

This Opinion is not a
Precedent of the TTAB

Mailed: September 30, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Surflin e/Wavetrak, Inc.

Serial No. 88416048

Thomas Thibault, Esq.,
for Surflin e/Wavetrak, Inc.

Odette Martins, Trademark Examining Attorney, Law Office 123,
Susan Hayash, Managing Attorney.

Before Zervas, Lykos and Lynch,
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Surflin e/Wavetrak, Inc. (“Applicant”) seeks registration on the Principal Register of the proposed standard character mark FISHTRACK for “online informational services, namely, providing a website featuring non-downloadable fishing charts, fishing reports, and fishing cams in the nature of videos featuring recreational fishing spots,

non-downloadable informational articles related to fishing, and non-downloadable photos and videos of fish over the Internet” in International Class 41.¹

The Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the mark is merely descriptive of Applicant’s identified services. After the Examining Attorney made the refusal final, Applicant appealed to this Board and requested reconsideration. The Examining Attorney denied the request for reconsideration, the appeal was resumed and both Applicant and the Examining Attorney filed briefs. We affirm the refusal to register.

In the absence of acquired distinctiveness,² Section 2(e)(1) of the Trademark Act prohibits registration on the Principal Register of “a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive . . . of them.” 15 U.S.C. § 1052(e)(1). A term is “merely descriptive” within the meaning of Section 2(e)(1) 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 contrast, a mark is suggestive if it “requires imagination, thought, and perception to arrive at the qualities or characteristics of the [services].” *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009,

¹ Application Serial No. 88416048 was filed on May 5, 2019, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming first use and first use in commerce on February 16, 2012.

² Applicant has not asserted acquired distinctiveness.

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 services for which registration is sought, not in the abstract or on the basis of guesswork. Descriptiveness must be evaluated “in relation to the particular goods [or services] for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods [or services] because of the manner of its use or intended use.”³ *In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219 (quoting *In re Bayer AG*, 82 USPQ2d at 1831). In other words, we evaluate whether someone who knows what the services are 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); *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002).

Evidence that a term is merely descriptive to the relevant purchasing public “may be obtained from any competent source, such as dictionaries, newspapers, or surveys,” *In re Bayer AG*, 82 USPQ2d at 1831, as well as “labels, packages, or in advertising material directed to the [services].” *In re Abcor Dev. Corp.*, 588 F.2d 811, 200

³ For this reason, Applicant’s argument that “it is improper to conclude that ‘informational articles related to fishing’ include articles on how to track fish, without a review of the services that Applicant actually provides” (Applicant’s brief at p. 8, 7 TTABVUE 13) cannot be successful.

USPQ 215, 218 (CCPA 1978). It may also be obtained from websites and publications, and, in the case of a use-based application, an applicant'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).

When two (or more) merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the services, the combination results in a composite that is itself merely descriptive. *See e.g.*, *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004) (PATENTS.COM merely descriptive of computer software for managing a database of records that could include patents, and for tracking the status of the records by means of the Internet); *In re Petroglyph Games, Inc.*, 91 USPQ2d 1332 (TTAB 2009) (BATTLECAM merely descriptive for computer game software); *In re Carlson*, 91 USPQ2d 1198 (TTAB 2009) (URBANHOUSING merely descriptive of real estate brokerage, real estate consultation and real estate listing services). Thus, “[i]n considering a mark as a whole, the Board may weigh the individual components of the mark to determine the overall impression or the descriptiveness of the mark and its various components.” *Oppedahl & Larson*, 71 USPQ2d at 1372.

The Examining Attorney argues that the proposed mark “immediately describes to consumers a feature or purpose of applicant’s services because applicant is providing online information which can be used to track the location of fish.”⁴

With regard to the term FISH, the Examining Attorney relies on (i) The American Heritage Dictionary of the English Language definition, “[a]ny of numerous cold-blooded aquatic vertebrates characteristically having fins, gills, and a streamlined body and including the bony fishes, such as catfishes and tunas, and the cartilaginous fishes, such as sharks and rays”;⁵ (ii) webpages showing “fish” “used in connection with online information which feature fish as the subject matter of the information”;⁶ and (iii) Applicant’s identification of services which refer to fishing.⁷

We find that the word “FISH” in the proposed mark immediately describes a feature of the services — Applicant’s online informational services pertain to “the sport or business of catching fish”⁸ and its non-downloadable photos and videos feature fish. Applicant has not contested that FISH merely describes a feature of its services.

Turning now to the term TRACK, “track” is defined in The American Heritage Dictionary of the English Language as

⁴ Examining Attorney’s brief, 9 TTABVUE 9.

⁵ May, 25, 2019 Office Action, TSDR 2-3; December 10, 2019 Office Action, TSDR 2-3.

⁶ Examining Attorney’s brief, 9 TTABVUE 6.

⁷ *Id.* at 6-7.

⁸ See definition of “fishing” (“the sport or business of catching fish”) from <https://www.merriam-webster.com/dictionary/fishing> (accessed on September 29, 2020). We take judicial notice of this definition. 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 regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

- “[t]o determine or discover the location or origin of: *tracked the money to an offshore account*”;⁹ and
- “[t]o follow a course; travel: *The storm is tracking up the coast*.”¹⁰

The Examining Attorney submitted the following Internet evidence regarding the term “track”:

- <http://www.lakegastonguide.com> (May 25, 2019 Office Action, TSDR 22)

We also maintain an archive of previous reports so you can track fishing trends on Lake Gaston.

- <https://www.onthewater.com> (December 10, 2019 Office Action, TSDR 28-33)

Find out by following along as we track the Striper Migration, and contribute to our map updates by sharing your striper fishing reports and photos.

- <https://rochesterbirding.com> (December 10, 2019 Office Action, TSDR 42)

The term “NEXRAD” stands for next generation radar and is used by avid birders and professional ornithologists to track migratory birds.

⁹ Applicant argues that this definition does not apply because “it pertains to tracing a ‘thing’ (i.e., money) back to its source.” The reference to money in the passage is not part of the definition itself, but rather is in an example of use and is not limiting. Also, as reflected in some of the evidence discussed, *infra*, and as is commonly known, fish and other animals migrate during certain times of the year. Accordingly, their movements can be “tracked,” as the term is used in this definition. See Encyclopedia Britannica entry for “Tuna” (<https://www.britannica.com/animal/tuna-fish#ref120187>, accessed on September 29, 2009) (“Tunas migrate long distances over all the world’s oceans and occupy tropical, temperate, and even some cooler waters.”). We also take judicial notice of this encyclopedia entry. See *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.24 (TTAB 2013) (judicial notice taken of entry for “tea” from Encyclopedia Britannica).

¹⁰ May, 25, 2019 Office Action, TSDR 20-21; December 10, 2019 Office Action TSDR 23-27.

- <http://www.cbf.org> (December 10, 2019 Office Action, TSDR 43)

CBF's Osprey Tracking Project ran from 2001 to 2017 and allowed students and teachers to track birds – ones they had seen during field experiences at CBF education centers.

- <http://globalfishingwatch.org/> (December 10, 2019 Office Action, TSDR 44-47)

We use cutting edge technology to visualize, track and share data about global fishing activity in near real-time and for free.

- <https://www.alphaoutpost.com> (December 10, 2019 Office Action, TSDR 48-52)

You can track a deer to hunt or simply just to watch them in their natural habitat.

- <https://journeynorth.org> (December 10, 2019, Office Action, TSDR 53)

Use species data to create a distribution map and get ready to track this year's spring migration.

- <http://www.mybirdmaps.com> (December 10, 2019 Office Action, TSDR 54)

The hope of the mybirdmaps.com team is to allow users to review birdwatching maps to help plan upcoming outing as well as track bird sightings to enable users to archive a lifetime of birding experiences.

- <https://www.islandadventures.com> (May 25, 2019 Office Action TSDR 23, December 10, 2019 Office Action, TSDR 55)

We also plot the GPS coordinates of each day's sightings on our website so you can track the whales' patterns yourself.

- <https://www.hawkmountain.org> (December 10, 2019 Office Action, TSDR 56)

Provide the general public, including school children, with the ability to track the daily movements of these important scavengers across North and South America.

The Examining Attorney argues that “TRACK” is merely descriptive because Applicant’s services include providing information that is used to track fish; that “applicant’s identification of services includes broad wording to indicate that the applicant is providing ‘informational articles related to fishing’ which is broad wording that can include informational articles that are used to track fish”; and that “applicant’s website also indicates that the applicant’s services feature ‘an array of tutorials, destination and gear-related deep sea fishing articles to help fishermen locate and catch more fish’ and features ‘everything you need to find fish’.”¹¹

Applicant argues that its proposed mark is suggestive:

Even if the given definition of TRACK could apply to tracking the location or origin of fish, Applicant asserts that neither its described services, nor its website, provides for enabling users to discover the location or origin of fish. The website provides fishing charts and fishing reports of past fishing activity, but there is no information provided that would allow someone to know where fish are presently found. The charts and reports provide resources to allow users to **guess** as to where fish **may** be found in the **future**. This cannot be considered to be fish tracking.

The American Heritage Dictionary defines TRACK as “To observe or monitor the course of” and “To observe the progress of; follow”. Both definitions imply that some-

¹¹ Examining Attorney’s brief, 9 TTABVUE 8.

thing is being presently tracked. In contrast, “informational articles related to fishing” cannot be said to be any kind of present tracking, as information articles, by definition, describe events that happened in the past. Applicant asserts that FISHTRACK could reasonably be associated by consumers with real-time tracking of fish, i.e., following a fish or schools of fish as they migrate from one area to another. However, neither Applicant’s described services, nor Applicant’s actual services, provides for this kind of tracking. Therefore, this creates the type of ambiguity recognized by the Courts to declare marks such as FISH-TRACK suggestive, rather than descriptive, and thus allowable on the primary register.¹² (emphasis in original text).

Applicant’s website is clear that the objective of the information provided on the website is to catch fish. Under the heading “Deep Sea Fishing Features,” the website states:

FishTrack offers all of the tools needed to be successful in the sport of deep sea fishing. **The fishing charts tool offers the latest SST and Chlorophyll images for the world’s top sport fishing locations.** Deep Sea fishing anglers using the fishing charts can layer bathymetry, altimetry, ocean currents and plot waypoints. Weather is crucial in deep sea fishing and FishTrack offers accurate marine wind and swell forecasts. These toolsets are complimented by an array of tutorials, destination and gear-related deep sea fishing articles **to help fishermen locate and catch more fish.**¹³ (emphasis added.)

Applicant’s argument that “neither its described services, nor its website, provides for enabling users to discover the location ... of fish” is contradicted by the statements in its website. Further, its arguments that its website “provides fishing charts and fishing reports of past fishing activity, but there is no information provided that

¹² Applicant’s brief at p. 6, 7 TTABVUE 11.

¹³ May 25, 2019 Office Action, TSDR 26.

would allow someone to know where fish are presently found” and that “[t]he charts and reports provide resources to allow users to guess as to where fish may be found in the future”¹⁴ are inconsistent with its identification of services which does not specify that the information provided cannot be real-time information about current location of fish. We must consider descriptiveness in the context of Applicant’s services, *see In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219, not in the abstract, and there is no restriction in the identification of services providing that Applicant’s services pertain to locating fish in the future. Thus, to the extent that “track” refers to present tracking, Applicant’s identification of services allows for present tracking of fish, and the evidence in the record from its website support the notion of present tracking. Indeed, Applicant states that “Applicant asserts that FISHTRACK could reasonably be associated by consumers with real-time tracking of fish, i.e., following a fish or schools of fish as they migrate from one area to another.”¹⁵

As noted above, “track” is defined as “to follow a course.” This is only slightly different from “determin[ing] ... the location ... of” in the definition used by the Examining Attorney to refuse registration. Because fish move in the water, a feature of Applicant’s services as described in its recitation of services is to follow their course, and this is immediately clear from the term “track.” The examples of use of “track” in the record demonstrate use of the term “track” followed by the name of an animal, with “track” meaning both “determining the location of” the animal and “following

¹⁴ Applicant’s brief at p. 6, 7 TTABVUE 11.

¹⁵ *Id.* at p. 7, 7 TTABVUE 12.

the course of” the animal. For instance, one source noted, “[w]e also plot the GPS coordinates of each day’s sightings on our website so you can track the whales’ patterns yourself.”¹⁶

Applicant also argues that “[w]hile there may be information on the website on how to find fish based on, for example, past fishing reports and fishing charts, **finding** fish is different than **tracking** fish, as the former implies a present or future endeavor, while the latter implies past activities.”¹⁷ (emphasis in the original). This argument is a red herring. The proposed mark is FISHTRACK not FISHFIND. Thus, arguments regarding the term “find” are irrelevant. The issue is whether TRACK immediately describes a feature or characteristic of Applicant’s services as stated in its identification of goods.

Applicant points out that there are 14 meanings of “track” in the dictionary definition of record.¹⁸ This fact is unavailing. “That a term may have other meanings in different contexts is not controlling.” See *In re Franklin Cnty. Historical Soc’y*, 104 USPQ2d 1085, 1087 (TTAB 2012).

FISHTRACK as a combined term, results in a “the mark as a whole, *i.e.*, the combination of the individual parts,” which does not convey “any distinctive source-identifying impression contrary to the descriptiveness of the individual parts.” *In re Oppedahl & Larson*, 71 USPQ2d at 1372. Purchasers would immediately understand

¹⁶ May 25, 2019 Office Action TSDR 23, December 10, 2019 Office Action, TSDR 55.

¹⁷ Applicant’s brief at p. 8, 7 TTABVUE 13.

¹⁸ *Id.* at p. 7, 7 TTABVUE 12.

FISHTRACK as a combination of two merely descriptive terms, the first term indicating to purchasers that services pertain to fish and the second term indicating to purchasers that through the online information services, the fish may be tracked. Although there is no evidence in the record of use by third parties of FISHTRACK as a combined term, this does not defeat the Section 2(e)(1) refusal. Even if an applicant is the first or only user of a merely descriptive designation, the designation may be found merely descriptive. *See In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1514 (TTAB 2016) (“The fact that Applicant may be the first or only user of a term does not render that term distinctive”).

Applicant also argues that any doubt regarding descriptiveness should be resolved on Applicant’s behalf. The record in the present case leaves us with no doubt that the proposed mark in its entirety is merely descriptive.

Upon consideration of all of the Examining Attorney’s and Applicant’s arguments and evidence in the record, we affirm the Examining Attorney’s refusal to register Applicant’s proposed mark under Section 2(e)(1) of the Trademark Act.

Decision: The refusal to register Applicant’s proposed mark is affirmed.