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Paper No. 16
TEH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SpecComm International, Inc.

Serial No. 75/300,898

Lisa Kaufman of Blank Rome Comisky & McCauley LLP for SpecComm International

Alex H. Butterman, Trademark Examining Attorney, Law Office 106
(Mary Sparrow, Managing Attorney).

Before Quinn, Chapman and Holtzman, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by SpecComm International, Inc. to register the mark VIRTUAL FIRE & RESCUE EXPO for "conducting educational workshops in the field of fire and rescue by means of a global computer information network."¹

¹ Serial No. 75/300,898 filed May 30, 1997. Applicant has claimed ownership of Registration No. 2,078,917 for the mark NATIONAL FIRE & RESCUE and design with NATIONAL FIRE & RESCUE disclaimed.

The Trademark Examining Attorney initially refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark is merely descriptive of its services. In response to the refusal, applicant argued that the mark is not descriptive and moreover claimed that the mark has acquired distinctiveness under Section 2(f) of the Act. The Examining Attorney rejected applicant's Section 2(f) claim and issued a final refusal on the ground that the mark is "merely descriptive and generic." Applicant responded by filing a notice of appeal followed by its appeal brief. Recognizing that his final was premature in view of applicant's Section 2(f) claim, the Examining Attorney requested a remand of the application in order to properly issue a non-final action on the new issue. The Board granted the remand, and the Examining Attorney subsequently issued a new, non-final action on the basis of the insufficiency of the evidence in support of applicant's Section 2(f) claim. Applicant did not respond to the merits of the Office action but instead filed a request with the Board to resume the appeal. By this request, applicant made it clear that it did not wish to pursue its claim of distinctiveness under Section 2(f) and that it wished to go forward on the appeal based solely on the issue of whether

the mark is merely descriptive under Section 2(e)(1) of the Act.² The Board granted applicant's request, noting that the appeal would proceed solely on the issue of descriptiveness.³ The Examining Attorney subsequently filed his appeal brief on that issue.⁴ An oral hearing was not requested.

Thus, the only question on appeal is whether the mark is merely descriptive of applicant's services.

The Examining Attorney contends in this regard that the wording VIRTUAL FIRE & RESCUE EXPO, when considered in relation to the identified goods, describes "the nature or characteristics

² Specifically, applicant stated that: "...[a]pplicant wishes to move forward with the Appeal based on the refusal under Section 2(e)(1) of the Trademark Act. The issue of distinctiveness under Section 2(f) of the Trademark Act is not before the Board and the Applicant does not wish to have the Board consider such an issue at this time....Applicant respectfully requests that the Appeal move forward based on [the Section 2(e)(1)] ground alone."

³ The Examining Attorney had included evidence with his Office action following the remand consisting of dictionary definitions for "virtual," definitions of the terms "expo" and "exposition," articles taken from the NEXIS database showing the word "virtual" used with either "expo," "show" or "exhibition," and Internet references to the phrase "virtual expo." This evidence was also discussed and/or referenced by the Examining Attorney in his appeal brief. Because applicant subsequently withdrew its Section 2(f) claim and consequently did not respond to that Office action on the merits, with the exception of the dictionary definitions of which the Board can take judicial notice, none of that evidence will be considered.

⁴ Although the Board, on October 3, 2000, granted applicant's request for an extension of time to file a reply brief, no reply brief was filed.

of the service and its subject matter." The Examining Attorney maintains that the terms VIRTUAL and EXPO describe the nature of the service; that the services involve an exposition that takes place on a computer network; and that the phrase FIRE & RESCUE describes the subject matter of the workshops that are part of the exposition. In support of his position, the Examining Attorney has relied on entries from general and technical dictionaries, third-party registrations, lists of Internet search results, portions of selected websites, excerpts of articles from the NEXIS computer database, and the use of the mark in applicant's specimens.

Applicant states in its brief that the mark is not descriptive, but devotes virtually its entire argument to the claim that the mark is not generic for its services. Applicant argues that while the term as a whole "may suggest" its services, "the mark cannot be generic since the services provided do not actually rescue people, but deal with apparatus or means for rescuing people." Applicant admits that "the genus of services at issue is fire and rescue" (brief p.3) and that its mark "is plainly about 'fire and rescue.'" (Brief p.4). According to applicant, its services "seek to educate and teach the public the proper techniques involved in fire and rescue procedures, as well as describing and presenting devices used for such purposes." (Brief p.2). Applicant maintains, however, that the Examining

Attorney has not "met his burden of showing" that the mark "is generic" for the services. Applicant relies on five third-party registrations containing the phrase "FIRE & RESCUE" and eight third-party registrations which include the word "EXPO" in the marks to support its claim that its own mark is not "generic" for the identified services.⁵

As indicated earlier in this decision, and in accordance with the applicant's express request, the only issue to be decided in this appeal is whether the Examining Attorney has met his burden of showing that applicant's mark is merely descriptive of its services under Section 2(e)(1) of the Trademark Act. Any issues concerning the acquired distinctiveness or genericness of applicant's mark are not before us on appeal and will not be decided or discussed herein. Thus, we turn our attention to the Section 2(e)(1) issue.

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods or services with which it is used. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Moreover, the question of whether a particular term is merely descriptive must be determined not in the abstract, but in

⁵ None of these third-party registrations is properly of record. Nevertheless, the Examining Attorney has stated that he does not object to the evidence and, moreover, he addressed the evidence on the merits. Accordingly, we have considered this evidence for whatever probative value it may have.

relation to the goods or services for which registration is sought. See *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986).

The evidence made of record in this case is strongly persuasive that the phrase VIRTUAL FIRE & RESCUE EXPO, when applied to applicant's services, immediately and without conjecture, describes the nature of applicant's services as well as the subject matter and/or intended audience for those services. The dictionary definitions submitted by the Examining Attorney and the third-party registrations submitted by both applicant and the Examining Attorney, illustrate the descriptive meaning of the word "expo." One such dictionary entry defines "expo" as "any exhibition or show" and refers to an "annual computer expo" as an example of such an exhibition. The services identified in a number of the third-party registrations for marks containing EXPO (such as GOLFERS' EXPO; WEB EXPO; ELECTRONIC ENTERTAINMENT EXPO; and BOOKEXPO AMERICA) indicate that educational programs and activities for attendees, such as workshops, clinics and conferences in a particular industry are typical of the services offered at an expo. It is also noted that each of the EXPO marks for those types of services issued on the Supplemental Register and with a disclaimer of the term EXPO. While third-party registrations are not conclusive on the question of descriptiveness, if nothing else, we can see that the word "expo"

in the context of services such as those of applicant has been treated consistently by the Office as, essentially, an unregistrable term.

Moreover, the word VIRTUAL in applicant's mark describes the format of the exposition. Where traditionally, an expo and its associated workshops would take place at a brick and mortar facility, technology has made it possible to "attend" the exhibition by accessing the Internet. As indicated in applicant's description of services and as described in its specimens, applicant's expo is conducted, "[e]ntirely on the Internet." The dictionary listing submitted by the Examining Attorney defines VIRTUAL as "[n]ot real; a computer representation of something that is real"⁶ and as "...the computer-enabled representation or simulation of an action, transaction, object or state."⁷ We note, for example, that a "Virtual Classroom" in that same dictionary is described as "[a] learning environment in which students and teachers are connected and interact by means of teleconferencing or videoconferencing software, e-mail, and/or chat rooms." Thus, in the context of applicant's services, the word VIRTUAL simply means that applicant's expo workshops are conducted online rather than at a physical facility. See *In re Styleclick.com Inc.*, ==

⁶ *Webster's New World Dictionary of Computer Terms*. (7th ed.)

⁷ *Official Internet Dictionary A Comprehensive Reference for Professionals*. (1993).

USPQ2d___, Serial No. 75/459,912 (TTAB February 12, 2001)[VIRTUAL FASHION is merely descriptive when used in connection with electronic retailing services via the Internet featuring apparel, fashion, accessories, personal care items, jewelry and cosmetics].

In addition, there is no question that FIRE & RESCUE directly describes the subject matter and/or audience for applicant's EXPO. Applicant admits that its "mark...is plainly about 'fire and rescue'," and the evidence of record makes it clear that "fire and rescue" identifies both a service and a class of service providers. In this regard, the Examining Attorney points to the use of "fire and rescue" in applicant's recitation of services as describing the field in which applicant's workshops are offered, and the Internet and NEXIS references which show that numerous organizations, often in the nature of local or community service agencies, use "fire and rescue" in their names. As can be seen from the following examples, the descriptive nature of this use is obvious: "COUNTY AGENCY: Department of Fire and Rescue Services"; "Stamford Fire & Rescue Department"; "Montgomery County Fire and Rescue Services"; "Darlington Fire and Rescue Brigade"; and "Catoosa County Fire and Rescue Department." In addition, the Internet articles describe the capabilities of "fire and rescue" departments and the operations they perform. Other NEXIS references submitted by the Examining Attorney demonstrate that "fire and rescue" refers to the industry itself or to industry

members. Examples of those articles appear below. (Emphasis added).

While in many careers, the term professional implies compensation, this is not so within the **fire and rescue professions**. *The Virginian-Pilot (Norfolk)* (May 17, 1996).

Dyer said that nationwide, the **fire and rescue industry** made a philosophical shift 15 to 20 years ago that added minutes to response times. *The Kansas City Star* (April 24, 1997).

Finally, the descriptive meaning of "fire and rescue" in the context of the services is confirmed by applicant's own specimens which contain the statement, "Bring the Worldwide Fire and Rescue Community to your Department...National Fire & Rescue and WCES introduce the industry's first Online trade show."⁸

Thus, the evidence clearly shows that the phrase VIRTUAL FIRE & RESCUE EXPO, when considered in its entirety, is merely descriptive of applicant's services. The relevant purchasers of applicant's services, whether they are the fire and rescue industry, or interested members of the community, would, without the exercise of any imagination, immediately understand the phrase to mean that applicant is providing online workshops in the fire and rescue field.

Decision: The refusal to register is affirmed.

⁸ Applicant's third-party registrations incorporating "fire" and/or "rescue" are not persuasive of a different result. In each of the identified registrations, the "fire" and "rescue" terms have been disclaimed. Applicant has also relied on a pending application which is of no probative value.