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Paper No. 9
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Louis R. Bucalo

Serial No. 75/486,133

Amy F. Divino of Steinberg & Raskin for Louis R. Bucalo.

Robert L. Lorenzo, Trademark Examining Attorney, Law Office
111 (Craig Taylor, Managing Attorney).

Before Cissel, Hohein and Chapman, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On May 15, 1998, applicant filed the above-referenced application to register the mark "NEWSPHONE" on the Principal Register for "providing of news information that customers access by telephone," in Class 41. The application was based on applicant's assertion that he possessed a bona fide intention to use the mark in commerce in connection with the services.

The Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act on the ground that the

mark applicant seeks to register is merely descriptive of the services identified in the application because the mark identifies the fact that the services are reporting the news via telephone. He also required that applicant amend the recitation of services to be more definite, and pointed out that telephone information services are properly classified in International Class 42.

Applicant responded by amending the recitation of services in the application to read as follows: "telephone information services featuring local, national and international news that customers access by telephone," in Class 42. Applicant also argued that the refusal to register under Section 2(e)(1) is improper because the mark is at most suggestive, rather than merely descriptive of the services set forth in the amended recitation.

Submitted in support of applicant's position was a copy of the file history of a prior-filed application, S.N. 75/432,597, by which a third party sought to register the mark "SNOWPHONE" for "providing information regarding school and business closings due to whether via telephone, radio, tv, global computer network." Applicant argued that that application had been passed to publication, and that consistent administration of the Lanham Act by the United States Patent & Trademark Office requires that the instant

application also be approved for publication. Applicant also submitted a list of third-party registrations from a search report for what applicant asserted were similar marks registered on the Principal Register without any disclaimers and without reliance on Section 2(f) of the Lanham Act.

The Examining Attorney accepted the amended recitation of services, but was not persuaded by applicant's evidence or arguments, so the refusal to register based on Section 2(e)(1) was repeated and made final. In support thereof, he submitted dictionary definitions of "news" as "information about recent events and happenings, especially as reported by newspapers, periodicals, radio, or television"; and of "phone" as a reference to the telephone. He repeated his conclusion that in relation to the services identified the application, the term sought to be registered would immediately convey to prospective purchasers the fact that applicant's services consist of providing news by means of the telephone.

Also submitted with the final refusal in support of the Examining Attorney's position were copies of fifteen third-party registrations for marks which combine the term "phone" with other wording. The registrations either contain disclaimers of the word "phone" or the marks are

registered on the Principal Register under Section 2(f) or on the Supplemental Register.

Citing *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983), the Examining Attorney noted in his final refusal that he had not considered the third-party registrations listed by applicant in his response to the refusal to register. He pointed out that a search report is not evidence of the existence of the registrations listed therein, and, citing *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992), instructed applicant how to make properly of record copies of the registrations themselves.

In addition, the Examining Attorney submitted copies of a number of excerpts from articles retrieved from the Nexis® database of publications. It is clear from consideration of this evidence that news is now available to consumers via wireless telephones.

Applicant timely filed a Notice of Appeal, followed by an appeal brief. Attached as exhibits to applicant's brief were copies of the third-party registrations listed in the search report applicant had submitted in response to the first Office Action.

The Examining Attorney properly objected to the additional evidence submitted with applicant's brief. Trademark Rule 2.142(d) provides that the record in an

application should be complete prior to filing the Notice of Appeal. The Board may, in its discretion, permit additional evidence to be submitted after that time, but the rule allows this to be done only in response to a request by either the applicant or the Examining Attorney. In the case at hand, neither made such a request, so the additional materials submitted with applicant's appeal brief have not been considered. If the Examining Attorney had responded to the list of registrations as if the registrations were properly of record, we would not sustain his objection to the subsequent submission of actual copies of them. However, in his second Office Action, the Examining Attorney did not respond to the merits of the list of registrations submitted by applicant. Instead, the Examining Attorney advised applicant that he had not made the registrations properly of record by submitting a mere list. As noted above, the Examining Attorney explained to applicant how to make the third-party registrations of record, but applicant did not do so prior to the filing of his Notice of Appeal or by concurrently filing a request for reconsideration. Thus, when applicant submitted the copies with his brief, the Examining Attorney, in his

brief¹, timely objected, so under Trademark Rule 2.142(d), we cannot consider the exhibits.

Applicant did not request an oral hearing before the Board.

The test for determining whether a mark is merely descriptive within the meaning of Section 2(e)(1) of the Lanham Act is well settled. A mark is unregistrable under this section if it immediately and forthwith provides information about a significant quality, characteristic, function, feature, purpose or use of the goods or services with which it is, or is intended to be, used. In re MetPath Inc., 223 USPQ 88 (TTAB 1984), and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979).

As noted above, applicant seeks to register "NEWSPHONE" for a telephone information service featuring local, national and international news that customers can access by telephone. Applying the ordinary meanings of the words "NEWS" and "PHONE," when the mark combining these two words is considered in connection with the service of providing news by telephone, it is clear that the mark

¹ We accept the Examining Attorney's explanation of the clerical mistake that led to the late mailing of his appeal brief. We therefore have considered it as if it had been timely mailed.

describes the purpose or function of the services.

Applicant makes a number of unpersuasive arguments. One is that when the descriptive words "news" and "phone" are combined, whatever information the resulting mark provides about applicant's services is "vague" and "indirect." (brief, p.4). To the contrary, the combination of these descriptive words itself provides specific information with respect to the recited services, namely that the services consist of providing news by phone. Applicant submitted no evidence in support of the theory that the mark is descriptive only in a "vague" or "indirect" sense.

Applicant contends that a person would have to engage in a multi-stage reasoning process to determine the attributes of applicant's services from consideration of the mark. As the Examining Attorney points out, however, whether a mark 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 used, or will be used, in connection with those goods or services, and the possible significance which the mark would have, because of that context, to the average purchaser of the goods or services in the marketplace where they are sold. In re Abcor Development

Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). The test is not whether someone could look at only the mark and correctly speculate as to significant characteristics, purposes or functions of the services with which it is used. The test is whether one who understands what the services are would be provided with information as to their characteristics, purposes or functions by consideration of the mark. This test is plainly met in the instant case. That the word "phone" could have other connotations in connection with other products or activities is not relevant.

Applicant argues that the term sought to be registered "is being used in a suggestive and non-descriptive manner." (brief, p.4). This application is based on applicant's assertion that he intends to use the mark, not on a claim of actual use of it, however. This record contains no evidence that applicant has in fact used the mark, much less that it has been used in a "suggestive and non-descriptive manner."

Applicant's argument that "NEWSPHONE" is a coined term that combines two words to form an incongruous mark is similarly not well taken. Applicant provides no evidence or reasoning in support of this contention. To the contrary, as noted above, the combination of these two

descriptive words results in a term which is itself merely descriptive of the services set forth in the application.

Similarly, whether or not anyone else has ever adopted the term or used the term sought to be registered in connection with the same or similar services is immaterial. In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987). In view of our ruling with respect to the third-party registrations submitted by applicant with his brief, there is no evidence that others have registered, much less used, marks similar to the one sought to be registered. Moreover, even if the record contained evidence of registration by others of the same or similar marks for the same or similar services, such evidence would not be determinative of this appeal. The Board is not bound by previous decisions by Examining Attorneys who passed other marks to publication. In re Nett Designs, Inc., 57 USPQ2d 1564 (Fed. Cir. 2001). We are obligated to decide each case before us on its own record and merits. In re Cosvetic Laboratories, Inc., 202 USPQ 842 (TTAB 1979).

While the information with regard to the application to register the mark "SNOWPHONE" is properly of record, it does not constitute any reason to reach the conclusion that the mark in the case at hand, "NEWSPHONE," is not merely

descriptive of the services recited in the instant application. Applicant does not contend that "SNOWPHONE" was registered for the services set forth in that application, claiming only that it was passed to publication, but was abandoned before registration. Even if that mark had been registered for those services, however, as noted above, the Board would not be bound by the decision of the Examining Attorney in that application made on that record with regard to that mark for those services. The mark, the services and all the other information of record in that case differ from those in the application which is the subject of this appeal.

The record in this case clearly demonstrates that "NEWSPHONE," if used in connection with a telephone information service featuring local, national and international news that customers can access by phone, would be merely descriptive of the services because it would immediately and forthwith inform potential customers of the purpose, function, central feature or characteristic of the services.

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

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