

THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ziff-Davis Publishing Company

Serial No. 75/049,228

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for Ziff-Davis Publishing Company.

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107 (Thomas Lamone, Managing Attorney).

Before Cissel, Hohein and Hairston, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On Jan. 26, 1996, applicant applied to register the
mark "INTERNET COMPUTING" on the Principal Register for
"general interest publications principally for users and
potential users of online services and products," in Class
16. The application was based on applicant's assertion
that it possessed a bona fide intention to use the mark in
commerce.

The Examining Attorney originally refused registration under Section 2(d) of the Trademark Act, but that refusal was subsequently withdrawn in view of applicant's arguments.

The Examining Attorney also refused registration under Section 2(e)(1) of the Act on the ground that the mark merely describes the subject matter of applicant's publication. Submitted in support of this refusal were copies of published articles retrieved from the Nexis® database wherein the term "Internet computing" was used in a descriptive context. Typical examples include the following: "Digital has been extremely visible as a leader in Internet computing."; "Both technologies are designed to monitor the virtual nature of the PC inherent in Internet computing..."; "as corporations adjust to the convergence of client/server and Internet computing, the components of enterprise-wide security are encompassing new elements..."; "Myers had also noted that PC computing readers are very interested in Internet computing, so that developing a series of state-of-the-art Web sites was another way to serve the magazine's print and online fans."; and "In Internet computing, the client and server communicate over the Internet instead of over a private network."

Further, the Examining Attorney required applicant to amend the identification-of-goods clause to indicate the specific types of publications on which applicant intends to use the proposed mark.

Responsive to the first Office Action, applicant amended the application to identify the goods with which it intends to use the mark as "publications, namely, magazines and newspapers and supplements thereto and sections thereof, and newsletters, journals, brochures, catalogues, directories and pamphlets in the field of technology and subjects of general interest." Applicant also presented arguments against the refusal based on descriptiveness.

The Examining Attorney then maintained and made final the refusal based on Section 2(e)(1). She reiterated that "INTERNET COMPUTING" is merely descriptive of publications which feature information about and which deal with the subject of Internet computing. Additional excerpts retrieved from the Nexis® database were submitted with the final refusal. Examples include: "Internet computing is changing the very nature of business-critical computing..."; "... Digital Equipment Corporation has unveiled what it thinks will be the latest in Internet computing with the announcement of its brand new 64-bit Java Development Kit..."; "...maintaining its aggressive push to protect online

transactions and create a secure Internet computing environment for the enterprise, Hewlett-Packard Co. has introduced Version 2.0 of its [new product]..."; and "at the same time, the Internet computing revolution is creating new opportunities for high-growth software businesses."

Applicant then timely filed a Notice of Appeal and a request for reconsideration. The Board instituted the appeal, suspended action on it, and remanded the application to the Examining Attorney for reconsideration. The Examining Attorney reconsidered the application, but maintained the refusal to register.

Applicant filed an appeal brief, the Examining Attorney filed her brief, and applicant filed a reply brief. Applicant did not request an oral hearing before this Board, however, so we have resolved this appeal based on consideration of the written record and arguments before us.

The test for determining whether a trademark is merely descriptive of the goods or services with which it is used or with which it is intended to be used is well settled. A mark need not name the goods or services on which it is used in order to be considered merely descriptive of them. Rather, a mark is merely descriptive if, as used in connection with the goods or services, it immediately

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describes, i.e., immediately conveys information about, an ingredient, quality, characteristic, or feature thereof, or if it directly conveys information regarding the nature, function, purpose, or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Ethan Foods, Inc.*, 24 USPQ2d 1757 (TTAB 1992); and *In re American Screen Process Equipment Co.*, 175 USPQ 561 (TTAB 1972). Further, the question of whether a mark is merely descriptive must be determined not in the abstract, that is, not by asking whether one can guess from the mark itself, considered in a vacuum, what the goods or services are, but rather in relation to the goods or services for which registration is sought, that is, by asking whether, when the mark is seen on the goods or in connection with the services, it immediately conveys information about their nature. *In re Abcor Development Corp.*, supra. We are obligated to determine the question of registrability based on the identification of goods or recitation of services as set forth in the application for registration, subject only to such limitations as to scope, channels of trade, etc. as are specified therein, or which are normal for goods of the same nature. *In re Allen Electric and Equipment Co.*, 458 F.2d 1404, 173 USPQ 689 (CCPA 1972); *In re Vehicle Information Network, Inc.*, 32

USPQ2d 1542 (TTAB 1994); and In re Cryomedical Services Inc., 32 USPQ2d 1377 (TTAB 1994).

When this test is applied to the facts in the case at hand, we find that the mark applicant seeks to register is clearly merely descriptive of the goods set forth in the application. We agree with the Examining Attorney that the proposed mark conveys the fact that a characteristic of applicant's publications is that they feature information about Internet computing.

In its appeal briefs, applicant contended that the Examining Attorney did not allow applicant the opportunity to disclaim any descriptive elements in its mark. Applicant then offered to disclaim the term "INTERNET" apart from the mark as shown, and argued that the composite mark "INTERNET COMPUTING" in its entirety is not merely descriptive of the goods set forth in the application. Applicant also argued that the Examining Attorney did not properly consider the "vague meaning" of the mark among readers of computer and technology-related publications, and further, that she failed to support the refusal with adequate evidence.

Applicant claimed that it is not possible to understand the meaning of "Internet computing" from the examples cited by the Examining Attorney, and pointed out

that the term might be used to refer to several different things, such as the use of software downloaded from the Internet to do operations for a math computation, the use of a computer for traditional computing, or to the ability to perform multi-tasking between computing downloaded software programs and searching Web browsers on a global computer network. Applicant concluded that the Examining Attorney had not established that there was a generally understood meaning for the term sought to be registered among potential purchasers of its magazines.

Applicant asserted that the Examining Attorney was legally incorrect when she claimed that a term is unregistrable as merely descriptive if it describes only a single attribute of the goods with which it is used. Applicant conceded that it intends to feature information about the use of a global computer network in its publications, but argued that because its intention is to provide its customers with other information as well, the proposed mark is not unregistrable under Section 2(e)(1) of the Act.

Further, applicant argued that because its companion application to register the same mark in another class, Class 9, for computer products, was passed to publication,

the instant application should be accorded similar treatment by the Examining Attorney.

Applicant's final argument is that the Examining Attorney's decision to pass the mark to publication in Class 9 strongly suggests that doubt must have existed, or at least should exist, as to the descriptiveness of this mark for goods in Class 16. Accordingly, argues applicant, any doubt as to the registrability of the mark must be resolved in favor of the applicant, so the mark should be passed to publication.

None of these arguments is persuasive. Each of applicant's arguments will be addressed in turn.

To begin with, with regard to applicant's contention that the Examining Attorney did not give applicant the chance to enter a disclaimer of the word "INTERNET," we note that she was under no obligation to suggest such action by applicant, nor did she refuse to entertain an amendment wherein applicant asked to enter a disclaimer. Such a disclaimer would not solve applicant's problem in this case, however. That applicant is willing to concede that one of the two words in its proposed trademark is unregistrable because it is merely descriptive does not alter the fact that the other one is just as descriptive of the goods, or the fact that, as applied to the goods, the

combination of the two words is likewise merely descriptive.

As to the second argument made by applicant, we find that the examples of use of the term sought to be registered cited by the Examining Attorney do show the proposed mark used descriptively. Contrary to applicant's argument, one does not have to be able to construct a precise definition of the term based on these examples of its use in order for the term to be found unregistrable under the Act.

That a term may have several meanings does not establish its registrability when at least one of those meanings is descriptive in connection with the goods specified in the application. Contrary to the argument made by applicant, it is sufficient to support a descriptiveness refusal if a term describes a single significant attribute or characteristic of the goods in question. In re Bright-Crest, Ltd., supra.

Applicant's argument with regard to its companion application to register the same mark for goods in another class is not well taken either. There is no authority for contending that the Examining Attorney, in determining registrability, must disregard the goods and services set forth in the application. The determination of whether the

proposed mark is descriptive depends in large part on the connotation of the mark as applied to the goods with which applicant intends to use it. To contend that because a mark is registrable with respect to some goods, it should be registered for any and all goods is simply illogical.

As to applicant's final argument, we agree with the proposition that if doubts exist concerning the registrability of a mark, such doubts should be resolved in favor of the applicant. In the case at hand, however, no doubt exists.

In summary, because the record in this application clearly establishes the descriptiveness of the term sought to be registered in connection with the goods specified in the application, the refusal to register under Section 2(e)(1) of the Act is appropriate, and is accordingly affirmed.

R. F. Cissel

G. D. Hohein

P. T. Hairston
Administrative Trademark Judges,
Trademark Trial and Appeal Board

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