

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

MAY 08 2003

Applicant:	Barcrest Outdoors, Inc.	:	BEFORE THE
Trademark:	SHOTfinder	:	TRADEMARK TRIAL
Serial No:	76/341740	:	AND
Attorney:	Joseph Johnson	:	APPEAL BOARD
Address:	Lathrop & Gage L.C. 1845 South National P.O. Box 4288 Springfield, Missouri 65808	:	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

Grounds for Refusal

Registration was refused based on §2(e)(1) of the Act; the proposed mark is merely descriptive of the goods on which the mark is used.

ISSUE ON APPEAL

- I. Whether the term "SHOTfinder" is merely descriptive when used in connection with "accessories for hunters, namely electronic devices for detecting and signaling the presence of metal objects in the flesh of game animals."

ARGUMENT

I

THE TERM "SHOTfinder" DESCRIBES A CHARACTERISTIC OF THE GOODS WHICH ARE DESIGNED TO FIND SHOT AND IS, THEREFORE, MERELY DESCRIPTIVE OF GOODS

The Test For Descriptiveness:

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b).

A term which describes a characteristic or feature of a product is considered merely descriptive of the product itself. See: *In re Reckitt & Coleman, North America, Inc.*, 18 USPQ2d 1389 (TTAB 1991) ("PERMA-PRESS" used on clothing is generic for the clothing); *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 80, 195 USPQ 281, 285 (7th Cir. 1977), *cert. denied*, 434 U.S. 1025, 196 USPQ 592 (1978). ("LITE" is a generic term for beer).

"Shot" is defined as:

8.
 - a. A solid projectile designed to be discharged from a firearm or cannon.
 - b. *plural shot* Such projectiles considered as a group.
 - c. *plural shot* Tiny lead or steel pellets, especially ones used in a shotgun cartridge.
 - d. One of these pellets.¹

"Finder" is defined as:

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1. One that finds: *a finder of great hidden treasure.*²

The Board may take judicial notice of dictionary definitions, see *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Col, Inc.*, 213 USPQ 594 (TTAB 1982), AFF'D, 217 USPQ 505 (Fed. Cir. 1983). Literally, applicant's mark means something that finds shot. The identification of goods consists of "accessories for hunters, namely electronic devices for detecting and signaling the presence of metal objects in the flesh of game animals." The metal objects include lead shot. With regard to the word "FINDER" we have to assume that this word has its ordinary plain meaning.

This mark is at least prima facie descriptive. The examining attorney must consider whether a mark is merely descriptive in relation to the identified goods, not in the abstract. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). The specimens of record indicate that applicant's goods "[d]etect elusive pieces of shot before cooking", "[e]liminate discomfort of biting into shot" and "[m]akes traditional Game Bird cleaning obsolete". In addition, the specimens implore purchasers to "[u]se SHOTfinder to ensure your gourmet creations are SHOT-FREE!". "SHOTfinder" describes a characteristic or feature of applicant's goods. And, as such, the proposed mark is merely descriptive in relation to the goods, which are defined broadly as ""accessories for hunters, namely

²*The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation;

electronic devices for detecting and signaling the presence of metal objects in the flesh of game

Suffice it to say that it is basic trademark law that a term which is descriptive of, or generic for, an attribute, component, ingredient, or any characteristic of the goods on which the proposed mark is used, is descriptive or generic for the goods themselves. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *Miller Brewing Co. v. Heilman Brewing Co.* 195 USPQ 281 (7th Cir. 1977) *cert. den.* 434 U.S. 1025 (1978); TMEP section 1209.01(b). As such, the proposed mark must be refused based upon §2(e)(1).

Applicant's Arguments:

Applicant does not deny that its mark suggests that the goods could be used to locate shot. But, according to the applicant, SHOTFINDER does not describe how the shot will be located, from where they will be located or what happens once they are located. It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. See, e.g., *In re Gyulay*, 3 USPQ2d 1009

and *In re Abcor Development Corp.*, 200 USPQ 215 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether 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 or is intended to be 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 such use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Thus, "whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

"SHOTfinder" is not a dictionary word. Therefore, applicant argues that the mark is not descriptive. Perhaps the term is too new to appear in the dictionaries offered by applicant. And the fact that a term is not found in the dictionary is not controlling on the question of registrability. *In re Gould Paper Corp.*, 5 USPQ2d 1110 (Fed. Cir. 1987). The fact that an applicant may be the first and only user of a merely descriptive designation does not justify registration if the term is merely descriptive. *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983). The examining attorney must consider descriptiveness in relation to the relevant goods or services. The fact that a term may have different meanings in another context is not controlling on the

question of descriptiveness. *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).
TMEP Sec. 1209.03(e).

Applicant notes that any potential competitors would be able to describe similar products and advertise them without the use of the term "SHOTfinder". Applicant maintains that there are other ways of identifying such goods, but applicant does not specify any other ways of identifying the goods. While there may be other ways of referring to applicant's product, "SHOTfinder" is certainly an alternative way of stating that the goods find shot. It is a common or apt descriptive name for applicant's goods, which, like many products, may be named by more than one generic term. *In re Sun Oil Co.*, 165 USPQ 718, 719 (CCPA 1970) (J. Rich, concurring). There are few, if any, phrases which would more concisely and directly identify the nature of applicant's shot detector. The goods find shot.

Applicant also believes that it is unlikely that it will have any competitors since it has a patent and that the mark is incongruous since no one has ever produced or marketed a device for locating metal shot in game animals. Applicant has not submitted a copy of the patent. And the fact that applicant may be the only purveyor of shot finders to use the term "SHOTfinder" does not mean that the term will be perceived as a trademark rather than as a descriptive term. *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983).

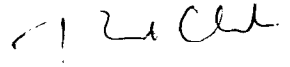
Applicant argues that the statutes do not proscribe a coined word from being descriptive. However, Sec. 2(e)(1) of the Act proscribes any mark that is merely descriptive. And applicant argues that descriptiveness must be considered as if no description of goods is available and potential buyers would not immediately know that "SHOTfinder" is a metal detector for locating metal pellets or bullets in the flesh of a game animal without the benefit of the description of goods being offered, as set forth in the application.

Applicant argues that the term "SHOTfinder" suggests that the goods could be used to locate shot but does not describe how the shot will be located. But a term which is merely descriptive if it describes any attribute, component, ingredient, or any characteristic of the goods on which the proposed mark is used. Applicant cites case law in which marks composed of descriptive elements were found not to be descriptive because the combination of the terms resulted in a unitary expression which require imagination for one to reach a conclusion about the nature of the goods. The examining attorney must consider descriptiveness in relation to the relevant goods or services. "SHOTfinder" as applied to electronic devices for detecting shot obviously refers to a device for finding gunshot.

Furthermore, Applicant has provided no evidence that the term "SHOTfinder" means anything other than a device for detecting pieces of shot.

Based upon the foregoing, the proposed mark "SHOTfinder" must be refused registration pursuant to §2(e)(1) of the Act.

Respectfully submitted,



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