

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re International Data Group, Inc.

Serial No. 74/695,110

Mark B. Harrison of Spencer & Frank for applicant.

David M. Mermelstein, Trademark Examining Attorney, Law
Office 103 (Michael A. Szoke, Managing Attorney).

Before Seeherman, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

International Data Group, Inc. has filed a trademark
application to register the mark WEB COMMERCE EXPO for
"arranging and conducting trade shows and exhibitions
relating to computers, on-line services, high technology,
communications and information services."¹ The application

¹ Serial No. 74/695,110, filed June 29, 1995, in International Class 35,
based on an allegation of a bona fide intention to use the mark in
commerce.

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includes a disclaimer of the words WEB and EXPO apart from the mark as a whole.

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 services.

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

Referring to dictionary definitions of the individual words comprising the mark, the Examining Attorney concludes that WEB COMMERCE EXPO immediately conveys that "applicant is organizing trade shows and exhibitions regarding trade or business on the Web." The Examining Attorney refers also to excerpts both of articles from the LEXIS/NEXIS database and from sites on the Internet's World Wide Web in support of his contention that the phrase "Web commerce" is "well-understood in the relevant industry and by the public at large." Additionally, the Examining Attorney submitted copies of third-party pending applications for trademark registration, contending that "at least two applications have been filed in which applicants themselves have used the term 'Web commerce' to describe their goods or services related to commercial activity on the Web." The Examining

Attorney concludes that the generally understood meaning of the phrase "Web commerce" is consistent with the meaning of that phrase in the context of applicant's mark as used in connection with applicant's goods; and that the addition of the "highly descriptive - if not generic - EXPO" neither adds to nor changes the meaning of the WEB COMMERCE portion of the mark.

Applicant contends that WEB COMMERCE EXPO is "merely suggestive of the wide range of topics covered by applicant's services"; and that it is a "vague and ambiguous [term], with multiple conceivable definitions with suggestive connotations with respect to the applicant's services." Arguing that doubts should be resolved in applicant's favor, applicant contends that "[w]hile consumers viewing Applicant's mark would know that Applicant's services have something to do with something that has some relation to business and the internet, they would, without more information, be hard pressed to articulate the exact subject matter of Applicant's trade show and conference."²

² Subsequent to applicant's submission of its brief, this application was remanded to the Examining Attorney two times for the submission of additional evidence and arguments. Each time, applicant was given an opportunity to supplement its brief, but did not do so. Thus, while applicant briefly discusses the Examining Attorney's evidence, this discussion does not address the evidence subsequently submitted.

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). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods, 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).

The evidence submitted by the Examining Attorney, several examples of which follow, indicates a consistent and voluminous use of the term "Web commerce" to refer to the electronic offering and sale of goods and services via the World Wide Web.

"ActivMedia says we now have more than 249,000 Web marketers out there, up from 94,000 last year. ... In other words, folks, it's happening. **Web commerce** is taking off." [*NetGuide*, July 1, 1997.]

"Outsourcing is likely to become a popular option as more companies come face to face with the complexity - and importance - of integrating **Web commerce** sites into their own back end along with the back-end systems of suppliers. ... Federal Express, for example, made its foray into E-commerce last fall when it announced Business Link, a **Web commerce** offering now known as Virtual Order." [*PC Week*, June 30, 1997.]

"'I can't believe Air France doesn't offer on-line booking,' asserted one **Web commerce**-oriented panelist." [*Business Marketing*, January 1, 1998.]

"... being able to scan objects will lead not only to more inviting home pages, but also to more compelling **Web commerce**, for instance, enabling you to rotate or 'walk around' a 3-D model of a coat or couch ..." [*Computer Shopper*, January, 1998.]

There is no question that the articles indicate numerous likely issues pertaining to doing "Web commerce," such as setting up a Web site for doing business, what software to use, and the economics of such an endeavor. Clearly, applicant's trade shows and exhibitions "relating to computers, on-line services, high technology, communication and information services" are topics pertinent to "Web commerce." In considering the descriptiveness of this phrase in connection with applicant's services, we note that the breadth of the field described by the term "Web

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commerce" does not render this term with a specific connotation suggestive as opposed to merely descriptive. See, *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd*. 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989).

We note the definition of record of the term "expo" as "any exhibition or show" and conclude that, in view of the identification of services, EXPO is merely descriptive, if not generic, in connection therewith. The addition in applicant's mark of the word EXPO to the phrase WEB COMMERCE does not alter the connotation of either word or phrase. In fact, the composite mark, WEB COMMERCE EXPO, when applied to applicant's services, immediately describes, without conjecture or speculation, a significant feature or function of applicant's services, namely, that applicant offers trade shows and exhibitions pertaining to issues relevant to doing business, *i.e.*, selling goods and services, via the World Wide Web. 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 services to readily perceive the merely descriptive significance of WEB COMMERCE EXPO as it pertains to applicant's services.

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

E. J. Seeherman

P. T. Hairston

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