

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB 10/5/99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re *Wildfire Communications, Inc.*

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Serial No. 74/715,185

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Michael J. Bevilacqua of Hale and Dorr for *Wildfire Communications, Inc.*

Dominic J. Ferraiuolo, Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw, Managing Attorney)

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Before Hanak, Walters and Chapman, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Wildfire Communications, Inc. (applicant) seeks to register VIRTUAL INTERCOM in typed drawing form for "computer programs for implementing a computer based messaging system by opening a communications channel to a remote party based upon a spoken command." The intent-to-use application was filed on August 14, 1995. Applicant

disclaimed the exclusive right to use the word VIRTUAL apart from the mark in its entirety.

The Examining Attorney refused registration pursuant to Section 2(e)(1) of the Trademark Act on the basis that applicant's mark, as applied to applicant's goods, is merely descriptive. When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

A review of the history of this case is in order. Initially, applicant's goods were described simply as follows: "Computer programs for implementing a computer based messaging system." In response, the Examining Attorney made of record definitions of the word "intercom" taken from Webster's New Riverside University Dictionary (1984) and Newton's Telecom Dictionary (7<sup>th</sup> ed. 1994). The first dictionary defined the word "intercom" as "an intercommunication system, as between two rooms." The second dictionary defined the word "intercom" as follows:

An internal communication system which allows you to dial another phone in your building, office complex, factory or home. There are three types of intercom: 1. Dial: It allows you to dial or pushbutton another extension; 2. Automatic: One phone goes off hook and automatically dials another; and 3. Manual: The user can manually signal

another phone by pushing a button for that phone. An example is a buzzer between a boss and a secretary.

In its brief, applicant argued that its trademark was not merely descriptive because its "trademark is not used on intercoms, nor on computer programs that act as or set up intercoms or intercom-like systems." (Applicant's brief page 3).

In response, the Examining Attorney argued in his brief that the mere descriptiveness of a term is not judged "in the abstract," but rather is judged "in relation to the identified goods." (Examining Attorney's brief page 3). In this regard, the Examining Attorney cited In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). The Examining Attorney then argued, correctly, that applicant's chosen description of goods -- computer programs for implementing a computer based messaging system -- was broad enough to encompass an intercom, that is, an internal communication system.

Subsequently, applicant requested that this Board suspend the appeal; remand the case to the Examining Attorney; and allow applicant amend its description of goods. This request was granted by the Board in an order dated January 28, 1999.

An office action dated February 26, 1991, the Examining Attorney accepted applicant's amended description of goods, which, as previously noted, reads as follows: "Computer programs for implementing a computer based messaging system by opening a communications channels to a remote party based upon a spoken command." (emphasis added). However, in this office action, the Examining Attorney, without any explanation whatsoever, still maintained that applicant's mark VIRTUAL INTERCOM was merely descriptive of applicant's described goods. In particular, the Examining Attorney never discussed the fact that the very definitions of the word "intercom" submitted by the Examining Attorney referred to an internal communication system, whereas now applicant's amended description of goods made it clear that applicant's goods were an external, "remote" communication system.

As previously noted, the Examining Attorney was entirely correct that the mere descriptiveness of a term is not to be judged in the abstract, but rather is to be judged in terms of the goods as identified. As presently identified, applicant's mark VIRTUAL INTERCOM is simply not descriptive of an intercom (i.e. an internal communication system) because applicant's computer messaging system is

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now limited to a system that allows or provides contact with a remote party.

Moreover, to the extent there are any doubts on the issue of mere descriptiveness, it is the long standing practice of this Board to resolve such doubts in applicant's favor. In re Gourmet Bakers Inc., 173 USPQ 565 (TTAB 1972).

Decision: The refusal to register is reversed.

E. W. Hanak

C. E. Walters

B. A. Chapman  
Administrative Trademark  
Judges, Trademark Trial and  
Appeal Board