

03/26/01

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 18  
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Trek Bicycle Corporation<sup>1</sup>

Serial No. 75/428,345

Mary Catherine Merz of Merz & Associates, PC for Trek Bicycle Corporation.

Jessie W. Billings, Trademark Examining Attorney, Law Office 103 (Michael Szoke, Managing Attorney).

Before Walters, Chapman and Drost, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On February 3, 1998, Trek Bicycle Corporation's predecessor-in-interest filed an application to register the mark TREKKING on the Principal Register for "educational services, namely, providing seminars and clinics relating to the use of exercise equipment" in International Class 41. The application was based on applicant's assertion of a bona fide intention to use the mark in commerce. Applicant filed, on April 12, 1998, an

<sup>1</sup> Trek Bicycle Corporation is the owner of application Serial No. 75/428,345 by assignment from Unisen, Inc. (Reel 1895, Frame 359.)

amendment to allege use setting forth a date of first use and first use in commerce of March 23, 1998.

The Examining Attorney has finally refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that the mark TREKKING, when used in connection with the identified services of applicant, is merely descriptive of them.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

The Examining Attorney contends that the mark TREKKING "describes a type of exercise performed on a treadmill wherein a teacher leads a workout for students on the treadmills" (Final Office action, p. 2), and she attached several excerpted stories from Nexis, all including the words "trekking" and "exercise." In her brief, she argues that the record shows the word TREKKING describes a form of exercise; and that because applicant's educational clinics involve the use of treadmills on which a person walks or runs, the term TREKKING merely describes the exercise benefits of walking indoors on a treadmill. She submitted

The American Heritage Dictionary definition of "trek" as "to journey on foot, especially through mountainous areas."<sup>2</sup>

Applicant argues that its mark is arbitrary, or at worst, is suggestive of applicant's services; that according to the TMEP §1209.01(a), "a mark does not have to be devoid of all meaning in relation to the goods or services" to be registrable on the Principal Register; that four of the eight excerpted Nexis stories submitted by the Examining Attorney refer to applicant (through Star Trac, its fictitious business name) as the developer of a new service which applicant markets under the mark "TREKKING"; that there are several excerpted Nexis stories (submitted by applicant), which discuss treadmill exercise classes without using the term "TREKKING", but rather use terms such as "Treading classes," "treadmill classes," and "High Energy Aerobic Training or HEAT classes"; and that there are several registered marks which indicate that a dictionary term may be arbitrary (or at worst, suggestive) with respect to instructional services, such as SPINNING for training and instruction to others by simulating an outdoor bicycle workout done on a stationary bike indoors

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<sup>2</sup> The Examining Attorney's request that the Board take judicial notice of this dictionary definition is granted. See TBMP §712.01.

(Registration No. 1,780,065), and JAZZERCISE for conducting a class in dance and exercise (Registration No. 1,079,083), and TREKKING for bicycles (Registration No. 1,989,281-- owned by applicant). From this, applicant concludes that its mark is not merely descriptive because the mark TREKKING does not immediately convey information to prospective purchasers about applicant's services, but instead requires imagination and thought to make a connection between the mark and applicant's services.

The test for determining whether a mark is merely descriptive is whether the mark immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). Whereas, a mark is suggestive if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. See *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ2d 505 (CCPA 1980).

Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or

services for which registration is sought, the context in which the term or phrase is being used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

In the present case, we conclude that the mark TREKKING requires a degree of imagination or perception to determine the nature of applicant's educational services. The Nexis stories of record do not evidence use of the word TREKKING descriptively in relation to the services which are the subject of this application. In fact, the Examining Attorney's own Nexis evidence shows use of the term TREKKING as applicant's mark for the exercise classes developed by applicant.

We agree with the Examining Attorney's statement that applicant's specimens of record show that applicant's clinics involve the use of treadmills, but the term is not used in a descriptive manner on the specimens.

The mark TREKKING does not readily and immediately evoke an impression and an understanding of the subject matter of applicant's educational seminars and clinics relating to the use of exercise equipment.

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Decision: The refusal to register under Section 2(e)(1) is reversed.