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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/**133,584**

Mark B. Harrison of Venable, Baetjer, Howard & Civiletti,
LLP for International Data Group, Inc.

Florentina Blandu, Trademark Examining Attorney, Law Office
110 (Chris Pedersen, Managing Attorney).

Before Cissel, Quinn and Bottorff, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On July 12, 1996, applicant applied to register the
mark "COMPUTERNET" on the Principal Register for what were
subsequently identified by amendment as "magazines,
magazine supplements, catalogues, manuals, brochures,
pamphlets, guides, newsletters, journals and books in the
field of high technology and information technology," in
Class 16; and "providing on-line magazines, magazine
supplements, catalogues, manuals, brochures, pamphlets,

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guides, newsletters, journals, and books in the field of high technology and information technology," in Class 42. The basis for the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce.

The Examining Attorney refused registration under Section 2(e)(1) of the Act on the ground that the term sought to be registered is merely descriptive of the goods and services set forth in the application. The Examining Attorney took the position that the mark applicant seeks to register is descriptive of the subject matter of the publication, in that publications about high technology and information technology include information about computer networks, which are also known as "computer nets."

In support of the refusal to register, the Examining Attorney enclosed copies of definitions from the Dictionary of Computers, Information Processing and Telecommunications, Second Edition, 1987, for the terms "COMPUTER" and "network (NET)." The dictionary definition of "network (NET)" includes "the assembly of equipment through which connections are made between data stations," and makes reference to the term "computer network." The same dictionary defines the term "computer" in reference to

machines that perform substantial computation or logic operations without intervention by a human operator.

Additionally, she attached copies of Office records of three third-party trademark registrations wherein the terms "COMPUTER" and "NETWORK" have either been disclaimed or the marks have been registered under the provisions of Section 2(f) of the Act. The marks are "Computer Network Technology Corporation" and design, for specified computer hardware and software;¹ "Advanced Computer Networks," for the service of maintaining and upgrading computer networks;² and "PHYSICIAN COMPUTER NETWORK," for educational services involving interactive computers.³

Applicant responded to the refusal to register by arguing that "COMPUTERNET" is not merely descriptive of the goods and services set forth in the application. Applicant argued that the mark does not, with any certainty, forthwith convey an immediate idea of the subject matter or any quality, characteristic, function or feature of applicant's goods and services. Further, applicant argued that a review of the Office records indicates that

¹ Registration No. 1,786,572 issued on the Principal Register on August 10, 1993 to Computer Network Technology Corp.

² Registration No. 1,868,604 issued on the Principal Register on December 20, 1994 to Advanced Computer Networks, Inc.

³ Registration No. 1,553,196 issued on the Principal Register under Section 2(f) to Physician Computer Network Inc. on Aug. 22, 1989.

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registrations have issued on the Principal Register, without either claims of distinctiveness or disclaimers, for the marks "DATANET," "STARNET," "PUBNET," and "MULTINET." Copies of information relating to these registrations were submitted, although applicant did not identify the source of the printouts, which appear to be from a computerized search report. Applicant argued that the fact that the terms "DATANET," "STARNET," "PUBNET," and "MULTINET" "do not appear to be synonymous with the terms DATA NETWORK, STAR NETWORK, PUBLIC NETWORK and MULTIPOINT NETWORK, respectively, supports applicant's contention that the term COMPUTERNET would not necessarily be viewed as synonymous with the term COMPUTER NETWORK."

The Examining Attorney was not persuaded, however, and with the second Office Action, she made the refusal to register under Section 2(e)(1) of the Act final. Submitted as additional support for the refusal were copies of Office records of three other third-party registrations of marks for goods and services relating to computers. In each of these registrations, the term "COMPUTER NETWORK" is disclaimed apart for the mark as shown.

Applicant filed a timely Notice of Appeal. Applicant filed its brief and the Examining Attorney filed hers. Attached to the latter were copies of additional computer

dictionary definitions, of which the Board may take judicial notice, of the terms "technology" and "information system." She explained that these references were intended to make clear that "computer nets or computer networks fall within the broad definition of high technology and information technology." (Brief, p. 7).

The test for determining whether a mark is merely descriptive, and hence unregistrable under Section 2(e)(1) of the Act, is not seriously disputed. A mark is merely descriptive if it immediately and forthwith conveys information concerning a characteristic, function, feature, purpose or use of the goods with which it is used. In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979).

In the case at hand, the term sought to be registered is merely descriptive of the goods and services set forth in the application because it immediately conveys information about a characteristic of applicant's printed and on-line publications, i.e., that they include information about computer networks.

The dictionary definition made of record by the Examining Attorney makes it clear that the term "NET" is the equivalent of "NETWORK." We further note that two other dictionaries, of which the Board may take judicial notice, equate the term "NET" with "NETWORK." The

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Computing Dictionary, PC Novice Learning Series, The Illustrated Book of Terms and Technologies, (Peed Corporation, 1996), lists "'net" as "short for network, a system of computers," and "NET" as "short for the Internet, a set of loosely connected networks..." Further, net.speak the internet dictionary, (Hayden Books, 1994) defines "net" as "the domain that includes network resources."

When the word "COMPUTER" is combined with the term "NET," the resulting combination is clearly synonymous with "COMPUTER NETWORK."

The third-party registration information made of record by the Examining Attorney shows that "COMPUTER NETWORK" describes products and services used in connection with computers, so the combination term, "COMPUTERNET" would have the same connotation. The additional dictionary definitions she submitted with her brief establish further that the terms "high technology" and "information technology," used by applicant to describe the subject matter of its publications, are understood to refer to the fields in which computer networks are used.

In summary, this record establishes that "COMPUTERNET," used in connection with publications in the field of high technology and information technology, would

immediately convey to prospective purchasers that the publications include information about computer networks.

Applicant's arguments to the contrary are not persuasive.

The third-party registrations referred to by applicant in response to the first Office Action are not of record. Merely listing such registrations does not accomplish this. In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983). Moreover, even if proper copies of the registrations asserted by applicant had been submitted, they would not establish that the mark at issue in the instant case is not merely descriptive. In the case at hand it is clear, and applicant does not persuasively dispute, that "COMPUTER NETWORK" identifies a topic with which high-technology and information technology publications would be expected to deal. The third-party registrations referred to by applicant combine the descriptive term "NET" with terms like "STAR," "PUB," and "MULTI," the descriptiveness of which has not been established in connection with the goods or services specified in those registrations.

Applicant contends that the mark does not, with any certainty, forthwith convey an immediate idea of the subject matter of the publications because the mark is not the equivalent of the term "computer network," and the

subject of computer networks is not necessarily included within the fields of high technology and information technology. As noted above, however, dictionaries equate the term "NET" with "NETWORK." Moreover, there is nothing incongruous or unexpected created by combining the descriptive terms "COMPUTER" and "NET." As to applicant's contention that the Examining Attorney is in error when she contends that the subject of computer networks might fall within the much broader field of high technology and information technology, the additional dictionary definitions the Examining Attorney submitted with her brief make it clear that computer networks are one aspect which one would expect to be covered by a magazine in the fields of high technology and information technology.

Applicant also argues that "while consumers viewing applicant's mark would know that applicant's print and on-line publications have something to do with something that has some relation to the information revolution resulting from the introduction of computer technology and global networks, without more information, they would be hard pressed to articulate the exact subject matter of applicant's print on-line publications."

The test for descriptiveness, however, is not whether one could, from consideration of the mark alone, determine

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what the goods and services are. Descriptiveness is not determined in such a vacuum. Instead, the test is whether the mark, when viewed in connection with the goods and services set forth in the application, conveys significant information about them. In re Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990).

As discussed above, the mark applicant seeks to register in this case indicates that the subject matter of applicant's publications is computer networks. Accordingly, the mark is merely descriptive of applicant's goods and services, and its registration is barred by Section 2(e)(1) of the Act.

Decision: The refusal to register is affirmed.

R. F. Cissel

T. J. Quinn

C. M. Bottorff
Administrative Trademark Judges,
Trademark Trial & Appeal Board

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