

Hearing:
April 3, 2001

06/29/01

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Paper No. 18
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Infonxx, Inc.

Serial No. 75/271,225

James S. Blank and Nicholas G. Mehler of Latham & Watkins for
Infonxx, Inc.

Wanda Kay Price, Trademark Examining Attorney, Law Office 111
(Craig Taylor, Managing Attorney).

Before Simms, Wendel and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Infonxx, Inc. seeks registration of the mark WIRELESS
PAGES for "telephone directory information services."¹

The Trademark Examining Attorney has finally refused
registration on the ground that applicant's mark is merely
descriptive of its services, under Section 2(e)(1) of the
Trademark Act, 15 U.S.C. §1052(e)(1).

Applicant has appealed. The case has been fully briefed
and applicant requested an oral hearing before this Board.

¹ Application Serial No. 75/271,225, filed on April 7, 1997,
based upon an allegation of a *bona fide* intention to use the mark in
commerce on the goods as recited above in Int. Cl. 35.

Applicant and the Office were both represented at this hearing.

The Trademark Examining Attorney argues that the mark WIRELESS PAGES merely describes a *feature* of applicant's services. In support of this position, she has placed into the record stories from the LEXIS/NEXIS database retrieved from several distinctly different search strategies, as well as a dictionary definition of the word "cellular."²

On the other hand, applicant contends that the Trademark Examining Attorney has failed to demonstrate that the mark as a whole is merely descriptive of applicant's telephone directory information services.

Based upon careful consideration of the record in this application and the arguments on appeal, we agree with applicant, and find that the Trademark Examining Attorney had not met her burden of establishing that the mark as a whole is merely descriptive of the services recited in the application.

It is well settled that a term is considered to be merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately conveys information about an

² **Cellular** A wireless local telephone service that operates by dividing a geographical area into sections (cells). Each cell has its own transmitter/receiver that tracks and operates with cellular telephones within its area. The dimensions of a cell can range from several hundred feet to several miles. McGraw-Hill Illustrated Telecom Dictionary, (1998) p. 83.

ingredient, quality, characteristic, feature, function, purpose or use of the goods or services with which it is being used. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and 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 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 idea about them. On the other hand, the immediate idea must be conveyed with some "degree of particularity." In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd 90-1495 (Fed. Cir. Feb. 13, 1991); and In re TMS Corporation of the Americas, 200 USPQ 57, 59 (TTAB 1987).

Furthermore, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought. 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). We must look to the context in which the term is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser

of the goods or services because of the manner of its use. In re Bright-Crest Ltd., 204 USPQ 591, 593 (TTAB 1979).

However, a mark is suggestive if, when the goods or services are encountered under the mark, a multistage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See In re Abcor Development Corp., *supra* at 218, and In re Mayer-Beaton Corp., 223 USPQ 1347, 1349 (TTAB 1984). As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See In re Atavio, 25 USPQ2d 1361 (TTAB 1992) and In re TMS Corporation of the Americas, *supra* at 58. The distinction, furthermore, is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. See In re George Weston Ltd., 228 USPQ 57, 58 (TTAB 1985).

As we examine the evidence placed into the record by the Trademark Examining Attorney, a brief review of the history of this case is in order. In the first Office action, the Trademark Examining Attorney did not find the matter descriptive, but did request a disclaimer of the word "pages."

Then in a supplemental Office action, the Trademark Examining Attorney refused the entire term as being merely descriptive of the services, including as proof the results of a LEXIS/NEXIS search. While this attached evidence demonstrated uses of the phrases "wireless pages" and "wireless pagers," all of these uses were in connection with wireless paging devices ("pagers") and the messages transmitted thereby ("pages").

Then in her Final refusal, the Trademark Examining Attorney focused on the term "pages" as used in connection with printed products in the nature of telephone books. In these LEXIS/NEXIS excerpts, the publications were referred to as "white pages," "yellow pages," etc. Based upon this use of the word "pages," she argues in her Final refusal as follows:

It is well settled in the relevant telecommunications or telephone trade or industry that 'pages' (whether yellow or white pages) are synonymous with telephone directories. The applicant's 'pages' or telephone directories are directories geared toward wireless users, namely, cellular users.

However, applicant contends on appeal that the Trademark Examining Attorney has failed to meet her burden of proof with respect to the mere descriptiveness of the mark WIRELESS PAGES, as a whole. Applicant points to the fact that the Trademark Examining Attorney has made of record no evidence of any competitors' descriptive usage of the combined term.

Rather, applicant argues that one must conduct a multistage reasoning process to connect the term WIRELESS PAGES to the recited telephone directory information services.

We learn from applicant's literature that applicant contracts with large enterprises. Its services are offered to the employees of large corporations and to the subscribers of cellular telephone companies. Applicant's service depends upon the availability of hundreds of actual telephone operators. Relying upon telephone contacts with these operators, cellular telephone users (i.e., who are the beneficiaries of the enterprise contracts with applicant), are offered nationwide directory assistance with automatic connections to other cellular telephones.

The word "Wireless" alone describes the industry targeted in connection with applicant's services, and hence is descriptive for services offered to cellular telephone users. However, the real question in this appeal is whether the combined term, "WIRELESS PAGES," is merely descriptive for applicant's directory assistance services.

Clearly, applicant's services have nothing to do with wireless transmissions via a paging device, or a pager. Other than applicant's alleged mark, this unrelated connotation is the only use shown in the record of these two words together.

Moreover, the issue presented by this appeal is not whether the asserted mark merely describes bound telephone directories of cellular or wireless users, or even their computerized analogues. The mark must be considered in relation to applicant's directory information services. Yet with respect to alphabetical listings and classified directories, each of the Trademark Examining Attorney's LEXIS/NEXIS excerpts attached to the Final refusal uses the phrase "white pages" and/or "yellow pages" to refer to telephone directories in the nature of books - not operator-based, directory assistance services. As applicant stressed throughout the prosecution of this application, applicant's services are not hard-copy telephone books, or even a computerized, online analogue.

Given widespread use of expressions like "white pages," "yellow pages," "classified pages," "telephone business pages," "telephone community pages," etc., we acknowledge that in this context, usage of the word "pages" may be vaguely suggestive of the informational nature of these services.

Even if we were to find that the word "pages" alone (i.e., apart from the phrase "white pages." "yellow pages," "classified pages," etc.) would be readily understood as a reference to telephone directories or phone books generally, applicant does not offer telephone directories or a Web

analogue (*contra* Trademark Examining Attorney's appeal brief, p. 4). Accordingly, we find that the term "Pages" in applicant's mark does not describe applicant's services. Furthermore, at the hearing, the Trademark Examining Attorney postulated that the same "pages" might also be understood as a short hand expression for the directory information services provided by telephone operators one reaches by calling the appropriate telephone information number (see also Trademark Examining Attorney's brief, pp. 6-7). However, the Trademark Examining Attorney appears to be speculating about how broad a connotation to accord the word "pages" within applicant's mark, as we find no evidence in the file to support this leap. Accordingly, we conclude that the Trademark Examining Attorney has not established on the record before us that the mark WIRELESS PAGES is merely descriptive of the identified services.

Applicant's combination of the two words, "Wireless Pages," creates a term for which, on this record, we must conclude that there is no third-party usage for this type of services (i.e., other than applicant's mark). The Trademark Examining Attorney has produced no evidence of usage in the United States of the combined term "wireless pages" by others in the field of telephone directory assistance.

Accordingly, on the basis of the limited record before us, we find insufficient evidence to hold the term WIRELESS PAGES, as a whole, merely descriptive when used in connection with applicant's enhanced directory assistance services. We conclude that a multistage reasoning process or imagination would be necessary in order for customers or prospective purchasers of these services to conclude anything meaningful about the features of such services. The term WIRELESS PAGES, when used in connection with directory assistance services, has not been shown to immediately or directly describe any significant feature or aspect of applicant's particular services. Based upon applicant's recited services, we agree with applicant that, while WIRELESS PAGES may be suggestive of the identified services, it is not merely descriptive thereof.

Moreover, to the extent that there may be any doubt as to whether applicant's mark as a whole is merely descriptive or suggestive of its goods, we consider it appropriate to resolve such doubt in the favor of applicant. Then upon publication of applicant's mark, any person who believes that she would be damaged by the registration of the mark will have the opportunity to file an opposition thereto. See In re Merrill Lynch, Pierce, Fenner, and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); In re Rank Organization Ltd., 222 USPQ 324, 326 (TTAB 1984); In re Morton-Norwich Products, Inc., 209

USPQ 791 (TTAB 1981); and In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972).

Nonetheless, having held that the term WIRELESS PAGES is not merely descriptive of applicant's telephone directory information services, we find it inappropriate to permit this composite term to issue on the Principal Register absent a disclaimer of the term "Wireless."

As noted *supra*, applicant does unquestionably offer directory information for wireless users. Accordingly, we earlier acknowledged that the term "Wireless" is highly descriptive of the wireless telephone industry targeted by applicant, and hence this element of the composite is merely descriptive of applicant's services.³ Thus, we must require a disclaimer of this term apart from the mark as a whole. Based upon the instant record, we are convinced that we must reverse the refusal that the entire mark is merely descriptive, but applicant must in turn submit a disclaimer of the word "Wireless."

In conclusion, based on the record before us, we have doubts as to whether this composite term is merely

³ And further, we find nothing in this combination that would have us conclude that this is a "unitary" expression where a disclaimer of one component would be improper (See TMEP §1213.06), although given the way this prosecution developed, there was really no need for specific advocacy on this point.

descriptive. Accordingly, we reverse the refusal to register on the basis of mere descriptiveness. On the other hand, we conclude, consistent with Trademark Rule 2.142(g), that applicant's mark should be published for opposition only if applicant, no later than thirty days from the mailing date hereof, submits an appropriate disclaimer of the word "Wireless."⁴

Decision: Provided that applicant submits an appropriate disclaimer of the word "Wireless" within thirty days of the mailing date of this decision, the refusal to register is reversed.

⁴ See In re Interco Inc., 29 USPQ2d 2037, 2039 (TTAB 1993). For the proper format for a disclaimer, attention is directed to TMEP §§1213.09(a)(i) and 1213.09(b).