

THIS DISPOSITION IS
NOT CITABLE AS PRECEDENT
OF THE TTAB

Mailed: June 24, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Boot Royalty Company, L.P.

Serial No. 76281084

Charles S. Cotropia of Sidley Austin Brown & Wood L.L.P.
for Boot Royalty Company, L.P.

Jeri Fickes, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Quinn, Chapman and Bucher, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

On July 6, 2001, Boot Royalty Company, L.P. (a
Delaware limited partnership) filed an application to
register the mark BARN ROPERS on the Principal Register for
"footwear, namely, boots" in International Class 25. The
application is based on applicant's assertion of a bona
fide intention to use the mark in commerce on the
identified goods.

The Examining Attorney initially refused registration
under Section 2(d) of the Trademark Act, 15 U.S.C.

§1052(d). In its response thereto, applicant argued, inter alia, as follows (applicant's March 27, 2002 response, p. 3):

As the attached materials demonstrate,¹ the term "roper" is a generic term used to describe a particular type of boot. Generally, a "roper" is considered to be a type of boot with a lower heel, lower overall height, and significantly less adornment than a typical western-style or "cowboy" boot.

In the next Office action, the Examining Attorney withdrew her refusal to register under Section 2(d) of the Trademark Act, and refused registration on the grounds that applicant's mark, BARN ROPERS, is (i) deceptive in relation to applicant's goods under Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a); (ii) deceptively misdescriptive of applicant's goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1); and/or (iii) merely descriptive of applicant's goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). She also required that applicant indicate whether the mark has any significance in the relevant trade pursuant to Trademark Rule 2.61(b). She inquired "Specifically, are applicant's goods a combination

¹ The attached materials consist of six exhibits -- all being printouts of pages from various websites showing use of the term "roper" or "ropers" as a type of boot.

of a barn boot and roper boot, or a barn boot with a roper heel?" (August 22, 2002 Office action, unnumbered page 3.)

When the three refusals to register were made final, applicant appealed to the Board, and both applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing.

The Examining Attorney submitted one full story and several excerpted stories retrieved from the Nexis database and printouts of pages from the Internet to show that the terms "barn" and "roper" each describe a type of boot and that both types of boots are suitable for particular functions. Specifically she asserts that "barn" boots are suitable for performing barn chores such as mucking stalls and grooming horses, or they are used for their resistance to the infiltration of the elements such as water; and that "roper" boots are designed to fit in stirrups in a way to accommodate roping work and also to accommodate walking and ground work with greater ease than other cowboy boot styles.

Examples of the stories retrieved from the Nexis database which were submitted by the Examining Attorney are reproduced below:

Headline: Secrets of the Boot
...Cowboy Boots ...

Q. What if you don't want high heels and curly toes?

A. Try the style known as the roper. It has a walking heel, a staff (or leg) about three inches shorter than average cowboy boots. A roping boot tends to bend around the stirrup as the rider leans back to tighten the rope. Ropers are constructed with no heavy mid-sole or shank to cause the toes to curl. Ropers are the boots to wear when you are planning to spend a lot of time off the horse. ... "Albuquerque Tribune," July 25, 1995;

Headline: From Classic Hats to Fancy Footwear, Riders and Fans Take a Western Look

...Boot trends are also going traditional, said Garr. Although "ropers" still sell, most customers now want the basic boot. A roper boot has stitching all the way around the shoe-like sole, a rounder toe and flatter heel. Traditional cowboy boots have stitching only three-quarters of the way around with a narrow, curved and reinforced shank under the arch for harder wear and tear. ... "Arkansas Democrat-Gazette," June 29, 1997;

Headline: The Good, The Great and The Good Grieffs

...Dress wear by Varvatos means either black or camel, with the snap of officers' coats and leather roper boots. ... "The Houston Chronicle," February 22, 2001;

Headline: The Inauguration of George W. Bush, Ballgowns and Boots Take the Spotlight

...velvet Donna Karan gown she wore to both of George W.'s gubernatorial inaugurals. Her fancy footwear will be her trusty roper boots. ... "The Houston Chronicle," January 18, 2001;

Headline: My Car, and My Son Are Transformed

...Eventually, I'll begin to look for another used vehicle for day-to-day driving. This time I'll get one so uncool, Tim won't even think to object if I drive in my barn boots, leave the floor mats bunched and cockeyed, and let the dogs ride shotgun, moist noses pressed to the window. ... "The Christian Science Monitor," April 29, 2002; and

Headline: A Special Land, A Special Time

...20 below or 10 below, even, says folklorist James P. Leary, as he sits in jeans and manure-resistant barn boots in his UW-Madison office. "I like to be outside then. Not forever, but I like to go out. ... "Milwaukee Journal Sentinel," July 18, 1999.

The Examining Attorney also submitted printouts of pages from two different Internet websites, specifically, one showing that the company offers men's boots (with a roper heel) and "Barn Boots" (www.drewsboots.com/boulet); and at www.gprix.com/erbbootp.htm it states the following: "EPC Rubber Barn Boots Durable and waterproof. Features a loose fitting 15" shaft for easy-on easy-off, long wearing gripper tread sole for good traction and spur rest for easier boot removable."

The Examining Attorney contends that the proposed mark is deceptive when used on boots that "may not combine the features of barn boots and roper boots" (brief, p. 2); that

consumers could "plausibly believe that applicant's boots have both barn boot and roper boot features" (brief, p. 6); and that this misrepresentation will materially affect consumers' decisions to purchase the goods.

Further, she argues that even if the mark is not deceptive under Section 2(a), the mark is deceptively misdescriptive under Section 2(e)(1) if applicant's goods do not (or if use has not yet commenced, will not) include the features of barn boots and roper boots; or it is merely descriptive of applicant's goods if they do (or will) include said features.

Applicant contends that there is no deception under Section 2(a) because (i) the combination of the words "BARN" and "ROPERS" in a single mark is a coined term that has no meaning in the industry, but is instead a unique and incongruous combination of terms, and the combination cannot be misdescriptive as it has no recognized descriptive significance; (ii) that assuming *arguendo* there is a misdescriptiveness, there is no evidence that purchasers would believe the misdescription actually describes the boots as there are many types of boots suitable for doing "barn chores"; and (iii) because there is no misdescription and purchasers are not likely to believe any possible misdescription, the alleged

misdescription cannot be likely to affect the decision to purchase.

Applicant argues that the mark is not deceptively misdescriptive under Section 2(e)(1) for essentially the same reasons set forth with regard to the first two prongs of the Section 2(a) deceptiveness test. Finally, applicant argues that the mark is not merely descriptive under Section 2(e)(1) as the combination of terms is at most, suggestive of the goods; that this combination of potentially descriptive terms creates an incongruous or ambiguous commercial impression; that purchasers, upon encountering the mark, must follow a multi-step reasoning process to determine any characteristics of applicant's goods; and that competitors would not be limited in using terms necessary to describe their goods.

Applicant generally contends that there is no evidence showing use of the combined words "barn" and "ropers" together in connection with boots; that the goods would be visible to consumers and even a casual perception allows consumers to avoid any alleged deception regarding the appearance and style of applicant's boots; that the word "barn" is a general term which is evocative of a farm or ranch setting; and that any doubt is resolved in applicant's favor.

Turning first to the question of whether the mark is either deceptively misdescriptive or merely descriptive of the goods, we start with applicant's failure to respond to the Examining Attorney's inquiries (second Office action dated August 22, 2002) regarding information about applicant's goods, and specifically, whether or not the goods are (i) a combination of a barn boot and a roper boot or (ii) a barn boot with a roper heel.

In its response to the second Office action, applicant responded to each of the three refusals to register, but made no comment or response of any kind to the Examining Attorney's requirement for information under Trademark Rule 2.61(b). That is, applicant did not either provide the requested information or state that there was not yet any such information, or argue that there were valid reasons why it should not be required to provide such information. Given the nature of the refusals at issue in this case, it obviously would have been helpful to the Board and to the Examining Attorney if applicant had simply responded to the Office's inquiries about applicant's goods.²

² Likewise, it would have been helpful had the Trademark Examining Attorney made final her requirement for such information pursuant to Trademark Rule 2.61(b). See, *In re Planalytics, Inc.*, 70 USPQ2d 1453, 1457 (TTAB 2004); *In re DTI Partnership LLP*, 67 USPQ2d 1699 (TTAB 2003); and *In re SPX Corp.*, 63 USPQ2d 1592, 1597 (TTAB 2002). (footnote continued)

In her brief on appeal, the Examining Attorney stated the following (footnote 1):

...As for the issuance of the alternative mere descriptiveness refusal under Section 2(e)(1), applicant has not directly responded to the examining attorney's August 22, 2002 inquiry as to whether the goods are (will be) a combination of a barn boot and roper boot, or a barn boot with a roper heel. That the proposed mark is merely descriptive or deceptively misdescriptive of the goods remain equal possibilities.

In its reply brief, applicant continued its arguments that none of the alternative bases for refusal are proper, but applicant made no specific response to the Examining Attorney's comment in footnote 1 of her brief. However, contained within the section of applicant's reply brief addressing the merely descriptive refusal, it made the following ambiguously (and carefully) worded statement: "[T]he so-called 'hybrid of barn and roper boots,' as those terms are defined by the Examining Attorney, has never been created." (Reply brief, p. 6.) Thus, the record remains devoid of any definitive statement or information from

The Board considered remanding this application to the Examining Attorney, but concluded that it would be futile and would cause unnecessary delay as the Examining Attorney already made a clear requirement for information under Trademark Rule 2.61(b) and she referenced it again in her brief on appeal, all with no information forthcoming from applicant. Quite frankly, the Board is at a loss in understanding why this requirement was not made final in light of applicant's non-compliance.

applicant regarding the characteristics and properties of the "footwear, namely, boots" on which it asserts it has a bona fide intention to use the mark BARN ROPERS.

The test to be applied in determining whether or not a mark is deceptively misdescriptive under Section 2(e)(1) is set forth as follows: (1) whether the term misdescribes a characteristic, quality, function, composition or use of the goods, and (2) if so, whether prospective purchasers are likely to believe the misdescription actually describes the goods. See *In re Berman Bros. Harlem Furniture Inc.*, 26 USPQ2d 1514 (TTAB 1993); and *In re Quady Winery, Inc.*, 221 USPQ 1213 (TTAB 1984).

The test for determining whether a mark is merely descriptive is whether the term immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the goods or services 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 Eden Foods Inc.*, 24 USPQ2d 1757 (TTAB 1992); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).

Of course, the determination of deceptive misdescriptiveness and/or mere descriptiveness must be made not in the abstract, but in relation to the goods or

services for which registration is sought, the context in which the term is being used or is intended to 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).

In considering the record before us, we find that there is clear evidence that both words "barn" and "roper" refer to a type of boot. (See, for example, the web sites of various boot manufacturers, and the stories from the Nexis database referred to above.) Applicant itself asserted that "roper" is generic for a type of boot. Applicant's argument that the word "barn" may connote a farm or ranch setting is not persuasive because we must consider the terms in the context of the identified goods, boots.

Contrary to applicant's contention, the combination of these two common English-language words does not create an incongruous or unique mark. Rather, applicant's mark, BARN ROPERS, when used in connection with applicant's identified goods, either immediately describes or misdescribes, essential characteristics of applicant's goods.

While evidence of descriptive use of the multiple words together is generally persuasive that such a multiple word mark is merely descriptive, there is no requirement for evidence showing all the words used together in order to hold a multiple word mark to be merely descriptive. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001.) See also, *In re Shiva Corp.*, 48 USPQ2d 1957 (TTAB 1998).

If applicant's boots intended to be sold under this mark are either barn boots with a roper heel or are a boot which combines the characteristics of both a barn boot and a roper boot, then the mark is merely descriptive and purchasers would so understand, without need of conjecture or speculation. No exercise of imagination or mental processing would be required in order for purchasers or prospective customers for applicant's goods to readily perceive the merely descriptive significance of the term BARN ROPERS as it pertains to applicant's goods. See, *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987). See also, *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994).

If, however, applicant's boots intended to be sold under this mark are either not barn boots with a roper heel

or are not a boot which combines the characteristics of a barn boot and a roper boot, then the mark is deceptively misdescriptive. As explained above, this record establishes that "barn" and "roper" each identify a type of boot, designed for specific functions, respectively. We find that purchasers and prospective purchasers are likely to believe that the misdescription actually describes applicant's goods. The fact that upon seeing the boot, they may understand that it does not have the characteristics of a barn boot or a roper boot, does not negate their understanding up to that point when they inspect the goods. See *R. Neumann & Co. v. Bon-Ton Auto Upholstery, Inc.*, 326 F.2d 799, 140 USPQ 245 (CCPA 1964); *R. Neumann & Co. v. Overseas Shipments, Inc.*, 326 F.2d 786, 140 USPQ 276 (CCPA 1964); *In re Berman Bros.*, supra; *In re Woodward & Lothrop Inc.*, 4 USPQ2d 1412 (TTAB 1987); *In re Quady Winery*, supra; and *The American Meat Institute et al. v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981). Cf. *In re Automatic Radio Mfg. Co., Inc.*, 404 F.2d 1391, 160 USPQ 233 (CCPA 1969); *In re Lyphomed Inc.*, 1 USPQ2d 1430 (TTAB 1986); and *In re Econoheat, Inc.*, 218 USPQ 381 (TTAB 1983).

Accordingly, in the alternative (both under Section 2(e)(1) of the Trademark Act), we hold that the term BARN

ROPERs when used on "boots" is merely descriptive if the boots include the characteristics of barn boots and/or roper boots; and we hold that the term is deceptively misdescriptive of the goods if the boots do not include the characteristics of barn boots and/or roper boots.

This brings us to consideration of the refusal to register under Section 2(a) of the Trademark Act which is determined under the following three-prong test:

(1) whether the term is misdescriptive of the character, quality, function, composition or use of the goods;

(2) if so, whether prospective purchasers are likely to believe that the misdescription actually describes the goods; and

(3) if so, whether the misdescription is likely to affect the decision to purchase. See *In re Budge, Manufacturing Co. Inc.*, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988), *aff'g* 8 USPQ2d 1790 (TTAB 1988).

There is no dispute that the term "ropers" is generic for a type of boot. Moreover, although applicant argues the term "barn" can have other general meanings, applicant does not seriously dispute that the term refers to a type of boot. We find that "barn" does refer to a type of boot

as established by the Examining Attorney's Internet and Nexis evidence.

Even assuming arguendo that the mark, in the alternative is deceptively misdescriptive, there is simply no evidence that the misdescription is likely to affect purchasers' decisions to buy applicant's products. See *U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307 (TTAB 1990). Cf. *In re Budge Manufacturing Co. Inc.*, supra; *In re Organik Technologies, Inc.*, 41 USPQ2d 1690 (TTAB 1997); and *In re Shapely, Inc.*, 231 USPQ 72 (TTAB 1986).

As explained previously, due to the lack of information from applicant about its goods, we cannot definitively state that the term misdescribes the goods. Thus, in the unusual circumstances of this case, the first prong of the test is not met. In any event, even if the term misdescribes the goods, we agree with applicant that the record does not establish that use of the misdescriptive term is likely to affect purchasers' decisions to buy applicant's goods. The third prong of the test is not met. Accordingly, the Section 2(a) refusal to register must be reversed.

Decision: The refusal to register on the ground that the proposed mark is deceptive under Section 2(a) of the Trademark Act is reversed. The refusals to register on the

Ser. No. 76281084

grounds that the proposed mark is deceptively
misdescriptive or merely descriptive under Section 2(e)(1)
are affirmed.