

TTAB



02-07-2003

Mark:  
Serial No.:  
Attorney Matter No.:

SHOTFINDER (stylized)  
76/341740  
393026

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

MARK: **SHOTFINDER (stylized)** Serial No.: 76/341,740  
Applicant: Barcrest Outdoors, Inc. Law Office: 108  
Filed: November 21, 2001 Examiner: Robert Clark

**BOX TTAB – NO FEE**  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

**APPLICANT'S APPEAL BRIEF**

**I. INTRODUCTION**

Applicant hereby appeals from the Examiner's office action dated June 12, 2002 making final his refusal to register the above identified mark, and respectfully requests the Trademark Trial and Appeal Board to reverse the Examiner's decision. Applicant does not request an oral hearing.

**II RELEVANT FACTS**

**A. PROCEDURAL POSTURE**

The Applicant filed its application to register the mark SHOTFINDER (stylized) on November 21, 2001, and Applicant has used this mark in commerce since May 2001. The Examining Attorney mailed his Office Action making final his refusal of registration on June 12, 2002. The Applicant noticed its appeal from that final rejection on December 12, 2002.

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## B. APPLICANT'S TRADEMARK

Applicant seeks registration on the Principal Register of its mark, Serial No. 76/341,740 SHOTFINDER (stylized) for use with: Accessories for hunters, namely electronic devices for detecting and signaling the presence of meal objects in the flesh of game animals, (IC 009).

## C. THE REJECTION

The Examiner has rejected the registration, on the Principal Register, of Applicant's mark under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1). The Examiner contends that Applicant's mark, as applied to the goods set forth in Applicant's application for registration is merely descriptive of an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods and therefore cannot be registered.

## III. ARGUMENT: APPLICANT'S MARK IS NOT MERELY DESCRIPTIVE OF THE RELEVANT GOODS.

The Examiner asserts that the pending mark is merely descriptive of the goods which will feature the mark. Applicant does not deny that it may be asserted that Applicant's mark suggests that the goods could be used to locate shot (metal pieces from a shotgun shell). Often the best trademarks are highly suggestive, and it is well settled that a valid trademark may be highly suggestive. *Van Camp Sea Food Co. v. Alexander B. Stewart Organization*, 18 CCPA 1415, 1420, 50 F.2d 976, 9 U.S.P.Q. 541, 544 (1931). In re *The Realistic Co.*, 58 CCPA 1204, 440 F.2d 1393, 169 U.S.P.Q. 610 (1971) (the

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mark CURV' held not to be "so descriptive of [permanent wave curling solutions] as to preclude registration"). SHOTFINDER is not a "dictionary word", nor is it, as far as Applicant is aware, a word which had any existence in the common vernacular until Applicant coined it. Nor has the Examining Attorney shown that it has become a part of the language. It is a short, catchy way of suggesting unique characteristics of the goods. Applicant notes that any of Applicant's potential competitors (of which there are presently none, due to the novel and proprietary nature of Applicant's business and products) would be able to describe similar products and advertise them without the use of the term coined by the present Applicant. It is unlikely that Applicant will have any competitors because the goods to which the SHOTFINDER (stylized) mark is applied are entitled to the benefits of U.S. Patent No. D459,244.

It is nowhere stated in the statutes or case law that a coined word cannot be descriptive. It is descriptive if it happens to be the new name of a new product. Names are necessarily coined in the beginning. It is well established that two or more words which would be merely descriptive by themselves can be joined together in such a way that the resulting term is a valid technical trademark. *In re Colonial Stores*, 55 CCPA 1049, 394 F.2d 549, 157 U.S.P.Q. (1968) (SUGAR & SPICE); *In re Chesapeake Corp. of Virginia*, 57 CCPA 838, 420 F.2d 754, 164 U.S.P.Q. 395 (1970) (SUPERWATERFINISH). In Applicant's opinion, SHOTFINDER (stylized) is such a term. It is a coined term, and one which is not merely descriptive. As applied to the

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goods, SHOTFINDER (stylized) does not describe that the device electronically detects and signals the presence of metal.

It is essential to consider a word or phrase in context when determining whether it is suggestive or descriptive. *See, e.g. Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033 (2d Cir. 1992). In the context of the pending application, the word SHOTFINDER suggest to consumers what the goods are capable of doing, namely locating shotgun pellets or bullets, but does not specify or suggest how they will be located, from where they will be located or what happens once they are located.

The true test of descriptiveness of a mark is its meaning to a class of buyers which are prospective purchasers, which is not necessarily the same as the popular meaning. *Educational Dev. Corp. v. Economy Co.*, 562 F.2d 26, 195 U.S.P.Q. 482 (10th Cir. 1977). Buyers of the goods of Applicant must interpret SHOTFINDER (stylized) to mean a device for locating a metal piece in the flesh of a game animal and providing an audible warning that metal bullet or pellet is present. Without thought, or prior association, the common buyer would not immediately know that SHOTFINDER (stylized) is a metal detector for locating metal pellets or bullets in the flesh of a game animal. With some thought that connection may be made, therefore, the conclusion is reached because the mark suggests the nature of the goods but does not describe them. Since the buyer will not have the benefit of the description of goods being offered, as set forth in the pending application, descriptiveness must be considered as if no description of goods is available.

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In that light, SHOTFINDER (stylized) is not descriptive, and the average buyer of goods will have to consider an array of possible goods. It is easier to deem a word or phrase descriptive, once the offered goods or services are known.

Hindsight should not be used to label a suggestive word or term descriptive simply because an association may be made once the goods or services are known. To do so avoids the distinction between suggestive marks and those which are "merely" descriptive and dismisses as descriptive any mark which is also suggestive. As required, in order to refuse registration under Trademark Act Section 2(e)(1) the mark must be "merely" descriptive. That means that any mark which might also be suggestive should not be denied registration.

Applicant further notes that the coined term SHOTFINDER (stylized) is particularly incongruous because no one has ever produced or marketed a device for locating metal shot in game animals. Incongruity is a strong indicator of suggestiveness. *American Home Products Corp. v. Johnson Chemical Co.*, 589 F.2d 103, 200 U.S.P.Q. 417 (2d Cir. 1978) (ROACH MOTEL). Applicant has developed the device for locating metal shot in game animals and has patented the device. Applicant also coined the mark, including the stylized "look" of the mark. It is coined terms with unique appearances which are most likely to be remembered by consumers. Therefore, Applicant maintains that the term SHOTFINDER (stylized) is thus not merely descriptive within the meaning of 15 U.S.C. 1052(e)(1).

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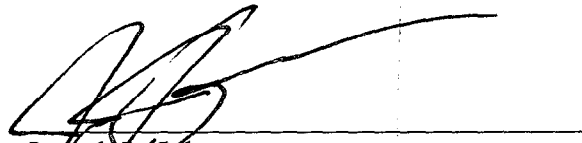
#### IV CONCLUSION

The mark, taken as a whole, is not merely descriptive but is a mark coined by the Applicant which is highly suggestive of the goods to which it is applied. For the reasons set forth hereinabove, Applicant submits that the mark is entitled to registration. The Board is therefore respectfully requested to reverse the Examiner's decision refusing registration of Applicant's mark.

Respectfully submitted,

LATHROP & GAGE L.C.

Date: 2/7/03

  
\_\_\_\_\_  
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**CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)**

Matter No.

Applicant(s): Barcrest Outdoors, Inc.

393026

Serial No.

Filing Date

Examiner

Group Art Unit

76/341,740

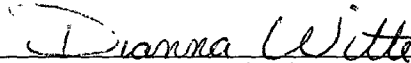
November 26, 2001

Robert Clark

108

For: SHOTFINDER and Design

I hereby certify that a Transmittal letter in duplicate (4 pages); Applicant's Appeal Brief (6 pages); a Certificate of Mailing by Express Mail for No. EU442922488US (1 page); and a pre-addressed postcard are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: Box TTAB-No Fee, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on February 7, 2003.



(Signature of Person Mailing Correspondence)

**DIANNA WITTE**

(Typed or Printed Name of person Mailing Correspondence)

**Express Mail No. EU442922488US**

("Express Mail" Mailing Label Number)

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Enclosures

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02-07-2003



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February 7, 2003

**VIA EXPRESS MAIL NO. EU442922488US**

BOX TTAB – NO FEE  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

Re: Trademark Application for SHOTFINDER and Design  
Applicant: Barcrest Outdoors, Inc.  
Serial No.: 76/341,740  
Filed: 11/26/2001  
Attorney Docket No.: 393026

Dear Sir or Madam:

We enclose for filing on behalf of applicant, Barcrest Outdoors, Inc., Applicant's Appeal Brief required by the Notice of Appeal received on December 12, 2002. Also enclosed are:

1. Return Post Card; and,
2. Certificate of Mailing by Express Mail.

If you should have any questions or need anything further, please do not hesitate to contact me at the number listed above.

Cordially,

LATHROP & GAGE L.C.

By:

Joseph L. Johnson

JLJ:dw

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