5/15/01

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Paper No. 12
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Petroleum Communications, Inc.

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Serial No. 75/613,912

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John S. Egbert of Harrison & Egbert for Petroleum Communications, Inc.

Andrea Koyner Nadelman, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

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Before Simms, Seeherman and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On December 28, 1998, Petroleum Communications, Inc. (applicant) filed a trademark application to register the mark FIBERWEB for services identified as "providing telecommunications services in the oil and gas industry, namely, telephone communication, cellular telephone services and electronic paging" in International Class 38.[1]

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[1] Serial No. 75/613,912. Applicant originally claimed a date of first use and first use in commerce of October 1998. However, after the Examining Attorney refused to register the mark on the ground that applicant had not used the mark in commerce prior to

The Examining Attorney refused to register the mark on the ground that the mark, when applied to the services, is merely descriptive. 15 U.S.C. § 1052(e)(1).

The Examining Attorney's position is that the mark FIBERWEB "immediately, and without conjecture or speculation, describes a significant feature or characteristic of applicant's services, namely, that they are telecommunication services that are provided through a fiber web." Brief at 7. The Examining Attorney relies on dictionary definitions, NEXIS printouts and applicant's literature to support her position.

First, the term "fiber" is defined as "a shortened way of saying 'fiber optics.'" *Newton's Telecom Dictionary* (1998), 294. A "web" refers to "a complex, interconnected structure or arrangement: a web of telephone wires." *The American Heritage Dictionary of the English Language*, (3rd Ed. 1992).

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the filing date of the application, applicant amended the application to request registration under Section 1(b) of the Trademark Act, alleging a bona fide intent to use the mark in commerce. See "Trademark Law Treaty Implementation Act Changes," 64 FR 48899 (September 8, 1999); Exam Guide No. 3-99 (October 30, 1999), § III.C.5.

Second, the Examining Attorney has submitted LEXIS/NEXIS articles that show that the term “fiber web” (highlighted in bold below) “has a recognized meaning within the communications industry.” Brief at 4.

> The fear of some cable operators and consumer groups is that the telephone industry will lean on ratepayers, a captive audience for local phone service, to build the expensive **fiber web**. *Bergen Record*, August 27, 1993, p. C01.
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> Still, the widespread **fiber web** will provide a platform capable of delivering “plain old television services,” he said. “With the cable companies moving into telephone company territory, every telephone company has to do something in defense. The analyst community views it as a positive move.” *San Diego Business Journal*, November 15, 1993, § 1, p. 1.
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> But both GTE and Pacific Bell, along with local phone companies in other states that plan to dive into the video business, face a struggle to line up programming to send over their **fiber webs**. Pacific Bell has announced no programming deals since its announcement last November that it would spend $16 billion over the next 7 years to deliver video services to 5 million homes. *Los Angeles Times*, May 25, 1994, part D, p. 1.
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> Within a few years, meanwhile, Dimension Cable is planning to use its high-capacity **fiber web** to carry a broad range of voice, data and video signals, spokesman Ivan Johnson said. Though Teleport is positioned to offer local phone service, Dimension may eventually offer some combination of cable-TV, computer data-line or phone service, Johnson said. *Phoenix Gazette*, April 6, 1995, A12.
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> Competitive access providers have arisen recently. By hiring a CAP, corporate clients sometimes slash phone bills by skirting the **fiber web** and switches of regional bells such as U S West. *Denver Business Times*, November 17, 1995, p. A26.

> A statewide electric authority wants to link its 48 members, including Marietta, through a $40 million **fiber web**. The network proposed by the Municipal Electric Authority of Georgia (MEAG Power) would provide not only an in-house communication system, but a springboard to the world. "Marietta's just the vanguard of other municipalities that want to offer some kind of telecommunications services." *Atlanta Journal and Constitution*, May 30, 1996, p.2B.

Two other articles also show use of the terms "fiber" and "web" in the communications industry.

> Sprint and MCI are the big dogs in long-distance, but they are struggling to connect their vast web of fiber to customers in local markets. *Kansas* City *Star,* January 14, 2000, p. C1.

> As the world becomes increasingly wired for the Internet, it's become more important for companies to keep track of the growing web of fiber that is in place. *The Columbian*, January 6, 2000, p. C1.

Finally, the Examining Attorney relies upon applicant's literature, which clearly refers to applicant's plans to provide telecommunication services through a fiber optic cable.

> Operators in the Gulf need the broadband coverage that only fiber can deliver. A multi-connection fiber optic will provide a high level of reliability, broad bandwidth and solid availability for users.

> FiberWeb – Subsea Fiber Optic Network in Late 1999.

> Due in late 1999, this 750 mile subsea fiber optic network will provide all digital, high-speed voice, data and video from offshore to the world.

Based on this evidence, the Examining Attorney concluded that the term FIBERWEB is merely descriptive in

relation to applicant's telecommunication services because the purchasing public will immediately comprehend the meaning of the term in relation to the services.

Applicant disagreed with the Examining Attorney's conclusion and argued that the term FIBERWEB does not immediately suggest to the consumer what the term means, but rather it requires "[a]n exercise of imagination, cognition, mental processing or gathering of further information" for consumers "to readily perceive the significance of the mark." Brief at 3. While admitting that "the word 'FIBER' could be a descriptive term" and that "the word 'WEB" could be a descriptive term," applicant alleges that the "mere combination of 'FIBER' and 'WEB' does not convey the exact nature of the goods." Reply Brief at 2.[2] Applicant further argues that the LEXIS/NEXIS printouts are not relevant because they show usage by newspaper writers, not purchasers, and that there is no evidence that "anyone has used or is using 'FIBERWEB' descriptively, in respect of the communication services of the Applicant." Brief at 4. Furthermore, applicant discusses its prior application, which is now

[2] While we will take judicial notice of the definition applicant submitted with its Reply Brief, we will not consider the LEXIS/NEXIS printouts containing articles that were not previously of record. 37 CFR 2.142(d).

abandoned, but which had been allowed, for the same mark and services, as additional support for its position that its mark is not descriptive.

After the refusal was made final, this appeal followed. Applicant and the Examining Attorney[3] have filed briefs. An oral hearing was not requested. We affirm the Examining Attorney's refusal to register applicant's mark.

We begin our analysis by noting that 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). A term may be descriptive even if it only describes one of the qualities or properties of the goods or services. In re Gyulay, 820 F.2d 1216, 1217, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). We look at the mark in relation to the goods or services, and not in the abstract, when we consider whether the mark is descriptive. Abcor, 588 F.2d at 814, 200 USPQ at 218.

The Examining Attorney's evidence demonstrates that at least some of applicant's telecommunication services will

[3] The current Examining Attorney was not the original Examining Attorney.

be performed over a fiber optic network. The Examining Attorney's dictionary definition identifies "fiber" as a shortened way of saying fiber optic. Applicant itself uses this shorthand when referring to its services ("Operators in the Gulf need the broadband coverage that only fiber can deliver"). The term "web," defined as "a complex interconnected structure or arrangement," would appear to be descriptive of applicant's "750 mile subsea fiber optic network."

In order to determine whether a term is descriptive, we must consider the mark as a whole. In this case, we do not have to speculate as to whether the individual terms retain their descriptive qualities when they are combined. The LEXIS/NEXIS evidence erased any doubts we may have had concerning the descriptiveness of the term. That evidence shows that the term "fiber web" is a term used in the communications industry. Applicant's literature claims that its "network will provide all digital, high-speed voice, data and video." The LEXIS/NEXIS evidence shows use of the term "fiber web" with voice, data and video services. For example, Dimension cable plans "to use its high-capacity fiber web to carry a broad range of voice, data, and video signals." These services would include the telephone communication services identified in applicant's

application. GTE and Pacific Bell, along with local phone companies are also planning to dive into the video business, and send programming "over their fiber webs." The Municipal Electric Authority of Georgia is linking its members through a fiber web and one of its members (Marietta) wants "to offer some kind of telecommunications service." Long distance providers, MCI and Sprint, are described as having "webs of fiber."

Therefore, when viewed in the context of applicant's telecommunication services in the oil and gas industry, the term "FIBERWEB" describes a function, feature or characteristic of the services, i.e., that the telecommunication services are conducted over a fiber web or a web of fiber.

Finally, we briefly discuss three of applicant's arguments. First, applicant emphasizes that the terms "fiber" and "web" have multiple meanings. While this is obviously true, we are only concerned with the meaning the terms may have in relation to applicant's telecommunication services. We do not view the terms in the abstract. Viewed in this context, the Examining Attorney's evidence supports the finding that the term FIBERWEB would be descriptive.

Second, applicant now points out that no story has the words “fiber” and “web” “put together as in the present mark ‘FIBERWEB’”. Reply Brief at 5. The absence of a space does not convert a descriptive term into a suggestive term. Abcor. In this case, the commercial impressions are the same with or without the space.

Also, applicant refers to a prior allowance of a now-abandoned application for the same mark and services as evidence that reasonable minds could differ about the descriptiveness of applicant’s mark. We do not have the record of that case before us, including whether the prior intent-to-use application contained the same literature that applicant submitted with this application. But in the present case, there is clear evidence that leaves us with no doubt that the mark describes applicant’s services. Under these circumstances, we must affirm the Examining Attorney’s refusal to register applicant’s mark.

Decision: The Examining Attorney’s refusal to register on the ground that the mark FIBERWEB is merely descriptive of the involved services is affirmed.