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Paper No. 20
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Debra Bachtel

Serial No. 75/338,459

Cory M. Amron of Vorys, Sater, Seymour and Pease LLP for
Debra Bachtel.

William G. Breckenfeld, Trademark Examining Attorney, Law
Office 112 (Janice O'Lear, Managing Attorney).

Before Hohein, Walters and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On August 11, 1997 Debra Bachtel filed an application
to register on the Principal Register the mark TROPHYMUG
for "novelty mugs shaped as sports items" in International
Class 21. The application is based on applicant's
assertion of a bona fide intention to use the mark in
commerce on the identified goods.

Citing Section 2(e)(1) of the Trademark Act, 15 U.S.C.
§1052(e)(1), the Examining Attorney has finally refused
registration on the ground that when applicant's mark is

used on the goods identified in the application, it is merely descriptive thereof.

Applicant has appealed, and both applicant and the Examining Attorney have filed briefs.¹ Applicant requested an oral hearing, but subsequently withdrew that request.

The test for determining whether a mark is merely descriptive under Section 2(e)(1) of the Trademark Act is whether the term immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used or is intended to be used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Associates*, 226 USPQ 285 (TTAB 1985); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). The determination of mere descriptiveness must be made, not in the abstract, but rather in relation

¹ A previous Examining Attorney handling this application had finally refused registration of the mark on two grounds under Section 2(e)(1), 15 U.S.C. §1052(e)(1)--that the mark was merely descriptive, or alternatively that it was deceptively misdescriptive. Subsequent to that Final Office action, the current Examining Attorney requested a remand of the application, which was granted by the Board. The Examining Attorney then issued a new Final office action mentioning only the ground of mere descriptiveness. From the Examining Attorney's silence on the issue of deceptive misdescriptiveness in both his Final Office action and in his brief on appeal, the Board presumes that the Examining Attorney withdrew the refusal to register the mark as deceptively misdescriptive. Hence, the issue of deceptive misdescriptiveness will not be considered on appeal.

to the goods or services for which registration is sought, the context in which the term or phrase is being or will be 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 Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991). That is, the question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

The Examining Attorney argues that the word "TROPHYMUG" describes a significant feature of the goods, namely, "the applicant's mugs can be used as trophies" (Final Office action dated April 17, 2000, p. 2). In support of the refusal to register the record includes (i) dictionary definitions of the terms "trophy" and "mug"; (ii) photocopies of excerpted stories retrieved from the Nexis database relating to "trophy mug(s)"; and (iii) photocopies of the results of a search on the Internet and

printouts of certain web pages, all showing references to "trophy mug(s)."

The relevant portions of the definitions from The American Heritage Dictionary of the English Language (Third edition 1992) are as follows:

- (1) "trophy" (noun) is defined as "1.a. A prize or memento, such as a cup or plaque, received as a symbol of victory, especially in sports...."; and
- (2) "mug" (noun) is defined as "1. A heavy cylindrical drinking cup usually having a handle."

The following are examples of the excerpted stories retrieved from the Nexis database, showing use of the term "trophy mug(s)" (emphasis added):

HEADLINE: Kathy Whitworth; A Drive to succeed Is Par for Her Course
...All over the house, there are engraved sterling-silver loving cups, urns and **trophy mugs**, all slowly turning pewter-gray with tarnish. She doesn't have a housekeeper, and keeping Kathy Whitworth's trophies polished would be a career in itself. "The Dallas Morning News," May 24, 1994;

HEADLINE: Kick-Off Run and Fond Memory
...The first time James came home from a run with a **trophy mug**, he put it on an open shelf in the kitchen. And soon there was a second and a third and more. Stephen occasionally would bring home a cup, too. And he made a big deal of putting his on the

opposite end of the same shelf. "The Houston Chronicle," June 4, 1999; and

HEADLINE: Speed demons, Autocross Events Let Drivers Pretend They're Indy Racers

...racers from all walks of life racing against the clock in something called an autocross or solo, sanctioned by the Sports Car Club of America.

This past summer we became two of those people. Maybe it's the thrill of being the fastest, the row of **trophy mugs** on the bookcase (or in our case a starter set) or the rush that comes over you and causes your body to shake with excitement after you finish a good run.

...

On your drive to work Monday, the only thing you'll show from the event from the day before is a little premature tire wear, the shoe polish numbers still on your window, maybe a **trophy mug** in your back seat and a huge grin on your face. "The Courier-Journal (Louisville, Kentucky)," October 24, 1997.

The Internet websites include on-line shopping sites to purchase items such as a "Trophy Mug," or a "Sport Bottle," and sites where the various listed prizes are "trophy mugs" or "commemorative badges."

The Examining Attorney also points out that although this is an intent-to-use application, applicant, in response to an Office request, submitted one page of literature about her product ("novelty mugs shaped as

sports items"). This literature includes the following statements regarding the product (emphasis in original):

The TROPHYMUG™ is the perfect union of **two patented products** that together form the ultimate gift for sports fans.

The patented **Helmet™Mug**, designed as a miniature football helmet, is actually an insulated mug and can cooler first introduced on national TV by the Dallas Cowboys to celebrate their Superbowl XXVII championship.

The patented **Display Coaster**, with its trophy styled name plate, features a unique pedestal that cradles the **Helmet™ Mug** for display as a desktop accessory and also serves as a functional coaster.

Applicant contends that her goods are "novelty-souvenir items which may be used as mugs or coasters as well as pen/pencil holders, [and that] they are not intended to be nor are likely to be recognized or used by consumers as trophies" (applicant's response, May 10, 1999, p. 2); that applicant's goods are inexpensive gift items and not trophies which can be engraved and presented for particular achievements or skills; that the nameplate of applicant's product (which reads "No. 1 Fan") is not suitable for engraving; that consumers will not believe applicant's product is a "real trophy"; that under the Examining Attorney's proffered definition of "trophy," virtually any item could be utilized as a trophy (e.g.,

automobile, golf ball, clothing, bottle of hand lotion); and that while the term "trophy" may have a suggestive connotation with regard to applicant's goods, the mark TROPHYMUG is not merely descriptive of her goods, but rather is an oxymoron since it is clear that the goods are novelty gift items, not trophies.

We agree with the Examining Attorney that the term TROPHYMUG immediately and directly conveys information about a significant feature of applicant's "novelty mugs shaped as sports items." Applicant's novelty mugs are shaped like various sports helmets, and they come on display bases with a nameplate attached thereto. The dictionary definition of "trophy" as a prize or memento received as a symbol of victory, especially in sports, is quite broad. The commonly understood English meaning of the term "trophy" could include novelty mugs. Applicant concedes "that under the Examiner's definition of 'trophy,' the TROPHYMUG is, indeed, capable of being a trophy."

(Brief, p. 7.)

In fact, the record includes evidence that mugs (ranging from ornate pewter mugs to common coffee mugs), are used as trophies, and, applicant's mugs could certainly be so used. The fact that applicant contends they are intended as "gifts" and are not real "trophies" is not

persuasive. There is no limitation in the identification of goods as to such intended uses of the goods. This record establishes that the term "TROPHYMUG" describes a significant feature of the goods, namely that these mugs can be used as trophies. Purchasers may purchase these novelty mugs to be used as trophies.

The combination of these two words into one word does not create an incongruous or creative or unique mark. Rather, applicant's mark, TROPHYMUG, when used on applicant's identified goods, immediately describes, without conjecture or speculation, a significant feature of applicant's goods, as discussed above. Nothing requires the exercise of imagination or mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's goods to readily perceive the merely descriptive significance of the term TROPHYMUG as it pertains to applicant's goods. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792 (TTAB 1996); and *In re Time Solutions, Inc.*, 33 USPQ2d 1156 (TTAB 1994).

Decision: The refusal to register the mark as merely descriptive under Section 2(e)(1) is affirmed.