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**THIS DISPOSITION
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Paper No. 12
RLS/kk

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **NetCarrier, Inc.**

Serial No. 75/**571,430**

Sherry H. Flax of Saul Ewing, LLP for NetCarrier, Inc.

Angela M. Micheli, Trademark Examining Attorney, Law Office
108 (David E. Shallant, Managing Attorney).

Before Simms, Cissel and Drost, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

NetCarrier, Inc. (applicant), a Pennsylvania
corporation, has appealed from the final refusal of the
Trademark Examining Attorney to register the mark
NETCARRIER for providing telecommunications connections to
a global computer network; telecommunications services,
namely, personal communication services; electronic
transmission of messages and data.¹ The Examining Attorney

¹ Application Serial No. 75/571,430, filed October 30, 1998,
based upon allegations of use and use in commerce since May 25,
1996.

has refused registration under Section 2(e)(1) of the Act, 15 U.S.C. §1052(e)(1), on the basis that applicant's mark merely describes the function and nature of applicant's services in that applicant is a carrier for the Internet. The Examining Attorney has also refused to allow this application under Section 2(f) of the Act, 15 USC §1052(f). Applicant and the Examining Attorney have submitted briefs, but no oral hearing was requested.²

We affirm.

It is the Examining Attorney's position that applicant's mark consists of the combination of two generic terms -- "Net" (the abbreviation for the Internet), and "carrier," a company that provides communications signals. The combination forms another descriptive term, according to the Examining Attorney, signifying an Internet carrier or a "Net carrier."

In support of her refusal, the Examining Attorney has relied upon various articles retrieved from the Nexis computer search system. The Examining Attorney contends that these excerpts show that the term "Net carrier" is

² In response to the first refusal, applicant disclaimed "NET and CARRIER" apart from the mark. In her brief, the Examining Attorney stated for the first time that an applicant may not disclaim the entire mark. See TMEP § 1213.07. Accordingly, we shall disregard this disclaimer.

used by others to refer to providers of Internet access.

The following are examples from these excerpts:

She noted that the Internet Operators Group, the coalition of Net carriers and equipment providers charged with coordinating coverage of hot spots around the globe, logged just 10 problems in the 24-hour rollover period, not all of them directly related to Y2K...

San Jose Mercury News, January 3, 2000

* * * * *

Platinum, a maker of infrastructure software, had revenue of more than \$900 million last year, while Net carrier Broadcast.com took in \$22.4 million.

InformationWeek, April 5, 1999

* * * * *

HEADLINE: HAGGLE OVER PRICE WITH NET CARRIERS

Computer Weekly, October 8, 1998

* * * * *

In order to provide the ubiquity that lies at the heart of the Internet, a company that wants to carry Net traffic has to connect with other Net carriers... ..There are about 40 public peering points in the U.S. where dozens of Net carriers set up their communications gear side by side and share traffic...

Business Week, July 20, 1998

* * * * *

We also consider mammoth Net carrier MCI's move into so-called "usage billing," a practice that could put an end to flat payment as we know it and could find companies charging higher prices for "premium services."

Electronic Engineering Times, November 4, 1996

* * * * *

Further, demand for its corporate hosting services is growing. In its just-ended second quarter, Unet racked up \$54 million in Internet service revenues, a 185 percent increase. The Net carrier logged 1,011 new orders for high-speed corporate Internet connections.

InternetWeek, August 19, 1996

* * * * *

...In general, readers said they are counting on public net carriers for data networking...

Network World, March 27, 1995

* * * * *

HEADLINE: Direct control eludes net carrier users
Computerworld, June 27, 1994

The Examining Attorney has also relied on dictionary definitions of "Net" as an abbreviated form of "Internet," and that "carrier" is used to refer to "carrier service provider," which is a company offering telephone and data communications between points in a state or in one or more countries. Another definition defines "carrier" as:

A company which provides communications circuits. Carriers are split into "private" and "common." A private carrier can refuse you service. A "common" carrier can't. Most of the carriers in our industry -- your local phone company, AT&T, MCI, US Sprint, etc. -- are common carriers. Common carriers are regulated. Private carriers are not.

(Newton's Telecom Dictionary, 1997). Because applicant is a carrier which offers Internet access, the Examining Attorney maintains that applicant's mark NETCARRIER merely describes applicant's services.

With respect to applicant's evidence of acquired distinctiveness, more fully discussed below, the Examining Attorney maintains that the evidence is insufficient because of the high degree of descriptiveness in applicant's mark.

Applicant, on the other hand, while acknowledging that it provides Internet access through several search engines, maintains that its mark is a distinctive unitary one which is not merely descriptive, but only suggestive of its services. Applicant argues that the combination of words it has chosen for its mark creates a valid mark that is inherently distinctive, and that some thought or imagination is needed in order to determine the nature of applicant's services. Further, applicant argues that, even if its mark were considered descriptive of one aspect of its services -- its telecommunications services -- it does not describe all of applicant's services. In this regard, applicant states that it provides a variety of services including Web site hosting, Web site development, residential and commercial Internet connectivity, the

electronic transmission of messages and news, weather and sports information.

Applicant also maintains that, although the term "carrier" is sometimes used to describe a telecommunications service provider, the term is more commonly used to describe a common carrier transportation service. Therefore, according to applicant, the compound term NETCARRIER is more likely to describe a container constructed with a net material for transporting goods. Applicant also notes the issuance of various third-party registrations covering such marks as QUICKNET, COURIERNET, WEBNET, and others. Applicant also claims ownership of the mark NETCARRIER with design (Registration No. 2,391,550, issued October 3, 2000).³

Alternatively, applicant argues that its mark has acquired distinctiveness within the meaning of Section 2(f) of the Act. Applicant's supporting declaration asserts that it has annually budgeted advertising expenditures of \$200,000 since 1996; that applicant has exclusively and continuously used the mark since 1996; that applicant has 6,500 subscribers, and that a substantial number of its

³ According to Office records, that registration contains a disclaimer of the term NET CARRIER.

subscribers associate the mark with the services they receive from applicant.

A mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services, or if it conveys information regarding a function, purpose or use of the goods or services. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). 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 designation is being used, and the significance the designation is likely to have to the average purchaser as he or she encounters the goods or services bearing the designation. *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary that a term describe all of the characteristics or features of the goods or services in order to be merely descriptive; it is sufficient if it describes only one of the qualities, properties or attributes of the goods or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) and *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1755 (TTAB 1991).

Upon careful consideration of this record and the arguments of the attorneys, we find that this record

adequately establishes that applicant's mark is merely descriptive of its services. The excerpts noted above use the term "Net carrier" to describe Internet service providers or Internet carriers. As noted above, because descriptiveness must be considered in relation to the relevant goods or services, the fact that the words which make up applicant's mark may be used in other contexts to describe other goods or services is irrelevant. Nor need a term describe all of an applicant's goods or services in order to be considered merely descriptive. Further, the fact that there exist third-party registrations with the word "NET" is not persuasive. Not only are these registrations for different marks, but also each case must be decided on its own facts. Thus, the third-party registrations cannot be the basis for a conclusion that "NET" in applicant's mark is not part of a merely descriptive term. We conclude that NETCARRIER is merely descriptive of at least some of applicant's services.

With respect to applicant's claim of acquired distinctiveness, we agree with the Examining Attorney that applicant's mark is highly descriptive and that, therefore, more evidence is required to show that the term has become recognized as an indication of origin for applicant's services. *In re Bongrain International Corp.*, 894 F.2d

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1316, 13 USPQ2d 1727 (Fed. Cir. 1990). Here, we have only information that applicant has 6,500 customers and an annual advertising budget of around \$200,000, but no direct evidence from purchasers that they recognize applicant's mark as an indication of origin. See *In re Swift and Company*, 217 USPQ 87, 89 (TTAB 1982). Accordingly, because applicant's mark is highly descriptive, applicant has failed to demonstrate that its mark has acquired distinctiveness.

Decision: The refusal to register is affirmed.