Mailed: June 24, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Shimano North America Holding, Inc.

Serial No. 88185338

Rod S. Berman of Jeffer Mangels Butler & Mitchell LLP,
for Shimano North America Holding, Inc.

Christopher J. Nodes,[1] Trademark Examining Attorney, Law Office 116,
Elizabeth Jackson, Acting Managing Attorney.

Before Cataldo, Pologeorgis, and Lebow,
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

Shimano North America Holding, Inc. ("Applicant") seeks registration on the Principal Register of the standard character mark FLAT-FALL for "Fishing lures; Lures for fishing" in International Class 28.[2]

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that

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[1] On January 3, 2020, the Office reassigned the prosecution of the involved application to the above-identified examining attorney.

[2] Application Serial No. 88185338, filed on November 7, 2018, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming July 2013 as both the date of first use and the date of first use in commerce.

the mark, in its entirety, is merely descriptive of the goods identified in Applicant's application.

When the refusal was made final, Applicant appealed and requested reconsideration on three occasions. The last request was filed on the same day Applicant filed its timely notice of appeal. When the requests for reconsideration were denied, this appeal resumed. The appeal is fully briefed. For the reasons explained below, we affirm the refusal to register.[3]

I. Preliminary Matter – Evidentiary Objection

We first turn to an evidentiary objection lodged by the Examining Attorney regarding evidence presented by Applicant purportedly for the first time with its appeal brief.[4] Specifically, the Examining Attorney objects to the inclusion of Exhibit A to Applicant's Appeal Brief which consists of various definitions for the term "flat," ostensibly submitted to support Applicant's argument that the definition of this term does not describe Applicant's goods.[5]

It is well-settled that the record in an ex parte proceeding should be complete prior to appeal. Trademark Rule 2.142(d); 37 CFR § 2.142(d). Exhibits or other evidentiary material that are attached to or included with a brief but not made of record during examination are untimely, and will not be considered. *See In re Fitch IBCA, Inc.,* 64

[3] All TTABVUE and Trademark Status & Document Retrieval ("TSDR") citations reference the docket and electronic file database for the involved application. All citations to the TSDR database are to the downloadable .PDF version of the documents.

[4] Examining Attorney's Brief, p. 11, 6 TTABVUE 12.

[5] *Id*.

USPQ2d 1058, 1059 n.2 (TTAB 2002); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") §§ 1203.02(e) and 1207.01 (2020).

Here, however, the dictionary definitions submitted with Exhibit A to Applicant's brief were made of record during the examination of Applicant's involved application.[6] The only difference is that Applicant highlighted in yellow some of the definitions contained in Exhibit A. The highlighting of the definitions, however, does not detract from the fact that the dictionary definitions were previously submitted during the prosecution of Applicant's application. Accordingly, the Examining Attorney's evidentiary objection is overruled.[7]

II. Mere Descriptiveness – Applicable Law

A mark is merely descriptive of goods or services within the meaning of Section 2(e)(1) of the Trademark Act if it conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *see also In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a mark is merely descriptive is determined in relation to the goods or services for

[6] *See* April 29, 2019 Office Action, TSDR p. 16; October 4, 2019 Request for Reconsideration, TSDR pp. 15-87.

[7] Further, and as noted below, it is established that the Board may take judicial notice of definitions from dictionaries, including online dictionaries that exist in printed format. *E.g.*, *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018). As a result, even if these definitions had not been introduced during prosecution of the involved application, they represent one of the few exceptions to Trademark Rule 2.142(d) and could have been submitted by Applicant or the Examining Attorney for the first time during briefing with a request that the Board take judicial notice of the definitions.

which registration is sought and the context in which the mark is used, not in the abstract or on the basis of guesswork. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ2d 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, we evaluate whether someone who knows what the goods or services are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). A mark need not immediately convey an idea of each and every specific feature of the goods or services in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the goods or services. *See In re Gyulay*, 3 USPQ2d at 1010; *In re H.U.D.D.L.E.*, 216 USPQ 358, 359 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338, 339 (TTAB 1973).

When two or more merely descriptive terms are combined, the determination of whether the combined mark is also merely descriptive turns on whether the combination of terms evokes a non-descriptive commercial impression. If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004) (quoting *Estate of P.D. Beckwith, Inc. v. Commr.*, 252 U.S. 538, 543 (1920)); *see also In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1318 (TTAB 2002) (SMARTTOWER merely descriptive of commercial and industrial cooling towers); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001) (AGENTBEANS merely descriptive of computer programs for use in developing and deploying application programs).

On the other hand, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a non-descriptive meaning, or if the composite has an incongruous meaning as applied to the goods or services. *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE for "bakery products"); *In re Shutts*, 217 USPQ 363, 365 (TTAB 1983) (SNO-RAKE for "a snow removal hand tool having a handle with a snow-removing head at one end, the head being of solid uninterrupted construction without prongs"). In this regard, "incongruity is one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive from the descriptive mark." *Shutts*, 217 USPQ at 365; *see also In re Tennis in the Round, Inc.*, 199 USPQ 496, 498 (TTAB 1978) (the association of applicant's mark TENNIS IN THE ROUND with the phrase "theater-in-the-round" creates an incongruity because applicant's services do not involve a tennis court in the middle of an auditorium). Thus, we must consider the issue of descriptiveness by looking at Applicant's mark in its entirety.

In determining how the relevant consuming public perceives Applicant's mark in connection with its identified goods, we may consider any competent source, including websites and webpages, newspaper articles and publications, and Applicant's own advertising material and explanatory text. *See In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709-10 (Fed. Cir. 2017); *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (citing *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986)); TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") §1209.01(b) (October 2018).

III. Arguments and Evidence

In support of the Section 2(e)(1) refusal, the Examining Attorney submitted the dictionary definitions of the terms "flat" and "fall" set forth below:

- "flat" is defined as "having a continuous horizontal surface;" "being or characterized by a horizontal line or tracing without peaks or depressions" and "arranged or laid out so as to be level or even."[8]
- "fall" is defined as "to descend freely by the force of gravity."[9]

In addition, the Examining Attorney points to Applicant's specimen of record which describes the orientation of Applicant's fishing lure during descent as "flattened." The specimen also shows that the packaging for the goods features a diagram that depicts the trajectory of the fall of the lure through the water, showing that, at a particular phase of the fall, the lure assumes a horizontal position. At this phase of horizontal orientation, the diagram identifies the trajectory as "Jig flattened." The specimen also specifically states that "[t]he center balanced jig falls with a wobbly action **in a horizontal position**, keeping the strike zone longer than

[8] February 14, 2019 Office Action, TSDR p. 6 (accessed from www.merriam-webster.com on February 13, 2019).

Also, the Examining Attorney submitted the dictionary definition of the term "flat" from the Collins Dictionary (collinsdictionary.com/dictionary/english/) which defines the term as "horizontal and not upright." *See* April 29, 2019 Office Action, TSDR p. 16. We note that Collins Dictionary offers a British and an American version. The entry submitted by the Examining Attorney does not appear to be from the British version, which does not necessarily evidence perceptions of the term by consumers in the United States. *See In re Manwin/RK Collateral Trust*, 111 USPQ2d 1311, 1313 n.18 (TTAB 2014) (finding such definitions from the British version of the Collins Dictionary to be "of little or no probative value"). Accordingly, we have considered the definition from the Collins Dictionary.

[9] February 14, 2019 Office Action, TSDR p. 5 (accessed from www.merriam-webster.com on February 13, 2019).

the original butterfly jig." (emphasis added). The Examining Attorney argues that the packaging in which the Applicant's goods are sold to consumers directly shows that Applicant describes the horizontal orientation of the fish lure during its fall as "flattened." A copy of the specimen is reproduced below:[10]

In a signed declaration, Applicant's product manager describes the motion of Applicant's jigs as a "fall."[11] Also, Applicant concedes that its lures fall through the

[10] Applicant's Specimen submitted with the application on November 7, 2018.

[11] October 4, 2019 Request for Reconsideration, Declaration of Adam Lytton, Applicant's Product Manager, ¶ 2, TSDR p. 88 ("The jig is designed to 'jerk' or 'wobble' on both the **fall** and the retrieve.") (emphasis added).

water[12] and that its lures "may, at points during their descent through the water column, achieve a 'flattened' position in the water … ."[13]

Additionally, a video in the record refers to the "free fall" of the jig right between segments of the video in which the fish lure is shown to descend.[14] The same video shows Applicant's fishing lure falling through the water with a wobbled action and, at some point, achieving a horizontal orientation.[15]

The Examining Attorney also submitted various online articles discussing Applicant's goods as designed to employ a technique known as "slow pitch jigging" stating that (1) "[t]he center balanced jig slides to the side and moves in the **horizontal position**," and (2) "it's when the jig is on its side, **the horizontal position**, and when the jig is falling, going downward, that it attracts most bites." (emphasis added). Applicant has admitted that its lures are typically used in slow-pitch jigging.[16]

In addition, the evidence of record includes Internet articles from FISHFIGHT, Gulf Coast Mariner Magazine, Searcher Sportfishing, and Premium Comfort that refer to Applicant's brand of lures which use the term "flat fall" descriptively. For example:[17]

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[12] April 4, 2019 Response to Office Action, TSDR p. 6.

[13] Applicant's Appeal Brief, p. 2, 4 TTABVUE 4.

[14] October 4, 2019 Request for Reconsideration, Exh, I.

[15] *Id*.

[16] Applicant's Appeal Brief, p. 3, 4 TTABVUE 5.

[17] October 4, 2019 Request for Reconsideration; TSDR pp. 98-116.

- www.fishfight.com – "Take a closer look at how anglers are fishing the **flat-fall** jig as well as the size and color preferences in the following passages." "While some lures tend to torpedo down or sink eventually, the **flat-fall** almost sways from side to side. It can torpedo momentarily but will catch an edge and return to the butterfly-like pattern."

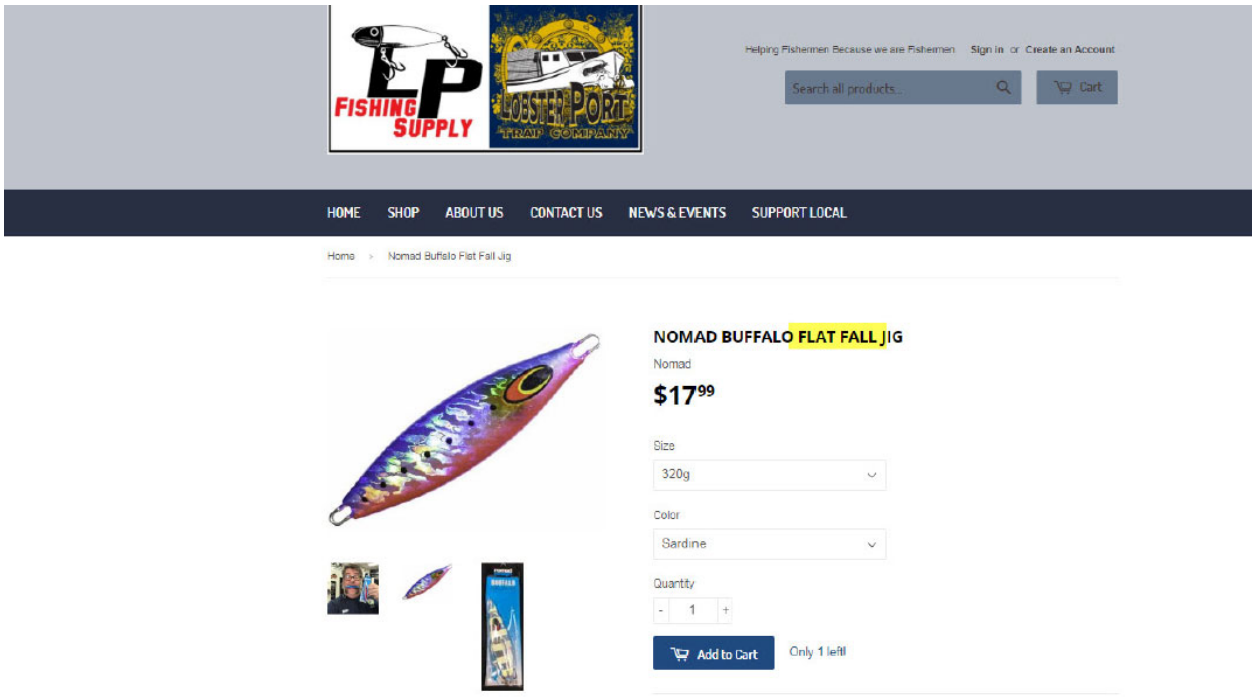
- www.gulfcoastmariner.com - "The 200g and 250 **flat fall jigs** should also be perfect for other Gulf species like amberjack, grouper and tuna."

- www.searchersportfishing.com – "In my experience, while the original Shimano butterfly lure receives strikes about 50 percent of the time on both the sink and retrieve, the **flat-fall** receives about 80 percent of strikes on the sink." "The most common **flat-fall** mishap I have seen is that someone will tie it on the end of their line, and a 40 plus pound bluefin will come along and bite it off."

- www.premiumcomfort.com - "The action of the **flat fall** is what makes it unique….Since the jig is balanced in the center, it will fall with a wobbled action in a horizontal position, keeping it in the strike zone longer and enticing hungry tuna. No other lure can match the action of a **flat fall**." "Targeting bluefin tuna with a **flat fall jig**…? Luckily, you do not have to be an expert angler to catch fish on a **flat fall**."

Additionally, the Examining Attorney submitted evidence demonstrating that third parties use the phrase "flat fall" descriptively to indicate a type of lure motion for goods identical to those offered by Applicant under its applied-for mark. For example:[18]

[18] April 29, 2019 Office Action, TSDR pp. 19-35.


LP FISHING SUPPLY
LOBSTER PORT TRAP COMPANY
Helping Fishermen Because we are Fishermen
Sign In or Create an Account
Search all products...
Cart
HOME
SHOP
ABOUT US
CONTACT US
NEWS & EVENTS
SUPPORT LOCAL
Home › Nomad Buffalo Flat Fall Jig
NOMAD BUFFALO FLAT FALL JIG
Nomad
$17.99
Size
320g
Color
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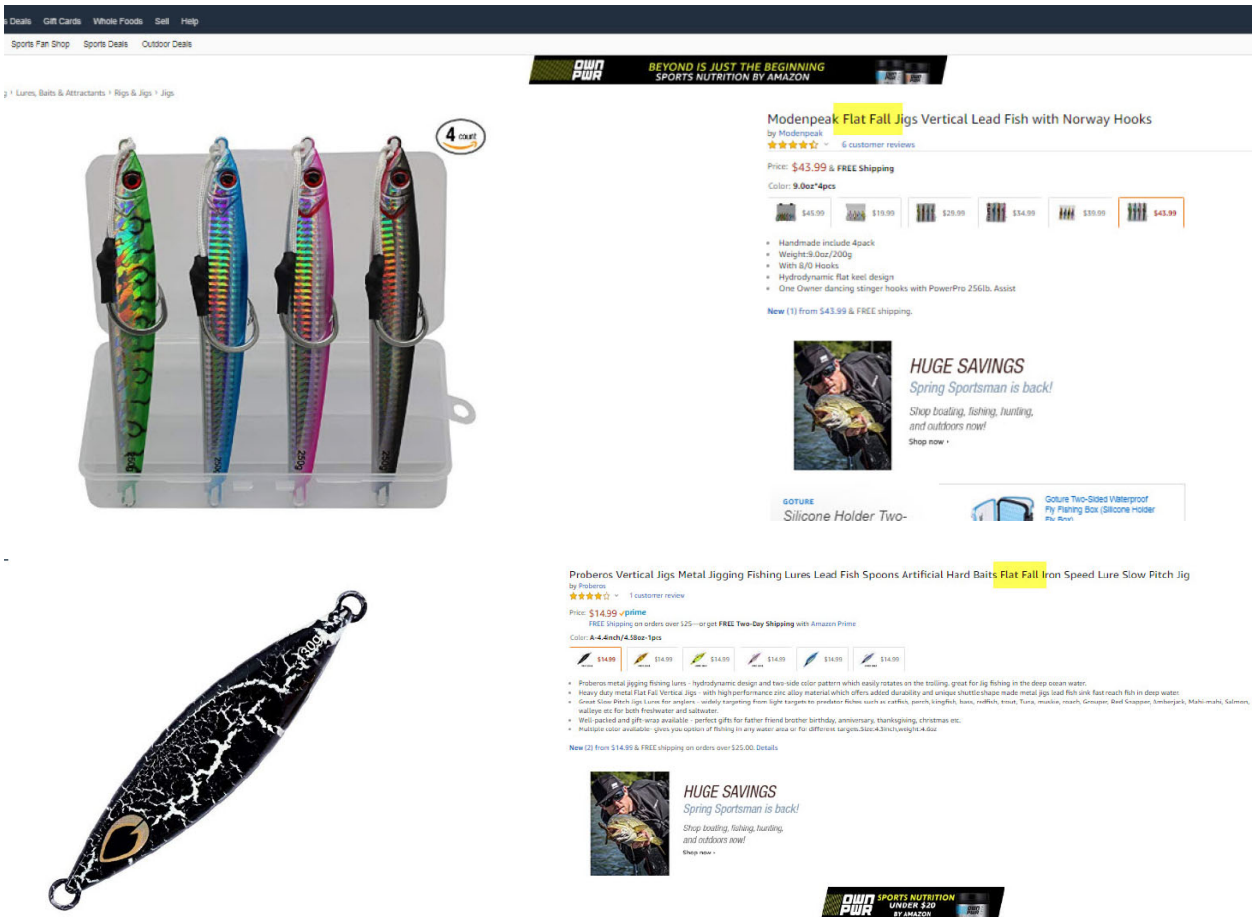
Quantity
1
Add to Cart
Only 1 left!


Gift Cards
Whole Foods
Sell
Help
Sports Fan Shop
Sports Deals
Outdoor Deals
BEYOND IS JUST THE BEGINNING
SPORTS NUTRITION BY AMAZON
4 count
Modenpeak Flat Fall Jigs Vertical Lead Fish with Norway Hooks
by Modenpeak
6 customer reviews
Price: $43.99 & FREE Shipping
Color: 9.0oz*4pcs
Handmade include 4pack
Weight:9.0oz/200g
With 8/0 Hooks
Hydrodynamic flat keel design
One Owner dancing stinger hooks with PowerPro 256lb. Assist
New (1) from $43.99 & FREE shipping.
HUGE SAVINGS
Spring Sportsman is back!
Shop boating, fishing, hunting, and outdoors now!
Shop now
GOTURE
Silicone Holder Two-
Goture Two-Sided Waterproof Fly Fishing Box (Silicone Holder
Proberos Vertical Jigs Metal Jigging Fishing Lures Lead Fish Spoons Artificial Hard Baits Flat Fall Iron Speed Lure Slow Pitch Jig
by Proberos
1 customer review
Price: $14.99 prime
FREE Shipping on orders over $25—or get FREE Two-Day Shipping with Amazon Prime
Color: A-4.4inch/4.58oz-1pcs
New (2) from $14.99 & FREE shipping on orders over $25.00. Details
HUGE SAVINGS
Spring Sportsman is back!
Shop boating, fishing, hunting, and outdoors now!
Shop now
SPORTS NUTRITION UNDER $20 BY AMAZON

palomar JIGS FLUOROCARBON ABOUT JOIN TEAM CONTACT KNOWLEDGE

HOME / REELDICULOUS JIGS / REELDICULOUS FLAT FALL "SMOKER" / REELDICULOUS FLAT FALL "SMOKER"

Flat Fall Smoker Purple Pink Spotted 150g (5.3oz)

$13.99

Purple Pink Spotted gets the nod for most effective deep drop jig. The use of black and dark purple give it a long range of sight in the deep. The skinny slivers of white/pink/silver within the overall design give an extreme opposite color contrast that translates perfectly in the deepest, darkest depths. A worldwide oceanic deep drop favorite.

98 in stock

Home / Fall Flat Keel Jigs / Flat Fall Glow Jig 250g

Flat Fall Glow Jig 250g

$13.95 – $120.00

Color: Neon Glow

Weight: 250g

Hook: 8/0 Single Short Shank Hook

Split Ring: Rated 800 lbs Stainless Steel

Quantity 1 pack | 3 pack | 5 pack | 7 pack | 10 pack

Clear

$13.31 each

Save $1.90

$39.95

1 Add to cart

Jimy Jigs › Flat Fall Jig - 170 GR Dancing Jimy - Jimy Jigs

Flat Fall Jig - 170 GR Dancing Jimy - Jimy Jigs

$ 22.99 USD

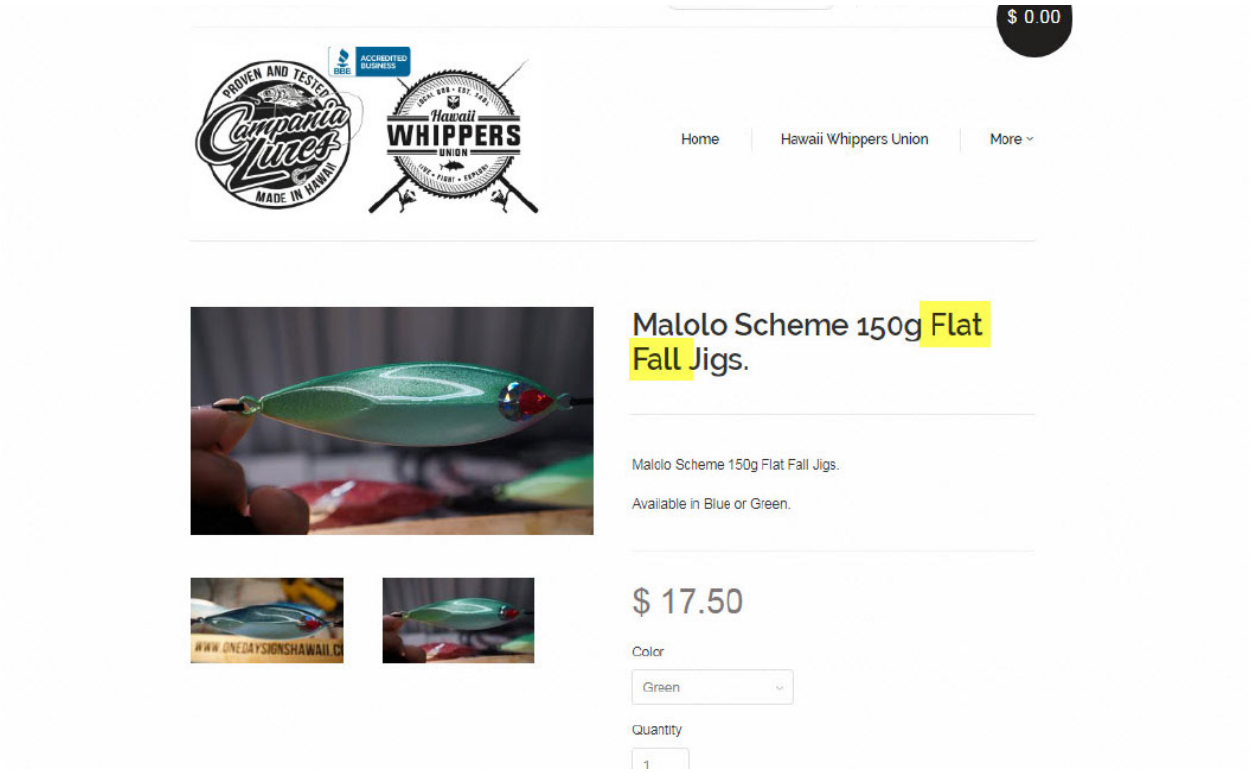
Color Yellow

Quantity 1 Add to cart

GUARANTEED SAFE & SECURE CHECKOUT

McAfee SECURE VISA MasterCard AMERICAN EXPRESS DISCOVER PayPal

Jimyjigs Dancing Jimy Jigs are designed to work perfectly with the "slow pitch" vertical jigging technique. These jigs are center balanced causing them to "dance" from side to side. This keeps these lures in the "fish zone" longer than any pencil style vertical jigs would. Perfect for targeting groupers and snappers.



Based on the foregoing evidence and concessions by Applicant, the Examining Attorney concludes that when relevant consumers are confronted with Applicant's fishing lures, including the packaging in which they are sold, they will immediately understand that the designation FLAT-FALL, when viewed in its entirety, merely describes a significant feature of Applicant's goods, namely, the lures trajectory position, i.e., flattened or in a horizontal position, when falling or descending into the water.

In challenging the refusal, Applicant argues that its FLAT-FALL mark is at least suggestive and, as such, is entitled to registration on the Principal Register.[19] Moreover, while conceding that its fishing lures do drop through the water, Applicant

[19] Applicant's Brief, p. 1, 4 TTABVUE 3.

argues that the term "flat" does not describe their motion or position or position in the water.[20] Applicant further contends that if its FLAT-FALL mark were actually descriptive, i.e., the wording immediately conveyed to consumers information about the nature of the motion of Applicant's FLAT-FALL branded lures, then neither a diagram nor a written description of its lures on the product packaging would be necessary.[21]

Applicant also argues that the Examining Attorney selected definitions of the term "flat," which has numerous meanings, from a variety of definitions in order to support the descriptiveness refusal.[22] In light of such multiple meanings, Applicant maintains that its mark does not communicate, without further analysis, a clear understanding of Applicant's goods.[23] More specifically, Applicant contests the Examining Attorney's conclusion that the term "flat" is equivalent to the term "horizontal."[24]

Further, Applicant attempts to downplay the importance of its fishing lures' "flattened position in the water," claiming that the orientation is fleeting and "does not properly describe the wobbling and jerking motion."[25] With regard to the Internet articles submitted by the Examining Attorney, Applicant argues that these articles

[20] *Id*. at p. 2, 4 TTABVUE 4.

[21] *Id*.

[22] *Id*. at pp. 3-5, 4 TTABVUE 5-7.

[23] *Id*.

[24] *Id*. at p. 5, 4 TTABVUE 7.

[25] *Id*. at p. 2, 4 TTABVUE 4.

specifically and explicitly refer to Applicant's fishing lures and, given this context, the use of the phrase "flat fall" or "flat-fall" in the articles does not reference a broad category of lures; instead, the use of these terms are directly attributable to Applicant and its fishing lures.[26]

With regard to the third-party uses of the term "flat-fall" of record, Applicant maintains that these third-parties are mere infringers of its applied-for FLAT-FALL mark and it has sent cease and desist letters to these entities.[27] Applicant further contends that while some of third-parties have failed to comply with Applicant's cease and desist demands, such failure is not evidence that Applicant lacks rights in its FLAT-FALL mark.[28]

Finally, Applicant requests that the Board resolve any doubt as to whether Applicant's FLAT-FALL mark is descriptive in Applicant's favor and allow the application to proceed to publication.[29]

IV. Analysis

We are not persuaded by Applicant's arguments. With regard to Applicant's argument that the term FLAT may have multiple meanings, that fact alone is not controlling on the issue of whether Applicant's composite mark is merely descriptive of Applicant's identified goods. *In re Franklin Cnty. Historical Soc'y*,

[26] *Id*. at pp. 9-10, 4 TTABVUE 11-12.

[27] *Id*. at pp. 11-12, 4 TTABVUE 13-14; *see also* October 22, 2019 Request for Reconsideration, TSDR pp. 6-17 (copies of cease and desist letters).

[28] Applicant's Appeal Brief pp. 11-12, 4 TTABVUE 13-14.

[29] *Id*. at 12-13, 4 TTABVUE 15-16.

104 USPQ2d 1085, 1087 (TTAB 2012) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)); TMEP § 1209.03(e). "It is well settled that so long as any one of the meanings of a term is descriptive, the term may be considered to be merely descriptive." *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1590 (TTAB 2018) (quoting *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984)). Here, the record includes the definition of the term "flat" which is defined as "horizontal."[30] We take judicial notice of the dictionary definition of the term "horizontal" which is defined as "flat or level."[31] Accordingly, the words "flat" and "horizontal" are synonymous terms. When viewing the term "flat" in the context of Applicant's goods, it is clear that the term describes a feature of Applicant's fishing lures, namely, the trajectory of the lures during their descent into the water. As shown above, Applicant's own packaging touts the horizontal or flat orientation of the lure as a significant feature of its goods which maintains the "strike zone" of catching a fish for a longer period of time. Indeed, it is this horizontal or flat orientation that Applicant claims distinguishes its fishing lures from others. If the flat orientation of the Applicant's lures were not a salient feature of Applicant's goods and only a "fleeting" orientation of the lures' trajectory into the water, as Applicant contends, then there would be no reason for Applicant to hype the flattened or horizontal orientation of its fishing lures in

[30] *See* n.7, *supra.*

[31] www.dictionary.com (based on Random House Unabridged Dictionary, 2020). As previously noted, the Board may take judicial notice of dictionary definitions, including online dictionaries. *See, e.g.*, *In re Omniome, Inc.*, 2020 USPQ2d 3222, *2 n.17 (TTAB 2020).

its packaging or advertising materials. Moreover, the fact that Applicant does promote the horizontal or flattened orientation on the packaging of its goods, reinforces to the prospective purchaser of the goods that the term "flat" is a descriptive feature of Applicant's fishing lures. Further, Applicant has conceded that the term "fall" describes a function of its goods.[32] As such, we not only find that the individual terms "flat" and "fall" are merely descriptive of Applicant's fishing lures, but the combination of these terms results in a composite mark that is itself merely descriptive.

As noted, Applicant argues that the Internet websites of record refer specifically to Applicant's fishing lures and do not use the wording "flat fall" descriptively, yet it appears that is exactly what the articles are doing. For example, the above-referenced premiumcomfort.com website shows that a webpage can refer to both Applicant's fishing lures and use the term "flat fall" to describe the motion or action of a type of lure. After describing the fall in detail ("it will fall with a wobbled action in a horizontal position"), premiumcomfort.com goes on to say that "[t]he action of the flat fall is what makes it unique" and "[n]o other lure can match the action of a flat fall."[33] Additionally, the website fishlight.com, in discussing Applicant's fishing lures, states "[t]ake a look at how anglers are fishing the flat-fall jig as well as size and color preferences in the

[32] *See* n.10, *supra*.

[33] October 4, 2019 Request for Reconsideration, TSDR p. 114.

following paragraphs."[34] The article also states that "[w]hile some lures tend to torpedo down or sink uneventfully, the flat-fall almost sways from side to side."[35] Most significantly, the article includes a hyperlink which states "View Flat Fall Jigs On Amazon,"[36] clearly employing the designation "flat fall" as a type of jig.

Further, to the extent that Applicant is arguing that it is the first user of the designation FLAT-FALL for its identified goods, the fact that an applicant may be the first or only user of a merely descriptive designation does not necessarily render a word or term incongruous or distinctive; as in this case, the evidence shows that FLAT-FALL is merely descriptive of the goods at issue. *See In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1514 (TTAB 2016); *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012); TMEP §1209.03(c).

Although Applicant argues that the third-parties using the phrase "flat fall" for goods identical to those of Applicant are infringers and that it has taken action to halt such alleged infringing use, it does not appear that Applicant, based on the record, has been successful in enjoining third-parties from using the designation. Even if the evidence did demonstrate that Applicant's competitors may have agreed to discontinue use of the designation "flat fall" or "FLAT-FALL" upon threat of legal action by Applicant, such action may show a desire by those competitors to avoid litigation, rather than demonstrating the distinctiveness of the wording. *See In re*

[34] *Id.*, TSDR p. 98.

[35] *Id.*, TSDR p. 100.

[36] *Id.*

Wella Corp., 565 F.2d 143, 196 USPQ 7, n.2 (CCPA 1977); *In re Consolidated Cigar Corp.,* 13 USPQ2d 1481, 1483 (TTAB 1989). *Cf. In re Cree, Inc.*, 818 F.3d 694, 118 USPQ2d 1253, 1259 (Fed. Cir. 2016) (because it is cheaper to take a license than defend a patent infringement action, licenses are often entered into to avoid litigation).

Finally, the use of the hyphen between the terms FLAT and FALL does not obviate a finding of mere descriptiveness. *See e.g.*, *In re Vanilla Gorilla, L.P.*, 80 USPQ2d 1637 (TTAB 2006) (finding that the presence of a hyphen in the mark "3-0's" does not negate mere descriptiveness of mark for automobile wheel rims).

V. Conclusion

We have carefully considered all arguments and evidence of record. Based on this evidence, we conclude that the designation FLAT-FALL is merely descriptive of Applicant's identified goods since the mark merely describes a primary function or characteristic of Applicant's identified goods, namely, the lures trajectory position, i.e., flattened or in a horizontal position, when falling or descending into the water. We further find that the combination of the descriptive term "flat" with the descriptive term "fall" does not create a non-descriptive or incongruous meaning. Instead, we find that each component retains its merely descriptive significance in relation to Applicant's identified goods, the combination of which results in a composite mark that is itself merely descriptive. Moreover, while Applicant correctly states the general principle that any doubt as to descriptiveness must be resolved in its favor, in this case, we have no doubt that FLAT-FALL is merely descriptive of Applicant's identified goods under Section 2(e)(1) of the Trademark Act.

Decision: The refusal to register Applicant's FLAT-FALL mark on the Principal Register under Section 2(e)(1) of the Trademark Act on the ground that the designation, in its entirety, is merely descriptive of Applicant's identified goods is affirmed.