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RFC

THIS DISPOSITION IS NOT
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JAN. 11,98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Precision Resource Company, LLC.

Serial No. 74/717,937

Michael W. Hicks of Blakely, Sokoloff, Taylor & Zafman for
Precision Resource Company, LLC.

David M. Marmelstein, Trademark Examining Attorney, Law
Office 103 (Michael A. Szoke, Acting Managing Attorney).

Before Simms, Cissel and Chapman, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On August 21, 1995, applicant, a California limited
liability company doing business as "PRC Gaming Systems,"
filed the above-referenced application to register the mark
"PITBOSS" on the Principal Register for what was
subsequently identified by amendment as "computer hardware
and software for tracking and managing transactions in
single or multiple pit areas of a gaming establishment," in
Class 9. The basis for the application was applicant's

assertion that the mark had been in use in commerce since October 5, 1994.

This application is now before the Board on appeal from a final refusal to register under Section 2(e)(1) of the Lanham Act on the ground that as applied to applicant's goods, the mark sought to be registered is merely descriptive of them. The Examining Attorney contends that "'PITBOSS' identifies either the person who will use the software (the 'Pit boss') or the function performed by the software (the job of the 'pit boss')." (March 4, 1996 Office Action, p.2)

In support of the refusal, the Examining Attorney made of record a dictionary definition of "pit boss" as "a casino employee who supervises gaming activity." Also submitted were excerpts retrieved from the Nexis® database of published articles. These articles show that a pit boss engages in a number of activities related to the supervision of gambling, e.g., he or she stands behind and supervises the dealers, watches people on the floor, strolls around the gaming tables, and in general oversees all of the gambling activities in his or her area of the casino.

Of particular significance to the Examining Attorney are the original specimens of record, printed promotional

materials submitted when the application was first filed. In these specimens, which are apparently directed to the people who manage casinos, applicant describes the product on which it uses its "PITBOSS" trademark. Explaining that its PitTrak Player Tracking System "automatically gathers critical player data right from your gaming tables," applicant characterizes the information available from its devices as "data your accounting, marketing and security departments need." Applicant states that "...using the optional PitBoss™ Management Workstation, your pit supervisors, surveillance specialists, or managers can monitor table activity at the pit, casino, or even enterprise level." Thus, contends the Examining Attorney, the computer products applicant sells under this mark are designed for use by casino pit bosses to help them do what pit bosses do with regard to tracking gaming transactions.

Neither applicant nor the Examining Attorney disputes the test for determining whether registration may be refused under Section 2(e)(1) based on mere descriptiveness. A mark is merely descriptive of the goods on which it is used if it forthwith identifies a quality, characteristic, function, feature, purpose or use of the goods. In re MetPath Inc., 223 USPQ88 (TTAB 1984). Another principle which is applicable to the facts in the

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case at hand is the rule that whether a mark is merely descriptive must be determined in relation to the goods identified in the application, rather than in the abstract. In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987). More specifically, marks have been found to be unregistrable under Section 2(e)(1) of the Act if they identify or describe the users or intended users of the goods. Hunter Publishing Co. v. Caulfield Publishing Ltd., 1 USPQ2d 1996 (TTAB 1986); In re Camel Manufacturing Co., 222 USPQ 1031 (TTAB 1984).

In the instant case, the materials made of record make it clear that pit bosses are the users of applicant's computer hardware and software, so the refusal to register under Section 2(e)(1) is appropriate.

Citing In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979), applicant argues that "PITBOSS" does not "convey an immediate idea of an ingredient, quality, characteristic, function or feature of the product in connection with which it is used." Further, applicant contends that its mark is not merely descriptive because "some imagination, thought and perception is required to reach a conclusion as to the nature of the goods bearing the mark." Neither of these arguments is well taken.

When considered in connection with the goods set forth in the application, the mark is merely descriptive of the goods because it identifies the aforementioned characteristics or features of them. The test is not whether someone presented with only the mark could determine what the goods are simply by considering the mark. The test is whether the mark provides someone who knows what the goods are with information about their characteristics. See *In re Omaha National Corp.*, supra. As noted above, the mark in the instant case tells prospective purchasers of applicant's computer hardware and software that it is used by a pit boss in the performance of the job functions of a pit boss.

Applicant makes other arguments to the effect that its mark is not merely descriptive of its goods, but rather is only suggestive of a feature or characteristic of them. None of these arguments is persuasive. The combination of the words "PIT" and "BOSS" into the single term "PITBOSS" does not result in any incongruity or new meaning which is different from the connotation of "PIT BOSS" as a two-word term. The fact that pit bosses have other duties in addition to monitoring the gaming activity levels that applicant's computer hardware and software tracks and manages does not make the term sought to be registered any

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less descriptive of that particular aspect of the duties of a pit boss.

Because we have found the first basis offered by the Examining Attorney to constitute a proper reason for affirming the refusal to register under Section 2(e)(1) of the Act, we do not need to discuss the alternative theory under which he found the mark to be merely descriptive. The mark is unregistrable under Section 2(e)(1) of the Act because it names the intended user of the goods set forth in the application. Accordingly, the refusal to register is affirmed.

R. L. Simms

R. F. Cissel

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B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board

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