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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	88438747
Applicant	Bass Pro Intellectual Property, L.L.C.
Applied for Mark	OUTDOOR MARKETPLACE
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Application of Bass Pro Intellectual Property, L.L.C. :

Serial No. 88/438747 :

Filed: May 20, 2019 :

Mark: OUTDOOR MARKETPLACE :

Attorney Docket No. 18580-200364 :

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**APPLICANT'S BRIEF ON APPEAL**

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### **Statement of the Case**

This is an appeal from refusal to register Applicant's word mark OUTDOOR MARKETPLACE. Registration was refused on the grounds that OUTDOOR MARKETPLACE is merely descriptive under 15 USC 1052(e)(1).

### **Background**

Applicant, Bass Pro Intellectual Property, L.L.C. ("Applicant"), the intellectual property arm of Bass Pro Shops, seeks to register the mark OUTDOOR MARKETPLACE for "retail store services in the field of hunting, fishing and outdoor gear." Registration has been finally refused, Applicant's request for reconsideration denied, and now Applicant appeals the final refusal. Applicant respectfully requests reversal of the final refusal of registration if its mark OUTDOOR MARKETPLACE. Applicant respectfully submits that OUTDOOR MARKETPLACE does not convey an immediate impression about applicant's services, and therefore it is not merely descriptive, but at most suggestive of applicant's services.

### **Issues on Appeal**

Is Applicant's mark OUTDOOR MARKETPLACE merely descriptive of "retail store services in the field of hunting, fishing and outdoor gear"?

## Argument

### **The Evidence Does Not Establish that OUTDOOR MARKETPLACE is Merely Descriptive Of “Retail Store Services in The Field Of Hunting, Fishing and Outdoor Gear”**

The response to Applicant’s request for reconsideration purports to show that “OUTDOOR MARKETPLACE” is commonly used to describe retail store services especially for goods for hunting, fishing and outdoor gear. However, this is not the case.

For example, “outdoor marketplace” in this excerpt from Mountainsmith is not referring to a retail store:

Mountainsmith is committed to building the best-made, most durable and functional packs on the market; unmatched by anyone for their comfort, stability, value and performance in the backcountry. The quality and comfort of all Mountainsmith products – technical backpacks, trekking poles, tents, travel storage systems, luggage, pet products, adventure camera bags, as well as our iconic lumbar packs – set a standard of excellence in the outdoor marketplace.

this excerpt from SGB Media is not referring to a retail store:

**About Granite Gear:** For 33 years, Granite Gear has brought cutting-edge products to the outdoor marketplace. Their award-winning backpacks, adventure travel gear, extensive variety of storage sacks, lifestyle accessories, and canoe gear offer excellence in design and construction. Granite Gear’s desire is for all outdoor enthusiasts and travelers to experience the incredible durability and comfort of their products. Located in Northern Minnesota, just minutes from the Boundary Waters Canoe Area Wilderness and the Superior Hiking Trail, they have a rugged and beautiful testing ground for their products. You can find out more about Granite Gear on their site, Facebook, or Instagram. Learn about Granite Gear’s Grounds Keepers program here.

this excerpt from The WON Women’s Outdoor News is not referring to a retail store:

Heat Factory continues to heat up the outdoor marketplace with its new-for-2010 Great Outdoors Warmer Pack

this excerpt from the LA Times is not referring to a retail store, but a swap meet:

Saddleback College's Outdoor Marketplace will have its grand opening at 8 a.m. Saturday.

The swap meet will include vendors selling arts and crafts, antiques, clothing, sporting goods and professional services.

this excerpt from Moosejaw is not referring to a retail store:

Sierra Trading Post has physical stores, a robust online community, and has won awards for its customer service and development as an innovative company in the outdoor marketplace.

this excerpt from SHOTbusiness is not referring to a retail store:

Based in Sparta, IL, Zanders is one of the most respected firearms wholesalers in the country, having served the outdoor marketplace since 1962. As a full-service wholesaler, Zanders offers a wide range of firearms and accessories, now including many of the hunting and tactical-oriented rifles manufactured by Rock River Arms.

this excerpt from D&H is not referring to a retail store:

HARRISBURG, PA - July 31, 2015 - D&H Distributing, the leading North American computer products and consumer electronics distributor, announces is exhibiting at the Outdoor Retailer Summer Market trade show taking place on August 5 to 8, 2015 at the Salt Palace Convention Center, Salt Lake City, Utah. This event engages retailers and dealers selling merchandise for the outdoor marketplace, including sporting goods products. Representatives from D&H's Sporting Goods division will be available at booth PV3343 on the exhibit floor.

this excerpt from the NSSF Marketplace is not referring to a retail store:

When it comes to packaging, we've got you covered.™ Since merging Universal Packaging Solutions expertise in the shooting, hunting and outdoor marketplace with 50 years of innovative packaging design by Blackbourn, we truly do have your packaging needs covered.

While the evidence shows that term "OUTDOOR MARKETPLACE" has at least on occasion been used, it does not show that it has been used to describe "retail store services in the field of hunting, fishing and outdoor gear."

### **OUTDOOR MARKET Does not Convey an Immediate Impression of Applicant's Services**

Applicant submits that OUTDOOR MARKETPLACE does not convey an immediate impression about applicant's services, and therefore it is not merely descriptive, but at most suggestive of applicant's services. OUTDOOR MARKETPLACE could suggest that the services are provided outdoors; it could alternatively suggest that the services are provided in an environment that is like the outdoors, or it could suggest that the service relate in some way to things outdoors, such as the sale or leasing of land. In view of these vague and non-specific meanings,

consumers need to apply a non-trivial amount of imagination, thought and perception to reach a conclusion as to the nature of applicant's services.

Applicant submits that OUTDOOR MARKETPLACE is similar in this regard to HOME MARKETPLACE, which is the subject of Reg. No. 5,840,832 on the Principal Register; MEGA GLOBAL MARKETPLACE, which is the subject of Reg. No. 5,478,918; EASTSIDE MARKETPLACE, which is the subject of Reg. No. 4,726,965; and many others of the 450 registrations on the Principal Register on marks for marks containing "marketplace." The nature of the services is not immediately ascertainable, and therefore OUTDOOR MARKETPLACE is not merely descriptive.

A further indication that OUTDOOR MARKETPLACE is not merely descriptive is the fact that none of the citations use this phrase to describe retail store services. These citations establish that "outdoor" and "marketplace" are commonly used terms, but do not show the phrase OUTDOOR MARKETPLACE merely to describe applicant's services. Rather, the records of the U.S. Patent and Trademark establish that "marketplace" is also a commonly registered term (appearing in 522 registrations), and that OUTDOOR is even more common, appearing in more than 1700 registrations.

As the Federal Circuit recently recognized in *In re Driven Innovations, Inc.*, 674 Fed. Appx. 996, 2017 ILRC 1013 (Fed. Cir. 2017), the line between descriptive and suggestive marks can be difficult to determine. A term is descriptive if it "immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used," while a mark is suggestive if it "requires imagination, thought and perception to reach a conclusion as to the nature of the goods." Applicant submits that OUTDOOR MARKET does not immediately convey information about applicant's services.

As the Federal Circuit said in *Nautilus Grp., Inc. v. ICON Health & Fitness, Inc.*, 372 F.3d 1330, 1340 (Fed. Cir. 2004). "If the mental leap between the word and the product's attribute is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness." The imagination, thought, and perception needed to reach a conclusion as to the nature of applicants services from OUTDOOR MARKETPLACE is not instantaneous, indicating that OUTDOOR MARKETPLACE is not merely



descriptive, and explaining why there are so many existing MARKETPLACE registrations.

Although applicant recognizes that it is not controlling on the TTAB, the Office previously determined that OUTDOOR MARKETPLACE was not merely descriptive of slightly different services when it issued Reg. No. 1586172, As in the present case, discerning the nature of the services (television entertainment services in the nature of show which features the products of others for sale) from the mark was not instantaneous, and required the use of imagination, thought and perception to reach a conclusion as to the nature of applicant's services. OUTDOOR MARKETPLACE is no more descriptive now, than it was when the Office issued Reg. No. 1586172.

#### CONCLUSION

Because (1) the cited references do not show OUTDOOR MARKETPLACE used to describe retail store services in the field of hunting, fishing and outdoor gear; (2) OUTDOOR MARKETPLACE does not immediately convey knowledge of a quality, feature, function, or characteristic of applicant's retail store services in the field of hunting, fishing and outdoor gear; and (3) OUTDOOR and MARKETPLACE are common components of registerable marks, and in fact that exact combination OUTDOOR MARKETPLACE has been previously registered, the Office has failed to show that OUTDOOR MARKETPLACE is merely descriptive. The refusal of registration should be reversed, and the mark published for opposition.

Respectfully submitted,

Dated: September 28, 2020

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