

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JULY 29, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Ziff Davis Publishing Company**

Serial No. 75/193,204

James E. Rosini and Karen L. Feisthamel of Kenyon & Kenyon
for applicant.

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

Before Cissel, Quinn and Hairston, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Ziff Davis Publishing
Company¹ to register the mark GAME BUYER for "dissemination
of advertising for others via an online electronic
communications network" (in International Class 35) and
"providing multiple user access to a global computer

¹ Applicant states that its name was changed in May 1998. To
date, the change of name documents have not been recorded in the
Office.

information network for the transfer and dissemination of a wide range of information and information in the field of computer related products and technology; providing a wide range of information and information in the field of computer related products and technology via computer information networks" (in International Class 42).²

The Trademark Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark, if used in connection with applicant's services, would be merely descriptive of them.

When the refusal was made final, applicant appealed.³ Applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

² Application Serial No. 75/193,204, filed October 8, 1996, based on a bona fide intention to use the mark in commerce.

³ In the final refusal dated October 30, 1997, the Examining Attorney raised, for the first time, an alternative refusal based on deceptive misdescriptiveness. Applicant, in a request for reconsideration, correctly noted that making this alternative refusal final was premature. TMEP §1105.04(e). The Examining Attorney, in denying the request for reconsideration, failed to address applicant's correct view that the final refusal was premature. Applicant, in its appeal brief, reiterated its view that the final refusal was premature, but went on to argue the merits of the deceptively misdescriptive refusal. The Examining Attorney, in his appeal brief, relegated to a footnote his discussion of the merits of a deceptively misdescriptive refusal, with no mention made in response to applicant's view that the final refusal was premature.

Applicant contends that the proposed mark is just suggestive and does not immediately convey any information about the services. More specifically, applicant claims that "GAME BUYER is suggestive of an agent that provides information pertaining to computer products to an interested customer." Applicant has relied upon dictionary definitions of the words "game" and "buyer," and a list of third-party registrations which, according to applicant, show the Office's "policy of treating marks incorporating the word BUYER as being registrable on the Principal Register without a showing of acquired distinctiveness."⁴

The Examining Attorney maintains that the mark merely describes the target audience of applicant's services, namely game buyers, and/or describes the information content of the services, that is, information about, directed to or of interest to computer game buyers. In particular, the Examining Attorney points to applicant's statement that "[w]hile arguably the audience may include individuals that will ultimately purchase computer related

Inasmuch as the alternative final refusal based on deceptive misdescriptiveness under Section 2(e)(1) was premature, no consideration will be given to this refusal.

⁴ Mere listings of third-party registrations generally are not sufficient to make the registrations of record; copies of the registrations themselves are required for that purpose. The Examining Attorney, however, has not objected to this evidence, and so we have considered it in making our decision.

products or services, this is not the sole focus of the services." In support of the refusal, the Examining Attorney has furnished excerpts retrieved from the NEXIS database, and has relied on dictionary definitions of the two words in applicant's mark.⁵

It is well settled that a term is considered to be merely descriptive of goods and/or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods and/or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods and/or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods and/or services for which registration is sought. In re Bright-Crest, Ltd., 204 USPQ

⁵ The dictionary definitions, which accompanied the brief, are proper subject matter for judicial notice.

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591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

The term "game" means "the material or equipment used in playing certain games" and the term "buyer" means "purchaser; a person who buys."

The Nexis evidence shows the following uses:

Venture Communications List Marketing Inc. has the 35,929-name list of computer game buyers from Starplay Productions.
DM News, June 2, 1997

...topped computer-game buyers' shopping lists last year.
The Seattle Times, November 24, 1996

...and Computer Gaming World, which caters to the volume game buyer with in-depth reviews that give gamers a real feel for the latest games.
M2 Presswire, February 14, 1996

For the predominantly school-going crowd of computer game buyers, saving 50 percent is simply too good to pass up.
WorldPaper, April 1995

The average computer game buyer...
The Plain Dealer, April 23, 1995

Some 4,500 game buyers were polled for the survey.
The Boston Globe, February 17, 1995

In the present case, it is our view that, if applied to applicant's services, the term GAME BUYER would immediately describe, without conjecture or speculation, a significant characteristic or feature of the services, namely, that they involve advertisements and on-line information targeting buyers of computer games, i.e., game buyers. Prospective purchasers, upon confronting the term GAME BUYER for applicant's services, would immediately perceive that the services impart information about or for game buyers. See: In re Shiva Corp., 48 USPQ2d 1957 (TTAB 1998) [term TARIFF MANAGEMENT held merely descriptive of key feature of function of "computer programs to control, reduce and render more efficient wide area network (WAN) usage" by finding lowest tariff or cost for telephone calls]. See also: Reese Publishing Co. v. Hampton International Communications, Inc., 620 F.2d 7, 205 USPQ 585 (2d Cir. 1980) [term VIDEO BUYER'S GUIDE found to be generic when applied to magazines aimed at the home market for television products].

The list of third-party registrations is of little help in determining the registrability of the mark at issue in this case. As often noted by the Board, each case must be decided on its own set of facts, and we are not privy to the facts involved with these registrations. While uniform

treatment under the Trademark Act is highly desirable, our task here is to determine, based upon the record before us, whether applicant's mark is registrable.

Lastly, applicant essentially contends that the nature of the mark mandates reversal of the refusal. More specifically, applicant asserts that "the provision of information on-line should be treated similarly to marks which are the titles of printed publications." This argument is not persuasive, except to the extent that on-line information services, like periodicals, depend principally on their marks or titles to convey their character. Thus, it strains credulity to believe that a significant feature of applicant's services would not involve dissemination of information of particular interest to game buyers. Further, we would point out that "the courts and this Board have recognized that titles of publications are not considered any differently from trademarks for other products; in these cases 'we apply a test as close as possible to the tests of descriptiveness or validity applied to a mark used for any goods or services.'" In re Waverly Inc., 27 USPQ2d 1620, 1622 (TTAB 1993), citing In re Gracious Lady Service, Inc., 175 USPQ 380, 381 (TTAB 1972).

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We find that applicant's mark is merely descriptive as contemplated by Section 2(e)(1) of the Act.

Decision: The refusal to register is affirmed.

R. F. Cissel

T. J. Quinn

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

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