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Paper No. 26
HRW

11/27/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SpanLink Communications

Serial No. 75/023,266

Richard A. Arrett of Vidas, Arrett & Steinkraus, P.A.
for SpanLink Communications.

Mark Sparacino, Trademark Examining Attorney, Law Office
103 (Michael Szoke, Managing Attorney).

Before Cissel, Hohein and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Spanlink Communications has filed an application to
register the mark WEBCALL for a "computer program for
allowing users of global computer information network sites
to leave a message requesting telephone contact."¹

¹ Serial No. 75/023,266, filed November 22, 1995, based on an
allegation of a bona fide intention to use the mark in commerce.
An amendment to allege use was filed March 14, 1997, setting
forth a first use date and first use in commerce date of June 24,
1996.

Registration has been finally refused on the ground that the mark is merely descriptive under Section 2(e)(1) of the Trademark Act.² The refusal was appealed and both applicant and the Examining Attorney have filed briefs.³ An oral hearing was not requested.

The Examining Attorney maintains that the proposed mark WEBCALL is merely descriptive of the purpose or use of applicant's software. He points out that the software, as identified, allows users of global information network sites to leave a message requesting "telephone contact." He then goes on to argue that this phrase "telephone contact" may refer to either contact by a traditional telephone or "contact via an internet phone using an internet telephony system." (Brief p. 3) He cites the

² Concurrent with the filing of its amendment to allege use and in response to the first final refusal issued by the Examining Attorney, applicant filed a "declaration showing distinctiveness under 37 CFR 2.41" in support of its claim that its mark WEBCALL had become distinctive of its goods. The Examining Attorney refused to accept the claim, stating that applicant had failed to properly amend its application to set forth a claim of distinctiveness under Section 2(f). The Examining Attorney also stated that the evidence which had been submitted by applicant was insufficient to support such a claim. In applicant's subsequent responses and its brief, no mention was made of a claim under Section 2(f). Accordingly, the Examining Attorney has found no need to address the issue in his brief. We consider any claim of distinctiveness to have been withdrawn.

³ After applicant filed its initial brief, the application was remanded to the newly-assigned Examining Attorney for purposes of supplementing the record with recently available evidence. When the refusal was again made final, applicant was allowed to file a supplemental brief and the Examining Attorney then submitted his brief.

Nexis article from *Computer Telephony* (December 1996), which he made of record in his action of April 8, 1999, for its description of applicant's software as that which would in fact include both regular telephone call back and Internet phone callback. In relevant part, the article reads:

Spanlink ... demonstrated on stage how their Web-Call product links web browsers to agents, either via phone or Internet phone, just by a customer clicking a button on a company's web page labeled 'Talk to a Real Person.' On the other end, an agent gets a mirrored pop.

When a web-based customer elects to call up a Web-Call form and fills out a form to request a callback, the customer sees an approximate callback time for the appropriate agent group. The customer then chooses to communicate via either an Internet phone or telephone.

...

The WebCall agent form shows the information the customer provided, pages visited, and the customer's choice for phone or Internet phone callback. When the agent is ready, WebCall automatically calls back the customer. ...

This being the case, the Examining Attorney argues that WEBCALL is merely descriptive of applicant's software, because, as identified, the product encompasses return telephone contact via an Internet phone. He maintains that the term "web call" is descriptive in general as applied to a telephone call via the Internet. Moreover, as he points out, applicant has specifically stated that "[i]f Applicant's goods description were directed to an internet telephony system (i.e., a system in which direct person-to-

person voice communications occurs over the internet), descriptiveness would be conceded." (Supplemental Brief, p. 3).⁴ Although applicant followed this statement with the assertion that its goods, as identified, are not directed to an Internet telephony system, the Examining Attorney contends that not only would the identification of goods, as worded, encompass "telephone contact" of this nature, but also that the cited Nexis article demonstrates that applicant's software is intended to cover callback and further communication over Internet phone or, in other words, contact using an Internet telephony system.

In addition, the Examining Attorney has made of record Nexis excerpts showing use of the term "web call" in reference to Internet telephone calls, and in particular Internet telephone calls directed to a call center, such as the following:

... The ICC software allows users to browse a Web page and talk to a call center agent simultaneously, over a single analog phone line. Costs for the software and installation range from about \$120,000 for 20 concurrent Web calls to \$190,000 for 60 concurrent calls. *Sales & Marketing Management* (Sept. 1998);

⁴ As noted by the Examining Attorney, applicant earlier stated in its response of October 12, 1999, that "there is quite a bit of software on the market that allows a person to actually place a phone call through the internet. As to this type of application, the term WEBCALL would be merely descriptive, because it would describe a function of the product, i.e., make a phone call using the internet."

Internet telephony programs and links to service bureaus are combining to offer a new opportunity to Web site operators. For those users with the right bandwidth and software, a single click can put a live operator onto a Web call, offering the benefits of a real sales experience. *Computer Economic Research and Analysis* (January 1998).

As previously noted, applicant strongly denies any connection of its software with Internet telephony. Applicant argues that its mark WEBCALL is used in connection with software which allows a user of a global computer information network site to e-mail a call center, leaving a non-voice message which is used by a service representative to telephone the user back "using the plain old telephone system."⁵ (Reply brief, p. 1) Applicant insists that the Examining Attorney is incorrectly attributing to applicant's software the feature of permitting a person to actually telephone and speak to a person to request a return telephone call. Applicant argues that not only is its software not directed to an

⁵ Applicant, in its reply brief, has requested that if the Board finds the present identification does not make it clear that the message is left by e-mail and not direct voice contact, the identification be amended to read: computer program for allowing users of global computer information network sites to e-mail a non-voice message requesting telephone contact.

In the first place, the proffered amendment is untimely and hence will not be considered. Furthermore, the clarification which applicant seeks to make has no effect on the scope of the term "telephone contact," which is the basis for the Examining Attorney's refusal under Section 2(e)(1). Thus, the proffered amendment is immaterial with respect to the present refusal.

Internet telephony system, it is not even limited in the identification of goods to usage on the Internet or World Wide Web.

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 with which it is being used. Whether or not a particular term is merely descriptive is determined not in the abstract, but rather in relation to the goods for which registration is sought, the context in which the mark is being used, and the significance the mark is likely to have, because of the manner in which it is used, to the average purchaser as he encounters the goods bearing the mark. See *In re Abcor Development Corp.*, 588 F.2 811, 200 USPQ 215 (CCPA 1978). It is not necessary that the term describe all the characteristics or features of the goods in order to be merely descriptive; it is sufficient if the term describes one significant attribute thereof. See *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

We find the evidence of record is adequate to support the Examining Attorney's position that the term WEBCALL is merely descriptive when used in connection with applicant's software as identified in the application. We agree that it is the breadth of the term "telephone contact," as used

in the identification of applicant's goods, which renders the term WEBCALL descriptive. Even if we were to accept applicant's argument that its software product only allows the Internet user to leave a non-voice message requesting a call back, and not to use Internet telephony in making the initial contact with the call center, the term WEBCALL, when used in connection with this software, is descriptive thereof. As demonstrated by the article about applicant's new software product, its WEBCALL software is designed to cover callback either by the "plain old telephone" or by Internet phone. Despite applicant's arguments to the contrary, the goods as identified encompass both types of telephone contact. It has been shown by the evidence of record that the term "web call" would be readily recognized as referring to Internet phone calls. Thus, we are convinced that the correlation by purchasers of the term WEBCALL with a software product which permits callback by means of an Internet phone call would be obvious. The term WEBCALL, when used in connection with applicant's software, immediately conveys information as to this callback feature of the goods.

Applicant's further argument that in the identification of goods the software is not limited to use on the Internet or World Wide Web is without merit. In the

application as originally filed, applicant identified its program as a "computer program for allowing users on the World Wide Web" At the Examining Attorney's request, applicant changed the wording "World Wide Web" to the terminology accepted by the Office at that time, namely, "global computer information network." Applicant is clearly estopped from arguing a broader scope for this latter terminology than that covered by its original identification. See TMEP 804.09(b). Applicant's software product is limited to use on the Internet or World Wide Web. Even if it were not, the descriptiveness of the term WEBCALL would not be avoided, since the software could be used on the Web.

Applicant has also advanced the argument that, even considering the identification of goods, WEBCALL has multiple connotations and thus creates an ambiguity making the mark suggestive rather than merely descriptive. For example, applicant argues, the term WEBCALL might be thought to refer to a program that actually allows the caller to call via Internet telephone to request the callback, or to a program for the user's computer which directs the computer to dial a site and leave a prerecorded message requesting telephone contact in conjunction with web usage.

The fact that applicant's goods may be have been so broadly identified that the term WEBCALL might describe more than one feature of goods encompassed thereby does not remove the term from the realm of mere descriptiveness. If the identification of goods covers a software product which allows the user of the Web site to leave a message via Internet telephone, which in fact it does, then WEBCALL is merely descriptive of this feature of the software. If each possible interpretation of WEBCALL merely describes some feature of the software which lies with the scope of the goods identified in this application, the term is merely descriptive of the goods for which registration is sought. See *In re Vehicle Information Network Inc.*, 32 USPQ2d 1542 (TTAB 1994).

Accordingly, we find the term WEBCALL to be merely descriptive when used in connection with the computer program identified in the application.

Ser No. 75/023,266

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

R. F. Cissel

G. D. Hohein

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

Ser No. 75/023,266