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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Internet Profit Systems, LLC

Serial No. 78144064

G. Henry Welles of Best Best & Krieger LLP for Internet Profit Systems, LLC.

Michele-Lynn Swain, Trademark Examining Attorney, Law Office 116 (Meryl Hershkowitz, Managing Attorney).

Before Chapman, Bottorff, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

Applicant, Internet Profit Systems, LLC, seeks to register the term INTERNET PROFIT SYSTEMS, in typed form, on the Principal Register for services ultimately identified as:

Market research and advertising services to others who offer goods and services over the Internet, television, print, and other media, by providing statistical research in the field of marketing products and services, by providing assistance in the development of methods of promoting those businesses'

goods and services and by providing assistance in the development of methods of merchandising, marketing and promoting of products and services offered over the Internet by others in International Class 35; and

Technical consultation in the field of Internet retailing websites and operating Internet retailing websites; designing, improving and implementing Internet retailing websites for others in International Class 42.¹

The examining attorney has refused to register applicant's mark on the ground that the mark is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). The examining attorney argues (Brief at unnumbered pages 5 and 3) that the "applicant has combined the descriptive terms INTERNET, PROFIT and SYSTEMS to form a descriptive mark" and "the services comprise a system for generating Internet profits." Applicant submits that the "words 'INTERNET PROFIT SYSTEMS' are an incongruous coupling of words, that do not call to mind any specific, generic,² product or service." Reply Brief at 1.³

¹ Serial No. 78144064 filed July 15, 2002. The application contains a claimed date of first use and first use in commerce of December 5, 2000.

² The only refusal in this case is the merely descriptive refusal. Therefore, applicant's arguments in its brief concerning the non-genericness of its mark are not relevant.

³ With its brief, applicant submitted five registrations as support for its argument that its mark is suggestive. The examining attorney objected to the untimely submission of this evidence. We agree that this evidence was untimely submitted and we will not consider the five registrations (37 CFR § 2.142(d)), but we do note that many of the registrations are for significantly different goods and services.

After the examining attorney made the refusal final, applicant appealed to this Board.

A mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information regarding a function, purpose, or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). See also In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) (A "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service").

To be merely descriptive, a term need only describe a single significant quality or property of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959). We look at the mark in relation to the goods or services, and not in the abstract, when we consider whether the mark is descriptive. Abcor Dev., 200 USPQ at 218.

Obviously, we must consider whether the mark in its entirety is descriptive of the services, however, it is appropriate to consider the individual components of the mark. The mark consists of three words, INTERNET, PROFIT, and SYSTEMS. As to the first word, "Internet," it is clear that this term describes a feature of the services. Applicant's identification of services specifies that its market research and advertising services are offered to those operating on the Internet and that applicant is providing assistance to those offering products and services over the Internet. Its technical consultation services are in the field of Internet retailing websites and operating Internet retailing websites and designing, improving and implementing Internet retailing websites. Clearly, applicant's services are directed to assisting others operating on the Internet. Applicant's specimens tout applicant's "unique understanding of the Internet marketplace" and a "key factor in our success has been the understanding that effective Internet Marketing strategies are ever evolving." Thus, there is nothing incongruous about applicant's use of the term "Internet" in association with its Internet-related services.

The next term is the word "Profit." The examining attorney (Office Action dated November 24, 2002 at 2) has

submitted a dictionary definition of "profit" as "an advantageous gain or return" or "benefit." Applicant's specimens describe applicant's services as: "Unleashing online profits through unconventional concepts and powerful success strategies." One of applicant's customers is quoted as saying: "My profits are up 650% since you re-worked my web site." Applicant's services are designed to "increase your ROI (return on investment) while simultaneously increasing your bottom line." Therefore, the term "Profit" would describe the fact that applicant's marketing and research services and technical consultation and website services are designed to increase its clients' profits.⁴

The third word "Systems" is defined (Office Action dated November 24, 2002 at 2) as "an organized set of interrelated ideas or principles." Applicant's literature describes its services as "unconventional yet powerful success strategies" and providing its clients "with powerful Internet marketing solutions based upon customer driven insight, strategic communications and proprietary technology that unconditionally drives and builds the

⁴ While applicant argues (Brief at 4) that it "does work for non-profit organizations," it is not clear why these organizations would not also be interested in their return on investments for the individual items they would offer for sale on their websites.

demand side of business." In addition, applicant's "team applies special strategies and in-depth methodologies to develop creative solutions to ensure your success." These excerpts indicate that applicant's methodologies and strategies would be a system that applies an interrelated set of principles or ideas.

The examining attorney also submitted printouts of several third-party registrations to show that the term "system" has been disclaimed when it has been part of a registered mark for somewhat similar services. See, e.g., Registration No. 2,472,507 (SELECTED AUDIENCE SYSTEM for direct mail advertising services, Supplemental Registration with "System" disclaimed); 1,983,177 (CUSTOMER AUTOMATED REPLENISHMENT SYSTEM for assisting others in maintaining inventory storage services, Supplemental Registration with "System" disclaimed); and 2,380,116 (CHICAGO SYSTEMS GROUP for computer consulting services, Supplemental Registration with "Systems Group" disclaimed). The evidence demonstrates that the term "Systems" would be viewed as a merely descriptive term when used in connection with applicant's services.

However, we must keep in mind that merely because the individual terms of a mark may be merely descriptive, the question is whether the mark as a whole is merely descriptive. In re Colonial Stores, Inc., 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE held not merely descriptive of bakery products). The ultimate question in this case is whether the term INTERNET PROFIT SYSTEMS immediately describes a feature, quality, or characteristic of applicant's services. Applicant's literature supports a conclusion that it immediately describes the fact that applicant's services are a system designed to generate profits on the Internet. Applicant's website has a publication referred to as "The Profit Systems Report." One of the featured articles is entitled "Making 'Rock Star' Internet Profits - 'How to make money online like a rock star starting with nothing to build your business.'" Another publication applicant advertises on its website as "coming soon" is entitled "The Dead-Broke Beginner's Guide to Internet Profits," which is described as a "step-by-step roadmap for small business to establish an online presence faster and with less risk." Applicant's specimens also use the phrase "Unleashing Online Profits." The term "online" and "Internet" are virtually interchangeable terms. See, e.g. "Our Specialties" web page, "Our Internet clients are

from many diverse fields, and we can assist in virtually all areas of online marketing”).

Applicant also acknowledges (Brief at 7) that the examining attorney “shows some instances of use of the combination of the words ‘Internet profit systems’ with various discussions of strategies to make money on the Internet.”⁵ While these excerpts are brief, they are some evidence that users would likely see the term “Internet profit system(s)” as being merely descriptive. See Google listings: “How to earn \$500.00 a week with my “Auto-Pilot’ Internet Profit System;” “Home Based Internet Profit System;” InstantInternetProfits.com is a new web site that provides an “Instant Internet Profit System” for selling digital products online;” and “FREE Report titled ‘How to Create Your Own Custom Internet Profit System in 30 Days or Less.’” In addition, there is a printout concerning a course on CD entitled “Internet Profit Systems: Breakthrough Internet Marketing Course” (apparently affiliated with applicant) that is described as “The World’s Only Complete Video Success Training System.”

Besides this evidence, the examining attorney has also presented evidence that the words “Internet profit” are

⁵ Applicant argues that the examples do not show use in a trademark sense and that the services are different.

used to refer to making money on the Internet. See, e.g. *Bell & Howell Information and Learning*, April 20, 2003 ("Participating distributors have the ability to mark up prices and can request their Internet profits checks every month"); *Newsbytes*, July 24, 2003 ("AOL Time Warner is focused on finding its own ways to mine the company's 150 or so print magazines for Internet profits"); *Bell & Howell Information and Learning*, July/August 2002 ("a simple reduction of even a half percent in churn a month can dramatically increase overall Internet profit margins"); and *Boston Globe*, September 15, 2002 ("Apostles of the old economy are having their laugh now over the meltdown of Internet profits and stock prices").

Applicant argues that it "is not in the business of producing Internet profits for its customers. Applicant is essentially an advertising and marketing research consultant" and "Applicant helps its customers develop effective advertisements that the customers then can use to sell goods or services over the Internet, or television, or print ads, perhaps at a profit, perhaps not." Brief at 2 and 3. While applicant is "an advertising and marketing consultant," applicant's own specimen describes its services as "Unleashing online profits." In addition, applicant's literature refers to applicant as more than a

consultant: "Part Internet developers; part marketing/advertising agency; and part digital technology consultants... Everything we do is focused on increasing our clients' ROI" (ellipse in original). Therefore, while applicant is a consultant, at least one focus of its services is increasing profits for its Internet-based clients.

In addition, applicant (Brief at 4) maintains that its "work is not always on the Internet; it is not always for profit." In order to be descriptive, a term does not have to describe every aspect of an applicant's goods or services. In re Pencils, Inc., 9 USPQ2d 1410, 1411 (TTAB 1988) ("We agree with applicant that the sale of pencils is not the central characteristic of applicant's services. Nevertheless, pencils are significant stationery/office supply items that are typically sold in a store of applicant's type, that is, a stationery and office supply store. While applicant's stores may carry a variety of products, pencils are one of those products, and, thus, the term 'pencils' is merely descriptive as applied to retail stationery and office supply services"). Accord In re CyberFinancial.Net Inc., 65 USPQ2d 1789, 1791 (TTAB 2002) ("[I]f applicant's mark BONDS.COM is generic as to part of the services applicant offers under its mark, the mark is

unregistrable"). Clearly, the terms "Internet" and "Profit" are descriptive of at least an aspect of applicant's services that seek to increase profits for the Internet websites of applicant's clients. See Specimen ("My profits are up 650% since you [applicant] re-worked my web site").

When we view the mark in relation to applicant's services, we find that the evidence supports the examining attorney's position that the combined term INTERNET PROFIT SYSTEMS is merely descriptive when used in connection with applicant's services of developing, managing, operating, and improving clients' websites. Applicant's own literature makes it clear that a key characteristic of its services is to increase the return on investment or profit from Internet transactions. The evidence also shows that the term "systems" would likewise be descriptive of applicant's methods and strategies to increase the return on investment or profits from the Internet websites of its clients. The individual words are descriptive of applicant's services and when the terms are combined, there is nothing incongruous about the terms. Therefore, we find that applicant's mark INTERNET PROFIT SYSTEMS is merely descriptive of applicant's services.

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