Mailed: April 4, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Stella McCartney Limited

Serial No. 87410072

Charles T. J. Weigell of Fross Zelnick Lehrman & Zissu PC,
for Stella McCartney Limited.

Douglas M. Lee, Trademark Examining Attorney, Law Office 111,
Chris Doninger, Managing Attorney.

Before Shaw, Kuczma, and Hightower,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

A typographical error in the March 29, 2019 decision of the Board is corrected. On page one of the attached decision, the caption is amended to read that the appeal was heard by judges Shaw, Kuczma, and Hightower.

This Opinion is Not a Precedent of the TTAB

Mailed: March 29, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Stella McCartney Limited

Serial No. 87410072

Charles T. J. Weigell of Fross Zelnick Lehrman & Zissu PC,
for Stella McCartney Limited.

Douglas M. Lee, Trademark Examining Attorney, Law Office 111,
Chris Doninger, Managing Attorney.

Before Shaw, Kuczma, and Hightower,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Stella McCartney Limited ("Applicant") seeks registration on the Principal Register of the mark FUR FREE FUR[1] (in standard characters) for goods identified as:

> Handbags; tote bags; hobo bags; beach bags; crossbody bags; city bags in the nature of tote bags and carry-all bags;

[1] Application Serial No. 87410072 was filed on April 13, 2017 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a); Applicant claims a date of first use of the mark on the class 18 goods anywhere as of March, 2015 and in commerce as of April, 2015, and claims a date of first use of the mark on the class 25 goods anywhere as of March, 2014 and in commerce as of April, 2014.

> re-usable shopping bags; canvas shopping bags; belt bags; hip bags; all-purpose carrying bags; clutch bags; shoulder bags; messenger bags; wheeled bags; suitcases; luggage; sports bags; kit bags; gym bags; backpacks; toilet bags sold empty; cosmetics bags sold empty; wash bags sold empty for carrying toiletries; briefcases; pouches; dog, cat, and other smaller animal carriers; pet accessories, namely, specially designed canvas, vinyl or imitation leather bags attached to animal leashes for holding small items such as keys, credit cards, money or disposable bags for disposing of pet waste, in International Class 18; and
>
> Clothing, namely, suits, coats, topcoats, jackets, parkas, waistcoats, raincoats, wraps, vests, blouses, shirts, t-shirts, polo shirts, vests, jumpsuits, combination tops and bottoms, jerseys, pullovers, sweaters, sweat shirts, jumpers, hooded jumpers, skirts, evening gowns, dresses, petticoats, trousers, jeans, sweatpants, shorts, pants, hats, hoods, headbands, caps, baseball caps, berets, beanie hats, flat caps, hoods, ear muffs, shawls, scarves, shoulder wraps, mittens, mufflers, gloves, shoes, boots, ankle boots, lace boots, sandals, slippers, pumps being footwear, court footwear, bath slippers; headwear; footwear, in International Class 25.

The Trademark Examining Attorney has 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 Applicant's mark is merely descriptive of the identified goods. When the refusal was made final, Applicant appealed and requested reconsideration. The Examining Attorney denied the request for reconsideration and the appeal resumed. The case is fully briefed. We reverse the refusal to register.

Mere Descriptiveness under Section 2(e)(1)

"A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used." *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); *In re Gyulay,* 820 F.2d 1216, 3 USPQ2d 1009, 1009-10 (Fed. Cir. 1987). Conversely, a mark is suggestive if it "requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods or services." *In re Franklin Cty. Historical Soc'y*, 104 USPQ2d 1085, 1087 (TTAB 2012). Whether a particular term is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle,* 66 USPQ2d 1222, 1224 (TTAB 2002).

There is no disagreement as to the meaning of the terms in the mark in relation to the goods. The term "fur" is defined as:

1. "the dense coat of fine silky hair on such mammals as the cat, seal and mink;"
2. "a garment made of or lined with the dressed pelt of a mammal;"
3. "a pile fabric made in imitation of animal fur;" or
4. "a garment made from such a fabric."[2]

The term "free" is defined as:

1. "not affected or restricted by a given condition or circumstance;" or

[2] Thefreedictionary.com (citing Collins English Dictionary – Complete and Unabridged, 12th ed. 2014), 12 TTABVUE 21.

2. "not containing something specified (often used in combination)."[3]

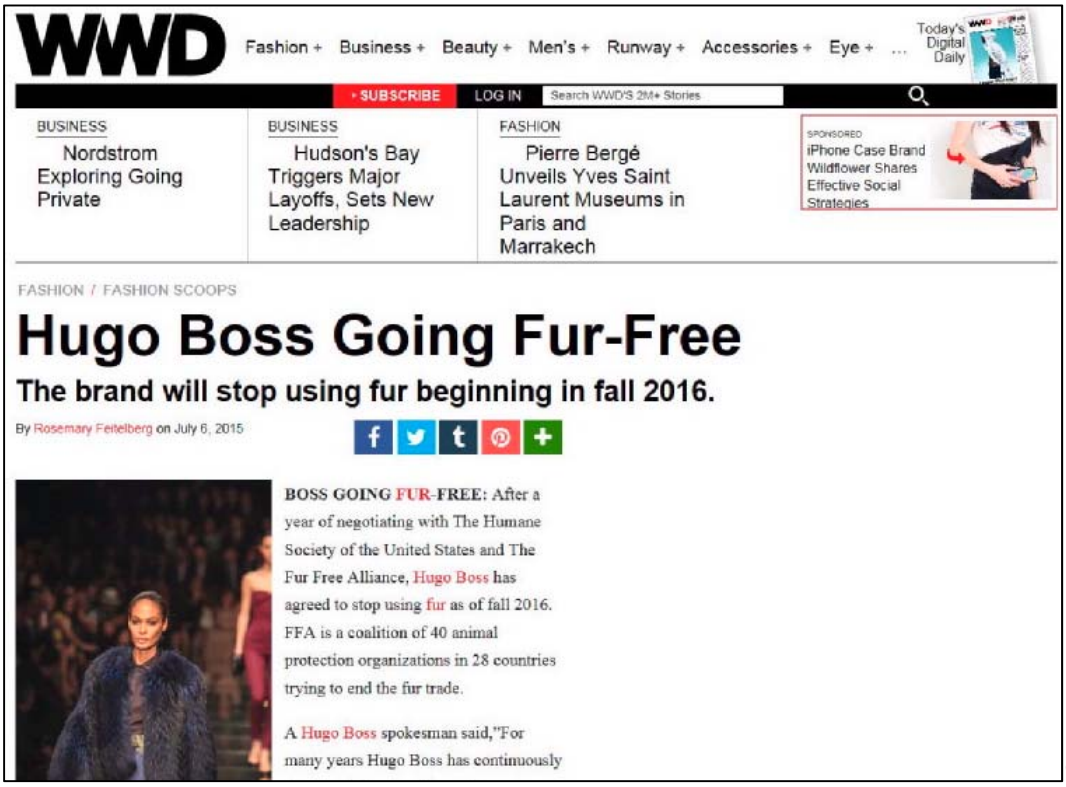
Thus, when used on the goods, the term "fur" is used to refer to both actual animal fur and imitation animal fur. The combined term, "fur free," has a slightly narrower meaning and is generally recognized as indicating that the particular goods, usually clothing and accessories, do not contain actual animal fur. The Examining Attorney provided ample evidence of the growing trend to banish animal fur from clothing and accessories. The following examples are representative:

[4]

[3] *Id.,* Office Action of June 12, 2017, pp. 55-57.

[4] Http://www.furfreeretailer.com, Office Action of June 12, 2017, p. 13.

[5]



[6]

[5] Http://www.humanesociety.org, Office Action of June 12, 2017, p. 10.

[6] Https://wwd.com, Office Action of June 12, 2017, p. 70.

7

8

Given that there is no dispute as to the meaning of the constituent terms, the issue before us is what happens when FUR FREE and FUR are combined as in Applicant's mark, FUR FREE FUR.

Applicant argues that its mark is more than the sum of its parts because it "is comprised of terms that, when taken together, present an incongruous and circular meaning that is nearly self-negating."[9]

The Examining Attorney argues that the sum of the parts of Applicant's mark are merely descriptive:

> Here, both the individual components and the composite result are descriptive of applicant's goods and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods. . . . Applicant has taken the established term of art "fur free" and merely added the

[7] Https://nypost.com, Office Action of December 22, 2017, p. 25.

[8] Https://huffingtonpost.com, Action of December 22, 2017, p. 30.

[9] Applicant's Br., p. 1, 10 TTABVUE 4.

> highly descriptive if not generic term "fur" which is defined as both animal fur and material made in imitation of animal fur.[10]

The problem with the Examining Attorney's argument is that it ignores the fact that, in Applicant's mark, the two instances of the term FUR have different meanings, which is likely to give consumers pause. In the first instance, FUR FREE, the term "fur" refers exclusively to animal fur, as shown above. That is, the goods are "animal fur free." In the second instance, FUR alone, the term "fur" refers to imitation fur. That is, the goods do not contain actual animal fur because they are "fur free." The two different meanings of the term "fur" within Applicant's single mark creates a logical paradox. By way of analogy, Applicant's mark is the "Schrödinger's cat" of trademarks: it suggests that the goods are both fur-free and made of fur at the same time.[11]

As Applicant argues, the mark "is suggestive as its internal inconsistency forces consumers to exercise a higher level of thinking to perceive its meaning, which is not immediately clear or obvious, let alone merely descriptive."[12] In other words, the prospective consumer is faced with an incongruous phrase that requires some imagination, thought, or perception to reach a conclusion as to the nature of the

[10] Examining Attorney's Br., p. 10, 12 TTABVUE 11.

[11] *See* https://www.encyclopedia.com/science-and-technology/physics/science-general/schrodingers-cat. Schrödinger's cat is a well-known quantum mechanics thought experiment devised by Austrian physicist Erwin Schrödinger in 1935 in which a hypothetical cat in a box may be simultaneously both alive and dead. Inasmuch as it was only a thought experiment, no actual cats were harmed.

[12] Applicant's Br., p. 10, 10 TTABVUE 13.

goods. *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1652 (Fed. Cir. 2014) ("A suggestive mark requires imagination, thought and perception to reach a conclusion as to the nature of the goods, while a merely descriptive mark forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods."). Such incongruous marks are suggestive rather than merely descriptive. *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE held not merely descriptive of bakery products); *In re Tennis in the Round Inc.,* 199 USPQ 496, 498 (TTAB 1978) (TENNIS IN THE ROUND created an incongruity because applicant's tennis facilities are not analogous to those used in a "theater-in-the-round"); *In re Shutts*, 217 USPQ 363, 364–65 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow-removal hand tool).

The Examining Attorney argues that the structure of Applicant's mark nevertheless mirrors typical descriptive usage referring to types of fur:

> Due to the dual meaning of the term "fur", companies often use an additional term before the term "fur" to clarify the meaning of the term to the relevant public (*see*, *e.g.*, reference to the descriptive phrases "fun fur", "faux fur" or "fake fur" from the dictionary definitions and the website excerpts of record). Here, the grammatical structure of the proposed mark is similar to those descriptive phrases, namely, the term "fur" preceded by the descriptive wording "fur free" to clarify that the material resembles animal fur but is not, in fact, real animal fur.[13]

[13] Examining Attorney's Br., p. 11, 12 TTABVUE 12.

This argument is unpersuasive. None of the examples suggested by the examining Attorney use the term FUR twice to describe other kinds of fur, for example, "faux fur fur" or "fake fur fur." In essence, the Examining Attorney is treating Applicant's mark as if it were "ANIMAL FUR FREE FAUX FUR." But that is not the mark Applicant has applied for.

In sum, we find Applicant's mark to be suggestive.

Decision: The refusal to register Applicant's mark, FUR FREE FUR, under Section 2(e)(1) of the Trademark Act is reversed.

Kuczma, Administrative Trademark Judge, dissenting:

The majority reversed the refusal of registration from which I respectfully dissent.

I do not view Applicant's mark as being more than the sum of its parts. As stated in the majority opinion, the "term 'fur' is used to refer to both actual animal fur and imitation animal fur." Given the broad meaning of the term "fur" it may be necessary to further describe the particular type of fur in certain products. One of the ads submitted by the Examining Attorney shows the descriptive use of "fur free" to advertise "faux fur" products, i.e., imitation animal fur products. "Fur free" and "faux" are terms used in connection with the word "fur" to indicate that such products do not contain actual animal fur.

Applicant's mark uses "fur free" in place of "faux" to let consumers know that its "fur" goods do not contain animal fur. Both the individual components of Applicant's mark, as well as the composite mark, describe Applicant's goods. Thus, no

imagination, thought or perception is needed to arrive at the characteristics of Applicant's goods.

Accordingly, I would hold that Applicant's mark is merely descriptive under § 2(e) and affirm the refusal to register.