

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB                      AUG. 26, 99  
U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Freedom Magazines, Inc.

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Serial No. 75/130,249

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Steven J. Nataupsky of Knobbe Martens Olson & Bear for  
Freedom Magazines, Inc.

Andrew J. Benzmilller, Trademark Examining Attorney, Law  
Office 106 (Mary I. Sparrow, Managing Attorney).

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Before Hanak, Chapman and Bucher, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Freedom Magazines, Inc., a California corporation, has  
filed an application for registration of the mark "SMALL  
OFFICE HOME OFFICE COMPUTING & COMMUNICATIONS" for  
"magazines."<sup>1</sup>

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<sup>1</sup> Serial No. 75/130,249, in International Class 16, filed  
July 5, 1996, based upon an allegation of a *bona fide* intention  
to use the mark in commerce. An acceptable identification of the

The Trademark Examining Attorney issued a final refusal to register based upon Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that if applicant's proposed mark were used on magazines, it would be merely descriptive of applicant's goods. The Trademark Examining Attorney also issued a final refusal to register based upon applicant's failure to comply with his requirement for a more definite identification of goods.

Applicant has appealed both the refusal to register based upon the alleged merely descriptive nature of the mark as well as the requirement for a more definite identification of goods. Briefs have been filed, but applicant did not request an oral hearing.

A mark is unregistrable under Section 2(e)(1) of the Trademark Act as merely descriptive of the goods on which it is used if it immediately and forthwith conveys information about the characteristics, features or functions of those goods. See In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987), and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Accordingly, the Trademark Examining Attorney contends that the wording "SMALL OFFICE HOME OFFICE

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goods continues to be an issue in this case and will be discussed below.

COMPUTING & COMMUNICATIONS" immediately tells potential readers that applicant's magazine focuses on computing and communications issues of interest to those who work in small offices or home offices. Evidence placed in the record by the Trademark Examining Attorney demonstrates the use of various combinations of these phrases in ways that make this point:

To help you define your needs and choose the components that will best serve your computing purposes, we've divided our special report into three home PC categories: the small-office/home-office (SOHO) system ...  
"Choosing the Perfect Home PC," Computer Shopper, September 1997.

These statistics suggest a tremendous opportunity for the home office category. Home office products and computer accessories are more in demand than ever, as harried workers try to find products that fit their office needs at home...  
"Sales Potential Soars as Homes Become Offices," Drug Store News, August 4, 1997.

Now, with home computers becoming almost as common as TVs, many big-time furniture manufacturers are offering home-office lines. Their computer desks and cabinets feature...  
"Workstations aren't just desks, they're furniture," The San Diego Union-Tribune, August 3, 1997.

At \$1,799 (including a decent monitor), [this PC] is fast, versatile and pleasing to the eye - so it fits into a variety of home computing, small office computing and small business computing contexts.

"Gateway G5-200M: Best Buy for \$1,799,"  
Chicago Sun-Times, July 24, 1997.

Most entrepreneurs say they had the beginnings of a home office already: an acceptable computer, a printer, and a desk and chair. Most add fax machines, sometimes a second phone line, business software...  
"Entrepreneurs in Atlanta," The Atlanta Journal and Constitution, July 21, 1997.

Apple Computer ... announced performance improvements ... designed to address the general purpose mobile computing requirements in small office, home office, business and education settings...  
"Apple boosts performance of popular Powerbook 1400 Notebook Computers," M2 Presswire, July 18, 1997.

What we would like to see is our product bundled on computers that are specifically targeted to the small office and home office users...  
"SafeGuard wants to backup the retail software game," Pittsburgh Business Times and Journal, July 14, 1997.

These stories taken together -- and all of them were published during the summer of 1997 when the final refusal was issued -- demonstrate the recognition within the computer industry that this specific category of consumers have come to represent a distinct and rapidly growing segment of the market. In fact, we see within the LEXIS/NEXIS evidence several indicators that the niche market applicant would be targeting is referred to multiple times using the identical designation "small-office / home-office" and has even earned an acronym, "SOHO."

Furthermore, we see nothing in the joining of the term "small office home office" with the term "computing & communications" that creates a new or different meaning than one would anticipate when melding these individual components. Certainly, common, ordinary words can be combined in a novel or unique way and thereby achieve a degree of protection denied to words when used separately. However, in adopting this specific formulation, applicant has not created any new double or incongruous meaning for the combined phrase. In short, the term "small office home office computing & communications" does not require imagination, thought and perception to reach a conclusion as to the nature of the magazine and therefore it cannot be considered a suggestive term.

We find that the Trademark Examining Attorney herein has more than adequately demonstrated that this term is merely descriptive of a magazine title. This conclusion is entirely consistent with past decisions of this Board and federal courts. See *In re Waverly Inc.*, 27 USPQ2d 1620 (TTAB 1993) ["MEDICINE" is merely descriptive for a medical journal]; *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876 (TTAB 1992) ["DECORATING DIGEST" is merely descriptive of magazine featuring articles on decorating but is protectible with proof of acquired distinctiveness]; *In re*

The Gracious Lady Service, Inc., 175 USPQ 380 (TTAB 1972) ["CREDIT CARD MARKETING" descriptive for a periodical pamphlet devoted to subjects of interest to those engaged in the credit card merchandising field]; Harbrace Publications, Inc. v. Grocers Publishing Co., Inc., 171 USPQ 814 (TTAB 1971) ["SNACK FOOD MERCHANDISER" merely descriptive of a publication directed at owners of candy stores, bowling alleys, etc.]; In re Hunter Publishing Company, 204 USPQ 957 (TTAB 1979) ["JOBBER AND WAREHOUSE EXECUTIVE" merely descriptive of magazine directed to aftermarket manufacturers and distributors generally].

In the interest of completeness, we now turn to the Trademark Examining Attorney's requirement for a more definite identification of goods. While the original application simply listed the goods as being "magazines," applicant responded to the requirement of the first office action by proposing an amendment to "general interest magazines." The Trademark Examining Attorney went final on the requirement that this remained indefinite because it still failed to specify the subject matter of the magazine. At the time of its appeal herein, applicant proposed amending the identification yet again to read "general interest magazines regarding technology needs for business operators." The Trademark Examining Attorney continued to

find this unacceptable, explaining the Office's position as follows:

The wording "general interest magazines" identifies magazines covering a wide range of topics of interest to the general public, typically including subjects such as news, politics, entertainment, sports, arts, and business. In contrast, "magazines regarding technology needs of (sic) business operators" identifies special interest publications covering a much narrower subject matter and aimed at a limited readership, i.e., those interested in computing and communications issues affecting those who work in small offices or home offices. Accordingly, applicant's proposed amendment is unacceptable because it is not clear whether its magazines are general interest magazines or magazines regarding a particular specialized topic.

Trademark Examining Attorney's appeal brief, pp. 6 - 7. The Trademark Examining Attorney refused at this late date to accept this wording because it did not appear that applicant intended to launch a "general interest magazine" - at least not as that term is used in the Patent and Trademark Office.

Applicant's final proposed identification appears to us to be a belated attempt to move toward a more narrow listing of the subject matter of, or target audience for, the magazine. On the other hand, we agree with the Trademark Examining Attorney that this latest proposal, because it is inherently contradictory, is not the model of

optimum clarity. Nonetheless, however inartfully drawn, this proposal (i.e., "general interest magazines regarding technology needs for business operators") merits at least a passing grade, and so we find it acceptable. Thus, we reverse on this requirement.

Decision: We affirm the refusal of the Trademark Examining Attorney to register this matter under Section 2(e)(1) of the Act, but reverse as to the acceptability of applicant's latest amendment to the identification of goods.

E. W. Hanak

B. A. Chapman

D. E. Bucher

Administrative Trademark  
Judges, Trademark Trial and  
Appeal Board