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Mailed: September 29, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re WasteBid.com, Inc.

Serial No. 76001834

Mark B. Harrison and Jacqueline Levasseur Patt of Venable,
Baetjer, Howard & Civiletti for WasteBid.com, Inc.

Michael W. Baird, Trademark Examining Attorney, Law Office
116 (Meryl L. Hershkowitz, Managing Attorney).

Before Seeherman, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

WasteBid.com, Inc. has filed an application to register
on the Principal Register the mark WASTEBID.COM for, as
amended, the following services:

"providing a website through which waste and
recycling collectors, processors and disposers may
submit bids to waste generators seeking to
purchase their services and related products," in
International Class 35; and

"providing information via an Internet web site in
the fields of waste collection, recycling
collection, and waste disposal, to facilitate the
business to business purchasing of such services
and related equipment and materials through the

Internet, and to facilitate electronic negotiations between buying organizations and their trading partners in these fields," in International Class 37.¹

The Trademark Examining Attorney has issued a final refusal to register, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its services.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We reverse the refusal to register.

The Examining Attorney contends that "the compound term WASTEBID merely indicates that applicant provides a web-based forum for making bids on waste removal contracts, and provides information in the field of waste removal bidding" (brief, p. 1); that "the deletion of the space between the terms 'WASTE' and 'BID,' and the addition of the non-distinctive suffix '.COM' did not significantly alter the commercial impression of the wording [and] the relevant purchasers would view the compressed wording as a domain name and interpret the term accordingly" (brief, p. 3); and that "applicant has simply selected two salient features of

¹ Serial No. 76001834, filed March 16, 2000. No basis was originally stated, but a declaration was subsequently submitted asserting a bona fide intention to use the mark in commerce. On December 10, 2001, applicant submitted an amendment to allege use and specimen of use. Applicant alleges first use and use in commerce as of August 2000, and the specimen is a printout from applicant's web site. The application includes, by amendment, a claim of ownership of Registration No. 2689708.

its services, the field of waste and the activity of bidding, and combined the terms to form the Internet domain 'WASTEBID.COM' [the combination of which] is in no way novel or incongruous, nor does it create a separate, non-descriptive commercial impression" (brief, 5).

In support of his position, the Examining Attorney submitted with its brief definitions, of which we take judicial notice, from *The American Heritage Dictionary of the English Language* (3rd ed. 1992) of "bid" as "an offer or proposal of a price" and of "waste" as "garbage; trash"; and, from *The Computer Glossary* (Alan Freedman, 9th ed. 2001) of ".com" as "a top level domain name, used as part of an Internet address to indicate that the operator of the identified Internet domain is a commercial entity" (brief, p. 2). The Examining Attorney also submitted excerpts from several third-party Internet web sites "to support his assertion that companies do, in fact, bid on waste removal contracts" (brief, p. 4).

Applicant contends that its mark is, at most, suggestive; that "consumers are not 'bidding' on 'waste' as the terms considered separately might suggest[;] in that context, the mark would invoke an image of a heap of trash for which customers are offering money to purchase" (brief, pl 2); that "a consumer encountering applicant's web site would not immediately understand the nature and purpose of

the applicant's services" (brief, p. 3); and that the evidence does not support the Examining Attorney's contention that the mark is descriptive. Applicant asserts that the definitions submitted by the Examining Attorney are not the primary definitions of those terms and, thus, that customers will not immediately know the nature of applicant's services. Applicant references its recently issued registration for the mark shown below for essentially the same services as are involved herein and argues that the mark should also register and that, if any doubt exists, such doubt should be resolved in favor of publication of the mark for opposition.

waste[!]id.com

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The Examining Attorney asserts that this registration is inapposite because it has a significant design element and the words and design form a unitary commercial impression, so that a disclaimer of the words would be inappropriate.

² Registration No. 2689708, issued February 25, 2003, for the same services as those identified in the present application, namely, "providing a web site through which waste and recycling collectors, processors and disposers may submit bids to waste generators seeking to purchase their services and related products," and "providing information via an Internet web site in the fields of waste collection, recycling collection, and waste disposal, to facilitate the business to business purchasing of such services and related equipment and materials through the Internet, and to facilitate electronic negotiations between buying organizations and their trading partners in these fields."

Applicant's Internet web site, which, along with a trade show letter introducing the company, comprise the specimens of record, includes the following statements describing its business:

Q: What is WasteBid.com?

A: WasteBid.com is an on-line marketplace for the buying of waste and recycling services, equipment and products. Waste generators [customers] post their waste and recycling service requirements and pre-approved Service Providers submit a bid. WasteBid.com also provides other services, such as government RFP postings, downloads of entire bidding documents, and waste generation and recycling reporting. For buying and selling equipment and other products, WasteBid.com currently offers an online auction and is developing a comprehensive online store. WasteBid is also a leading source for industry news and other technical and regulatory information.

. . .
Using our "smart engine" technology, we analyze your solid waste service needs and recycling opportunities to maximize savings. We then get competitive bids from pre-qualified service providers. You choose the winner. You save time and money.

Applicant's specimen letter to trade conference attendees includes the following statement:

The WasteBid website provides a venue for waste and recycling collectors, processors, and disposers ("Service Providers") to bid waste generators ("Generators") seeking to purchase these services and related products through WasteBid's Internet-based catalog, bidding, auction and proposal systems.

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient,

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attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

If, however, when the goods or services are encountered under a mark, a multistage reasoning process, or resort to imagination, is required in order to determine the attributes or characteristics of the product or services, the mark is suggestive rather than merely descriptive. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); and *In re Atavio*, 25 USPQ2d 1361, 1362 (TTAB 1992). To the extent that there is any doubt in drawing the line of demarcation between a suggestive mark and a merely

descriptive mark, such doubt is resolved in applicant's favor. In re Atavio, *supra* at 1363.

The Examining Attorney bears the burden of showing that a mark is merely descriptive of the identified goods or services. See *In re Merrill, Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 21567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

There is no question that the ".COM" portion of the mark is of no trademark significance as it is merely an Internet domain name. Further, the terms "WASTE" and "BID" are, separately, descriptive of aspects of applicant's services. However, we agree with applicant that several mental steps are required to move from the combined term WASTEBID.COM to an understanding of the nature of applicant's services. The combination of the two individually descriptive words, WASTE and BID, into WASTEBID results in an incongruous compound term. A prospective purchaser must mentally reorder the words and add words to make sense of the phrase, *i.e.*, to understand that the services involve submitting bids to dispose of waste.

Therefore, we conclude that the Examining Attorney has not established that the term WASTEBID.COM when applied to applicant's services is merely descriptive; that some mental processing or cogitation is required in order for purchasers of and prospective customers for applicant's services to

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understand the significance of the term WASTEBID.COM as it pertains to applicant's services.

Decision: The refusal under Section 2(e)(1) of the Act is reversed.