

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

OCT. 27,99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re America Online, Inc.

Serial No. 75/280,610

Jeffrey S. Standley of Standley & Gilcrest for applicant.

Kelly L. Williams, Trademark Examining Attorney, Law Office
115 (Tomas Vlcek, Managing Attorney).

Before Cissel, Walters and Wendel, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

CompuServe Incorporated filed a trademark application,
which has been assigned to America Online, Inc.,¹ to
register the mark VIRTUAL KEY for "computer services,
namely, computer programming for on-line information
services and global computer information network
communications; computer consultation services for on-line

¹ While Section 10 of the Trademark Act, 15 U.S.C. 1060, permits
assignment of intent-to-use applications only under limited
circumstances, the propriety of this assignment is not before us.

information services and global computer information network communications; designing and updating computer security software for on-line and global computer information network communications; monitoring security systems for on-line information services and global computer information network communications."²

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 in connection with its services.³

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

The Examining Attorney submitted excerpts from the *Random House Personal Computer Dictionary* (2nd ed. 1996) defining "virtual" as "not real ... [and] is popular among computer scientists and is used in a wide variety of

² Serial No. 75/280,610, in International Class 42, filed April 24, 1997, based on an allegation of a bona fide intention to use the mark in commerce.

³ The final refusal to register also included a requirement to amend the identification of services. Applicant complied with the requirement in a request for reconsideration. The request for reconsideration was filed in a timely manner, but it was associated with this application file only after the filing of the briefs in this appeal. The Board did not remand the application to the Examining Attorney to expressly respond to the request for reconsideration because both briefs adopt the identification of services as amended in the request for reconsideration. Thus, we consider the amendment to be accepted and the issue on appeal limited to the refusal under Section 2(e)(1).

situations ... it distinguishes something that is merely conceptual from something that has physical reality" and "key" as "a password or table needed to decipher encoded data." The Examining Attorney contends that, rather than creating a unique phrase with a non-descriptive meaning that is different from the meaning of the individual terms, the combination of the two terms, VIRTUAL KEY, "merely describes a feature of the applicant's computer programming, computer security software, and security systems services as including conceptual passwords to decipher encoded data." The Examining Attorney submitted copies of three articles from the LEXIS/NEXIS database in support of her position.

Applicant admits that the term "virtual" is commonly used in the computer industry, but contends that there is no evidence in the record that when "virtual" is combined with "key" the combination merely describes the enumerated services.⁴ Rather, applicant contends that the mark is suggestive of its services.

The test for determining whether a mark is merely descriptive is whether the involved term immediately

⁴ In support of its argument, applicant cited a non-precedential decision of the Board and did not submit a copy of the decision. As noted by the Examining Attorney, the Board does not take notice of such

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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 before us consists only of two dictionary definitions and copies of three articles from the LEXIS/NEXIS database. While the Examining Attorney's search report indicates that a NEXIS search for "virtual key" and "computer" or "software" revealed 69 articles, she entered only three of those articles in this record and there is no indication that these three articles are a

decisions and we have not considered this decision as it is described

representative sample. It is not necessary for the Examining Attorney to submit all of the stories found in her search of the NEXIS/LEXIS database; however, she must submit a sufficient number of them to enable the Board to determine the meaning of the term in question to the relevant public. We must presume that the excerpts selected for submission provide the best, if not the only, support of the refusal to register available from that source. *See, In re Homes & Land Publishing Corp.*, 24 USPQ2d 1717 (TTAB 1992), and cases cited therein.

Further, of the three articles submitted, one of the articles is from a United Kingdom publication and pertains to business in the United Kingdom. We have no evidence concerning the possible circulation of that publication in the United States from which to infer its possible impact on the perceptions of the relevant public in this country. *See, In re Men's International Professional Tennis Council*, 1 USPQ2d 1917 (TTAB 1986). Another of the articles is from a wire service, thus, the extent to which this information was available to the general public is unknown. A proprietary newswire article is circulated primarily to newspapers and news journals whose editors select from the releases those stories of sufficient interest to publish.

by applicant.

The article's appearance in the NEXIS database does not prove that the news release appeared as a story in any newspaper or magazine. This story is evidence that the author used the phrase "virtual key" in a certain manner and that editors were exposed to such use. However, we cannot conclude that the public was exposed to the story. *See, In re Men's International Professional Tennis Council, supra.*

The third article submitted is relevant⁵ and includes the following use of the phrase "virtual keys": "The CA [certification authority] is an entity or service that distributes electronic keys for encrypting information and electronic certificates for authenticating user and server identities. The CA also issues new passwords, or 'virtual keys,' when a password is forgotten or misplaced." This reference, however, does not persuade us to conclude that the relevant public understands the phrase VIRTUAL KEY as a reference to computer services of the type described herein. While the use of "virtual keys" in this article is not inconsistent with the connotation asserted by the Examining Attorney, it is the only such reference and,

⁵ This article is from the September, 1996, edition of *Health Management Technology*.

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therefore, it does not convince us that this term is widely understood to have this meaning.

Based on this meager example, we cannot reach the conclusion argued by the Examining Attorney, namely, that "these stories demonstrate that the phrase 'virtual key' is used in the computer industry to refer to a conceptual password used to unlock, to access or to decipher encoded data." The most we can conclude from this record is that VIRTUAL KEY is suggestive in connection with the identified services. Thus, we find that the phrase VIRTUAL KEY is not merely descriptive in connection therewith. It requires some, albeit minimal, thought to determine the nature of applicant's services or at least a feature of those services.

We readily admit that our determination on this issue is not free from doubt. However, where there is doubt on the question of mere descriptiveness, that doubt is to be resolved in applicant's behalf and the mark should be published for opposition. See, *In re Rank Organization Ltd.*, 222 USPQ 324, 326 (TTAB 1984) and cases cited therein.

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

R. F. Cissel

C. E. Walters

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