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Paper No. 25

HRW

10/13/00

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Brand Institute, Inc.

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Serial No. 74/656,196

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Jay H. Begler of Buchanan Ingersoll PC for Brand Institute, Inc.

Hannah Fisher, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

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Before Hanak, Wendel and Holtzman, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Brand Institute, Inc. has filed an application to register the mark BRANDSEARCH for "trademark screening services."<sup>1</sup>

Registration has been finally refused on the ground that the mark is merely descriptive under Section 2(e)(1) of the Trademark Act. Applicant and the Examining Attorney

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<sup>1</sup> Serial No. 74/656,196, filed April 5, 1995, based on an allegation of a bona fide intention to use the mark in commerce.

have filed briefs. An oral hearing was scheduled several times but finally waived by applicant.

The Examining Attorney maintains that the designation BRANDSEARCH merely describes the subject matter and nature of applicant's trademark screening services. As support for her position, the Examining Attorney has made of record a listing in *Roget's International Thesaurus* showing use of the term "brand" as a synonym for "mark," an entry from the Office information directory showing that the areas in the Office for screening or examining existing trademarks and patents are called "search" facilities, and several Nexis excerpts showing third-party use of the term "brand search" in a generic manner. In her brief, she referred additionally to dictionary definitions for "brand" as "a trademark or distinctive name identifying a product..." and for "search" as "to look over carefully in order to find something."<sup>2</sup>

Applicant argues that the phrase BRANDSEARCH is the coupling of two ordinary words which, although suggestive, does not merely describe or convey the essence of applicant's services. Applicant insists that the consumer,

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<sup>2</sup> Inasmuch as we may take judicial notice of dictionary definitions, we have considered these definitions, even though not earlier made of record by the Examining Attorney.

upon seeing the mark BRANDSEARCH would not know exactly what applicant's services consist of without further description; that imagination would be required to reach a conclusion as to the nature of applicant's services. Applicant further argues that competitors will be fully able to describe their services without the use of the term BRANDSEARCH and that in fact applicant cannot preempt others from using either "brand" or "search" per se.

A term or phrase is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic or feature of the goods or services with which it is being used. Whether or not a particular term is merely descriptive is not determined in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the designation is being used, and the significance the designation is likely to have, because of the manner in which it is used, to the average purchaser as he encounters the goods or services bearing the designation. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

We find the evidence made of record by the Examining Attorney fully adequate to establish that the designation BRANDSEARCH is merely descriptive of the trademark

screening services of applicant. Both the thesaurus reference and the dictionary definition show the equivalence of the terms "brand" and "trademark." The Office information directory demonstrates use of the term "search" in reference to the review of trademark records, i. e. the Trademark Search Branch. Even if potential purchasers of applicant's services are not aware of this use of the term "search" in the trademark vernacular, we believe the descriptive significance of the term in its ordinary dictionary meaning would be readily apparent, when used in connection with a screening process which would necessarily involve the review and examination of existing trademarks.<sup>3</sup> We fail to see where any mental gymnastics or even imagination would be required in order to make an association between the designation BRANDSEARCH and the services which applicant intends to offer under this designation. The many cases cited by applicant involving suggestive marks are irrelevant to our determination to the descriptiveness of this particular designation when used with these particular services.

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<sup>3</sup> We take judicial notice of the following definitions found in *Webster's Third New International Dictionary* (1993)

screen      4 b(1) to examine usu. methodically in order  
                    to make a separation into different groups;  
                    (3) to select by a screening process;  
                    (4) to eliminate by or as if by a screening  
                    process.

Moreover, as has frequently been pointed out by the Board and our reviewing court, the descriptiveness of a mark is not determined in the abstract, but rather as used in connection with the particular services at issue. The question is not what the significance of the designation BRANDSEARCH is per se, but what the significance is when used in connection with a trademark screening (brand searching) operation. The descriptiveness is obvious. Furthermore, the mere joinder of the two words "brand" and "search" is clearly insufficient to avoid the proscription of Section 2(e)(1), so long as the combined term is likely to be perceived by purchasers as the equivalent of the separate terms, as is the case here. See *In re State Chemical Manufacturing Co.*, 225 USPQ 687 (TTAB 1985) and the cases cited therein.

Although applicant argues that competitors will be adequately able to describe their similar services by using other terms, this does not overcome the fact that BRANDSEARCH is a descriptive designation which should be available for all to use, in the absence of any showing of acquired distinctiveness. Although it is unclear from the severely excerpted Nexis articles made of record by the Examining Attorney as to the exact manner of use of the phrase "brand search" in these articles, it is at least

**Ser No.** 74/656,196

evident that the phrase is a recognized term in the field of trademarks. As such, it should be available for use by all in any manner which is descriptive, which obviously would not be the case if applicant were permitted to register the joined term BRANDSEARCH.

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

E. W. Hanak

H. R. Wendel

T. E. Holtzman

Administrative Trademark Judges,  
Trademark Trial and Appeal Board

**Ser No.** 74/656,196