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Paper No. 13
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Brian S. Gladden

Serial No. 75/711,655

Lori M. Stockton of Blakely, Sokoloff, Taylor & Zafman
for Brian S. Gladden.

Brendan Regan, Trademark Examining Attorney, Law Office 113
(Meryl Hershkowitz, Managing Attorney).

Before Hanak, Wendel and Rogers, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Brian S. Gladden has filed an application to register
the mark EOUTDOORS for the following services:

Providing on-line pricing information for outdoor
products and services, namely, fishing, camping,
hunting, boating, archery and hiking equipment;
on-line ordering services featuring outdoor products,
namely, fishing, camping, hunting, boating, archery
and hiking equipment; on-line auctions featuring
outdoor products and services (Class 35);

Providing on-line chat rooms and bulletin boards for
dissemination of information concerning outdoor
activities, namely, fishing, camping, hunting,
boating, archery and hiking (Class 38);

Providing information on-line concerning outdoor activities, namely, fishing, camping, hunting, boating, archery, hiking, outdoor videos and outdoor games, and publications, namely, books, magazines, and newsletters about a variety of outdoor experiences (Class 41); and

Providing on-line consumer information concerning testing and evaluations of outdoor products, activities, and services; providing information on-line concerning weather, tides, lunar phases and maps (Class 42).¹

Registration has been finally refused under Section 2(e)(1) of the Trademark Act on the ground that the mark, if used in connection with the services identified in the application, would be merely descriptive thereof. The refusal has been appealed. Both applicant and the Examining Attorney have filed briefs but an oral hearing was not requested.²

Applicant contends that the mark EOUTDOORS is an incongruous combination of terms that requires imagination and thought to determine the nature of applicant's services; that EOUTDOORS has no readily identifiable meaning; that even accepting the Examining Attorney's assertion that "E" is an abbreviation for "electronic," applicant does not offer an electronic version of the

¹ Serial No. 75/711,655, filed May 21, 1999, based on an allegation of a bona fide intention to use the mark in commerce.

² The application was reassigned to a new Examining Attorney for the preparation of the brief.

outdoors; and that EOUTDOORS is no more than suggestive of applicant's online ordering, communication and information services. Applicant points to several third-party registrations for marks containing the prefix "E" as evidence that marks of this nature have been found registrable in the past by the Office.

The Examining Attorney maintains that the OUTDOORS portion of applicant's mark merely describes applicant's services which concern the "outdoors." As evidence thereof, the Examining Attorney first points to the identification of services itself, in which applicant frequently used the term "outdoor" to describe the products which are offered or the activities about which information is provided. In addition the Examining Attorney notes the NEXIS evidence submitted by the prior Examining Attorney showing widespread use of the term "outdoors" (or outdoor) in reference to "outdoors (or outdoor) stores," "outdoors (or outdoor) information," "outdoor activity information," "outdoor activities," and "outdoor equipment."³

As for the significance of "E" prefix in applicant's mark, when used in connection with this descriptive word,

³ We find no need to make any distinction between the two forms of the word, "outdoors" and "outdoor." The terms are used interchangeably and project the same connotation.

the Examining Attorney relies upon the recently published decision of the Board in *In re Styleclick.com Inc.*, 57 USPQ2d 1445 (TTAB 2000). The Examining Attorney argues that the *Styleclick.com* case is on all fours with this case; that in both cases the mark consists of the E- prefix and a word descriptive of the involved services and, moreover, in both cases the services include the on-line retailing of products in the field described by this word.

We agree with the Examining Attorney that our decision in *Styleclick.com* is controlling here. In that case the issue was whether the mark E FASHION would be merely descriptive if used in connection with "computer software for consumer use in shopping via a global computer network and computer software for providing fashion, beauty and shopping advice" and "electronic retailing services via a global computer network featuring apparel, fashion, accessories, personal care items, jewelry and cosmetics."

The Board found the term E FASHION

immediately describes, without conjecture or speculation, a significant characteristic or feature of the goods and/or services, namely, that they involve retrieving fashion information and/or shopping for fashions electronically via software and retail websites on the Internet. To consumers for applicant's goods and/or services, there is nothing in the term E FASHION which, in the context of such goods and/or services would be ambiguous, incongruous or susceptible to any other plausible meaning.
[57 USPQ2d at 1447.]

Speaking in more general terms, the Board concluded that

[i]n sum, "e-," when used as a prefix in the manner of applicant's mark, has the generally recognized meaning of "electronic" in terms of computers and the Internet. When this non-source-identifying prefix is coupled with the descriptive word "fashion," the mark E FASHION, as a whole, is merely descriptive for applicant's goods and/or services. That applicant may be the first or only entity using E FASHION is not dispositive. [Citation omitted].

The intent of Section 2(e)(1) is to protect the competitive needs of others, that is, "descriptive words must be left free for public use." [Citation omitted.] As the Internet continues to grow, merely descriptive "e-" prefix terms for Internet-related goods and/or services must be kept available for competitive use by others. [57 USPQ2d at 1448.]

Here the prefix "E" clearly refers to the term "electronic" and more specifically to the Internet.⁴ The services with which applicant intends to use the mark involve either on-line retailing of outdoor products, communication or provision of information with respect to outdoor products or outdoor activities, or provision of information about the outdoors itself. Just as FASHION was found to be merely descriptive when used in the context of retailing of fashion items or providing fashion

⁴ We note in particular the following definition made of record by the Examining Attorney from the *Official Internet Dictionary* (1998):

e- An abbreviation of "electronic" that generally indicates information or functions involving the Internet.

information, OUTDOORS is merely descriptive when used in the context of marketing or promoting outdoors products or providing information about outdoor activities and the like. The addition of the prefix "E" merely serves as a designation of the Internet as the means of obtaining these products or information. There is nothing incongruous in the term EOUTDOORS, when and if used in connection with on-line services involving products and information which may aptly be described as involving the "outdoors."

Furthermore, there is nothing left for speculation; persons encountering the term EOUTDOORS in connection with the on-line services identified in the application would immediately grasp the informational connotation of the term.

Applicant attempts to distinguish the *Styleclick.com* case by arguing that, although in the case of E FASHION, a person could "literally order 'fashion' over the Internet," one cannot order the "outdoors." We do not find this to be a viable distinction. In *Styleclick.com*, the Board clearly focused on the descriptive nature of the term "fashion" as used in connection with obtaining fashion information and shopping for fashion items. In summing up its holding, the Board once again referred to the "descriptive word 'fashion'," and noted the competitive need for using

"descriptive words." Thus, we see no basis for any argument that the term was found to be or must be virtually generic for the involved goods or services; instead, the test is whether the term is merely descriptive of the goods and/or services and would need to be used by others in this sense. Just as general retailers in the line of outdoors products have been shown to use the term "outdoors" to describe their retail stores, on-line competitors of applicant should be free to use the term "outdoors" to describe a similar line of outdoor goods and/or services. The addition of the prefix "E", which is widely understood to refer to Internet activities, is insufficient to impart non-descriptive status to the term as a whole.

Although it is true that there are numerous third-party "E-" prefix marks which have been previously registered by the Office, the Board dealt directly with this issue in the *Styleclick.com* case. Pointing out that Office practice in the past has resulted in inconsistent treatments of marks of this nature, the Board noted that

only "recently" [one to three years in the past] the Internet meaning of the "e-" prefix may have been known only by those few who were then accessing the Internet. We have no doubt that in the year 2000, the meaning of the "e-" prefix is commonly recognized and understood by virtually everyone as a designation for the Internet.
[57 USPQ2 at 1448].

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Thus, given the present widespread recognition of the meaning of the prefix, there can be no valid argument for continuing to register marks consisting of a merely descriptive term in combination with the "E-" prefix for Internet-related goods and/or services.

Accordingly, we find that EOUTDOORS, if used in connection with the various on-line ordering, communication and information services identified in the application, would be merely descriptive thereof.

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

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