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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 Harry V. Lehmann

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Serial No. 75/222,870

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Mark C. Comtois Esq. for Harry V. Lehmann.

Steven R. Berk, Trademark Examining Attorney, Law Office  
102 (Thomas Shaw, Managing Attorney).

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Before Simms, Chapman and Rogers, Administrative Trademark  
Judges.

Opinion by Simms, Administrative Trademark Judge:

Harry V. Lehmann (applicant) has appealed from the  
final refusal of the Trademark Examining Attorney to  
register on the Principal Register the mark PHRASESCAN for  
"computerized online retail ordering services in the field  
of books, publications, excerpted text, and non-textual

images.”<sup>1</sup> Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

The Examining Attorney has refused registration under Section 2(e)(1) of the Act, 15 USC §1052(e)(1), arguing that applicant’s mark PHRASESCAN is merely descriptive of his services.

Before discussing the respective arguments of applicant and the Examining Attorney, it will be helpful to briefly discuss the nature of applicant’s services. According to applicant, a customer accessing applicant’s Web site is presented with a list of materials, such as books, by title and author. If a particular book title is selected, one is led to applicant’s summary of the book. Certain words and phrases used by applicant in that summary are hyperlinked to certain passages in the book itself-- that is to say, if one clicks on a particular word or phrase, that leads the customer to the relevant passage from the book. A customer does not type in a word or phrase into the search feature of applicant’s Web site. Rather, the selection of a word or phrase in a particular summary leads one to a particular passage from the book.

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<sup>1</sup> Application Serial No. 75/222,870, filed January 8, 1997, based upon applicant’s allegation of a bona fide intention to use the mark in commerce.

The Examining Attorney argues that the combination of the merely descriptive words "PHRASE" and "SCAN" does not create a new and different term which has an incongruous meaning in connection with applicant's services. Rather, the Examining Attorney argues that when one uses applicant's services, scanning of phrases occurs, either by the user or by applicant. The Examining Attorney contends that applicant's services offer the customer the ability to scan a book summary through a hyperlinked phrase. Because scanning refers to the sequential searching of a file for specific content (according to a dictionary definition of record), and because a user is directed to certain passages in a piece of text by means of phrases which are scanned and/or pre-scanned to facilitate the review of textual material, the asserted mark merely describes applicant's services, according to the Examining Attorney. In other words, inasmuch as "phrase" refers to a small number of words and because the term "scan" refers to the sequential review that occurs or has occurred as a result of using applicant's services, the Examining Attorney argues that applicant's mark is merely descriptive of his services. The Examining Attorney has submitted a number of excerpted stories retrieved from the Internet and from the Nexis database to demonstrate that the scanning of phrases is a

common function of computer search systems. Some of these excerpts are set forth below.

...With a computer program of his own design, he scanned lists of phrases showing the same patterns of letters...  
The Advocate (Baton Rouge), December 1, 2000

MailSite can scan all of the usual headers...but can also scan the message body for words and phrases...  
Network World, November 27, 2000

"MIMESweeper's word and phrase scanner means businesses can apply Lexical Scanning technology to their own needs..."  
Information Security, October 1998

...A software program that, after the user enters a key word or phrase, scans the Internet and suggests relevant Websites to explore...  
Medical Marketing & Media, November 1997

...Simply put, a search engine is a little program that takes input from a user, such as keywords or phrases, and scans a big database of web page descriptions for terms matching the input...  
News & Record, September 15, 1997

I tried two portable handheld scanners...Each is about the size of a husky highlighter [sic] pen. They scan in words or phrases and then attempt to translate them into a foreign language...  
Computerworld, November 29, 1999

Some of this software blocks messages from flowing in or out of a company's e-mail system if they contain any of a predefined list of objectionable words

or phrases. Other programs scan e-mail headers...

New York Law Journal, August 23, 1999

...There is software that scans documents for keywords. SRA's product, though, scans for specific phrases and context used by the securities industry.

Investor's Business Daily, September 17, 1998

The biotech firm, for instance, may scan for the phrase "DNA sequencing" in resumes of candidates applying for a research associate or scientist position...

The Times Union (Albany, NY), July 1, 1998

Applicant, on the other hand, argues that applicant's services do not involve the scanning of phrases. While the mark PHRASESCAN may immediately indicate the scanning of a database file to locate a phrase, applicant argues that this is not how his services work. Applicant contends that his mark does not immediately inform potential customers that they may locate a particular passage in the book by hyperlinks from words or phrases used in applicant's summary. Nor does applicant "scan" the database for a particular word or phrase from the book summary selected by the customer. The fact that certain words or phrases used by applicant in his summary will be hyperlinked to pre-selected passages in the work does not mean that the text

is scanned to find pre-selected phrases, applicant maintains. Applicant further explains:

[W]ords not necessarily appearing in the text of the work are hyperlinked to passages...in the text which do not necessarily include the words of the hyperlink. It will thus be common for a phrase like "the moonlight walk" as used in a customized summary to be hyperlinked to a passage which states "When the couple reached the beach, the moon appeared from behind the clouds and silouetteed [sic] the old wreck. As the couple continued their stroll along the beach..." As so used, the mark may be suggestive of a scan of the work for the related passage. However, it cannot be descriptive since the work is not scanned, *a fortiori* is not scanned for a particular phrase used in the work.

Further, applicant argues that none of the articles submitted by the Examining Attorney relate to computerized online retail ordering services.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. See, for example, *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term

Serial No. 75/222,870

describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive. Rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of such use. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Upon careful consideration of this record and the arguments of the attorneys, we conclude that the Examining Attorney has not carried his burden of demonstrating that applicant's mark is merely descriptive of his services. It is clear that applicant's book ordering and other services entail the review of a book summary composed by applicant with certain words or phrases in that summary being hyperlinked to actual text in the book. First, we do not

Serial No. 75/222,870

believe that the user of applicant's services can be said to scan phrases of applicant's book summaries or passages. A user is merely reading a book summary and selecting a word or phrase in order to be led to the actual book passage. Nor, as explained by applicant, does it appear that applicant's services involve a search engine scanning for phrases in a search for certain information in a computer database. Applicant's services involve merely the selection by the potential customer of a word or phrase in applicant's book summary, after which the customer is led to the pertinent book passage. The use of applicant's services does not offer one the ability to scan a database for a particular phrase. On this record, the asserted mark does not, therefore, merely describe the nature or function of applicant's computer ordering services.

While we conclude that this record is not sufficient to support a holding that applicant's mark is merely descriptive of his services, when applicant submits specimens of use with his statement of use, if the Examining Attorney believes, upon review of that material, that applicant's mark is indeed merely descriptive of his services, the Examining Attorney is not precluded from again refusing registration on this ground, if appropriate.

Decision: The refusal of registration is reversed.