

Paper No. 11

HRW

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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re c/net, inc.

Serial No. 75/061,139

John C. Nishi of Wilson Sonsini Goodrich & Rosati
for c/net, inc.

Gary R. Thayer, Trademark Examining Attorney, Law Office
103 (Michael A. Szoke, Managing Attorney).

Before Hanak, Hohein and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

c/net, inc.¹ has filed an application to register the
mark DOWNLOAD EXPRESS for "computer services, namely,

¹ Applicant has indicated in its brief that its name has been changed to CNET, Inc. No evidence of the name change has been provided to the Board, however, nor has the change been recorded with the Assignment Branch of the Patent and Trademark Office. Until such evidence is made of record, applicant's name will remain as initially set forth in the application. If applicant has not done so in the interim, the change of name documents should be forwarded promptly to the Assignment Branch to ensure

providing on-line engines for searching or browsing electronic communications networks; providing software featuring a wide variety of general interest educational and entertainment subject matter that may be downloaded from electronic communications networks."²

Registration has been finally refused on the ground that the mark DOWNLOAD EXPRESS is merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act.³ Applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

The Examining Attorney maintains that the mark DOWNLOAD EXPRESS immediately conveys information with respect to a central and desirable feature of applicant's services, namely, that one may "download" software or other

that any registration would issue in the proper name. See Trademark Rule 3.85.

² Ser. No. 75/061,139, filed Feb. 22, 1996, based on a bona fide intention to use the mark in commerce. A disclaimer of the word DOWNLOAD has been made of record.

³ The Examining Attorney has also made final the requirement that the identification of services be amended to indicate that applicant's services were more accurately described as "content" provision than "access" provision. In its brief, applicant submitted a proposed amendment of the identification of services, for consideration if the Board reversed the refusal under Section 2(e)(1). The Examining Attorney, in his brief, states that although applicant's proffer was made contingent upon the outcome of the appeal, the Examining Attorney stipulates to the acceptability of the identification as proffered and assumes it to be operative for purposes of this appeal. Accordingly, the application is deemed to have been so amended, as indicated above.

information in an "express", or in other words, speedy and efficient, fashion. Inasmuch as applicant has already disclaimed the word DOWNLOAD, the Examining Attorney has directed his arguments to the descriptiveness of the word EXPRESS as used in connection with applicant's services.

In support of his interpretation of the term "express" as a reference to the speed or efficiency with which applicant's download services are provided, the Examining Attorney has submitted definitions for the adjective "express" listed in Webster's Third New International Dictionary,⁴ relying in particular upon the following:

3a: dispatched with or traveling at special or high speed; *specif*: traveling between terminal or specified points without stop or with a limited number of stops (an ~ train)(an ~ bus)(an ~ elevator) -- compare LOCAL
b: adapted or suitable for or characterized by travel at special or high speed (an ~ highway); *also*: specially fast (traveling at ~ speed).

In addition, the Examining Attorney has made of record several third-party registrations encompassing a variety of services in which the term "express" has been disclaimed when used in contexts in which the term "appears to refer to desirable characteristics such as the speed, efficiency, and the like, of rendering such services." (Brief, p. 2).

⁴ In view of the fact that the Board may take judicial notice of dictionary definitions, we have considered the definitions, although not introduced by the Examining Attorney until his brief.

The Examining Attorney contends that applicant does not dispute that the "speed and convenience with which customers can access software" is a central feature of its services, citing applicant's statement in its brief that "the term 'express' ... is suggestive of the speed and convenience with which customers can access software." (Applicant's brief, pp.5-6). The Examining Attorney argues, however, that the term "express" is more than "suggestive," in that it is merely descriptive of this most desirable and central characteristic of applicant's services.

Applicant contends that the Examining Attorney has failed to meet his burden of proof with respect to the mere descriptiveness of the mark DOWNLOAD EXPRESS, as a whole. Applicant points to the fact that the Examining Attorney has made no evidence of record of competitors' descriptive use of the term or, in fact, of any third-party use of either "download express" or "express download." Thus, applicant likens the situation here to that in *In re Wells Fargo & Co. (Wells Fargo III)*, 231 USPQ 116 (TTAB 1986), where the Board based its reversal of the refusal to register EXPRESS SAVINGS for banking services under Section

2(e)(1), at least in part, on the lack of evidence of descriptive use of the term by others in the field.

Applicant further argues that the third-party registrations cited by the Examining Attorney, in which the term "express" has been disclaimed, cannot be considered determinative of the issue of descriptiveness. In the first place, according to applicant, we are without any indication as to the reason for a particular registrant's disclaimer of the term, whether it was made upon a determination of descriptiveness or upon a decision not to argue against the requirement for disclaimer in order to expedite issuance of the registration. Second, applicant has cited several third-party registrations in its response to the first Office action, and some additional registrations in its brief, in which the term "express" was not disclaimed. Applicant argues that these registrations should be given more weight, as an indication that the term "express" is not descriptive.⁵

⁵ The Examining Attorney, in his brief, strongly objected to the third-party registrations referred to by applicant, on the basis that none of the registrations had been properly made of record. Previously, the Examining Attorney did not treat the registrations as of record and made no reference to them in his arguments. Applicant, in its reply, notes that the Examining Attorney did not make this objection until his brief and thus applicant had no opportunity to perfect the record by submitting proper copies. Furthermore, applicant notes that the Examining Attorney in his final refusal responded to applicant's citation by introducing third-party registrations in which "express" had

Finally, applicant argues that by its allusion to a transportation metaphor, either a train or a nonstop trip, the mark DOWNLOAD EXPRESS is only suggestive of high speed delivery of software, such as that provided by applicant. By contrast, argues applicant, if its mark were in the inverted form EXPRESS DOWNLOAD, this allusion would be less and the potential for descriptiveness would be greater.

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic, use, function, or feature of the goods or services with which it is being used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Bright-Crest Ltd.*, 204 USPQ 591 (TTAB 1979). Moreover, the immediate idea must be conveyed with some "degree of particularity." *In re Entenmann's Inc.*, 15 USPQ2d 1750, 1751 (TTAB 1990), *aff'd* 90-1495 (Fed. Cir. Feb. 13, 1991); *In re TMS Corporation of the Americas*, 200 USPQ 57, 59 (TTAB 1987).

been disclaimed. We agree with applicant that by the introduction of registrations in rebuttal to applicant's cited registrations, and by the failure to object to applicant's registrations in the final refusal, the Examining Attorney waived any right to later object to applicant's evidence. Accordingly, we have taken the third-party registrations cited by applicant in its first response, but not the ones cited only in its brief, into consideration, with the probative weight to be accorded to them to be discussed *infra*.

In applying these basic principles to the case at hand, we have found it helpful to review the Wells Fargo III case cited by applicant, and its related cases, *In re Wells Fargo & Company (Wells Fargo I)*, 231 USPQ 95 (TTAB 1986) and *In re Wells Fargo & Company (Wells Fargo II)*, 231 USPQ 106 (TTAB 1986). In Wells Fargo I, the Board held the mark EXPRESSSERVICE merely descriptive of banking services, partially on the basis of the dictionary definition of "express", but more particularly because of other evidentiary material, including a study conducted by the applicant showing that the public would associate the term "Express Banking" with fast, efficient banking service or a fast delivery mode, i.e., "express service", and Nexis evidence showing at least a few references to "express service" in contexts descriptive of banking services. The Board found that applicant's study clearly demonstrated that consumers would extract the speed characteristic from the transportation meaning of "express" and apply that characteristic to banking. In Wells Fargo II, the Board relied even more heavily upon this study to affirm the refusal of the mark EXPRESS BANKING for banking services under Section 2(e)(1), the Nexis evidence submitted in this case being found not very useful as corroborative evidence. In Wells Fargo III, however, the tables were turned. There

the mark involved was EXPRESS SAVINGS for banking services. The Examining Attorney relied only upon the dictionary definition and the manner in which the mark was used on the specimens. There was no evidence produced of descriptive use by others in the banking field of the term "Express Savings." The Board found this to be an insufficient record to affirm the refusal under Section 2(e)(1), particularly in view of the fact that the relationship of the term "express" to "savings" is rather incongruous since the accumulation of savings is in general a slow process.

Here, as in Wells Fargo III, we are similarly faced with a small evidentiary record. We have the dictionary definition of "express", but no evidence of descriptive use by others in the field of the term "express" in connection with the downloading of software. If "express" were clearly descriptive of downloading services such as applicant's, it would seem that it would have been used at least occasionally by others with respect to these services. See In re Stroh Brewery Co., 34 USPQ2d 1796 (TTAB 1994). Nor has the Examining Attorney introduced any evidence that applicant's downloading of software is a new or unique service, such that there would have been no reason for prior use of the phrase "download express" by others. Thus, we do not consider this to be a situation

where dictionary definitions alone are sufficient to render obvious the descriptiveness of the phrase as applied to the service. Cf. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) [dictionary definitions sufficient to establish that compound term SCREENWIPE immediately and unequivocally describes the function and nature of a cloth for cleaning computer and television screens].

While the Examining Attorney has submitted several third-party registrations containing disclaimers of the term "Express", we do not find these registrations to be of much probative value here. As the Board noted in the Wells Fargo cases with respect to third party registrations, and as applicant has argued here, there is nothing of record to indicate the basis on which the other registrations were issued with disclaimers of the term. Furthermore, although disclaimers may be construed as evidence, albeit not conclusive, of descriptiveness of a term,⁶ the registrations must involve disclaimers of the term in connection with similar goods or services. See *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172 (TTAB 1987) [third-party registrations may show that a term has descriptive

⁶ See *Sweats Fashions Inc. v. Pannill Knitting Co., Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

significance as applied to certain goods or services]. Of the third-party registrations submitted by the Examining Attorney, only a few are directed to on-line computer services. The majority are directed to mail order services, delivery services and the like. The registrations cited by applicant similarly cover a broad range of services. Thus, we find these registration to be of little probative value in determining whether the mark DOWNLOAD EXPRESS is merely descriptive of applicant's specific services.

Accordingly, on the record before us, we find insufficient evidence to hold the mark DOWNLOAD EXPRESS, as a whole, merely descriptive when used in connection with applicant's services. While our decision is not entirely without doubt, we consider it appropriate to resolve this doubt in the favor of applicant, since any person who believes he would be damaged by the registration of the mark will have the opportunity to file an opposition thereto. See *In re Merrill Lynch, Pierce, Fenner, and Smith inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

Decision: The refusal to register under Section 2(e)(1) is reversed.⁷

E. W. Hanak

G. D. Hohein

H. R. Wendel
Trademark Administrative Judges,
Trademark Trial and Appeal Board

⁷ The amendment to the identification of the services proffered by applicant in its brief will be entered prior to publication.