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**THIS DISPOSITION
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Paper No. 11
EJS

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Northridge Cellular, Inc.**

Serial No. 75/687,288

Anthony O. Cormier for Northridge Cellular, Inc.

Linda E. Blohm, Trademark Examining Attorney, Law Office
110 (Chris A. F. Pedersen, Managing Attorney).

Before Seeherman, Hanak and Walters, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Northridge Cellular, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register 2-WAY WIRELESS as a mark for "retail store services featuring cellular telephones, pagers, and wireless equipment and accessories therefor."¹ Registration has been refused pursuant to Section 2(e)(1) of the Trademark Act,

¹ Application Serial No. 75/687,288, filed April 19, 1999, and asserting a bona fide intention to use the mark in commerce.

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15 U.S.C.. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its services.

The appeal has been fully briefed, but an oral hearing was not requested.

We affirm the refusal of registration.

A mark is merely descriptive if it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of a product or service.

In re Venture Lending Associates, 226 USPQ 285, 286 (TTAB 1985. See also, **In re Gyulay**, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

The evidence of record, consisting of articles taken from the NEXIS database and third-party registrations, show that "2-WAY WIRELESS" is a descriptive term for, inter alia, pagers and cellular telephones. See, for example, the following NEXIS excerpts:²

When a lender wants to order a broker price opinion, appraisal, or look at a photo, the two way wireless pagers and e-mail features speed up that process.
"Mortgage Technology," March 2000

Metrocall, with 6 million customers, and its partners are betting that Internet access on two-way wireless pagers...
"The Washington Post," February 7, 2000

² See, also, Registration No. 2,006,525 for one-way and two-way wireless personal communications devices, namely, pagers, mobile telephones and wireless modems.

BellSouth Wireless Data LP is using 'Rbco Software Inc's enterprise application integration technology to link the systems... that help it set up two-way wireless pagers for new customers.

"Informationweek," December 6, 1999

In South America, Africa, Asia, and many island countries, cellular and PCS phones are the only solution because an infrastructure of wired communications services does not exist. Almost half of all new sales of two-way wireless equipment will be in these areas.

"Electronic Buyers' News," January 8, 1996

Newton source, retailer of Apple Computer Inc's MessagePads, Newton personal digital assistant technology and two-way wireless communications products and services, opened a new store May 10 in Chicago.

"Wireless Week," May 20, 1996

Applicant does not dispute that 2-WAY WIRELESS is merely descriptive of the goods to be sold in its retail stores. Indeed, applicant acknowledges that "the phrase describes two characteristics of certain radio products."

Brief, p. 3.

However, it is applicant's position that 2-WAY WIRELESS is not merely descriptive of its retail store services because it is not the generic name of any product sold in applicant's stores. Applicant points to **In re France Croissant, Ltd.**, 1 USPQ2d 1238 (TTAB 1986) and **In re**

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Pencils, Inc., 9 USPQ2d 1410 (TTAB 1988) as standing for the proposition that "when the mark under consideration is for retail services and the mark makes reference to the products sold in those stores, if the entire mark is nothing more than the generic name for the products, registration will not be allowed." Brief, p. 3. Applicant extrapolates from these cases that if the mark is not the generic name for the products, it is registrable even if it describes a major characteristic of the products.

In France Croissant the Board found LE CROISSANT SHOP and design to be merely descriptive of restaurant services, noting that, as stated in **In re Le Sorbet, Inc.**, 228 USPQ 27 (TTAB 1985), a mark for restaurant services which comprises the generic name of a food which is the specialty of the house is merely descriptive of the restaurant services. The Board also found, in the Pencils case, that the word PENCILS was merely descriptive of one of the items sold in retail stationery and office supply stores.

However, although these cases stand for the proposition that marks which are the generic terms for items sold through the stores are merely descriptive of the retail store services, we cannot agree with applicant's corollary conclusion, namely, that if the mark is not the generic name for the goods which are sold, the mark cannot

be merely descriptive of the retail store services. On the contrary, marks which describe a characteristic of the goods sold through an applicant's retail store services have been found to be merely descriptive. See, for example, **In re Anania Associates, Inc., aka, Off the Rack**, 223 USPQ 740 (TTAB 1984), which held OFF THE RACK merely descriptive of retail men's apparel store services, and **In re Melville Corporation**, 228 USPQ 970 (TTAB 1986), which held BRAND NAMES FOR LESS merely descriptive of retail store services in the clothing field. And, more recently, the Court of Appeals for the Federal Circuit found that 1-888-M-A-T-R-E-S-S was merely descriptive of telephone shop-at-home services in the field of mattresses. The Court concluded this because the mark immediately conveys the impression that a service relating to mattresses is available by calling the telephone number. The Court never made a finding that 1-888-M-A-T-R-E-S-S is a generic term for the goods sold through applicant's services although, if applicant's position were correct, such a conclusion would have been necessary to support the finding that 1-888-M-A-T-R-E-S-S was merely descriptive.

In view of the foregoing, we reject applicant's contention that a mark for retail store services can be

found merely descriptive only if it is the generic name of the goods sold by the retail store.

Applicant has also cited certain other cases, including **Magic Wand, Inc. v. RDB, Inc.**, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991) and **In re Seats, Inc.**, 757 F.2d 274, 225 USPQ 364 (Fed. Cir. 1985) for the proposition that "the fact that a word is descriptive of a characteristic of products sold at applicant's store is not a circumstance that, by itself, constitutes a bar to registration." Brief, p. 3. However, these cases do not support the proposition for which they are cited. Neither the Magic Wand nor the Seats cases involved the question of whether the involved term was merely descriptive. In Magic Wand, the petition for cancellation was brought more than five years after the issuance of the registration, and therefore mere descriptiveness was not a ground. In Seats, the issue was genericness and/or whether the mark was registrable under the provisions of Section 2(f) of the statute (acquired distinctiveness).

In conclusion, it is not necessary, in order to support a finding of mere descriptiveness, that the Patent and Trademark Office show that the applied-for mark is a generic term for the goods sold through the retail store services. In this case, the Office has met its burden of

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proving that the mark is merely descriptive by showing that 2-WAY WIRELESS immediately conveys information about a characteristic of the goods applicant sells through its "retail store services featuring cellular telephones, pagers, and wireless equipment and accessories therefor." Accordingly, the mark is merely descriptive of these services.

Decision: The refusal of registration is affirmed.