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U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re *Ziff-Davis Publishing Company*

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Serial No. 75/049,193

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*Peter S. Sloane* of Fross Zelnick Lehrman & Zissu PC for  
*Ziff-Davis Publishing Company*.

Jennifer Krisp, Trademark Examining Attorney, Law Office  
107 (Janice O'Lear, Managing Attorney).

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Before *Cissel*, Seeherman and McLeod, Administrative  
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On January 26, 1996, applicant corporation applied to register the mark "INTERNET COMPUTING" on the Principal Register for services which were subsequently identified by amendment as "providing information on a global computer network in the fields of on-line marketing, advertising and business, including providing marketing statistics, and marketing and advertising trends," in Class 35. The basis

for the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with these services, but the application was subsequently amended to assert use in interstate commerce as early as April 11, 1997.

The Examining Attorney refused registration under Sections 2(e)(1) and 2(d) of the Lanham Act, but the refusal based on likelihood of confusion was later withdrawn.

This case is now before the Board on appeal from the final refusal to register based on the Examining Attorney's finding that the mark is merely descriptive of the specified services. Both applicant and the Examining Attorney filed briefs on this issue. Applicant filed a reply brief, but did not request an oral hearing before the Board.

Based on careful consideration of the record in this application and the written arguments on appeal, we hold that the Examining Attorney had not met her burden of establishing that the mark is merely descriptive of the services recited in the application.

The basic test to determine registrability under Section 2(e)(1) of the Lanham Act is not disputed: a mark is merely descriptive of the services with which it is used

if it conveys information about a characteristic, feature or function of those services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re MetPath Inc., 223 USPQ 88 (TTAB 1984); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979).

In support of her refusal to register under Section 2(e)(1) of the Act, the Examining Attorney submitted excerpts of articles from various printed publications retrieved from the Nexis® database wherein the term sought to be registered is used. The Examining Attorney argues that this evidence supports her conclusion that "Internet computing" is commonly used in reference to the "means by which marketing and advertising are carried out, namely, a means which involves harnessing Internet technology for the purpose of promoting one's own segment of commerce on a global or near-global scale." (Final refusal, p.2).

Examples of the excerpts provided by the Examining Attorney are reproduced below. Each is from a different source, but none provides a clear understanding of exactly what the term in question means.

A new form of computing is emerging called Internet computing... it will replace some client/server systems and evolve the computer industry over the next five years.

... Internet computing is server-centric computing, which has great advantages and lower management

costs. You've all heard complaints about the complexity and cost of client/server. Internet computing has the potential to reduce that pain.

Digital announced comprehensive, channel-ready firewall offerings that help resellers ensure secure Internet computing for businesses and enterprises of all sizes.

In no way does Internet computing replace client-server computing.

... Java technologies would become key to their Internet computing strategies within a year.

... management software tools are the cornerstone of the HP OpenView service-management program, delivering end-to-end service management in Internet computing environments.

"Virtually all of our corporate customers are asking for network redundancy and increased bandwidth as they deploy enterprise-wide Internet computing applications," said Wallace...

In its appeal brief, applicant concedes that the term it seeks to register "arguably may have a meaning linked to the general use of the Internet," but contends nonetheless that it is vague and imprecise, and has alternative meanings, so that it does not convey with any particularity or specificity information about the services applicant renders under the mark.

As noted above, we agree with applicant on this point. As Professor McCarthy explains in his treatise, Vol. 2, J. Thomas McCarthy, McCarthy On Trademarks and Unfair Competition, Section 11:19,:

To be characterized as "descriptive," a term must directly give some reasonably accurate or tolerably distinct knowledge of the characteristics of a product. If information about the product or service given by the term used as a mark is indirect or vague, then this indicates that the term is being used in a "suggestive," not descriptive, manner.

There is no question but that the examples provided by the Examining Attorney show that the term sought to be registered is used in connection with computers. Applicant concedes this point. The evidence of use of the term, however, does not establish specifically what the term means, so we cannot use that evidence as the basis for adopting the conclusion urged by the Examining Attorney, that the term is merely descriptive of a feature or characteristic of applicant's services.

The Examining Attorney has therefore not met her burden of establishing that applicant's mark is unregistrable under Section (2)(e)(1) of the Act. Moreover, even if the evidence of record had left us with doubt on this issue, such doubt would necessarily be resolved in favor of the applicant.

We emphasize that our determination of the issue before us in this appeal has necessarily been based upon the record in this application. This is not to say that a different conclusion might not have been reached if we had

had different evidence before us, nor would it preclude us from finding the term in question to be unregistrable in any subsequent inter partes proceeding.

We also want to make it clear that we were not persuaded to adopt applicant's position on the issue of descriptiveness in the case at hand because of applicant's argument that because the Examining Attorney passed to publication applicant's other application, which sought registration of the same mark for goods in Class 9, the instant application must likewise be approved. Although it is, of course, the goal of the United States Patent and Trademark Office to take consistent action with respect to all applications before it, the Board is aware of no legal requirement or logical reason that would mandate the withdrawal of the refusal in the case at hand, where applicant seeks to register the mark in connection with services, based on the fact that applicant's application to register the mark in connection with goods was not refused registration. Too many distinctions are possible. The Board is not privy to the reason why the Examining Attorney determined that the other application was entitled to publication. In any event, we are certainly not bound by her decision with respect to that application.

Applicant concedes the descriptiveness of the

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word "INTERNET," however, and in its brief, has offered to disclaim that word apart from the mark in its entirety.

Accordingly, a disclaimer of the descriptive word "INTERNET" will be entered into the record and the refusal to register under Section 2(e)(1) of the Act is reversed.

R. F. Cissel

E. J. Seeherman

L. K. McLeod  
Administrative Trademark Judges  
Trademark Trial & Appeal Board

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