

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB**

Mailed: Sept. 29, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Inventor's World, Inc.

Serial No. 76082804

Alex Rhodes, Esq. for Inventor's World, Inc.

Michael P. Keating, Trademark Examining Attorney, Law
Office 113 (Odette Bonnet, Managing Attorney).

Before Seeherman, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Inventor's World, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register THE AMERICAN INVENTOR as a trademark for "printed publications, namely, books, magazines and pamphlets in the field of inventors and inventions."¹ Registration has been refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C.

¹ Application Serial No. 76082804, filed July 3, 2000, and asserting a bona fide intention to use the mark in commerce.

§1052(e)(1), on the ground that applicant's mark is merely descriptive of its identified goods.

Applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

As preliminary matters, we note that with its response to the first Office action, applicant submitted a list consisting of trademarks and their respective registration numbers. Such a list is not an appropriate method for making third-party registrations of record. See *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974). However, the Examining Attorney did not advise applicant of this; on the contrary, he discussed the registrations in the next Office action. Accordingly, we will consider this list of registrations for whatever probative value they may have. Also, with his appeal brief, the Examining Attorney submitted certain dictionary definitions, and asked that we take judicial notice of them. That request is granted.²

During the examination of the application the Examining Attorney made the statement that "the term AMERICAN is descriptive in this instance as it has geographic significance, and also because it pertains to

² The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

the subject matter of the publications, i.e., publications in the field of *American* inventors or inventions." Office action mailed December 29, 2000 (emphasis in original). Applicant apparently viewed this statement as indicating a refusal on the basis that its mark was geographically descriptive. However, it is clear that throughout the examination of the application the refusal has always been based on Section 2(e)(1), on the ground that the mark is merely descriptive (as opposed to geographically descriptive) of applicant's goods.

This brings us to a consideration of the substantive ground for refusal. A mark is merely descriptive, and therefore prohibited from registration by Section 2(e)(1) of the Trademark Act, if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods with which it is used. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). It does not have to describe every quality, characteristic, attribute or feature of a product or service. Rather, it is sufficient it describes a single significant quality, characteristic, attribute or feature. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

It is the Examining Attorney's position that the mark is merely descriptive because the publications "pertain at

least in part to American inventors and their inventions" and therefore "the mark immediately identifies the subject matter of the goods and does nothing more." Brief, p. 6. The Examining Attorney points to the specification of goods provided by applicant in the identification, which identifies the subject matter of the publications as being, inter alia, "in the field of inventors." He also has pointed out that "American" is defined as "of or relating to, or typical of the United States of America, its people, culture, government or history."³

We agree with the Examining Attorney that the mark is merely descriptive. The subject matter of applicant's publications, as identified in the application, is "inventors and inventions." Applicant does not dispute that American inventors are encompassed within this subject matter. Thus, THE AMERICAN INVENTOR, when used in connection with publications, immediately conveys to purchasers and prospective purchasers that the subject matter of the publications includes American inventors.

Applicant contends that other marks similar to its own have been registered. In particular, applicant has submitted copies of two third-party registrations which were taken from the USPTO's database. However, the

³ Webster's II New Riverside University Dictionary © 1984.

registration for AMERICAN INVENTOR for magazine publications (cancelled in 1990)⁴ was on the Supplemental Register, which is an acknowledgement that the mark is merely descriptive. The registration for SOCIETY OF AMERICAN INVENTORS for "promoting and advertising newly invented products to the market, for others"⁵ is also a Supplemental Register registration. Thus, these registrations actually support the Examining Attorney's position, not applicant's.

As noted above, applicant also submitted a list of third-party registrations. This list does not provide the goods or any other details of the registrations, so they do not show that the Office has treated these marks as being inherently distinctive. Moreover, the Examining Attorney stated that "a review of the list of prior registrations supplied by applicant indicate that in most cases, the marks are registered on the supplemental register, under Section 2(f), or have the relevant terms disclaimed." Office action mailed May 16, 2002. In any event, we point out that there is a distinction between a mark which indicates the target audience for a publication and a mark,

⁴ Registration No. 1253392.

⁵ Registration No. 2085104.

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like applicant's, which actually describes the subject matter of the publication.

Decision: The refusal of registration is affirmed.