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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Hearing:
November 12, 2002

Paper No. 20
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Stephens Media Intellectual Property, LLC

Serial Nos. 75/712,211, 712,212 and 712,213

Steven A. Gibson of Santoro, Driggs, Walch, Kearney,
Johnson & Thompson for Stephens Media Intellectual
Property, LLC.

Michael W. Baird, Trademark Examining Attorney, Law Office
109 (Ronald R. Sussman, Managing Attorney).

Before Cissel, Walters and Bottorff, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

The above-referenced applications were filed on May
24, 1999 by DR Partners, a partnership organized and
existing under Nevada law. All three applications were
subsequently assigned to Stephens Media Intellectual
Properties, LLC, prior to the filing of the Notice of
Appeal. The marks in these use-based applications (in
ascending file-number order) are as follows:

lasvegas.com
one city. one site.

LASVEGAS.COM
ONE CITY. ONE SITE.

and

LASVEGAS.COM

As amended, the recitations of services are all as follows:
"providing online websites featuring information such as
that generally found in daily newspapers, as well as
information in the fields of news, politics, public policy,
and technology." All three applications are before the
Board on appeals from final refusals based on the Examining
Attorney's holding that the terminology "LASVEGAS.COM" is
merely descriptive in connection with the recited services.
In the first two applications, the Examining Attorney
required disclaimers of this terminology under Section 6 of
the Lanham Act, and in the other application, seeking
registration of the term by itself, he refused registration
under Section 2(e)(1) of the Act on the ground of
descriptiveness.

The records and the issues are essentially identical in each of these applications, so after the appeals were instituted, they were consolidated. The briefs submitted by applicant and the Examining Attorney dealt with all three applications, and at the oral hearing before the Board, all three appeals were argued. This opinion explains our reasoning with respect to all three. Applicant does not dispute the fact that if we find the term to be merely descriptive in connection with the services recited in these applications, the refusal to register in the application for the term by itself must be affirmed and the requirements for disclaimers in the other two applications also must also be affirmed.

The sole issue in these appeals is therefore whether "LASVEGAS.COM" is merely descriptive of the services set forth in the amended applications. Based on careful consideration of the records in the applications, the arguments of applicant and the Examining Attorney and the relevant legal precedents, we hold that it is, and therefore that the refusals to register must be affirmed.

The records include evidence submitted by both applicant and the Examining Attorney. The specimens of use submitted with the application as filed are copies of the page from applicant's website. The main headings include

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"Visit Las Vegas," "Living in Las Vegas" and "Move to Las Vegas." A line at the bottom of this page shows that the website is "brought to you by the Las Vegas Review-Journal."

Responsive to the first Office actions, applicant submitted several advertisements from its website which are not related to Las Vegas. On each page where such an advertisement appears, however, there is other information directly related to Las Vegas, e.g., promotion of the "Las Vegas Senior Classic" golf tournament; a horse jumping competition which is "headed to Las Vegas, the Entertainment Capitol of the World"; and ski areas which are "a short drive from Las Vegas and are frequented by Las Vegas visitors and locals."

Responsive to the second Office Actions, applicant conceded that "... it is true that the website that is associated with the mark depicts content contextual to Las Vegas," but applicant maintained that its services are not limited to providing information about Las Vegas. Along with the responses, applicant listed ten third-party registered marks for services which applicant argued are similar to the services specified in the instant applications. Each mark included an arguably geographic designation combined with computer terminology such as

"Web," or "Internet." Responsive to applicant's responses, the Examining Attorney submitted a dictionary definition showing that Las Vegas is a well-known city in Nevada and a computer glossary establishing that ".com" is a top-level domain indicator used to signify a commercial enterprise. Applicant countered with copies of the ten third-party registrations it had listed in response to the first Office Actions, as well as with several links from its website that do not appear to relate to the city of Las Vegas. Interestingly, this evidence also makes it clear that applicant's website also provides information that is directly related to living and or visiting Las Vegas.

Submitted in conjunction with applicant's brief on appeal were copies of several third-party registrations which had previously been made of record. Also submitted, however, were copies of six additional third-party registrations which had not been made of record prior to the appeal.¹ In his brief, the Examining Attorney properly objected to the Board's consideration of this untimely-submitted evidence. His objection is sustained under Trademark Rule 2.142(d). The record should be complete prior to filing a Notice of Appeal. Accordingly, we have

¹ Registration Nos. 2,477,319; 2,419,696; 2,317,982; 2,249,377; 2,312,431 and 2,432,007.

not considered those registrations or the copies submitted with applicant's reply brief. Moreover, even if we had, as discussed below, our resolution of these appeals would not have been different.

Turning to the merits of this controversy, we note that the tests for mere descriptiveness and the propriety of requiring a disclaimer are well settled. Section 2(e)(1) of the Act precludes registration of the term which is merely descriptive in connection with the services for which it is sought to be registered. The term is merely descriptive under the Act if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). Section 6(a) of the Act requires an applicant to disclaim a descriptive component of an otherwise registrable mark.

The evidence submitted by the Examining Attorney establishes that Las Vegas is a well-known city in Nevada. The elimination of the space between "LAS" and "VEGAS" in the mark as presented in the drawing does not change the significance of the term, which is still recognizable as the name of the city. The Examining Attorney also made of record evidence showing that the designation ".COM" is a

top-level domain indicator which would be recognized as part of an Internet address for a business. As such, the suffix has no source-indicating significance because it merely indicates that the business which operates at that address is a commercial entity.

Plainly, when the geographic designation is combined with the domain indicator, the primary significance of the term is that of a website relating to Las Vegas. There is no question that "LASVEGAS.COM" is merely descriptive of the service of providing an online website featuring information about Las Vegas. The mark describes the subject matter of the services and the fact that they are rendered by means of the website. These are significant characteristics of the service of providing an online website featuring information about Las Vegas. Applicant does not appear to disagree with this proposition.

The heart of the dispute before us, however, centers on the fact that the recitation of services in these three applications does not mention provision of information about the city of Las Vegas, but instead only refers in general terms to "information such as that generally found in daily newspapers, as well as information in the fields of news, politics, public policy, and technology." Applicant predicates its argument in favor of registration

on the well-established principle that in order for a refusal under Section 2(e)(1) of the Act to be appropriate, the mark must be merely descriptive in connection with the services as they are identified in the application, rather than in connection with other activities which applicant may or may not render, but in connection with which registration is not being sought. Applicant argues that unless the recitation in these applications specifically mentions services related to Las Vegas, the term sought to be registered cannot be held to be merely descriptive of the services under the law.

Applicant's analysis is flawed, however. Applicant does not dispute the fact that the evidence of record shows that applicant does render services relating to Las Vegas. As noted above, although there is information which is apparently unrelated to Las Vegas available on applicant's website, a substantial amount of the information applicant provides on its website is in fact related to that city.

The key here is that although the recitation of services does not specify services relating to Las Vegas, such services are encompassed within the recitation as it stands. Any reasonable reading of the broad language in the recitation, "providing online websites featuring information such as that generally found in daily

newspapers," necessarily includes providing online information about Las Vegas because the term "daily newspapers" includes Las Vegas daily newspapers and such information would be expected to be found in a Las Vegas newspaper, which is exactly what the Las Vegas Review-Journal is. (As we noted above, on applicant's website there is a statement that the Las Vegas Review-Journal is the entity which brings applicant's services to visitors to the website.)

Because providing an online website featuring information about Las Vegas such as that which can be found in a daily Las Vegas newspaper is encompassed within the broad recitation of services common to these applications, the mark applicant seeks to register is merely descriptive of the services within the meaning of the act. The mark conveys significant information about the nature of the services, namely that they include online information about Las Vegas.

Applicant also argues that refusing registration of the marks in these applications is contrary to the past practice of the Patent and Trademark Office, pointing in support of this contention to the third-party registrations of record for what it argues are similar marks registered for similar services. The Examining Attorney argues that

the Patent and Trademark Office policy with regard to this area of trademark law was specifically addressed by clarifications and changes made by Examination Guide No. 2-99, issued in September of 1999, and that since then, no registrations have been issued in situations analogous to the one presented by the instant applications. Both applicant and the Examining Attorney present arguments on whether or not the third-party registrations applicant made of record were or were not issued in accordance with the examination procedures in effect at the times of their issuance, but this is really not persuasive of either the result urged by the Examining Attorney or the one asserted by applicant. The fact is that whether or not the operative guidelines were adhered to when these registrations issued is not a factor in our decision-making process. We are no more bound by the administrative practice guidelines which have been provided to Examining Attorneys to assist in the examination of applications than we are bound by examination errors committed in attempting to comply with such guidelines. Put another way, even if the third-party registrations issued erroneously, we are not bound to repeat such mistakes. Neither applicant nor the Examining Attorney has identified any legal precedent by which this Board is bound which is on all fours with the

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fact scenario with which we are presented in the instant appeals.

In summary, the term "LASVEGAS.COM" is merely descriptive of the services broadly recited in these three applications because it conveys significant information about their nature, namely that they include online provision of information about Las Vegas. That "Las Vegas" has been compressed by elimination of the space between the two words does not alter the significance of the term any more than combining it with the top-level domain indicator does.

DECISION: The refusal to register the term by itself is affirmed under Section 2(e)(1) of the Act, as are the requirements under Section 6(a) for disclaimers of the descriptive term in the other two applications. This decision will be set aside with respect to application S.N.s 75/712,211 and 75/712,212 if applicant, within thirty days of the mailing of this decision, submits an appropriate disclaimer in each of the two applications. See Trademark Rule 2.142(g). A properly worded disclaimer would read: "No claim is made to the exclusive right to use LASVEGAS.COM apart from the mark as shown."