

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

Mailed: October 16, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*In re Shimano North America Holding, Inc.*  
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Serial No. 88185346  
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Rod S. Berman of Jeffer Mangels Butler & Mitchell LLP,  
for Shimano North America Holding, Inc.

Rebecca Eubank, Trademark Examining Attorney, Law Office 116,  
Elizabeth F. Jackson, Managing Attorney.

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Before Thurmon, Deputy Chief Administrative Trademark Judge,  
Greenbaum and Heasley, Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

I. Background

Shimano North America Holding, Inc. (“Applicant”) seeks registration on the Principal Register of the mark FLAT-SIDE (in standard characters) for Fishing lures; Lures for fishing, in International Class 28.<sup>1</sup>

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<sup>1</sup> Application Serial No. 88185346 was filed on November 7, 2018, based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as 2007.

The Trademark Examining Attorney has refused registration of Applicant's proposed mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), as merely descriptive of the identified goods.

When the refusal was made final, Applicant requested reconsideration, which was denied. On October 29, 2019, Applicant timely filed a notice of appeal, and again requested reconsideration. When the October 29, 2019 Request for Reconsideration was denied, this appeal resumed.<sup>2</sup> The appeal is fully briefed. We affirm the refusal to register.

## II. Applicable Law

In the absence of acquired distinctiveness, Section 2(e)(1) of the Trademark Act prohibits registration of a mark on the Principal Register that, when used in connection with an applicant's goods, is merely descriptive of them.<sup>3</sup> "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 AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). See also *In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015). By

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<sup>2</sup> Due to a procedural anomaly, Applicant filed its Appeal Brief before the Examining Attorney acted on the October 29, 2019 Request for Reconsideration. The Board therefore allowed Applicant time to file a Supplemental Brief. 8 TTABVue. Applicant declined this opportunity.

<sup>3</sup> "No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . (e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive ...." 15 U.S.C. § 1052(e)(1).

contrast, a mark is suggestive if it “requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods.” *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Suggestive marks, unlike merely descriptive terms, are registrable on the Principal Register without proof of acquired distinctiveness. *See Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004).

Whether a mark is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the mark is used, not in the abstract or on the basis of guesswork. *Bayer*, 82 USPQ2d at 1831; *see also In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). In other words, we evaluate whether someone who is familiar with the goods 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 in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the goods. *See Gyulay*, 3 USPQ2d at 1010. In addition, the descriptiveness analysis concentrates on the identification of goods set forth in the application. *See In re Cordua Rests., Inc.* 823 F.3d 594, 118 USPQ2d 1632, 1636 (Fed. Cir. 2016) (quoting *Octocom Sys., Inc. v. Hous. Comput. Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)).

“Evidence of the public’s understanding of [a] term ... may be obtained from any competent source, such as purchaser testimony, consumer surveys, listing in

dictionaries, trade journals, newspapers and other publications,” *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1374 (Fed. Cir. 2018) (quoting *Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1046 (Fed. Cir. 2018)), as well as “labels, packages, or in advertising material directed to the goods ....” *Abcor*, 200 USPQ at 218. It may also be obtained from websites and, in the case of a use-based application or registration, an applicant’s or registrant’s own specimen of use and any explanatory text included therein. *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017); *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1565 (Fed. Cir. 2001).

### III. Analysis

Applicant contends that the proposed mark FLAT-SIDE is suggestive of the identified fishing lures because the goods feature two sides that are curved, and neither side is flat.<sup>4</sup> App. Br., 4 TTABVUE 4-5. The Examining Attorney asserts that FLAT-SIDE is descriptive of the identified goods because it immediately describes a feature of the goods, namely, fishing lures where one side is flatter than the other, and that the consuming public would understand FLAT-SIDE to refer to that feature of the fishing lures. Ex. Atty. Br., 10 TTABVUE 4.

“Flat” is defined as “having a continuous horizontal surface,” “being or characterized by a horizontal line or tracing without peaks or depressions” or “having a relatively smooth or even surface,” and “side” is defined as the “surface of an object,

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<sup>4</sup> During prosecution, Applicant referred to both sides of its lure as asymmetrically rounded. April 4, 2019 Response to Office Action, TSDR 4.

especially a surface joining a top and bottom.” February 14, 2019 Office Action, TSDR 5-6 (quoting Merriam-Webster.com and AHDictionary.com). The Examining Attorney asserts that “[e]ven taking into consideration the applicable definitions from the numerous definitions applicant has provided, the term describes a surface that is smooth, even, or level.” Ex. Atty. Br., 10 TTABVUE 5. She contends that, based on the dictionary definitions alone and in relation to Applicant’s identified goods, the term “flat side” merely describes asymmetrically rounded fishing lures, that is, fishing lures that feature one side that is more horizontal, even or smooth than the other.

There is no dispute that Applicant’s goods do not have a side that is entirely flat, as that term is strictly defined. However, the Examining Attorney submitted ample evidence from third party providers of fishing lures demonstrating that sellers, purchasers and users of lures commonly refer to fishing lures that have a relatively smooth or even surface (as compared to the other side) as “flat side” lures or jigs,<sup>5</sup> or lures that have a “side” that is “flat” (emphasis added):

- Peace Token Fishing Tackle offers “PEACE TOKEN’S TUNA METAL JIG – **FLAT SIDE MACKEREL**” lure. February 14, 2019 Office Action, TSDR 7-8.

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<sup>5</sup> A “jig” is a type of fishing lure. *See* evidence from Wikipedia and BassResource.com attached to April 4, 2019 Response to Office Action, TSDR 20-27.

- The Tackle Room sells a “**Flat Side** Jig 6 Pack by Reeldiculous Fishing” described as follows: “These **flat side** jigs are a rear/center balanced jig that performs excellent in vertical drop situations.” *Id.*, TSDR 9-10.
- Everhart’s Outdoor Store offers several types of “Strike King KVD 1.5 **Flat Side** Crankbait” described as follows: “Designed by Kevin VanDam to have a slender modified **flat side** for erratic thumping action with a body similar to the KVD 1.5 Square Bill, making this bait perfect to reach those fish down to 8 feet.”<sup>6</sup> *Id.*, TSDR 11-12.
- BICO Jigs highlights the “flat side” feature of their lures: “The jig features a flattened head, which offers particular benefits. For one, the contour makes it skip on the surface better than conventional. The heads are made lead-free in order to increase size without adding extra weight. This gives the **flat side** of the jig a wider surface area, which allows it to skip exceptionally well.” April 30, 2019 Final Office Action, TSDR 5-7.
- Jacksonville Fishing Trips describes the best jig heads “for targeting inshore fish in northeast Florida”: “The first step to catching inshore saltwater fish with artificial lures is picking out a jig head. ... The standard, double eye, **flat side** jig head in both 1/8 and ¼ ounce weights are great choices ....” *Id.*, TSDR 8-10.

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<sup>6</sup> Outdoor Pro Shop also offers the Strike King KVD **Flat Side** Crankbait. April 30, 2019 Final Office Action, TSDR 16.

- Palomar, a provider of lures, touts the “Reeldiculous **Flat Side** ‘Slammer’” as “the best **flat-side** jig, hands down. It’s an asymmetric 3D designed jig ....” *Id.*, TSDR 11-13.
- HanapaaFishing.com offers the “HP JIG **FLATSIDE** LURE” described as follows: “One side is colored and ridged, other **side** is **flat** and silver.” *Id.*, TSDR 14-15.
- Jigging World offers the “Jigging World **Flat Side** Jig” for sale on Amazon.com. *Id.*, TSDR 17.

Based on the evidence, we have no doubt that anglers who see the proposed mark FLAT-SIDE used on fishing lures immediately would understand that the lures feature one side that has a relatively smooth or even surface compared to the other. The definitions of the words in the mark show their descriptiveness in this context, and as discussed below, the combination of FLAT and SIDE does not evoke a new and unique commercial impression. Accordingly, the proposed mark is merely descriptive of the identified goods.

We do not find persuasive Applicant’s arguments that the proposed mark is suggestive because there are multiple definitions of the word “flat.” As we stated above, we must consider the meaning of a term in relation to the identified goods, not in the abstract. *See Bayer*, 82 USPQ2d at 1831; *Abcor*, 200 USPQ at 218. The evidence supports a finding that anglers who encounter the term FLAT-SIDE on Applicant’s identified goods would immediately understand that the lures feature one side that is more flat, and conversely, one side that is more round, than the other. This is

particularly true given the various third party providers of fishing lures in the marketplace who use the term “flat side” to describe asymmetrical fishing lures, as discussed above.

Applicant points to two articles as evidence that its “jigs have been recognized in a number of media outlets popular in the industry....” App. Br., 4 TTABVUE 6. The article from THE FISHERMAN MAGAZINE titled “Jig & Pop: Run & Gun Tuna” by Capt. Jack Sprengel contains a single buried reference to Applicant’s goods “Shimano Flat-side Jigs,” one of three lures that the author prefers to use. October 4, 2019 Request for Reconsideration, TSDR 91-94 (listed on TSDR 92). And the November 2, 2011 article from SPORT FISHING MAGAZINE, titled “24 Great Metal Jigs” by Doug Olander, also contains only a single reference to Applicant’s goods, listed as “Butterfly Flat-Side Jigs.” *Id.*, TSDR 95-135 (listed on TSDR page 99). This article also includes a “manufacturer’s tip”: “Try counting in a rhythmic cadence to get used to ‘walking’ the **flat-side** jig.” (emphasis added). Neither article uses the term FLAT-SIDE in a source identifying manner, and thus this evidence does not support a finding that consumers would understand or use that term to refer solely to Applicant’s goods. Moreover, the use of “flat-side” in the “manufacturer’s tip” indicates that “flat-side” is a type of jig. *Id.* at TSDR 99. Such usage provides additional support for our finding above that “flat-side” is merely descriptive of a feature of the identified goods.

Further, to the extent Applicant is arguing that it is the first user of the designation FLAT-SIDE 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-SIDE 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); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 1209.03(c) (Oct. 2018).

Although Applicant argues that “every example of third-party use of FLAT-SIDE in the record is a third-party that has appropriated FLAT-SIDE, or something similar, to designate a product” is an infringing use (App. Br., 4 TTABVUE 7), 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. Indeed, the record consists of two cease and desist letters that Applicant characterizes as “not one hundred percent effective.” October 29, 2019 Request for Reconsideration. In any event, even if the evidence did demonstrate that Applicant’s competitors may have agreed to discontinue use of the designation “flat side” or “FLAT-SIDE” 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 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).

Moreover, by arguing that all of the third-party uses are infringing uses, Applicant essentially has conceded that the evidence describes a product that is identical to, or nearly identical to, Applicant's identified fishing lures. And because the evidence of third-party uses amply demonstrates that consumers understand the term "flat side" to merely describe a feature of fishing lures, namely, lures with a relatively smooth or even side, consumers also would understand that Applicant's fishing lures have the same type of "flat side" as the third-party fishing lures.

Finally, the use of the hyphen between the terms FLAT and SIDE does not obviate a finding of mere descriptiveness. *See e.g., In re Vanilla Gorilla, L.P.*, 80 USPQ2d 1637, 1640 (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).

A combination of descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning. *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"). However, the mere combination of descriptive words does not necessarily create a nondescriptive word or phrase. *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988). If each component retains its descriptive significance in relation to the goods, the combination results in a composite that is itself 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.*

*Comm'r*, 252 U.S. 538, 543 (1920)); *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs, and pillows where the evidence showed that the term “breathable” retained its ordinary dictionary meaning when combined with the term “mattress” and the resulting combination was used in the relevant industry in a descriptive sense). We find that to be the case here.

#### IV. Conclusion

For the reasons discussed, we conclude that the relevant consumers, anglers, would immediately understand FLAT-SIDE, when used on Applicant’s identified fishing lures, to immediately describe a key feature of them. Furthermore, Applicant’s competitors who might offer similar goods should have the opportunity to use “flat side” or variations thereof to explain a significant feature or characteristic of their goods. *See In re Boston Beer Co., L.P.*, 47 USPQ2d 1914, 1920-21 (TTAB 1998), *aff’d*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999); *Abcor*, 200 USPQ at 217 (“The major reasons for not protecting [merely descriptive] marks are ... to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.”).

**Decision:** The refusal to register Applicant’s proposed mark FLAT-SIDE is affirmed.