

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

Trademark Trial and Appeal Board

In re International Data Group, Inc.

Serial No. 74/618,652

Mark B. Harrison and George W. Lewis of Spencer & Frank for
applicant.

Theresa K. Kaiser, Trademark Examining Attorney, Law Office
104 (Sidney Moskowitz, Managing Attorney).

Before Cissel, Seeherman and Walters, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

International Data Group, Inc. has filed a trademark
application to register the mark IWAY for "newsletters,
journals, newspapers and books regarding online
communication topics," in International Class 16;
"dissemination of information regarding online
communication to others through the use of an online
electronic communications network," in International Class

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38; and "providing online access through the use of a computer to magazines, newsletters, journals, newspapers and books regarding online communication topics," in International Class 42.¹

The Trademark Examining Attorney has finally refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its goods and services.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs,² but an oral hearing was not requested. We affirm the refusal to register.

The Examining Attorney contends that IWAY is a standard abbreviation for the "information superhighway"; that "the IWAY, or 'information superhighway,' is an online electronic communications network now commonly called the Internet"; and that IWAY merely describes a significant aspect of applicant's goods and services "because the subject matter of applicant's Class 16 publications, Class 38 information and Class 42 online publications is 'online

¹ Serial No. 74/618,652, filed January 6, 1995, based on an allegation of a bona fide intention to use the mark in commerce in connection with all classes of goods and services listed. The reference to "magazines" originally included in the identification of goods in International Class 16 was divided out of this application.

² Pursuant to the Board's order of October 14, 1997, to which applicant filed no response, applicant's late-filed reply brief has not been considered.

communication'." In support of her position, the Examining Attorney has submitted numerous excerpts of articles from the LEXIS/NEXIS database in which IWAY and I-WAY appear as shorthand terms for the phrase "information superhighway."³

While not expressly conceding this point, applicant does not appear to contest the premise that IWAY is a shorthand term for "information superhighway." However, applicant argues that "the term IWAY (or the phonetic equivalent I-WAY) and even the term 'information superhighway' are sufficiently vague and ambiguous, with multiple recognized definitions that have suggestive connotations with respect to the applicant's goods and services, so that it is not merely descriptive of those goods and services" (brief, p. 4); and that "while consumers viewing applicant's mark would know that applicant's goods and services have something to do with something that has some relation to the information superhighway, but that without more information, they would be hard pressed to articulate the exact subject matter of

³ Some examples include: "Netscape may have won the Internet's first license to print money, but when it comes to actually making the stuff on the I-Way, Yahoo seems to be ahead." [*Fortune*, February 19, 1996]; "... the companies seem to be working together to make Navigator the global I-Way platform." [*PC/Computing*, February 1996]; "Digital moneys, and particularly micropayments, are a key to the Next Generation Internet. In fact, InfoWorld's 1995 Iway Commerce Prize will in January go to a digital moneymen." [*InfoWorld*, January 1, 1996].

applicant's goods and services" (brief, p. 5). Applicant concludes that its mark is, at most, suggestive, noting (brief, p. 6) that its services "deal with information on products, content, business strategies, legal issues, commentary, etc. relating to aspects of the worldwide computer network."

The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986).

Applicant's arguments are not well taken. It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods and services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that

it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

We find it clear from this record that IWAY is a shorthand term for "information superhighway"; that both IWAY and "information superhighway" refer to the Internet; and that applicant's publications regarding "online communication" and its services involving "online access" to such information will pertain expressly to publications about, and services rendered via, the Internet. In this regard, we take judicial notice of the following definitions in *Computer Desktop Encyclopedia* (1998):

IWAY - See information superhighway.

information superhighway - A proposed high-speed communications system that was touted by the Clinton/Gore administration to enhance education in America in the 21st century. Its purpose was to help all citizens regardless of their income level. The Internet was originally cited as a model for this superhighway; however, with the explosion of the World Wide Web, the Internet became the information superhighway whether it was ready for it or not.

Online - Available for immediate use . . . If you use the Internet or an online service, such as AOL or Prodigy, you are online when you have made the connection via modem and logged on with your account number.

Online industry - The collection of service organizations that provide dial-up access to databases, shopping, news, weather, sports, e-mail, etc.

In the present case, it is our view that, when applied to applicant's goods and services, the term IWAY immediately describes, without conjecture or speculation, a significant feature or function of applicant's goods and services. Both the publications identified in International Class 16 and the information and publications accessed in connection with the identified services in International Classes 38 and 42 will pertain expressly to online communication, i.e., communication via the Internet. Further, based on the language of the recitations, the services will be rendered over the Internet. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's goods and services to readily perceive the merely descriptive significance of the term IWAY as it pertains to the identified goods and services.

Decision: The refusal under Section 2(e)(1) of the Act is affirmed.

R. F. Cissel

E. J. Seeherman

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board