

ESTTA Tracking number: **ESTTA717998**

Filing date: **01/04/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86283205
Applicant	Retail Royalty Company
Applied for Mark	AMERICAN BEAGLE OUTFITTERS
Correspondence Address	THEODORE R REMAKLUS WOOD HERRON & EVANS LLP 441 VINE ST, 2700 CAREW TOWER CINCINNATI, OH 45202-2814 UNITED STATES tremaklus@whe-law.com, usptodock@whe-law.com, bdram- barean@whe-law.com
Submission	Reply Brief
Attachments	Applicant's Appeal Reply Brief.pdf(303526 bytes )
Filer's Name	Theodore R. Remaklus
Filer's e-mail	tremaklus@whe-law.com
Signature	/theodore r remaklus/
Date	01/04/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

---

In re Retail Royalty Company, )  
Serial No. 86/283,205 )  
Mark: AMERICAN BEAGLE OUTFITTERS )  
Appeal Filed: August 25, 2015 )

---

**APPLICANT'S APPEAL REPLY BRIEF**

**TABLE OF CONTENTS**

I. INTRODUCTION .....1

II. ARGUMENT .....1

    A. The Word "Outfitter" Is Not Descriptive of Applicant's Goods .....2

    B. Third Party Registrations and Uses Do Not Require A Disclaimer of "Outfitter" ..4

    C. The Board's Prior Decision Involving Applicant's "American Eagle Outfitters"  
        Mark Supports Applicant's Position .....4

III. CONCLUSION.....5

**TABLE OF AUTHORITIES**

**Cases**

*In re Box Solutions Corp.*, 79 USPQ2d 1953 (TTAB 2006) ..... 1-2

*In re Remacki*, 66 USPQ2d 1222 (TTAB 2002)..... 3-4, 5

*In re Retail Royalty Company*,  
Serial Nos. 77791067 and 77979784 (March 9, 2011)..... 4-5

**Statutes/Rules**

15 U.S.C. § 1052(e)(2).....2, 3

15 U.S.C. § 1056.....1

**Other Authorities**

*Merriam-Webster's Online Dictionary*, 11th Edition ..... 2-3

*Vocabulary.com* ..... 2-3

## **I. INTRODUCTION**

The determination of whether a word in a mark is descriptive, and hence subject to a disclaimer requirement, cannot be made in the abstract. It must be decided based on the context of the mark, the goods or services with which it is to be used, and the recognized meaning of the words in the mark. The Examining Attorney, however, focuses on a reading of one definition (or a definition of a definition) of "Outfitter" to arrive at an abstract meaning taken out of context and divorced from its ordinary meaning. The clear ordinary meaning of an "Outfitter" does not include an establishment that sells pet products or pet products themselves, and the "evidence" submitted by the Examining Attorney fails to show otherwise. The word "Outfitter" is not descriptive of "pet apparel, pet clothing, pet collars, leashes for animals" or a retailer that sells such products, and the disclaimer requirement must be withdrawn.

## **II. ARGUMENT**

Disclaimers can only be required in the limited circumstance where a word within a mark constitutes an "unregistrable component" of that mark. 15 U.S.C. § 1056. Moreover, no trademark may be refused registration on the principal register unless it falls within one of the enumerated exceptions. In this case, the purported exception is under Section 2(e)(2) of the Lanham Act, 15 U.S.C. § 1052(2)(e), where the word is "merely descriptive" when used on or in connection with the goods. Of course,

[w]hether 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).

*In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006). Thus, the context and the specific goods are a paramount consideration. Here, the Examining Attorney has effectively ignored both.

**A. The Word "Outfitter" Is Not Descriptive of Applicant's Goods**

The Examining Attorney takes issue with Applicant's assertion that the word "Outfitter" is not descriptive of an establishment that sells the goods that are the subject of the present application, and even less so when applied to the goods themselves. Rather, the Examining Attorney asserts that a term that names the type of establishment from which goods come can also be descriptive of the goods themselves. She misses the point. Although a mark that is descriptive of an establishment may also be descriptive of goods sold in that establishment, it must be descriptive of at least one or the other. Here, the word "Outfitter" is not descriptive of a retailer that sells pet apparel, pet clothing, pet collars, leashes for animals, much less of the products themselves. Indeed, "Outfitter" is meaningless with respect to Applicant's goods.

The Examining Attorney relies exclusively on a single definition of "Outfitter" attached to the Office Actions, and then only by parsing the definition to arrive at a meaning other than the clear meaning. Specifically, the Examining Attorney relies on the following definition of "Outfitter", and of "equipment" (which appears in that definition):

- "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 Examining Attorney cited to and reads those definitions out of context, or simply ignores (or even omits) the portion that places the definition in context. The complete definitions in the sources cited by the Examining Attorney are::

**outfitter**

someone who sells men's clothes

a shop that provides equipment for some specific purpose

*"an outfitter provided everything for the safari"*

([www.vocabulary.com/dictionary/outfitter](http://www.vocabulary.com/dictionary/outfitter)) (see Exhibit 1 to Applicant's Appeal Brief)

**Full Definition of EQUIPMENT**

1 a: the set of articles or physical resources serving to equip a person or thing as (1): the implements used in an operation or activity: apparatus <sports equipment> (2): all the fixed assets other than land and buildings of a business enterprise (3): the rolling stock of a railway (see Final Office Action)

Taken in context, there is nothing to suggest that an "Outfitter" would be understood as relating in any way to "pet apparel, pet clothing, pet collars, leashes for animals" as the common meaning of "equipment" does not relate in any way to such products. Instead, the Examining Attorney resorts to submitting the definitions of a word appearing in one definition of "Outfitter" to cobble together an abstract meaning that, in its broadest sense, could encompass Applicant's goods (and in fact any and all goods). However, even in this broad, abstract sense, the Examining Attorney has failed to carry her burden of making a *prima facie* showing that the word "Outfitter" would be understood by the average consumer of Applicant's goods as descriptive of Applicant's goods or a retailer of such goods. In other words, the Examining Attorney has failed to show that the word "Outfitter" immediately conveys an idea of an ingredient, quality, characteristic, feature, function, purpose or use of Applicant's goods. *See In re Remacki*, 66 USPQ2d 1222, 1224 (TTAB 2002) (finding Examining Attorney failed to meet

burden of proof of establishing BIO-CD was descriptive of, among other good, compact discs related to biological molecules).

**B. Third Party Registrations and Uses Do Not Require A Disclaimer of "Outfitter"**

The Examining Attorney repeats her assertion that third party registrations show the word "Outfitters" must be disclaimed, but in doing so, she again resorts to citing only those portions of the goods/services in the registrations that may be related to pet products. However, as shown in the complete listing of the goods/services set out in Applicant's opening brief, the Examining Attorney ignores that in each case there are other products or services that fall within the ordinary meaning of "Outfitter". There is no evidence in the record that shows why the disclaimers were entered in those registrations, or why they may have been entered on the Supplemental Register, much less that it had anything to do with the inclusion of pet products.

Similarly, the Examining Attorney has failed to present any evidence that the handful of uses on the Internet by retailers of some pet products of the word "Outfitter" as part of their name has resulted in a change in the commonly understood meaning of "Outfitter".

**C. The Board's Prior Decision Involving Applicant's "American Eagle Outfitters" Mark Supports Applicant's Position**

Finally, the Examining Attorney takes issue with Applicant's citation to the Board's prior decision involving Applicant's American Eagle Outfitters mark arguing that the decision was not precedential and involved different goods. Applicant, however, specifically noted in its opening brief that the decision was not precedential. Nevertheless, the analysis in that decision applies equally in this case – the "evidence" relied on by the Examining Attorney "is simply outweighed by the other evidence showing that the term is only suggestive for the specific goods . . . involved herein" and "the third-party uses are minimal in number". *In re Retail Royalty*

Company, Serial Nos. 77791067 and 77979784 at p. 16 (March 9, 2011) (copy attached as Exhibit 3 to Applicant's Appeal Brief).

### III. CONCLUSION

The Examining Attorney has submitted no evidence that shows, or even suggests, the word "Outfitters" would be understood by the average consumer of Applicant's goods as descriptive of pet products or a retailer of such products. It was the Examining Attorney's burden to make that showing; she has failed to do so. *See In re Remacki*, 66 USPQ2d at 1224. For all of the foregoing reasons, and the reasons set out in the opening brief, the word "Outfitters" is not descriptive when used in connection with "pet apparel, pet clothing, pet collars, leashes for animals", the goods in the present application. The refusal to register the mark must therefore be reversed and remanded with instructions for the disclaimer requirement to be withdrawn.

Respectfully submitted,

January 4, 2016

By: Theodore R. Remaklus  
Theodore R. Remaklus, Esq.  
Wood, Herron & Evans, L.L.P.  
441 Vine Street  
2700 Carew Tower  
Cincinnati, Ohio 45202  
Tel: (513) 241-2324  
Fax: (513) 241-6234  
Email: tremaklus@whe-law.com

Attorney for Applicant  
Retail Royalty Company