

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

Mailed: August 19, 2004
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Patents+TMS, P.C.

Serial No. 76467958

Brian M. Mattson of Patents+TMS, P.C. for Patents+TMS, P.C.

Katherine Stoides, Trademark Examining Attorney, Law Office
110 (Chris A. F. Pedersen, Managing Attorney).

Before Hairston, Walters and Chapman, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Patents+TMS, P.C. has filed an application to register
PATENT LETTER NEWS on the Principal Register for
"intellectual property newsletter" in class 16 and
"providing information in the field of intellectual
property via websites on global computer networks" in class
42.¹

¹ Serial No. 76467958, filed on November 18, 2002, which alleges
a date of first use anywhere and in commerce of November 14,
2002.

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that, when used in connection with applicant's goods and services, the phrase PATENT LETTER NEWS is merely descriptive of them.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested.

The Examining Attorney argues that the phrase PATENT LETTER NEWS is merely descriptive of applicant's goods and services. In particular, the Examining Attorney maintains that not only are the individual words comprising the mark descriptive, but when combined, they create a phrase that is also descriptive. According to the Examining Attorney, prospective purchasers would immediately understand that the nature and subject matter of applicant's goods and services are namely a letter in either print or electronic form featuring patent news.

Applicant, in urging reversal of the refusal to register, argues that even if the individual words comprising the mark are descriptive, the combination of PATENT LETTER NEWS creates a distinct commercial impression. According to applicant, its mark is at most suggestive and the relevant purchasers or users of its goods and services would be required to exercise some

thought to determine the precise nature of applicant's goods and services. In support of its position, applicant relies on *In re Shutts*, 217 USPQ 363 (TTAB 1983) [SNO-RAKE held not merely descriptive of a snow removal hand tool]; and *In re The Noble Co.*, 225 USPQ 749 (TTAB 1985) [NOBURST held not merely descriptive of a product that reduces the likelihood that pipes will burst].

A mark is merely descriptive if "it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]." *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976) (emphasis added). See also *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). Moreover, in order to be descriptive, the mark must immediately convey information as to the ingredients, qualities or characteristics of the goods or services with a "degree of particularity." See *In re TMS Corporation of the Americas*, 200 USPQ 57, 59 (TTAB 1978); and *In re Entenmanns Inc.*, 15 USPQ2d 1750, 1751 (TTAB 1990), *aff'd*, unpub'd, Fed Cir. February 13, 1991.

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.*, supra at 218; 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).

We are not persuaded by the Examining Attorney's arguments that PATENT LETTER NEWS as a whole is merely descriptive of the identified goods and services. We recognize that the individual words have descriptive significance inasmuch as applicant's goods and services consist of newsletters in printed and electronic form covering, inter alia, patent topics. However, as the Board stated in *In re Wisconsin Tissue Mills*, 173 USPQ 319, 320 (TTAB 1972):

It does not follow as a matter of law that because component words of a mark may be descriptive, the composite is unregistrable. The established rule is that a composite must be considered in its entirety and the question

then is whether the entirety is merely descriptive. (citation omitted)

In this case, there is no evidence to indicate how the relevant purchasers and users of applicant's goods and services would perceive the composite mark PATENT LETTER NEWS. We believe it would be rare for such purchasers and users to refer to the subject matter of the goods and services as "patent letter news."

When we consider applicant's mark PATENT LETTER NEWS in its entirety, we find on this ex parte record that it is only suggestive of the identified goods and services. We reach this conclusion because of the unnatural order of the words comprising applicant's mark and the fact that some, albeit, minimal mental reasoning is required in order to determine the nature of applicant's goods and services. See Aluminum Fabricating Co. v. Season All Window Corp., 119 USPQ 61 (2nd Cir. 1958) [SEASON ALL held not merely descriptive of aluminum windows].

To the extent that there is any doubt in this case, we have resolved that doubt in applicant's favor.

Decision: The refusal to register is reversed.