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Paper No. 12  
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re U.S. Tsubaki, Inc.

Serial No. 75/684,389

James C. Wray for U.S. Tsubaki, Inc.

M. Catherine Faint, Trademark Examining Attorney, Law  
Office 103 (Michael Hamilton, Managing Attorney).

Before Chapman, Bucher and Bottorff, Administrative  
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

U.S. Tsubaki, Inc. seeks to register on the Principal  
Register the mark E-CHAIN for "electronic catalog and  
ordering software for ordering, purchasing and tracking  
industrial roller chain," in International Class 9.<sup>1</sup>

The Trademark Examining Attorney has finally refused  
registration, under Section 2(e)(1) of the Trademark Act,  
15 U.S.C. 1052(e)(1), on the ground that applicant's mark  
is merely descriptive of its goods.

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<sup>1</sup> Application Serial No. 75/684,389, filed on April 15, 1999,  
based upon an allegation of a *bona fide* intention to use the mark  
in commerce.

Applicant has appealed. Both applicant and the Trademark Examining Attorney have filed briefs, but applicant did not request an oral hearing. We affirm the refusal to register.

The Trademark Examining Attorney takes the position that the "E-" prefix stands for "electronic," which is descriptive of applicant's electronic software. Applicant's catalog and ordering software exists solely to market various "industrial roller chain(s)." Hence, the Trademark Examining Attorney finds that the word "chain" is descriptive of this software product. Further, the Trademark Examining Attorney concludes that the combination of these terms, E-CHAIN, is descriptive of the identified goods. She points out that the record demonstrates that third-party manufacturers and merchants who are competing with applicant provide online ordering, purchasing and product tracking systems similar to those listed in applicant's identification of goods.

On the other hand, applicant argues that while this combined term may well be suggestive of these goods, it is not merely descriptive of them; that there is no evidence that any third parties are currently using this term for similar goods or services; and that even if "E-" means "electronic" in this context, and conceding that the word

"chain" points unmistakably to the underlying goods herein, industrial roller chains, that applicant's composite mark, E-CHAIN, is more than the sum of its parts. Applicant makes the point that E-CHAIN is an incongruous combination of terms that requires imagination and thought to determine the nature of applicant's services:

E-CHAIN is not descriptive of the goods. E has nothing to do with CHAIN. One part, E, is ethereal (sic); the other, CHAIN, is as hard as heavy steel goods can be.

In summary, the Trademark Examining Attorney and applicant agree that separately, one can make the argument that "E-" and "chain" might each be descriptive of these goods. However, applicant and the Examining Attorney disagree, when the two terms are combined to create "E-CHAIN," whether the composite term is merely descriptive under Section 2(e)(1) of the Lanham Act.

The test under the Lanham Act for determining whether a mark is merely descriptive to whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979); In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986). It is not necessary, in order

to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. In re Venture Lending Associates, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. In re Recovery, 196 USPQ 830 (TTAB 1977).

In support of her refusal in the instant case, the Trademark Examining Attorney cited to several recent decisions where "E-" marks have been held to be descriptive. See Continental Airlines v United Air Lines, 53 USPQ2d 1385 (TTAB 2000) [E-TICKET is merely descriptive as an abbreviated form of "electronic ticketing."]; and In re Styleclick.com Inc., 57 USPQ2d 1445 (TTAB 2000) [E-FASHION is merely descriptive for software for providing fashion information, software for purchasing goods as well as the service of providing the goods].

Applicant attempts to distinguish these cases, arguing, for example, that E-TICKET was found to be an

abbreviated form of "electronic ticketing," and that there is no similar term to be abbreviated in the instant case.

We know that in considering a combined term such as E-CHAIN, we must determine the impact of the combined term as a whole on the average purchaser of the involved goods or services. See In re Recovery, *supra*.

The record shows that clearly the ubiquitous "E-" shorthand is derived from the word "electronic." However, in practice, "E-" prefix words have universally come to refer to the Internet. In this regard, we take judicial notice of the following definition from the *Official Internet Dictionary* (1998): "e- An abbreviation of "electronic" that generally indicates information or functions involving the Internet." Our own reported decisions, *supra*, suggest that when "E-" refers to goods or services available "online," it is devoid of any source-indicating significance. In the context of this case, adding "E-" as the prefix to the descriptive word CHAIN as applied to software for procuring roller chains does not create a distinctive composite.

Hence, "E-" prefix terms now convey specific information about the manner in which the goods and/or services are provided. The fact that the "E-" prefix had its origins as a simple abbreviation for the word

"electronic" is not critical to our current analysis. Today, in ordinary parlance, as in trademark and service mark usage, the "E-" prefix has become an informational placeholder. This is analogous to the information communicated, for example, by the "1-800" prefix within vanity telephone numbers *qua* service marks. In the latter case, a mark having the initial structure of "1-800 ... " signifies to prospective purchasers that the service mark also functions as a toll-free telephone number. *Cf. In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)) [Applicant's "1•888•MATRESS" mark is merely descriptive of applicant's service offering mattresses by telephone because it immediately conveys the impression that a service relating to mattresses is available by calling the telephone number].

As noted above, applicant argues that putting the ethereal, cyberspace "E-" in front of a noun representing durable goods made of steel is jarring and incongruous. However, we disagree with applicant's suggestion that in order to affirm the Trademark Examining Attorney, the term "electronic chain" must be a meaningful concept in and of itself. A term need not name the goods or services in order to be found to be merely descriptive; it is merely descriptive if it describes a feature, function or purpose

of the goods or services. The combination of "E-" and "CHAIN" is not incongruous as applied to software for use in the electronic ordering of chain.

We hasten to add that this holding does not represent a *per se* rule that any mark beginning with "E-" is automatically descriptive. However, if the mark is used in connection with goods or services involving electronic commerce, and the matter that follows the "E-" prefix is merely descriptive of the goods or services, the resulting composite is generally merely descriptive as well.

Decision: The refusal to register is affirmed.