

that applicant's mark, if used in connection with applicant's services, would be merely descriptive thereof.²

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs, and both appeared at an oral hearing held before the Board.

Before turning to the merits of the refusal, we must direct our attention to two evidentiary matters. First, attached to applicant's appeal brief is Exhibit B, comprising several third-party registrations.³ The Examining Attorney, in her appeal brief, objected to this evidence on the ground of untimeliness, citing Trademark Rule 2.142. The problem is that, just as in the case of the NEXIS evidence (i.e., Exhibit A), copies of all of the twenty-eight third-party registrations were submitted earlier by the previous Examining Attorney (see January 6, 1997 Office action). Thus, the copies of the registrations properly form part of the appeal record.

Second, applicant, in its appeal brief, lists nine third-party registrations.⁴ The Examining Attorney objects,

² When the original Examining Attorney left the Office, the application was assigned to the Senior Examining Attorney, who then handled the appeal brief and appeared at the oral hearing.

³ The appeal brief also was accompanied by Exhibit A, which consists of excerpts retrieved from the NEXIS database. As acknowledged by the Examining Attorney in her brief, this evidence previously was made of record.

⁴ We are referring to the list that appears in the brief at pages 12-13, but copies of these registrations have never been

contending that the Office does not consider a mere listing of third-party registrations as making the registrations of record, citing *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). Although the Examining Attorney is correct in stating that a mere listing of third-party registrations is insufficient to make the registrations of record, the problem here is that the previous Examining Attorney handling the case essentially waived the Office's right to object to the listing. In applicant's September 20, 1996 response to the first Office action, applicant listed eight of the nine registrations now referred to in the brief. In response, the Examining Attorney, in the final refusal dated January 6, 1997, not only did not object to the listing, but rather went on to consider the registrations as if they were properly of record, asserting that the evidence was not conclusive on the issue of mere descriptiveness. Thus, we find that the objection raised in the appeal brief was waived by the previous Examining Attorney's action. For the sake of completeness, all of the listed registrations have been considered, including the ninth one (Reg. No. 1,842,518) added in applicant's

submitted. The list appearing at pages 8-11 of the brief is merely a listing of the twenty-eight registration copies comprising Exhibit B.

appeal brief.

We now turn to consider the merits of the mere descriptiveness refusal. Applicant contends that the mark is not merely descriptive, stating that its activities "are not simply to 'give away money,' but rather to provide casino services, i.e., games of chance, where customers are entertained through the wagering of an amount of money on the possibility of receiving in return a greater amount of money based on one or more resulting outcomes of one or more games of chance." (brief, p. 3) Applicant goes on to argue that "a casino would not be the first place that a consumer would expect that there would be a 'giveaway,' especially involving money, since it is well known that casinos are relatively profitable." (brief, p. 5) Applicant also argues that the term "cash giveaway" is very broad, as shown by the NEXIS evidence, thereby failing to convey any immediate characteristic of the services. In contending that the refusal should be reversed, applicant points to the issuance of several third-party registrations of marks which contain the terms "fast" and/or "cash."

The Examining Attorney maintains that the designation sought to be registered "immediately describes a feature of the applicant's casino services, namely, a quick or speedy cash giveaway as a promotion or prize." (brief, p. 6) In

support of the refusal, the Examining Attorney relied on third-party registrations which show disclaimers of the terms "fast" and/or "cash," or show that resort to Section 2(f) was made. The Examining Attorney also relied upon excerpts retrieved from the NEXIS database which show use of the term "cash giveaway" in various contexts. Lastly, the Examining Attorney submitted dictionary listings for each of the words comprising the mark sought to be registered.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature of them. Moreover, contrary to the gist of some of applicant's remarks, whether a term is merely descriptive is determined not in the abstract, that is, not by asking whether one who

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sees the mark alone can determine what the applicant's goods or services are, but rather in relation to the goods or services for which registration is sought, that is, by asking whether, when the mark is used in connection with the goods or services, it immediately conveys information about their nature. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

As noted above, the Examining Attorney provided dictionary definitions of the three terms comprising the involved mark. The terms are defined, in relevant part, as follows: "fast: accomplished in relatively little time;" "cash: ready money;" and "giveaway: something given away free." We also take judicial notice of the definition of "giveaway" listed in *The Random House Dictionary of the English Language* (2d ed. 1993): "something that is given away, especially as a gift or premium."

Given the commonly understood meanings of the terms which form applicant's mark, we find that the combination of terms, FAST CASH GIVEAWAY, if used in connection with casino services, would be merely descriptive of a characteristic of them, namely, that the casino games offer players the chance of quickly winning a cash premium. We recognize applicant's argument that casinos are profitable and, therefore, casinos are not the first place that

consumers would expect to find money being given away. Nevertheless, consumers avail themselves of casino services to gamble, with the hope of winning cash. Thus, there is a "cash giveaway" aspect to games of chance; consumers, at least the lucky ones, are getting a cash premium, that is, an amount of cash that exceeds the amount wagered.

Also of record are excerpts retrieved from the NEXIS database. The excerpts show uses of "cash giveaway" in a variety of contexts. The bulk of the uses are in connection with promotions and contests conducted by television and radio stations. Two of the excerpts, however, show use of the term in connection with games of chance (a raffle and a state lottery). We acknowledge that these NEXIS excerpts do not present an overwhelming showing of the consuming public's perception of the term "cash giveaway" relative to games of chance. Nonetheless, they provide further support for our conclusion that "cash giveaway" is used to describe winnings, including in the gambling context.

In reaching our decision, we have given little weight to the third-party registrations. Our task in this appeal is to determine, based on the record before us, whether applicant's mark is merely descriptive. As often noted by the Board, each case must be determined on its own set of

facts. We obviously are not privy to the records involved in the cited registrations and, moreover, the determination of registrability of a particular mark by the Office cannot control the result in another case involving a different mark for different goods or services.⁵ Having said this, we cannot help but note what the Examining Attorney has pointed out, namely, that the term "fast" consistently has been disclaimed, that in two instances the terms "fast cash" was disclaimed and, in another, resort was made to a claim of acquired distinctiveness under Section 2(f).

Decision: The refusal to register is affirmed.

E. J. Seeherman

T. J. Quinn
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

⁵ In this connection, only one of the registrations covers casino services.

Administrative Trademark Judge Cissel, dissenting:

I respectfully dissent in this case because the record does not establish that the term sought to be registered immediately and forthwith conveys, with any particularity or specificity, information about the services with which it is intended to be used.

I find the proposed mark to be suggestive of the services set forth in the application, rather than descriptive of them, because of the plain meaning of the word "giveaway." Even though, as noted by my colleague in the majority opinion, the record does show "giveaway" used in connection with one raffle and one lottery, the evidence establishes that the word is ordinarily used in situations where things are simply given away, free, without a contribution, wager, or investment on the part of the person to whom the gift is made.

Experience and common sense tells us that casinos may take your money quickly (or slowly, or, for that matter, they may, if you make a wager and are lucky and win, they will even pay you money), but gambling establishments do

not give cash away, much less do they do it quickly. This applicant has made it clear that it does not intend to do so.

The use of "FAST CASH GIVEAWAY" in connection with "casino services, namely conducting games of chance," would undoubtedly be understood by prospective casino customers as suggesting that people who bet money in the casino could win money quickly, but no one in his or her right mind would expect that "FAST CASH GIVEAWAY" casino services involve a casino which rapidly makes gifts of cash. Some additional thought and imagination are required to make the connection between a fast cash giveaway and the casino services applicant plans to provide under this mark.

Additionally, I note that the Examining Attorney had the burden of establishing that this mark is merely descriptive of the services set forth in the application, and that any doubt as to whether she has met that burden must be resolved in favor of the applicant.

Because the term sought to be registered is suggestive, rather than merely descriptive, it is

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registrable on the Principal Register, and I would reverse the Examining Attorney's refusal to register it under Section 2(e)(1) of the Act.

R. F. Cissel
Administrative Trademark Judge
Trademark Trial & Appeal Board

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