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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Douglas Elslager

Serial No. 76626384

Brian M. Mattson of Patents + TMS for Douglas Elslager.

Richard F. White, Trademark Examining Attorney, Law Office
109 (Dan Vavonese, Managing Attorney).

Before Seeherman, Quinn and Hairston, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Douglas Elslager has appealed from the final refusal
of the Trademark Examining Attorney to register
ISLANDHOME.INFO in standard character form for "advertising
and marketing of real properties and other real estate
available for sale on or for lease in one or more islands."¹
Registration has been refused pursuant to 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 his identified services.

Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

Preliminarily, we note that in his appeal brief applicant has made reference to certain registrations and applications, but that copies of these documents were never made of record. The Examining Attorney has not objected to these references and, indeed, has discussed them in his brief. Accordingly, we deem the Examining Attorney to have stipulated to the information provided by applicant with respect to these registrations, and have considered them for whatever probative value they may have.

A mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the identified 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 MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778 (Fed. Cir.

¹ Application Serial No. 76626384, filed December 28, 2004, asserting first use first use and first use in commerce as of October 2004.

2003); In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

In order for a term to be descriptive, it need only describe a single significant quality or property of the goods or services. In re Venture Lending Associates, 226 USPQ 285 (TTAB 1985). See also In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) ("A mark may be merely descriptive even if it does not describe the full scope and extent of the applicant's goods or services") (internal quotation marks omitted).

The question of descriptiveness is decided not in a vacuum but by considering the term in relation to the goods or services; the test is not whether prospective purchasers can guess what the goods or services are after seeing applicant's mark alone. Abcor, 200 USPQ at 218 ("Appellant's abstract test is deficient - not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as required by statute").

It is the Examining Attorney's position that ISLANDHOMES.INFO is merely descriptive of a characteristic of applicant's services, namely, that applicant is offering island homes, i.e., homes for lease or sale on

various islands, on its website. In support of his position, the Examining Attorney has submitted evidence taken from various websites that use "island home" in connection with the sale and rental of real estate in various islands. For example, "island homes" is the name of the "Honolulu Star-Bulletin's" real estate site, which is said to offer "one of the most current and complete real estate sites in Hawaii," and depicts various homes for sale. An article on the MSN website entitled "Why are the rich buying island homes?" discusses why homes on islands are popular, with particular mention of islands in North Carolina, Georgia and Florida. The St. Lucia Tourist Guide, under the general title "Island Homes," states, "HOMES & LOTS For those seeking the privacy of a home or vacation villa, many well-established areas still have lots available or homes for resale in some very scenic spots." The article references various residential areas, and also discusses condominiums and townhouse developments.

In addition, applicant's own specimen makes it clear that he is offering information about owning a home on an island, specifically in the Caribbean: "Have you ever dreamed of owning your own private home in the Caribbean?" ... "Islandhome.info gives you the ability to compare the

different islands to find the home that is right for you. Our custom database allows us to help you refine your search..."

As for the .INFO part of applicant's mark, the Examining Attorney has submitted evidence showing that ".info" is:

a generic top level domain intended for informative websites, although its use is not restricted. It was a part of ICANN'S highly publicized announcement, in late 2000, of a phased release of seven new generic top-level domains.²

The Examining Attorney asserts that, as a top level domain name ("TLD"), .INFO has no source-indicating significance, and does not change the merely descriptive nature of ISLANDHOMES. In this connection, the Examining Attorney has cited *In re Microsoft Corp.*, 68 USPQ2d 1195, 1202 (TTAB 2003), for the proposition that "there is nothing in

² Wikipedia, <http://en.wikipedia.org/wiki/.info>. Although we are aware that there are some questions about the accuracy of information in Wikipedia, because the Examining Attorney made this excerpt of record with the first Office action, and because applicant has not challenged it, we have accepted the entry as showing that .info is a top level domain. Moreover, we take judicial notice of an entry in Computer Desktop Encyclopedia, 9th ed. © 2001: "New Domain Names. In November 2000, the Internet Corporation for Assigned Names and Numbers (ICANN) announced the following new top-level domains." One of the domain names that was listed is ".info" for "information services." 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 combination of a descriptive term and a TLD ...that renders the composite registrable on the Principal Register without a showing of acquired distinctiveness."

Applicant argues that his mark is not merely descriptive because it is "a combination of terms that creates a distinct commercial impression, which is not descriptive." Brief, p. 3. Applicant also asserts that this combination "does not result in a designation that has a plain and readily understood meaning for the services." Brief, p. 4. It is applicant's view that "the relevant public would be required to gather more information before determining that Appellant's mark is used to advertise and market real properties and other real estate available for sale on or for lease in one or more islands." Brief, p. 5.

We conclude, on the basis of the evidence, that "island home" is a recognized term for houses or other real estate located on islands. As such, it immediately and directly conveys to consumers a central characteristic of "advertising and marketing of real properties and other real estate available for sale on or for lease in one or more islands," applicant's identified services. That is, consumers seeing this term used in connection with such identified services would immediately understand it as

conveying that the subject of the advertising and marketing is real estate located on an island. The fact that this term is run together in the mark as ISLANDHOME does nothing to change this significance. Moreover, as the case law indicates, in general the addition of a top level domain name such as ".info" does nothing to change this descriptive significance. "The addition of a TLD such as '.com' or '.org' to an otherwise unregistrable mark will typically not add any source-identifying significance. Oppedahl, 71 USPQ2d at 1374 (PATENTS.COM merely descriptive of computer software for managing a database of records and for tracking the status of the records by means of the Internet). To the extent that .INFO has any meaning, it is descriptive in that it tells consumers that a feature of applicant's services is that they are performed in an on-line environment. See *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420 (Fed. Cir. 2005) (STEELBUILDING.COM held merely descriptive of computerized on-line retail services in the field of pre-engineered metal buildings and roofing systems). When the words ISLAND, HOME and .INFO are combined as ISLANDHOME.INFO, we find that the mark as a whole is merely descriptive of applicant's services.

We have considered applicant's arguments that his mark is not merely descriptive, but do not find them persuasive. As noted, applicant asserts that when the individual terms are combined to form the mark ISLANDHOME.INFO, the mark as a whole creates a distinct commercial impression. However, applicant does not explain how he has reached this conclusion. The cases applicant has cited to support his argument are distinguishable from the present situation. For example, applicant cites *In re Shutts*, 217 USPQ 363 (TTAB 1983) and *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) as support for his statement that ISLANDHOME.INFO is suggestive. However, the mark in Shutts was SNO-RAKE, which was not a recognized term for a snow-removal hand tool. Here, on the other hand, the evidence shows that "island home" is a commonly used and recognized term. In Colonial Stores, the mark SUGAR & SPICE was found not merely descriptive of bakery products because the mark suggested the nursery rhyme as well as the ingredients of the products. Applicant has not indicated what double entendre ISLANDHOME.INFO may have, and none is apparent to us or, we believe, would one be apparent to the consuming public. Applicant has also cited *Ice Cold Auto Air of Clearwater, Inc. v. Cold Air &*

Accessories, Inc., 828 F.Supp. 925 (M.D. Fla. 1993) as support for his statement that "it is well established that common or ordinary words can be combined in a novel or unique way and thereby achieve a degree of protection denied to the words when used separately." Brief, p. 3. However, that case was a trademark infringement action. In any event, our decision is not based on a finding that the individual words are merely descriptive. As noted above, because "island home" has a readily understood meaning, and because of the lack of significance of the TLD, we find that the mark as a whole is merely descriptive.

As for applicant's assertion that consumers would have to gather more information before determining the services for which applicant's mark is to be used, we reiterate the well-established principle, stated above, that the term must not be considered in the abstract. That is, the question is not whether consumers could guess what the services are if they see only the mark, but whether, when they see the mark used in connection with the services, they will immediately understand from the mark a significant characteristic, quality, function, purpose or use of the goods or services. Moreover, as stated above, a term need not describe all of the features

of the goods or services in order to be descriptive; it need only describe a single significant quality or property of the goods or services.

Finally, applicant has referenced various third-party registrations, as well as an application which was published for opposition, to show that other marks have been found to be registrable. However, all of those registrations/applications are for different marks and/or goods or services. It appears that applicant has cited them simply because they contain elements of applicant's mark, e.g., THE HOME DEPOT for retail home improvement stores and TREASURE ISLAND for casino services. Applicant also cites ISLAND HOUSE for mail order services in the field of furniture, and ISLAND HOME for dinnerware and stoneware. Applicant's reliance on these third-party marks is misplaced. Our decision should not be read to say that any mark that contains the word HOME or ISLAND is merely descriptive, or even that a mark which consists only of the words ISLAND HOME must be, ipso facto, merely descriptive. As stated previously, the question of descriptiveness is determined by considering the term in relation to the identified goods or services. Therefore, a mark that is merely descriptive as used in connection with certain goods or services may be arbitrary or

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suggestive if used with different goods or services. The record herein demonstrates that ISLANDHOME.INFO, as used in connection with applicant's identified "advertising and marketing of real properties and other real estate available for sale on or for lease in one or more islands," is merely descriptive of those services.

Decision: The refusal of registration is affirmed.