

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

SERIAL NO. 75/039009 Barber, Tina M.		APPLICANT	PAPER NO.	
MARK SHILOH SHEPHERDS		ADDRESS: Assistant Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513		
ADDRESS I. Louis Wolk 939 Coast Blvd. La Jolla, CA 92037		ACTION NO. 02	If no fees are enclosed, the address should include the word "Box Responses - No Fee."	
		MAILING DATE 01/02/98	Please provide in all correspondence:	
		REF. NO.	1. Filing Date, serial number, mark and Applicant's name. 2. Mailing date of this Office action. 3. Examining Attorney's name and Law Office number. 4. Your telephone number and ZIP code.	
FORM PTO - 1525 (5-90)	U.S. DEPT. OF COMM. PAT. & TM OFFICE			

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT. For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 75/039009

This letter responds to the applicant's Request for Reconsideration.

Refusals to Register the Mark Made Final

Registration was refused under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), because the subject matter for which registration is sought is merely descriptive of the identified goods. Furthermore, the applicant has not shown adequate evidence to support a claim of acquired distinctiveness under Section 2(f). The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusals to register the mark under Section 2(e)(1) and under Section 2(f) are maintained and made FINAL.

The applicant applied to register the mark SHILOH SHEPHERD for live dogs.

The applicant has submitted literature explaining the genesis of dogs known as Shiloh Shepherds. The applicant bred many dogs to obtain puppies with the best characteristics, and has kept careful records of the progeny and ancestry of these dogs.

Proposed Mark is the Generic Name for the Goods

The examining attorney refuses registration on the Principal Register because the proposed mark is merely descriptive of the identified goods. Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1); TMEP section 1209 *et seq.* Moreover, the proposed mark appears to be generic as

applied to the goods and, therefore, incapable of identifying the applicant's goods and distinguishing them from those of others. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991). Under these circumstances, the examining attorney cannot accept an amendment to proceed under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f).

Whether a term is generic is a question of fact. *The Loglan Institute Inc. v. The Logical Language Group, Inc.*, 22 USPQ2d 1531 (Fed. Cir. 1992); *In re Northland Aluminum Products*, 227 USPQ 961 (Fed. Cir. 1985). Evidence of what the public understands a term to mean may come from numerous sources, such as listings in dictionaries, surveys, consumer newspapers, and purchaser testimony. *In re Analog Devices*, 6 USPQ2d 1808 (TTAB 1988), *aff'd in unpublished decision*, 10 USPQ2d 1879 (Fed. Cir. 1989); *In re Merrill Lynch*, 4 USPQ2d 1141 (Fed. Cir. 1987); *In re Northland Aluminum Products*, 227 USPQ at 963. Dictionary definitions are influential because they reflect the general public's perception of a term's meaning and implication. *The Murphy Door Bed Co., v. Interior Sleep Systems Inc.*, 10 USPQ2d 1748 (2d Cir. 1989); *Liquid Controls Corp. v. Liquid Control Corp.*, 231 USPQ 579, 581 (7th Cir. 1986); *Gimix v. J.S. & A. Group, Inc.*, 217 USPQ 677 (7th Cir. 1983).

As was explained in the Office action dated March 14, 1997, the applicant developed a variation of the German shepherd dog. The name which the applicant, or the Federation of International Canines, has given this new dog is the Shiloh Shepherd. There is no other name by which to refer to this animal. The public has come to know this dog by the name Shiloh Shepherd. Thus, the name Shiloh Shepherd identifies a particular genus of goods.

The fact that an applicant may be the first and only user of a merely descriptive or generic designation, in this case, Shiloh Shepherd, does not justify registration if the term is merely descriptive. *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983).

The Public Recognizes The Name "Shiloh Shepherd" as Identifying a Genus of Dogs

To determine whether a term is being used as a trademark, the examining attorney must consider the specimens of record, together with any other evidence submitted with the application. *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213 (CCPA 1976); *In re Restonic Corp.*, 189 USPQ 248 (TTAB 1975). Not all words, designs, symbols or slogans used in the sale or advertising of goods or services function as trademarks, regardless of the applicant's intent. A term does not function as a trademark unless it is used in a manner which clearly projects to purchasers a single source of the goods or services. *In re Morganroth*, 208 USPQ 284 (TTAB 1980).

The Office action dated August 13, 1996 contained an excerpt from *The Encyclopedia of the Dog (1995)*, showing Shiloh Shepherd dogs. The applicant has stated that the publication misstated that formal recognition of this dog was granted in 1990, but that in reality, the American Rare Breed Society has accepted this dog as a "rare breed," which is not really a true breed, but just a "variety."

However, the literature shows that *the applicant*, as well as the public, considers the term SHILOH SHEPHERDS to identify a breed of dogs. For example, note the following (references to breeds shown in bold type):

The applicant's pamphlet, entitled SHILOH SHEPHERDS, states:

AT SHILOH KENNELS WE FEEL THAT *COURAGE, STABILITY, AND INTELLIGENCE* ARE FUNDAMENTAL TRAITS OF **OUR BREED**.

The applicant's booklet entitled "The Origins of the Shiloh Shepherd in Word & Picture" repeatedly refers to the Shiloh Shepherd breed, as follows:

Page 11: Chapter 4 The Fabulous Four

Although males like SHEP, SHANE (Kari's son), LUKE (Ursa's brother), ETC., ETC. have provided a large contribution toward the stabilization of **our breed....**

Page 20: As we approached the nineties, dedicated people rallied around these dogs, and convinced me to pull away from the AKC, and submit these dogs as a **SEPARATE BREED!!** Registries were contacted, and arrangements made, after reviewing all of the statistics, pedigrees etc. of these dogs, the F.I.C. (Federation of International Canines) agreed to recognize them as a separate breed. Now all that was left to do, was to "NAME" this breed and set up a **breed standard....**the F.I.C. board chose to call them the SHILOH SHEPHERD, naming them after the Kennel of Origin (or Kennel where they were preserved from the ORIGINAL GERMAN SHEPHERDS)....

On September 1, 1990, THE SHILOH SHEPHERD became recognized as **A RARE BREED!!**

Page 27: Chapter 8 THE FUTURE (OF THE SHILOH SHEPHERD)

The future of **this breed** is MUCH BRIGHTER than most people realize! WE HAVE THE TOTAL DOG!

Page 30: If you feel that **THIS** might be **the breed of dog**, you would like to own someday...I would like to INVITE you to JOIN our group...

Page 31: (In the list of items to be ordered)

3. BREED STANDARDS

The back of the booklet states:

COME BACK TO THE FUTURE
WITH THE
ULTIMATE *GIANT* RARE BREED
SHILOH SHEPHERD

Despite the applicant's protestations that its dog is a "rare breed," not a "true" breed, the fact is that the name SHILOH SHEPHERD is the name by which the applicant's dogs have become known by the public. Excerpts from *The Encyclopedia of the Dog*, and *Dog Breed Handbooks GERMAN SHEPHERD*, 62-63 (1996), listing the Shiloh Shepherd were attached to previous Office actions. Also, attached were copies of *Shiloh Shepherd Breed Standard*, from *Dog World*, v. 81, No. 7, pages 99-123 (July 1996), and from the World Wide Web, distributed at <http://www.cis.ufl.edu/~rjj/Shiloh/BreedStandard.html>, which states, at the beginning of the article:

SHILOH SHEPHERD BREED STANDARD. As accepted by the American Rare Breed Association.

Also attached was a copy of a printout from the Shiloh Shepherd Dog Club of America, Inc. web site, listing at least nine (9) kennels which breed Shiloh Shepherds. Even though the applicant may license these breeders to breed dogs bearing certain characteristics, and allowing them to use the name only if the dogs bear those characteristics, nevertheless, the name "Shiloh Shepherds" identifies the genus of dogs bred by the breeders. They are not breeding collies or beagles. They are breeding Shiloh Shepherds.

The International Shiloh Shepherd Registry, affiliated with the applicant, was established to ensure that only candidates which meet its requirements can be identified as Shiloh Shepherds. That organization can *certify* that certain dogs which meet its standards are Shiloh Shepherd dogs, but the applicant's proposed mark cannot serve as a trademark to indicate that all dogs bearing this name emanate from one single source

Even if the applicant has licensed other breeders to breed dogs meeting certain specifications, to be called Shiloh Shepherds, the fact remains that there is no other name by which to call these dogs. This is the essence of a generic term. There must be a generic name by which to call something; otherwise, the proposed trademark is the generic term. If the applicant called the dogs by a generic name and a trademark to identify the source of the dogs, there might be a registrable trademark. Or, if the applicant applied to register the name of its kennel, i.e., Shiloh Kennels, for dog breeding services, there might be a registrable mark. However, even were this the case, if the public refers to the dogs by the only name they have, that is, as Shiloh Shepherds, the proposed mark does not serve as a trademark.

Also, to further show that the general public refers to the applicant's dogs as Shiloh Shepherds, in addition to the stories from LEXIS/NEXIS® Research Database attached to previous Office actions, attached are two more stories referring to Shiloh shepherd dogs. The Trademark Trial and Appeal Board has held that materials obtained through computerized text searching are competent

evidence to show the descriptive use of terms under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1). *In re National Data Corp.*, 222 USPQ 515, 517 n.3 (TTAB 1984).

Third Party Registrations

The applicant referred to what it believed to be third party registrations for other animals. First of all, third-party registrations are not conclusive on the question of descriptiveness. The examining attorney must consider each case on its own merits. A mark which is merely descriptive is not registrable merely because other similar marks appear on the register. *In re Scholastic Testing Service, Inc.*, 196 USPQ 517 (TTAB 1977).

However, the marks which the applicant listed are not merely the names of breeds. Registration No. 1,836,418 for ATSS AMERICAN TUNDRA SHEPHERD CERTIFIED, INC. is a certification mark to certify that specific dogs have certain characteristics and that breeders have certain qualifications. Please note that the applicant disclaimed the exclusive right to use the term CERTIFIED AMERICAN TUNDRA SHEPHERD SOCIETY, INC.

Registration No. 1,775,621 for AMERICAN TUNDRA SHEPHERD and Design (a drawing of a dog), identifies association services for people interested in purebred dogs, printed matter, and clothing (for people and pets). Again, the applicant disclaimed the exclusive right to use the words AMERICAN TUNDRA SHEPHERD and the design of the dog, apart from the mark as a whole.

Application Serial No. 73/656,752 for TIMBERSHEPHERD, for dogs crossbred from German shepherds and wolves, never registered. It was abandoned by the applicant.

Proposed Mark Does Not Function as a Trademark

The refusal to register the mark for failure to function as a trademark is maintained and made FINAL. Trademark Act Sections 1, 2 and 45, 15 U.S.C. Sections 1051, 1052 and 1127. Based on the record, the proposed mark neither identifies and distinguishes the goods of the applicant from those of others nor indicates their source. *In Re Remington Products Inc.*, 3 USPQ2d 1714 (TTAB 1987). Rather, the term indicates a breed of dogs.

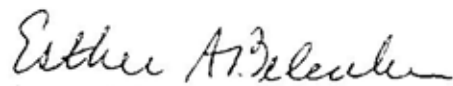
Conclusion

For the foregoing reasons, the mark is refused registration under Section 2(e)(1), Section 2(f), and Sections 1,2 and 45 of the Trademark Act.

Options

Please note that the only appropriate responses to a final action are either (1) compliance with the outstanding requirements, if feasible, or (2) filing of an appeal to the Trademark Trial and Appeal Board. 37 C.F.R. Section 2.64(a). If the applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. Section 2.65(a).

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.



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