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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SimDesk Technologies, Inc.

Serial No. 78269442

Scott J. Stevens of Woodard, Emhardt, Moriarty, McNett & Henry LLP for SimDesk Technologies, Inc.

Jacqueline A. Lavine, Trademark Examining Attorney, Law Office 101 (Ronald R. Sussman, Managing Attorney).

Before Seeherman, Hohein, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On July 1, 2003, SimDesk Technologies, Inc.

(applicant) applied to register the mark WORLD WIDE SERVER, in standard character form, on the Principal Register for goods and services ultimately identified as follows:

Communications software for connecting computer users to a global computer network and for allowing computer users to access on-line software applications, namely, word processing, spreadsheet, database, personal information management, file management, and email applications, and applications that provide a user with the ability to design and create data archiving

systems, to send printing instructions via a global computer network to a remote printer, and to develop multimedia presentations by integrating text, audio, graphics, still images and/or moving pictures in Class 9.

Application service provider services featuring on-line software applications for use in word processing, spreadsheet development, database development, personal information management, file management, e-mail, remote printing, data archiving system development and multimedia presentation development in Class 42.

The application (Serial No. 78269442) is based on an allegation of a date of first use anywhere and in commerce of the mark for both classes of August 1, 2002. 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 maintains that "WORLD WIDE SERVER merely describes a server that has the capacity to control a repository of data throughout the entire world. The composite mark means nothing else - it is a server that has worldwide functionality or use. In fact, applicant's own specimens would seem to indicate that its server has world-wide functionality by virtue of its being connected to a global computer network." Brief at 3-4.

Applicant's position is that "dictionary references suggest at least two definitions for both *world wide* (i.e. international or ubiquitous) and *server* (i.e., a program

that provides services to other programs or a computer that provides some services to other computers) giving at least four independent possible meanings for the combination of terms." Brief at 4.

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. 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). In order to assess whether a term is merely descriptive, we must

consider the mark in relation to the goods and services, not simply in the abstract. Abcor, 200 USPQ at 218.

We now look at the evidence in the case. The examining attorney included the following definitions in her first Office Action and her denial of the request for reconsideration:

World wide - Involving or extending throughout the entire world; universal: *a worldwide epidemic*.
Dictionary.com.

Server - A computer system in a network that is shared by multiple users. Servers come in all sizes from x86-based PCs to IBM mainframes...

The term "server" may refer to both the hardware and software (the entire computer system) or just the software that performs the service.
TechEncyclopedia.

Server - a computer or device on a network that manages network resources. For example, a file server is a computer and storage device dedicated to storing files. Any user on the network can store files on the server.
www.webopedia.com

We note the following additional definition of "server" as "a specialized network device or software that provides a service to other devices. The most common services on a LAN [Local Area Network] are printer servers, file servers, and mail servers." Tom Fahey, *Net.speak - The Internet Dictionary* (1994).¹

¹ We take judicial notice of this definition. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594,

The examining attorney also points to applicant's own website that describes its goods and services as follows:

SimDesk Technologies, Inc. has created a revolutionary combination of web-enabled client software and highly scalable data communications technology that are the most significant and pioneering Internet innovation in the last 20 years. This quantum leap is made possible by a unique data transport technology and high-speed server architecture that produce system efficiency, reliability, and scalability that are orders of magnitude beyond previous standards. SimDesk's World Wide Server™ provides communication, collaboration, and personal services securely to any Internet-capable computer, wireless, or personal device, anywhere in the world.

The website makes it clear that a key feature of applicant's goods and services are their "high-speed server architecture" that helps to provide communication, collaboration and personal services "anywhere in the world." An example of the use of applicant's goods and services is provided in a testimonial on its website:

Another advantage of SimHouston is that the works saved on SimHouston are saved onto a network. This means that a project started on a computer at one branch can be brought up on a computer at another without having to save to a disk. Some nights our branch closes at 6 pm, sometimes right when a student is in the middle of writing their assignment. They can simply save their work, and go to a branch that is open until 9 pm to finish their homework.

The example above makes it clear that applicant's goods and services involve a server that is shared by

596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

multiple users that permits these users to access and store data and programs from anywhere in the world, i.e., world wide.

Specifically, applicant's software and services describe accessing data and programs online:

Communications software for ... allowing computer users to access on-line software applications, namely, word processing, spreadsheet, database, personal information management, file management, and email applications, and applications that provide a user with the ability to design and create data archiving systems, to send printing instructions via a global computer network to a remote printer, and to develop multimedia presentations by integrating text, audio, graphics, still images and/or moving pictures.

Application service provider services featuring on-line software applications for use in word processing, spreadsheet development, database development, personal information management, file management, e-mail, remote printing, data archiving system development and multimedia presentation development.

The fact that applicant's software and services connect computer users online and to a global computer network would provide access to the data and programs "globally" or "world wide."

The examining attorney has also included some pages from Internet sites to show that the term "world wide server" is used to refer to servers that provide access to data and/or programs on a worldwide basis (emphasis added).

Webmaster MacIntosh: How to Build your Own **World-Wide Server** Without Really trying/Book and CD-ROM

This book is a fast and easy guide for turning your Macintosh into a World Wide Web site...
All the setup and configuration information you need for your Web server.
www.brianbooks.com

The Official BSC **World Wide Server**
The World Wide Web provides global access to a wide range of information services...
BSC [Birmingham-Southern College] Personal Home Page server stores home pages of students, faculty and staff.
www.bsc.edu

You are on the HOME page of the Art Nouveau **World Wide server**: the most complete site about Art Nouveau on the web.
<http://kubos.org>

When we consider the evidence of record and the mark as a whole, it is clear that prospective purchasers who encounter applicant's term WORLD WIDE SERVER will immediately understand that, when it is used in association with software and services that provide a server that permits access to data and programs on a world wide basis, the term merely describes a significant feature of these goods and services.

Applicant argues (Reply Brief at 2) that:

[T]he term "world wide server" has at least two meanings, based on the definitions provided by the Examining Attorney, i.e., "software that permits a user in one location, such as at home, to designate and use any internet-connected computer anywhere in the world as a server" or "software that allows a user who may be traveling anywhere in the world to use a computer at that location as a server." To a purchaser of computer software, either meaning is equally plausible or likely, yet they have very

different meanings and would create different impressions in the minds of those purchaser[s]. More information is needed by a purchaser to ma[k]e an accurate determination of what features and functions actually are performed by Applicant's goods and services. This requirement for more information is the essence of a suggestive mark. Additionally, as a third possibility, the mark is suggestive of a single computer or computer system that spans the entire globe.

Applicant's arguments are not persuasive.

Fundamentally, applicant overlooks the requirement that the question of descriptiveness is considered in the context of the goods or services. See Abcor, 200 USPQ at 218. Often, the definitions of words in a mark can be combined to create a variety of different meanings. However, the context determines whether the mark would be descriptive. See In re Ethnic Home Lifestyles Corp., 70 USPQ2d 1156, 1159 (TTAB 2003):

Similarly, that applicant can take the dictionary definitions of the individual words in the term and come up with a meaning that makes no sense in connection with the services recited in the application does not mandate a different conclusion on the issue of mere descriptiveness. As stated above, the determination of descriptiveness is made in the context of the identified services, and the meaning of "ETHNIC ACCENTS" in connection with applicant's services is clearly that of home furnishings or decorations relating to various ethnicities.

See also In re Time Solutions Inc., 33 USPQ2d 1156, 1158 (TTAB 1994):

When consumers encounter applicant's mark, YOUR HEALTH INSURANCE MANAGER, used in the context of applicant's

advertising, which describes applicant's goods as "new PC software to manage your medical records and health insurance" and lists the various tasks performed by the software programs, as recited above, we have no doubt that the mark will immediately convey to them information concerning a significant feature or function of applicant's programs, namely, that they manage, i.e., handle with skill, personal health insurance matters.

While applicant has combined the definitions of the terms "world wide" and "server" and come up with several different meanings, that is not of itself significant. In this case, we must consider the mark in the context of applicant's communications software for connecting computer users to a global computer network and for allowing computer users to access on-line software applications via a global computer network to a remote printer and application service provider services featuring on-line software applications. It is clear from the record that applicant is providing a server with online applications and data storage that is accessible worldwide. As such, the term immediately informs potential users of a feature of its goods and services. The fact that the term in a different context may also describe, inter alia, software that would permit a traveler to designate a computer at any location as a server does not mean that the term does not also describe applicant's goods and services. See In re

Polo International Inc., 51 USPQ2d 1061, 1062-63 (TTAB

1999):

Applicant is correct that the photocopy of a page from the dictionary submitted by the Examining Attorney shows definitions of both "doc" (for "doctor"), and "doc." (for "document"). However, we are not persuaded that it is the presence or absence of the punctuation which changes the meaning. Rather, the relevant meaning of either abbreviated term "doc" or "doc." will be understood as "document" by the purchasing public in relation to the involved goods. If applicant produced goods related to the medical field, or specifically related to physicians, then the term "DOC" would be readily understood by the public as referring to "doctor." However, here applicant's goods are computer software for document management, and "DOC" will be readily understood as referring to documents.

When we consider applicant's mark WORLD WIDE SERVER in the context of the identified goods and services, we conclude that the term is merely descriptive.

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