

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

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HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re F. Merrill Matlovich, dba iCam Productions

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Serial No. 75/795,272

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David L. Garrison of Garrison & Associates PS  
for F. Merrill Matlovich.

Maria-Victoria Suarez, Trademark Examining Attorney, Law  
Office 102 (Thomas V. Shaw, Managing Attorney).

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Before Seeherman, Hohein and Wendel, Administrative  
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

F. Merrill Matlovich, dba iCam Productions, has filed  
an application to register .SEX for "computerized online  
retail store services bringing together, for the benefit of  
others, a variety of adult oriented products, namely, adult

novelties and toys, marital aids, erotica, and lingerie available via a global computer network."<sup>1</sup>

Registration has been finally refused under Section 2(e)(1) on the ground that the mark would be merely descriptive, if used in connection with applicant's recited services. The refusal has been appealed and both applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

The Examining Attorney maintains that, when applied to applicant's online retail store services featuring "adult-oriented" products, the term SEX immediately describes a feature or characteristic of these services, i.e., that the products intended to be sold are sexual in nature. As evidence of the descriptiveness of the term "sex" when used in this manner, the Examining Attorney has made of record copies of several third-party registrations in which the term SEX has been disclaimed when used as part of a mark for sexual-related goods and services.

The Examining Attorney further argues that the addition of the period or dot to the term SEX does not detract from the descriptiveness of the mark as a whole. She insists that the public will recognize .SEX as

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<sup>1</sup> Serial No. 75/795,272, filed October 4, 1999, based on an allegation of a bona fide intention to use the mark in commerce.

signifying an adult-oriented website. In addition, she points out, as shown from excerpts of articles retrieved from the Nexis database, the designation .sex has been proposed as a future TLD (top level domain) for adult-oriented sites. Thus, she argues, "to the extent potential consumers view the mark as a TLD, the mark clearly names the nature of the website provided by the applicant." (Brief p. 4).

Applicant contends that the Examining Attorney has improperly dissected the mark and ignored an important element, namely the dot proceeding the letters SEX.<sup>2</sup> Looking to the mark as a whole, applicant argues that, although .SEX might reasonably "suggest that the services with which it is associated has [sic] to do with products and services having a sexual connotation" and that, although the dot "might also suggest, to the perceptive observer, that it has to do with computer based activities and services," the mark is not merely descriptive of applicant's services. (Brief p. 2). The mark, according to applicant, requires the exercise of imagination in order to come to a conclusion as to the nature of these services.

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<sup>2</sup> While stressing that the mark should be considered as a whole, applicant has, in its brief, offered to make a disclaimer of the word SEX apart from the composite mark, if found to be appropriate.

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a significant characteristic or feature of the services with which it is being used, or is intended to be used. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Whether or not a particular term is merely descriptive is determined not in the abstract, but rather in relation to the services for which registration is sought, the context in which the designation is being used, and the significance the designation is likely to have to the average purchaser as he or she encounters the services bearing the designation, because of the manner in which it is used. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).

We are fully convinced that the connotation of the term SEX, when used in connection with retail store services specializing in the variety of adult oriented products intended to be offered by applicant, would be readily and immediately understood by the average purchaser of these types of products. Applicant's products are sexual in nature and the term SEX clearly conveys this information.

Moreover, we fail to see how the addition of a dot to the term SEX, resulting in .SEX, raises the designation as a whole above the level of mere descriptiveness. As pointed out above, the issue of mere descriptiveness is not determined in the abstract, but rather in relation to the particular services with which the mark is being used, or is intended to be used. Applicant's services are online retail store services made available via a global computer network. In other words, the retail services are offered over the Internet. The use of a dot in Internet addresses is certainly familiar to all potential purchasers. Although applicant is using the dot as part of its mark, and not as an address, the implication that this is an Internet-related service is clearly conveyed to purchasers. There is no element of suggestiveness here, as argued by applicant. There is no need to exercise any imagination in order to come to a conclusion as to the nature of the products and the manner in which the products are made available when the designation .SEX is, or will be used, in connection with the online retail store services of applicant in which a variety of adult oriented products are offered. If perchance there are some potential purchasers who would not perceive the dot as an indication of an Internet-related service, we believe to such purchasers the

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dot would simply be seen as a punctuation mark with little or no trademark significance.

Although we find no need to consider the potential use in the future of .sex as a TLD for adult-oriented sites in order to uphold this refusal, we note that this is yet another indication of the merely descriptive nature of the designation when used in connection with adult oriented goods or services made available via a global computer network.

Accordingly, we find .SEX is merely descriptive, if used as intended with applicant's online retail store services featuring adult oriented products.

Decision: The refusal to register under Section 2(e)(1) is affirmed.

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