

**This Opinion is Not a
Precedent of the TTAB**

Mailed: August 7, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Boats Direct, LLC
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Serial No. 85418867
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Ejola Cook of The Ticktin Law Group,
for Boats Direct, LLC.

Jessica Ellinger Fathy, Trademark Examining Attorney, Law Office 110,
Chris A. F. Pedersen, Managing Attorney.

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Before Bergsman, Gorowitz and Hightower,
Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

Boats Direct, LLC (“Applicant”) seeks registration on the Principal Register of
the mark BOATS DIRECT USA (in standard characters) for

“Boat dealerships; Dealerships in the field of Boats” in
International Class 35.¹

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

¹ Application Serial No. 85418867 was filed on September 9, 2011, based upon Applicant’s
claim of first use anywhere and use in commerce since at least as early as July 19, 2011.

ground that the mark is primarily geographically descriptive of Applicant's services. Applicant appealed the final refusal. We reverse the refusal to register.

I. Evidentiary Issues.

Before proceeding to the merits of the refusal, we address an evidentiary matter. Applicant submitted new evidence with its appeal brief, consisting of: definitions of the term "direct" from the Free Merriam-Webster Dictionary (m-w.com), nine registrations from the Trademark Electronic Search System (TESS), and webpages regarding Applicant. Evidence submitted after an appeal is untimely and ordinarily will not be considered. Trademark Rule 2.142(d), 37 CFR § 2.142(d). However, if the Examining Attorney, in his or her brief, discusses the exhibits attached to the Applicant's brief without objecting to them, they will be deemed to have been stipulated into the record and will be considered. *See In re Development Dimensions International, Inc.*, 219 USPQ 161 (TTAB 1983), and Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 1207.03 (2014). We take judicial notice of the definitions of the term "direct."² Further, since the Examining Attorney did not object to the submission of the third-party registrations and, in fact, discussed them in her Brief, we consider the registrations to have been stipulated into the record and they will be considered. Finally, we note that some of the webpages had been

² The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

submitted during prosecution and were considered. We have not considered the webpages that were not submitted prior to the appeal.

II. Discussion.

The test for determining whether a term is primarily geographically descriptive is whether (1) the primary significance of the term in the mark sought to be registered is the name of a place generally known to the public, and (2) the public would make an association between the goods or services and the place named in the mark (a “goods or services/place association”), that is, believe that the goods or services for which the mark is sought to be registered originate in that place. *In re Hollywood Lawyers Online*, 110 USPQ2d 1852, 1853-54 (TTAB 2014). *See also In re Societe Generale des Eaux Minerals de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385 (TTAB 1994); and *In re California Pizza Kitchen, Inc.*, 10 USPQ2d 1704 (TTAB 1988). If the goods or services do in fact emanate from the place named in the mark, the goods or services/place association can be presumed. *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998).

Applicant admits that “the term ‘USA’ is generally known to be the United States of America.” Appeal Brief, p. 3, 4 TTABVUE at 4. Moreover, we find that there is nothing in the mark that affects the primary geographical meaning of the term USA. Thus, we find that the first factor of the test for determining whether a term is primarily geographically descriptive is satisfied.

Turning to the second factor of the geographic descriptiveness test, Applicant is located in Key Largo, Florida. The services Applicant has applied to register do in fact emanate from the place named in the mark, the United States of America. Therefore, a services/place association is presumed.

However, Applicant argues that there is no “association or evidence to show that the public would attribute boat sales in the United States to the applied for mark.” *Id.* To support its argument, Applicant relies on nine third-party registrations that include the term “USA.” Applicant’s reliance is misplaced. Four of the registrations (LED MFG, USA & design, SCOTT GOLF USA, AGRO PROTECTION USA, INC., and AUTO USA INTERNET SALES SOLUTIONS & design) include disclaimers of the term “USA”; one of the registrations (USA TODAY BEST SELLING BOOKS WHAT AMERICA’S READING) is on the Supplemental Register; and two of the registrations (USA FINANCIAL and USA PAWN & JEWELRY CO.) include a claim of acquired distinctiveness under Section 2(f) of the Trademark Act. The only exception is the registration for USA HAIR CLINICS, in which the term USA is in stylized form with a strand of hair depicted inside of the letter “U.” Thus, these registrations do not support Applicant’s argument that the public would not associate the term “USA” with a geographic location.

Applicant has not successfully rebutted the services/place presumption. Accordingly, we find that the term “USA” in the mark is geographically descriptive.

We next evaluate the mark in its entirety to determine whether the mark is primarily geographically descriptive. To that end, we look at the non-geographical

terms in the mark. “The presence of generic or highly descriptive terms in a mark which also contains a primarily geographically descriptive term does not serve to detract from the primary geographical significance of the mark as a whole.” *JT Tobacconists*, 59 USPQ2d at 1082 (MINNESOTA CIGAR COMPANY primarily geographically descriptive of cigars from Minnesota). Similarly, the presence of words that are both highly suggestive and laudatory does not detract from the primarily geographic significance of a mark. *In re South Park Cigar Inc.*, 82 USPQ2d 1507, 1513 (TTAB 2007) (“The word GOLD in Applicant’s mark YBOR GOLD [for cigars and tobacco] is highly suggestive and laudatory, simply connoting the high quality of the goods,” which does not detract from the primarily geographic significance of the mark.). In other words, if the term “BOATS DIRECT” is generic, highly descriptive, or highly suggestive and laudatory, the entire mark will be deemed primarily geographically descriptive.

It is uncontroverted that the word “BOATS” is generic for boats.³ Thus, the question is whether the addition of the word “DIRECT” creates a highly descriptive, generic or a highly suggestive and laudatory composite mark. “The [E]xamining [A]ttorney maintains that [t]he wording [BOATS DIRECT] does not detract for [sic] the primary geographic significance of the mark. The wording merely describes the nature of Applicant’s services, namely, that applicant’s dealerships provide the direct sale of boats.” Examining Attorney’s Brief, p. 9, 6 TTABVUE at 8. There is,

³ “Boat” is defined as: a. a relatively small, usually open craft of a size that might be carried aboard a ship. b. An inland vessel of any size. c. A ship or submarine. Definition from Houghton Mifflin on Yahoo Education website (education.yahoo.com). Office Action dated January 6, 2012, unnumbered p. 15.

however, no definition or other evidence explaining the meaning of the “direct” sale of boats.

Both the Examining Attorney and the Applicant submitted definitions of the word “direct,” including the following definitions from Yahoo.com, which essentially encompass all of the other definitions submitted:

Verb:

1. To manage or conduct the affairs of, regulate
2. To have or take charge of, control. See Synonyms at conduct.
3. To give authoritative instructions to: *directed the student to answer.*
4. To cause to move toward a goal: aim. See Synonyms at aim.
5. To show or indicate the way for: *directed us to the airport.*
6. To cause to move in or follow a straight course: *directed their fire at the target.*
7. To indicate the intended recipient of (a letter, for example).
8. To address or adapt (remarks, for example) to a specific person, audience, or purpose.
9. a. To give guidance and instruction to (actors or musicians, for example) in the rehearsal and performance of a work.
b. To supervise the performance of.

Verb:

1. To give commands or directions.
2. To conduct a performance or rehearsal.

Adjective:

1. Proceeding without interruption in a straight course or line, not deviating or swerving: *a direct route.*
2. Straightforward and candid; frank: a direct response.
3. Having no intervening persons, conditions, or agencies; immediate: *direct contact; direct sunlight.*

4. Effected by action of the voters, rather than through elected representative or delegates: *direct elections*.
5. Being of unbroken descent, lineal: *a direct descendant of the monarch*.
6. Consisting of the exact words of the writer or speaker: *a direct quotation; direct speech*.
7. Lacking compromising or mitigating elements; *direct opposites*.
8. *Mathematics* Varying in the same as another quantity, especially increasing if another quantity increases or decreasing if it decreases.
9. *Astronomy* Designating west-to-east motion of a planet in the same direction as the sun's movement against the stars.
10. *Sports* Being a free kick in soccer by which a goal can be scored without the ball being touched by a second player.

Despite Applicant's admission that some of the boats it sells are "factory direct," the Examining Attorney has not established that the term "BOATS DIRECT" describes a feature of Applicant's dealership in factory-direct boats, nor has the Examining Attorney established that any of these definitions apply to the word "direct" as used in conjunction with the word "boats." To be clear, there is no evidence supporting the Examining Attorney's contention that the term "Boats Direct" is merely descriptive or even that it is highly suggestive and laudatory. Accordingly, we find that the phrase "BOATS DIRECT" is not highly descriptive, generic or highly suggestive and laudatory.

Since the mark BOATS DIRECT USA does not consist of a geographically descriptive term combined with a highly descriptive, generic, or highly suggestive and laudatory term, the mark is not primarily geographically descriptive. As such, the mark is inherently distinctive and proof of acquired distinctiveness is not

required. Accordingly, it is not necessary for us to decide the issue of acquired distinctiveness.

As discussed above, the word “BOATS” is generic and the word “USA” is geographically descriptive. Registration of the mark BOATS DIRECT USA cannot issue without disclaimers of these words. Pursuant to Trademark Rule 37 CFR § 2.142(g), the Board is permitted to reopen the application for the purpose of entry of a disclaimer under Section 6 of the Trademark Act. *See In re Johanna Farms, Inc.*, 223 USPQ 459, 462 (TTAB 1984).

Decision: The refusal to register Applicant’s mark BOATS DIRECT USA is reversed. The application is reopened and remanded to the Examining Attorney for entry of disclaimers of the words “BOATS” and “USA.” Upon entry of the disclaimers, the application may be published for opposition.