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**THIS DISPOSITION
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Paper No. 16
HWR

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ZD Inc.

Serial No. 75/397,243

Mark D. Engelmann of Fross Zelnick Lehrman & Zissu, P.C.
for ZD Inc.

Elissa Garber Kon, Trademark Examining Attorney, Law Office
110 (Chris A.F. Pedersen, Managing Attorney).

Before Seeherman, Wendel and Rogers, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

ZDTV, L.L.C., filed an application to register the
mark BOOKSELLER for "providing information and reviews
about publications in the fields of technology, computers,
computing, computer hardware, computer software, computer
technology, computer networks and networking, information
technology, communications, telecommunications,
communications technology, high technology, interactive and
online services, entertainment, computer and video games,

finance, news and a wide range of general interest information, via global computer information networks." The application was subsequently assigned to ZD Inc. and the assignment recorded by the Office.¹

Registration has been finally refused under Section 2(e)(1) of the Trademark Act on the ground that the mark is merely descriptive. Applicant and the Examining Attorney have filed briefs but an oral hearing was not requested.

The Examining Attorney has made of record the dictionary definition of a "bookseller" as "one that sells books, especially the owner of a bookstore" and excerpts from websites showing that online booksellers often provide information and reviews incidental to the sale of books. On this basis, she argues that the mark BOOKSELLER merely identifies the type of entity that provides information and reviews similar to those recited in applicant's identification of services. She further argues that the "information" provided by applicant as part of its services might well include links to websites from which the books can actually be purchased.

¹ Serial No. 75/397,243, filed November 28, 1997, based on an allegation of a bona fide intention to use the mark in commerce. The assignment was recorded by the Office on January 21, 2000 at reel 1982, frame 0067.

The Examining Attorney also argues that the mark is merely descriptive because it identifies one group or class of purchasers to whom applicant directs its services, namely, booksellers. She has made of record excerpted Nexis articles which purportedly demonstrate that booksellers are an intended audience for book reviews, these reviews having a strong impact on their businesses.

Applicant insists that the mark BOOKSELLER is incongruous, rather than descriptive, because applicant does not sell books and because the services identified in the application do not include the sale of books. Applicant states that its mark is to be used in connection with the provision of free online information services with respect to publications in a variety of fields. Applicant argues that even if a user of applicant's services might be able to access a third-party bookseller thereby, this does not mean that applicant is offering the services of a bookseller.

Applicant further argues that its mark has multiple possible meanings, such as services directed to persons wishing to sell books or profiles of companies that sell books, and thus fails to describe the services with which it is intended to be used with any degree of particularity. Finally, applicant argues that there is no limitation in

the identification as to the intended audience for its services and that, in fact, the services would be directed principally to the general public.

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic, purpose, function, or feature of the goods or services with which it is being used, or is intended to be used. Whether or not a particular term is merely descriptive is determined not in the abstract, but rather in relation to the goods or services 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 or services bearing the mark. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

Thus, we make our determination of whether or not applicant's mark BOOKSELLER is merely descriptive by looking to the services with which applicant intends to use the mark, as identified in the application. We find it clear that these services cover only the provision of information about, and reviews of, publications on a wide variety of subjects. As applicant has pointed out, there

is no indication in the recitation of services of the sale of these publications under the mark BOOKSELLER.

Although, as applicant acknowledges, links may be provided in connection with applicant's online services such that users may access booksellers, under these circumstances applicant will not be functioning as the "bookseller." Rather than being incongruous, we find the mark BOOKSELLER, as intended to be used by applicant, to have somewhat of a double entendre. Applicant is using the mark BOOKSELLER, not in the literal sense of one selling books, but rather in the more figurative sense of one providing reviews and information to spike the interests of potential readers and in that way be a "seller" of the books. We do not agree with the Examining Attorney that simply because booksellers often provide similar information and reviews of the books they are selling, the mark BOOKSELLER must be merely descriptive as used by applicant.

While we do not agree with applicant with respect to the multiple potential meanings which applicant argues might be attached to its mark, this is immaterial to our decision. We would simply reiterate that descriptiveness is not determined in a vacuum, but rather in connection with the recited services. Just as the services, as

identified, do not encompass the sale of books to purchasers, neither do they encompass the sale of books for purchasers or any of the other hypotheticals advanced by applicant. On the other hand, we find the other allegedly descriptive meanings attributed to the mark by the Examining Attorney, including the intended audience or the subject matter of the publications, to be unsupported by any concrete evidence.

Thus, on the record before us, we do not consider the mark BOOKSELLER to be merely descriptive, when used in connection with the services identified in the application. If any doubt remains, we find it appropriate to resolve this doubt in applicant's favor, inasmuch as any person who believes that he 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 Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

Decision: The refusal under Section 2(e)(1) is reversed.