2) refusal and requiring the applicant to disclaim the descriptive wording “OUTFITTERS” apart from the mark as shown. Applicant responded on February 13, 2015, arguing against the disclaimer requirement.

On March 12, 2015, the examining attorney issued a Final Office Action making final the requirement that applicant disclaim “OUTFITTERS” apart from the mark as shown.

Applicant submitted an Amendment to Allege Use on March 16, 2015, which was accepted on March 19, 2015.

On August 25, 2015, the applicant filed a timely notice of appeal of the Final Action. On October 14, 2015, the applicant’s brief was forwarded to the examining attorney.

ISSUE

The issue on appeal is whether the wording “OUTFITTERS” when used in connection with the applicant’s goods, is merely descriptive of those goods and, therefore, must be disclaimed apart from the mark as shown. 15 U.S.C. §§1052(e)(1), 1056(a); TMEP §§1213, 1213.03(a).

ARGUMENT

THE REQUIRED DISCLAIMER OF “OUTFITTERS” IS APPROPRIATE BECAUSE IT IS MERELY DESCRIPTIVE OF THE PROVIDER OF THE GOODS.

Section 6(a) of the Trademark Act provides, *inter alia*, that the “Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.” 15 U.S.C. § 1056(a).

The Office can require an applicant to disclaim an unregistrable part of a mark consisting of particular wording, symbols, numbers, design elements, or combinations thereof. 15 U.S.C. §1056(a). Under Trademark Act Section 2(e), the Office can refuse registration of an entire mark if the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods and/or services. 15 U.S.C. §1052(e). Thus, the Office may require an applicant to disclaim a portion of a mark that, when used in connection with the goods and/or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). See TMEP §§1213, 1213.03. Failure to comply with a disclaimer requirement can result in a refusal to register the entire mark. TMEP §1213.01(b).

A term is “merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant’s goods and/or services. TMEP §1209.01(b); see, e.g., *In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543 (1920)).

Moreover, terms that describe the provider of a product or service may also be merely descriptive of the product and/or service. See *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1301, 102 USPQ2d 1217, 1220 (Fed. Cir. 2012) (affirming Board’s finding that NATIONAL CHAMBER was merely descriptive of online service providing directory information for local and state chambers of commerce and business and regulatory data analysis services to promote the interest of businessmen and businesswomen); *In re Major League Umpires*, 60 USPQ2d 1059, 1060 (TTAB 2001) (holding MAJOR LEAGUE UMPIRE merely descriptive of clothing, face masks, chest protectors and shin guards); TMEP §1209.03(q).

The required disclaimer of “OUTFITTERS” is appropriate here because it merely describes a provider of applicant’s goods, which are identified as “Pet apparel, pet clothing, pet collars, leashes for animals.”

The term “OUTFITTER” has been defined as follows:

- “an establishment that sells clothing, equipment, and services, especially for outdoor activities.” *Oxford Dictionaries*, available at http://www.oxforddictionaries.com/us/definition/american_english/outfitter. Non-final Office Action, October 2, 2014, TIGRS p. 5.
- “a shop that provides equipment for some specific purpose.” *Vocabulary.com*, available at <http://www.vocabulary.com/dictionary/outfitter>. Final Office Action, March 12, 2015, TIGRS p. 5.

The term “equipment” is defined as “the set of articles or physical resources serving to equip a person or thing” or “the implements used in an operation or activity.” *Merriam-Webster’s Online Dictionary*, 11th Edition. Final Office Action, March 12, 2015, TIGRS pp. 6-7.

The determination of whether a mark is merely descriptive is made in relation to an applicant’s goods and/or services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); see, e.g., *In re Polo Int’l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the “documents” managed by applicant’s software rather than the term “doctor” shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of “computer programs recorded on disk” where the

relevant trade used the denomination “concurrent” as a descriptor of a particular type of operating system).

“Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

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. The examining attorney has provided evidence that walking equipment for dogs includes collars and leashes. Final Office Action, March 12, 2015, TICRS pp. 8-11. 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.

In the Non-final Office Action dated October 2, 2014 and Final Office Action dated March 12, 2015, the examining attorney attached third-party registrations from the USPTO’s X-Search database, for services featuring pet-related goods similar to those of the applicant, wherein the term “OUTFITTER” or “OUTFITTERS” was disclaimed or otherwise treated as descriptive matter. See Non-final Office Action, October 2, 2014, TICRS pp. 8-28 and Final Office Action, March 12, 2015, TICRS pp. 83 and 98. The attached third-party registrations included the following:

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	in relevant part, “CATALOG ORDERING	2(f) as to “THE

	OUTDOOR OUTFITTER (with design)	SERVICE FEATURING CLOTHING... PET PRODUCTS...; RETAIL STORE AND ON-LINE RETAIL STORE SERVICES FEATURING CLOTHING... PET PRODUCTS..."	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

In addition, the examining attorney provided Internet evidence in the Final Office Action dated March 12, 2015 (with website addresses listed in the Office action) showing that the wording "OUTFITTERS" is commonly used by companies that sell pet apparel, collars, and leashes. Examples of third-party entities that sell apparel, collars, and leashes for pets and that refer to themselves as "outfitters," included the following (emphasis in italics added 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..." Final Office Action, March 12, 2015, TIGRS pp. 12-13.
- Henry & Rumble *Canine Outfitter*: 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..." Final Office Action, March 12, 2015, TIGRS p. 16.
- HuntinDawg.com *Outfitter for the Sporting Dog*: shows the shopping categories, "Collars and Leashes" and "Dog Coats." Final Office Action, March 12, 2015, TIGRS p. 17.
- Pooch *Outfitters*: shows product list to include "Coats/Jackets," "Deco Collars," and "Harness." Final Office Action, March 12, 2015, TIGRS p. 23.
- Urbandiggs: 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"; at the bottom of the webpage, "U Fashion-savvy *outfitter for dogs of all sizes*." Final Office Action, March 12, 2015, TIGRS pp. 24-25.
- St. Johnimals, Island *Pet Outfitter*: shows photographs of the store displaying dog collars and leashes. Final Office Action, March 12, 2015, TIGRS pp. 26-27.
- *Pet Outfitters* Healthy Choices for the Pampered Pet: shows the list of goods which include "Collars," "Harnesses," and "Leashes." Final Office Action, March 12, 2015, TIGRS p. 38.
- McCall *Pet Outfitters & Supply*: shows the wording "...we've been serving top quality pet food, treats, supplements, toys, clothing, and gear since 2006." Final Office Action, March 12, 2015, TIGRS p. 39.

- Ruff Life *Pet Outfitters* Everything for the Outdoor Dog: shows goods which include jackets, rain shells, coats, vests, sweaters, harnesses, collars, and leashes. Final Office Action, March 12, 2015, TICRS pp. 42-48.
- 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. Final Office Action, March 12, 2015, TICRS pp. 49-52.
- Village *Pet Outfitters*: shows list of dog products which include dog collars, leads, and harnesses. Final Office Action, March 12, 2015, TICRS pp. 53-54.
- Philomena London *Pet Outfitters*: shows as dog product categories, “Leads,” “Collars,” “Coats,” and “Sweaters & Jumpers.” Final Office Action, March 12, 2015, TICRS p. 56.
- Baxter Boo: shows the wording “Male Pooch *Outfitters for Dogs*,” categories of “Dog Clothing, Dog Coats, Dog Collars,” and “Dog Leashes,” as well as photographs of clothing and dog leashes. Final Office Action, March 12, 2015, TICRS pp. 57-76.
- Caninekids *Outfitters for Dogs*: shows photographs and product categories for “Leashes,” “Harnesses,” “Collars,” and “Apparel.” Final Office Action, March 12, 2015, TICRS p. 77-80.

Also included among the evidence were third-party website screenshots showing various retail establishments that sell clothing and outdoor equipment for people as well as clothing, collars, and leashes for their pets (emphasis in italics added below):

- Cabela’s World’s Foremost *Outfitter*: showing the sale of clothing and outdoor equipment for people, in addition to collars, leashes, and apparel for pets. Final Office Action, March 12, 2015, TICRS pp. 137-138, 141, 143-144, 146-147.
- HTO Hudson Trail *Outfitters*, LTD: showing the sale of dog leashes, jackets, and collars. Final Office Action, March 12, 2015, TICRS pp. 149 and 152.
- Half-Moon *Outfitters*: showing the sale of dog collars and leashes. Final Office Action, March 12, 2015, TICRS p. 154.
- Alpine *Outfitters*: showing the sale of dog collars, leashes, and booties. Final Office Action, March 12, 2015, TICRS pp. 156-161.

It is well established that two major reasons for not protecting descriptive marks are (1) to prevent the owner of a descriptive mark from inhibiting competition in the marketplace and (2) to avoid the possibility of costly infringement suits brought by the trademark or service mark owner. *In re Abcor Dev. Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978); TMEP §1209. Businesses and competitors should be free to use descriptive language when describing their own goods and/or services to the public in advertising and marketing materials. See *In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001).

The evidence of record thus demonstrates that commercial entities providing goods similar to those identified by the applicant (i.e., pet apparel, pet clothing, pet collars, leashes for animals) refer to themselves as “OUTFITTERS.” The evidence also shows that the wording is not inherently distinctive because it describes the provider of outdoor clothing and equipment for both humans and animals, including pets. The plain meaning of “OUTFITTER” as “an establishment that sells clothing, equipment, and services, especially for outdoor activities,” supports the disclaimer requirement because “clothing” and “equipment for outdoor activities” includes products such as pet apparel, pet collars, and pet leashes. The evidence of record demonstrates a competitive need by others in the outdoor equipment and pet products industries to use the wording “OUTFITTERS” when describing themselves and their goods and services that feature pet products.

In refusing to disclaim “OUTFITTERS,” the applicant contends that the Office has failed to make a *prima facie* showing that the term “OUTFITTER” is descriptive. Moreover, applicant argues that the term is suggestive of applicant’s goods and that the dictionary definitions referenced by the examining attorney as well as the additional definitions provided by the applicant in its brief show that “OUTFITTERS” is not understood to relate to pets or pet products. Applicant’s Brief, pp. 5-6. Applicant’s argument is unpersuasive because applicant’s emphasis on the narrower, more traditional definition of “OUTFITTER” to mean “one that outfits,” “haberdasher,” or “one who supplies, sells, or makes outfits” is not directly on point with respect to the goods at issue. 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).

It bears mentioning that the traditional definition of “OUTFITTER,” as shown in the online *Oxford Dictionary*, as “an establishment that sells men’s clothing” is prefaced as “British dated.” Applicant’s

Brief, Exhibit 1, p. 3. Moreover, the *Webster's* definitions upon which the applicant relies were printed in the 1960s, 1970s, and 1980s. Applicant's Brief, Exhibit 2. The definition of the term "OUTFITTER" has somewhat evolved over the years, and the relevant contemporary definitions in the context of the applicant's pet products are "an establishment that sells clothing, equipment, and services, especially for outdoor activities" and "a shop that provides equipment for some specific purpose." See the previously attached definitions from

- http://www.oxforddictionaries.com/us/definition/american_english/outfitter attached in Non-final Office Action, October 2, 2014, TIGRS p. 5 and
- <http://www.vocabulary.com/dictionary/outfitter> attached in Final Office Action, March 12, 2015, TIGRS p. 5

Given that "equipment" is understood to be "the set of articles or physical resources serving to equip a person or thing" or "the implements used in an operation or activity," the term "OUTFITTER" clearly describes a provider of pet clothing, pet apparel, pet collars, and pet leashes, which are articles or implements used in the outdoor activity of dog walking. See definition from *Merriam-Webster's Online Dictionary*, 11th Edition. Final Office Action, March 12, 2015, TIGRS pp. 6-7. In other words, the goods identified by the applicant have definite utility as equipment for outdoor activities such as dog walking.

Applicant 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. 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.

Also contrary to the applicant's assertion that the wording "OUTFITTERS" has no meaning with respect to pet products, the third-party website evidence of record supports the finding that more than a handful of companies that sell pet products and pet gear similar to those identified by the applicant,

call themselves “outfitters” for pets, canines, or dogs. The widespread use of the wording “OUTFITTERS” by others who provide pet apparel, pet collars, and pet leashes shows, at the very least, that the term “OUTFITTERS” is no longer suggestive when used in connection with pet products. A term that was once arbitrary or suggestive may lose its distinguishing and origin-denoting characteristics through use in a descriptive sense over a period of time, and may come to be regarded by the purchasing public as nothing more than a descriptive designation. *In re Digital Research, Inc.*, 4 USPQ2d 1242, 1243 (TTAB 1987); *In re Int’l Spike, Inc.*, 190 USPQ 505, 507 (TTAB 1976).

Thus, trademark rights are not static, and eligibility for registration must be determined on the basis of the facts and evidence in the record at the time registration is sought, which includes during examination and any related appeal. *In re Chippendales USA Inc.*, 622 F.3d 1346, 1354, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1344, 213 USPQ 9, 18 (C.C.P.A. 1982); *In re Thunderbird Prods. Corp.*, 406 F.2d 1389, 1391, 160 USPQ 730, 732 (C.C.P.A. 1969). The totality of the evidence indicates the competitive need by others who sell pet products to use the wording “OUTFITTERS” to describe themselves or the nature of their businesses. Final Office Action, March 12, 2015, TICRS pp. 12-80. The third-party registrations and Internet evidence of record also show that companies that sell outdoor gear and equipment for people also sell apparel, collars, and leashes for animals. Final Office Action, March 12, 2015, TICRS pp. 137-161.

Applicant also appears to question the validity and sufficiency of the examiner’s third-party Internet evidence of record. Establishing the size of third-party businesses and the extent to which these businesses are well known to the consuming public are not pre-requisites to demonstrating the competitive need by others to use certain wording that is in the applied-for mark. Material obtained from the Internet is generally accepted as competent evidence. *See In re Leonhardt*, 109 USPQ2d 2091, 2098 (TTAB 2008) (accepting Internet evidence to show descriptiveness); *In re Rodale Inc.*, 80 USPQ2d 1696, 1700 (TTAB 2006) (accepting Internet evidence to show genericness); TBMP §1208.03; TMEP §710.01(b).

The Internet has become integral to daily life in the United States, with Census Bureau data showing approximately three-quarters of American households used the Internet in 2013 to engage in personal communications, to obtain news, information, and entertainment, and to do banking and shopping. *See In re Nieves & Nieves LLC*, 113 USPQ2d at 1642 (taking judicial notice of the following two official government publications: (1) Thom File & Camille Ryan, U.S. Census Bureau, Am. Cmty. Survey Reports ACS-28, *Computer & Internet Use in the United States: 2013* (2014), available at

<http://www.census.gov/content/dam/Census/library/publications/2014/acs/acs-28.pdf>, and (2) The Nat'l Telecomms. & Info. Admin. & Econ. & Statistics Admin., *Exploring the Digital Nation: America's Emerging Online Experience* (2013), available at http://www.ntia.doc.gov/files/ntia/publications/exploring_the_digital_nation_-_americas_emerging_online_experience.pdf). Thus, the widespread use of the Internet in the United States suggests that Internet evidence may be probative of public perception in trademark examination.

The applicant also argues that it should not be required to disclaim "OUTFITTERS" because the third-party registrations in which the term "OUTFITTERS" was disclaimed, which were attached by the examining attorney, also recite goods that are not pet-related. This assertion is unpersuasive because unless there is a limitation in the disclaimer statement of record, the disclaimer is presumed to apply to the entire identification of goods and services. No limitations to the disclaimers were articulated in these referenced third-party registrations for the goods that are pet-related, such as pet supplies, pet gear, and pet products. 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).

Finally, the applicant references an earlier non-precedential decision in which the Board reversed the Office's requirement to disclaim "OUTFITTERS" in two of applicant's prior applications (Serial Nos. 77791067 and 77979784, now U.S. Registration Nos. 4053474 and 4017672). Applicant's Brief, Exhibit 3. A decision designated as not precedential is not binding upon the Trademark Trial and Appeal Board. TMEP §705.05. The instant application is distinguishable from the applications involved in the referenced decision because the marks at issue are different, as are the identified goods and services. The goods at issue in the instant application are identified as, "*Pet apparel, pet clothing, pet collars, leashes for animals,*" which are very different from "*Perfume and body lotion*" and "*Retail store services and online retail store services in the field of fragrances, cosmetics and personal care products, and jewelry.*" The goods at issue are distinguishable, notably for the reason that dog walking is an outdoor activity and walking equipment for dogs includes collars and leashes. Final Office Action, March 12, 2015, TICRS pp. 8-11. It is therefore not a stretch to conclude that clothing and apparel for animals,

as well as dog leashes and dog collars are encompassed by the definition, “an establishment that sells clothing, equipment, and services, especially for outdoor activities.”

It is well settled that prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); see *In re Midwest Gaming & Entm’t LLC*, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). Each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); *In re Binion*, 93 USPQ2d 1531, 1536 (TTAB 2009). The facts in the instant application are different from those considered by the Board in *In re Retail Royalty Company* with respect to Serial Nos. 77791067 and 77979784.

Applicant’s arguments against the required disclaimer are unconvincing. The examiner’s third-party evidence of record supports the finding that “OUTFITTERS” describes a provider of “Pet apparel, pet clothing, pet collars, leashes for animals.” Businesses and competitors should be free to use this term when describing their own pet-related goods and services to the public in advertising materials. The contemporary meaning of “OUTFITTER” as “an establishment that sells clothing, equipment, and services, especially for outdoor activities,” and the manner in which this term is used by other businesses that sell clothing and equipment for outdoor activities, which include clothing for animals as well as collars and leashes for outdoor activities such as dog walking, justifies the disclaimer requirement.

CONCLUSION

For the foregoing reasons, the refusal to register under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), on the basis that the wording “OUTFITTERS” in the applicant’s mark is descriptive and must therefore be disclaimed apart from the mark as shown, should be affirmed.

Respectfully submitted,

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