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Mailed:
October 10, 2002

Paper No. 12
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Simple.Com, Inc.

Serial No. 75/752,279

Erik B. Cherdak of Erik B. Cherdak & Associates, LLC for
Simple.Com, Inc.

Danielle I. Mattessich, Trademark Examining Attorney, Law
Office 101 (Jerry L. Price, Managing Attorney).

Before Hairston, Bucher and Drost, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Simple.Com, Inc. seeks to register the mark SITE
ENGINE on the Principal Register in connection with
"computer services, namely, providing online content
retrieval services for obtaining data on a global network,"
in International Class 42.¹

This case is now before the Board on appeal from the
final refusal to register based upon three separate
grounds: (1) that applicant's recital of services is

¹ Application Serial No. 75/752,279, filed on July 15, 1999,
is based upon applicant's allegation of a *bona fide* intention to
use the mark in commerce.

indefinite and unacceptable; (2) that applicant has not properly designated a domestic representative; and (3) that SITE ENGINE is merely descriptive under Section 2(e)(1) of the Lanham Act, 15 U.S.C. §1052(e)(1).

Both applicant and the Trademark Examining Attorney have fully briefed the case. Applicant did not request an oral hearing before the Board.

We reverse as to the first ground, but affirm as to the latter two grounds of the refusal to register.

Recital of Services

At the time this application was filed in July 1999, the original recital of services read as follows:

Internet and World Wide Web (WWW) site
search engine and content retrieval
services.

The Trademark Examining Attorney found this to be indefinite, suggesting instead:

Computer services, namely, providing search
engines for obtaining data on a global
computer network.²

The applicant responded by amending the recital to:

Computer services, namely, providing
categorized content such as news content and
sports content on a global computer network.

² This recital is drawn verbatim from the ID Manual.

The Trademark Examining Attorney found this too to be unacceptable inasmuch as she held "... providing categorized content such as news content and sports content ... " was not within the scope of "content retrieval services."³

Applicant then asked that the recital be changed to:

Computer services, namely, providing online content retrieval services for obtaining data on a global network.

The Trademark Examining Attorney found this formulation to be indefinite,⁴ and suggested again the language quoted above.

On appeal, applicant contends that its last recital is definite and acceptable.

In order to decide if applicant's last recital should be found to be acceptable, we turn to "General Guidelines for Acceptable Identifications of Goods and Services."⁵

³ While it is not immediately clear why this proposed amendment would be characterized as broadening the recital, because this earlier amendment is no longer before us, we do not need to decide this particular issue under Trademark Rule 2.71(a).

⁴ On page 6 of her brief, the Trademark Examining Attorney treats the services as if applicant intends to *provide content* - not *content retrieval*. She maintains that "content providers" must list the subject matter of the information provided so as to classify the service correctly and narrow the scope of protection. Indeed, if applicant were a "content provider" or intended to offer information services, we would need to have additional details about the field or the subject matter of the content, as these factors affect classification determinations (TMEP 1402.11(a) Computer Services: "Content Providers"; and TMEP 1402.11(b) "Information Services").

⁵ Examination Guide No. 3-00, issued on October 31, 2000; since incorporated into TMEP §1402.01(a).

With few exceptions, an identification of goods and services will be considered acceptable if it:

- Is written in English
- Describes the goods and/or services so that an English speaker could understand what the goods and/or services are even if the grammar or phrasing is not optimal
- Meets the standards (not necessarily the language) set forth in the US ID Manual
- Is not a class heading
- Is in the correct class

Deference should be given to the language and the classification set forth by the applicant in the original application. ...

Applicant's recital of services, as last amended ("Computer services, namely, providing online content retrieval services for obtaining data on a global network"), is written in English and does not function as a class heading in the Nice Classification system. As to classification, applicant did not actually designate a class in the initial application papers, but the Trademark Examining Attorney, in her first Office action, suggested that International Class 42 was the correct classification for these services. That indeed appears to be the proper classification for these services as originally filed and as amended.

On the other hand, unlike the language proposed by the Trademark Examining Attorney, the exact language proposed by the applicant does not appear in the USPTO's ID Manual.

Accordingly, judged by the standards of the ID Manual, we must determine whether the recital as proposed by applicant provides enough clarity to permit one to understand the nature of applicant's services.

Applicant and the Trademark Examining Attorney are in agreement that we are considering herein computer services designed to obtain information from the Internet. There is also no issue but that a key feature of this service is that it provides the user access to another search engine or browser.⁶ That leaves the question of whether "content retrieval" has a commonly understood meaning in connection with applicant's affected services, or contrariwise, whether it is indefinite in this context, as argued by the Trademark Examining Attorney:

⁶ Applicant's proprietary search engine is an indispensable tool in providing its services. Yet applicant never explicitly stated its semantic concerns over the Office's proposed language of "*providing search engines.*" Technically, it does seem that applicant has a *single search engine*, not *engines*. Furthermore, it is available only through applicant's website. That is, applicant merely provides *access* to the online functionalities of its search engine for the Internet user, so that the user of this service can search for, and retrieve information from, the Internet. See screen print from www.simple.com. We have no reason to believe that the search engine *qua* proprietary software is *provided* to the end-users. Of course, that would be true of most service providers having a search engine portal who apparently have accepted the Office's recital language, including that of "*providing search engines.*"

On the other hand, it seems that if applicant's recitation of the services offered is otherwise acceptable, naming the specific tool that makes these service possible (i.e., the search engine) may well be helpful, but should not be a requisite feature of the recital.

The recitation of services as drafted by the applicant could include the following services, among many others: "computer services, namely, providing search engines for obtaining data on a global computer network, in International Class 42," "providing information at the specific request of end-users by means of global computer networks, in International Class 42," or "providing customized online web pages featuring user defined information, which includes search engines and online web links to other's web sites, in International Class 42." (Trademark Examining Attorney's appeal brief, pp. 5-6).

Because the exact term, "content retrieval," does not appear in any computer dictionary that we could find, we have no evidence that it is presently a term of art in the field of personal computing. Nonetheless, we have consulted a number of computer dictionaries to determine the current understanding of the components of this term:

Content: general term that refers to information or text provided by a publisher that is useful to or of interest to a user, Dictionary of Personal Computing and the Internet, (2nd Ed. 1998).

Content: A jargon term used in the computer and entertainment industries to collectively describe the words, pictures, music, speech or film that is placed on a WEB SITE or delivered over a TV channel - that is, the stuff that has to be purchased from non-suit-wearing "creative" types. The New Penguin Dictionary of Computing, Dick Pountain (2001).

Retrieve: To extract an item of data from some storage device or data structure, The

New Penguin Dictionary of Computing, Dick Pountain (2001).

Retrieve: To find a piece of data and bring it to an active application... Computing Dictionary: PC Novice Learning Series (Winter 1996).⁷

Consistent with the meaning of these individual words, applicant offers its customers a generalized search and retrieval capability to get to Internet content. As seen from screen prints made a part of this record, it resembles other Internet search engines. In addition to having the option of typing in a known URL, it has metasearch capabilities (using a number of other extant search engines). In a variation on other search engines, applicant's engine features a template having three standard drop-down boxes that requires no typing for operation. Applicant claims that this eliminates excess information provided by other search engines and takes the user exactly where they want to go -- directly to applicant's commercial sponsors. See screen print from www.simple.com.

⁷ Although such definitions were not of record, it is settled that the Board may properly take judicial notice of dictionary definitions. See Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852, 860 (TTAB 1981) at n. 7.

However, applicant's competition herein appears to be other online search engine portals designed to retrieve and display a range of online content from the Internet. There is certainly no indication that applicant contracts with end-users to formulate and then conduct a search on their behalf. Nor is this an automated system that is capable of taking unstructured content from pre-defined web sites, structuring the content, and saving it into the end-user's database or web page. None of applicant's proposed recitals and none of the evidence in the file supports anything more involved than permitting users to search for, and retrieve information from, the Internet.

In short, we find that applicant's "providing online content retrieval services," without more, means much the same thing as the Trademark Examining Attorney's "providing search engines."

Accordingly, even if applicant's proposed recital is not the model of optimum clarity, we find that applicant's last proposed recital of services meets all the requirements of an acceptable recital, and on this issue, we reverse the Trademark Examining Attorney's refusal to register.

Designation of domestic representative by foreign applicant

We turn now to the second ground for refusal of registration.

The original application papers, in addition to the required jurat, also contain a "Power of Attorney" providing for applicant's counsel to "prosecute this application and to transact all business" before the United States Patent and Trademark Office. The Trademark Examining Attorney repeatedly refused to accept this as a designation of domestic representative and applicant repeatedly asked that it be found acceptable for that very purpose.

With applicant's response of February 12, 2000, we learn that applicant is a Nevada corporation. However, even U.S. corporations having a foreign address must file a document designating the name and address of a domestic representative on whom may be served notices or process in proceedings affecting the mark. 15 U.S.C. §1051(e); 37 C.F.R. §2.24. Because applicant failed to designate a domestic representative in the original application, the Trademark Examining Attorney correctly required such a designation in her first Office action.

As noted by the Trademark Examining Attorney, the designation of a domestic representative is not the same as

a power of attorney. The language of applicant's power of attorney does not specifically state that applicant intends to designate Mr. Cherdak as a domestic representative upon whom notices or process affecting the mark may be served.

Hence, we agree with the requirement of the Trademark Examining Attorney on this point, and affirm the refusal to register herein as a result.

Mere Descriptiveness

The Trademark Examining Attorney also refused registration of this application on the ground that applicant's SITE ENGINE mark is merely descriptive when used in connection with the identified services. She argues that applicant has combined two highly descriptive terms to create a new term that merely describes the nature of applicant's services. In support of her position, the Examining Attorney submitted the following dictionary definitions:

Site: See WEB SITE. Dictionary of Personal Computing and the Internet, (1st Ed. 1997).

Engine: part of a software package that carries out a particular function; for example, a search engine is the part of a multimedia title that lets a user search for text in a multimedia book. Dictionary of Personal Computing and the Internet, (1st Ed. 1997).

The dictionary definition of "site" points to "Web Site" - a location on the World Wide Web. Moreover, as seen in this computer dictionary entry, the definition of "engine" alone mentions as an example of an engine a "search engine" - the fundamental tool of applicant's affected services herein.

In addition to dictionary entries, the Trademark Examining Attorney submitted with the first Office action excerpts of articles retrieved from the Lexis/Nexis database. However, of the five Nexis excerpts attached to this initial Office action, four were drawn from newswire service stories, and hence offer little probative value in determining the alleged descriptive connotation of the term to consumers in the United States. These brief "hits" add nothing to the record beyond the fact already established by the dictionary entries that in the current context, "site engine" is virtually synonymous with "website engine."

With the continuing refusal of June 16, 2000, the Trademark Examining Attorney attached a printout she retrieved from the Webopedia site for the term "Search Engine":

A program that searches documents for specified keywords and returns a list of the documents where the keywords were found.

Although *search engine* is really a general class of programs, the term is often used to specifically describe systems like Alta Vista and Excite that enable users to search for documents on the World Wide Web and USENET newsgroups.

Typically, a search engine works by sending out a spider to fetch as many documents as possible. Another program, called an indexer, then reads these documents and creates an index based on the words contained in each document. Each search engine uses a proprietary algorithm to create its indices such that, ideally, only meaningful results are returned for each query. (emphasis in original).

http://webopedia.internet.com/TERM/s/search_engine.html .

This Webopedia site also has fourteen additional web sites with brief summaries of those related sites and hyperlinks to these sites.

Finally, with the final Office action of September 7, 2001, the Trademark Examining Attorney submitted thirty-five additional excerpts of articles retrieved from the Lexis/Nexis database, of which sixteen lacked probative value inasmuch as they were foreign publications and/or newswire service stories. Several articles selected by the Trademark Examining Attorney referred to automobile engines or a variety of engines in the oil and gas industry. Of the balance, the following are representative examples:

The eOne Group may never overtake IBM, but if its new Web site engine succeeds the 18-month-old company may one day be taken over by the computer giant.

...
... As the only Web site engine based solely on the Java programming language, which is becoming an Internet standard, it's compatible with most other computer ... ("Techno Stars eOne Group," Omaha World Herald, December 31, 2000).

As for the site itself, "the site engine is already built and in the hands of traders for testing," Narea said... ("Two Loan Trading Sites expect Launch soon," Bank Loan Report, June 19, 2000).

Such high usage is not peculiar to CE. Site engines commonly garner between 20 and 50 percent of all scripts, said Kris Carpenter, product manager for Excite ... ("Search Engines Seen as Key Site-Navigation Tools," Internet World, September 22, 1997).

Articles like the last two clearly use "site engine" alone to mean "website engine" (where the word "Web" or "web" does not immediately precede the words "site engine(s)"). The last article, which quotes a manager of Excite, makes it clear that the author is not referring to just any software functionality, but means specifically "website search engines." Hence, we find that to the extent it is clear that applicant's services depend upon a website search engines, then the designation "Site Engine" would appear to be highly descriptive of the recited services. Accordingly, we affirm the refusal of the Trademark Examining Attorney to register on the ground of the merely descriptive nature of the mark.

Decision: We reverse the Trademark Examining Attorney as to the requirement for a new recital of services. We affirm the requirement for the designation of a domestic representative and the refusal to register because the matter is merely descriptive.