

This Opinion is Not a
Precedent of the TTAB

Mailed: June 16, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Axel Ltd, Co.

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Serial No. 86418459

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Matthew H. Swyers of The Trademark Company, PLLC,
for Axel Ltd., Co.

Timothy Schimpf, Trademark Examining Attorney, Law Office 113,
Odette Bonnet, Managing Attorney.

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Before Wellington, Adlin and Pologeorgis,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Axel Ltd, Co. (“Applicant”) seeks a Principal Register registration for the mark

THRIFTER, in standard characters, for the following services:

On-line retail store services featuring a wide variety of
consumer goods of others in International Class 35; and

On-line social networking services in International Class
45.¹

¹ Application Serial No. 86418459 was filed on October 8, 2014, under Section 1(b) of the Trademark Act, based on an intent to use the proposed mark in commerce.

The Examining Attorney refused registration of the mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the basis that it is merely descriptive of Applicant's services. The Examining Attorney also refused registration based on Applicant's failure to comply with a final requirement pursuant to Trademark Rule 2.61(b) that it supply certain information which the Examining Attorney deemed necessary for proper examination of the application.

After the refusals became final, Applicant appealed. Applicant and the Examining Attorney filed briefs.

Information Requirement Refusal

Rule 2.61(b) provides that “[t]he Office may require the applicant to furnish such information ... as may be reasonably necessary to the proper examination of the application.” Noncompliance is a proper ground for refusing registration. *In re AOP LLC*, 107 USPQ2d 1644, 1651 (TTAB 2013); see also, *In re Cheezwhse.com Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTI Partnership LLP*, 67 USPQ2d 1699, 1701 (TTAB 2003); and TMEP § 814 (2015). Indeed, a failure to comply with a 2.61(b) requirement may be a sufficient basis in and of itself for refusal of registration. *DTI P'ship*, 67 USPQ2d 1699 (affirming refusal to register under Rule 2.61 without reaching substantive refusal under Trademark Act § 2(e)(1)).

Requests for information should be clear and “reasonably necessary” for examination. See *In re SPX Corp.*, 63 USPQ2d 1592, 1597 (TTAB 2002) (affirming requirement under Trademark Rule 2.61(b) “because . . . the request for information was reasonable”). The examining attorney otherwise has considerable discretion in

deciding whether and what type of information should be requested pursuant to Trademark Rule 2.61(b). It stands to reason that the examining attorney needs to understand the nature of the goods and services at issue, the meaning of the mark, and its significance in the relevant trade or industry. When an application is based on an intent to use the mark in commerce, as here, further information may be needed since specimens will not be of record and evidence of the applicant's actual use is often unavailable.

In the first Office Action, the Examining Attorney requested Applicant to provide “additional information about [Applicant’s] services,” specifically:²

. . . fact sheets, brochures, and/or advertisements. If these materials are unavailable, applicant should submit similar documentation for services of the same type, explaining how its own services will differ. If the services feature new technology and no information regarding competing services is available, applicant must provide a detailed factual description of the services.

In the same Office action, the Examining Attorney elaborated:

The submitted factual information must make clear what the services are and how they are rendered, their salient features, and their prospective customers and channels of trade. Conclusory statements regarding the services will not satisfy this requirement for information.

As part of the information, applicant should answer the following questions:

1. Explain the term THRIFTER in the context of the identified services.
2. Can the term THRIFTER be defined as a person who shops at thrift stores?
3. Will applicant sell previously owned goods in the online retail store? and
4. Will applicant’s social networking services be related to shopping?

² Office action issued on January 30, 2015.

In its response to the first Office action, Applicant curtly acknowledged the Examining Attorney's information request, stating that with respect to the "requested additional information ... Applicant represents there is none as it is an intent-to-use application" ³ Applicant did not answer any of the four itemized questions nor did Applicant follow, or explain why it could not follow, the Examining Attorney's instruction that "[i]f these materials are unavailable, applicant should submit similar documentation for services of the same type, explaining how its own services will differ."

In the second Office action, the Examining Attorney repeated and made final the same requirement for information. He noted that "[i]n the response applicant stated that as the application is an intent to use application there is no evidence to submit," but "even if applicant has not started offering these services, applicant was instructed to submit similar documentation for services of the same type, explaining how its own services will differ." ⁴

In its appeal brief, Applicant only addressed the information requirement to argue that the Examining Attorney's need for such information undercuts the legitimacy of the descriptiveness refusal: ⁵

Evidence of this fact can be found insofar as the Examining Attorney requested additional information about the proposed use of the mark. Applicant represented that there was none as it is an intent-to-use application. It seems somewhat impossible to therefor maintain a refusal

³ Applicant's response filed on June 4, 2015.

⁴ Office Action issue on June 19, 2015.

⁵ 4 TTABVue 12.

on merely an assumption of descriptive (sic) in the absence of any evidence thereof.

We find that the Examining Attorney's requirement for additional information was appropriate and that Applicant failed to comply with it. In particular, the Examining Attorney posed clear and well-directed questions attempting to ascertain information regarding Applicant's mark and the recited services. Applicant made no attempt to answer the questions or otherwise comply with the requirement except to state that its application was based on an intent to use and there was no additional information to provide. Applicant did not heed the Examining Attorney's instruction that, in the event Applicant has no materials such as fact sheets, brochures, and/or advertisements for its own services, Applicant should provide documentation involving services of the same type with an explanation how Applicant's services will differ. In *DTI Partnership*, which also involved an intent-to-use application, the Board affirmed an information request refusal and explained the options available to the applicant, noting that failure to respond was not one:

[Applicant] may comply with the request by submitting the required advertising or promotional material. Or it may explain that it has no such material, but may submit material of its competitors for similar goods or provide information regarding the goods on which it uses or intends to use the mark. Or it may even dispute the legitimacy of the request, for example, if the goods identified in the application are such ordinary consumer items that a request for information concerning them would be considered unnecessary and burdensome. What an applicant cannot do, however, is to ignore a request made pursuant to Trademark Rule 2.61(b), as applicant has here.

DTI, 67 USPQ2d at 1701, citing *In re SPX Corporation*, 63 USPQ2d 1592, 1597 (TTAB 2002).

Put simply, it was within the Examining Attorney's discretion to ask such questions, request such information, and refuse registration when the requirement went unsatisfied.

Accordingly, we affirm the refusal to register based on Applicant's failure to comply with the 2.61(b) information requirement. Again, this refusal, by itself, is a sufficient basis for refusing registration. *Id.* at 1699. Nevertheless, for sake of completeness, we now address the descriptiveness refusal under Trademark Act § 2(e)(1).

Descriptiveness Refusal – Applicable Law

A mark is deemed to be merely descriptive, within the meaning of Section 2(e)(1), if it immediately conveys knowledge of a quality, feature, function, characteristic or purpose of the services for which it is used. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (quoting *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009) (Fed. Cir. 1987)); 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 services in order to be considered merely descriptive; rather, it is sufficient that the mark describes one significant attribute, function or property of the services. *In re Chamber of Commerce of the United States of America*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *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 services for which registration is sought, the context in which it is

being used on or in connection with the services, and the possible significance that the mark would have to the average purchaser of the 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).

The Record

The Examining Attorney has the burden of creating a record that, *prima facie*, shows that the proposed mark is merely descriptive of Applicant's services, as described in each class. *Gyulay*, 3 USPQ2d at 1010; *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2052 (TTAB 2012).

In support of the refusal, the Examining Attorney has submitted evidence showing that THRIFTER is a recognized term for an avid shopper of thrift stores. He has submitted the following from Urban Dictionary (www.urbandictionary.com):⁶

Someone that religiously shops at Thrift Stores looking for bargains and often scores amazing deals. Often dedicated to recycling and reuse products to keep our planet “greener.”

In addition, he submitted various online articles and website printouts showing third-party use of the term “thrifter” consistent with the Urban Dictionary definition. For example:

“10 Questions About Vintage Every **Thrifter** Should Ask” ...Vintage Fashion Facts: What **Thrifters** Should Know ...There comes a time in

⁶ Submitted with Office action issued on January 30, 2015.

every **thrifter**'s experience of secondhand shopping when they begin to spot something 'special' between the racks. ... Not every **thrifter** is or wants to be a vintage lover, but eventually the time will come when a vintage garment catches a thrift lover's eye...

[article from Ebay online auction website, www.ebay.com];⁷

Thrifter of the Month

... Like most hardcore **thrifsters**, I can point to nearly everything in my house and say, 'I bought that at a thrift store.'

[third-party blog or website describing writer's thrift store shopping, www.thethriftshopper.com];⁸

Kids' Culture: Finding a **Thrifter**'s Paradise

Check out these low-cost alternatives for Back-to-School shopping. ... This is like Valhalla for the thrift-store aficionado.

[article in an informational website for parents, www.parentspress.com];⁹

Thrift shopping: What's old can be new again

... the number of thrift stores operating nationally has jumped 14 percent.

... Whether you're an experienced **thrifter** or a newbie to the trend, these tips can you master the craft of buying used and save you some serious cash.

[online article from the Las Vegas Sun, January 27, 2015 www.lasvegassun.com];¹⁰

Style Profile: Thriving **thrifter** Jen Meneely

... The self-proclaimed 'big **thrifter**' spends at least 20 hours per week haunting the racks of Goodwill, the Cottage Thrift Shop and the Charity Guild to find her prized pieces.

[online article from the Houston Chronicle, January 27, 2015, www.chron.com];¹¹

High Plains **Thrifter**

About me THRIFT-STORE SHOPPER

My name is Meghan and I'm the deal seeking, nacho eating, vintage loving lady that shares her Twin Cities thrifting adventures ...

⁷ *Id.*

⁸ *Id.*

⁹ *Id.*

¹⁰ *Id.*

¹¹ *Id.*

[a blog describing the writers visits and purchases from various thrift stores, www.highplainsthrifter.net];¹²

Beach Thrifter

THRIFTING FOR FUN AND RESALE IN VIRGINIA BEACH

[blog website offering guide to thrift stores in Virginia Beach, VA, www.beachthrifter.blogspot.com];¹³

Thrift shop makeovers Shoppers are benefitting from the battle between area second-hand shops, as new competition is forcing every store to raise its game ... An event like the re-fashionista challenge can reach a wide demographic, Taft said, such as crafters, people who want to recycle clothing and normal **thrif**ters.

[article from The Buffalo News, June 7, 2015];¹⁴

After a tough winter, Goodwill looks to spring ...

Jamie Nix of Tabernacle is a '**thrifter**' who was combing through shirts Tuesday.

[article from The Philadelphia Inquirer, March 5, 2014];¹⁵

But expert **thrif**ters know that the epic Goodwill Store down the street ... is the place where to haul in big bags of gently used goods.

[article from The Boston Globe, February 16, 2014];¹⁶ and

Frugal fashion: Secondhand shops thrive in recession ...

Both women are committed **thrif**ters, a category of shoppers who buy most of their casual and workday wardrobes from 'gently used' clothing stores. ... Thrift-store shopping is also a way to sidestep so-called 'fast fashion,' ...

[article from Sacramento Bee, July 28, 2013].¹⁷

¹² Submitted with Office action issued on June 19, 2015.

¹³ *Id.*

¹⁴ *Id.*

¹⁵ *Id.*

¹⁶ *Id.*

¹⁷ *Id.*

The Examining Attorney also submitted printouts from several different third-party retail websites featuring thrift store services. Excerpts from the printouts include:

Gone-Tomorrow
An Online Thrift Store
Welcome to Gone-Tomorrow – An Online Thrift Store
[www.gone-tomorrow.com];¹⁸

The Attic
Welcome to our Online Thrift Store
Where you can shop vintage clothes, used designer clothes, & retro clothes that are stylish & affordable ...
The Attic is the most stylish thrift store you've ever seen!
[www.atticclothes.com];¹⁹ and

WebThriftStore
We turn excess stuff into cash for charities ...
[retail website offering used items for sale, www.webthriftstore.com].²⁰

In addition, the Examining Attorney submitted copies of online articles about “social shopping” websites. Relevant excerpts include:

10 Best Social Shopping Sites Right Now
Social shopping sites integrate social aspects, such as product sharing and front-facing user engagement. ... Social shopping fills a fundamental desire for social interaction and decision reassurance, and helps mitigate the isolation inherent to most online activities.
[online article from PC Magazine, November 26, 2014, www.pcmagazine.com];²¹ and

7 Essential Social Shopping Websites
Want to get involved in social shopping but don't know where to start? These 7 essential social shopping websites will get you started whether you are interested in window-shopping on the web, getting product reviews,

¹⁸ Submitted with Office action issued on January 30, 2015.

¹⁹ *Id.*

²⁰ Submitted with Office action issued on June 19, 2015.

²¹ Submitted with Office action issued on January 30, 2015.

getting involved in a shopping community, keeping up with the latest fashion trends, or mainly focused on designer fashions. ... these social shopping websites will hook you into a community to help guide your web shopping.

[article from website offering list of seven “social shopping” websites, www.webtrends.about.com].²²

Analysis

Based on the record before us, we find the proposed mark THRIFTER is merely descriptive of both Applicant’s “on-line retail store services featuring a wide variety of consumer goods of others” and its “on-line social networking services.” The proposed mark merely describes the intended consumer or user of Applicant’s services. There is ample evidence showing that “thrifter” describes a shopper who avidly frequents thrift stores. The record also establishes the existence of online retail thrift stores and Applicant’s recitation of services is broad enough to include this type of online store.²³ Furthermore, Applicant’s online social networking services is broad enough to include social shopping websites where shoppers, including thrifters, can discuss various shopping techniques, their recent purchases and obtain shopping advice.

²² Submitted with Office action issued on June 19, 2015.

²³ With regard to the scope of Applicant’s services and the descriptiveness refusal, we note the following information requests are particularly relevant:

1. Explain the term THRIFTER in the context of the identified services
2. Can the term THRIFTER be defined as a person who shops at thrift stores?
3. Will applicant sell previously owned goods in the online retail store?
4. Will applicant’s social networking services be related to shopping?

If Applicant had information establishing that the proposed mark is not descriptive, it could have provided it in response, but failed to do so.

The Board has long held that a term is merely descriptive if describes the intended user or consumer of the relevant services. *See In re Planalytics, Inc.*, 70 USPQ2d 1453, 1456 (TTAB 2004) (with respect to the mark GASBUYERS for “providing on-line risk management services in the field of pricing and purchasing decisions for natural gas,” the Board held that “Applicant's identification of services makes it clear that its services are directed to those who are in the field of making purchasing decisions for natural gas. The evidence supports the conclusion that these people would be referred to as gas buyers.”). *See also Hunter Publ'g Co. v. Caulfield Publ'g Ltd.*, 1 USPQ2d 1996 (TTAB 1986) (SYSTEMS USER found merely descriptive of a trade journal directed toward users of large data processing systems; evidence sufficient to establish distinctiveness under §2(f)); *In re Camel Mfg. Co., Inc.*, 222 USPQ 1031 (TTAB 1984) (MOUNTAIN CAMPER held merely descriptive of retail mail-order services in the field of outdoor equipment and apparel). The term THRIFTER falls in line these decisions as it merely describes a particular type of person who would be interested in shopping via an online thrift store or partaking in online social shopping network services.

We disagree with Applicant's assertion that consumers, upon viewing THRIFTER in the context of the recited services, would “need to undertake ... imaginative steps to arrive at a tolerably accurate or direct description of the product or service from the mark itself.”²⁴ Again, the recitation of services is broad enough to include online thrift store services as well as social shopping websites and, with those particular

²⁴ 4 TTABVUE 13.

services in mind, it would take little imagination to understand that THRIFTER describes the target audience for these services.

Applicant's argument that competitors do not need to use the term "thrifter" is belied by the record showing the term used to describe a type of consumer to whom Applicant, and its competitors, will need to advertise their services. In other words, should other owners of online thrift stores or social shopping network websites direct their marketing efforts to avid thrift store shoppers, they may need and are entitled to use the term "thrifter." Applicant characterizes some of this evidence as "unauthorized use and potentially infringing," but by definition use of a descriptive term need not be authorized and is not infringing. In fact, the Examining Attorney's evidence reveals widespread third-party non-trademark use of the term "thrifter."

Decision: The examining attorney's requirement for information pursuant to Trademark Act § 2.61(b) is affirmed. The refusal to register pursuant to Trademark Act § 2(e)(1) is likewise affirmed.