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Paper No. 12
PTH

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Penton Publishing, Inc.**

Serial No. 74/460,641

Kenneth L. Mitchell of Woodling, Krost & Rust for **Penton Publishing, Inc.**

Kathleen Cooney-Porter, Trademark Examining Attorney, Law Office 107 (**Janice O'Lear, Acting Managing Attorney**).

Before **Seeherman, Hanak** and **Hairston**, Administrative Trademark Judges.

Opinion by **Hairston**, Administrative Trademark Judge:

This is an appeal from the Trademark Examining Attorney's final refusal to register the mark SECONDARY MARKET GUIDE for a "reference directory."¹

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 the mark merely describes applicant's goods.

¹ Application Serial No. 74/460,641 filed November 19, 1993, and based on a bona fide intention to use the mark in commerce. Applicant subsequently filed an amendment to the application, alleging a date of first use and a date of first use in commerce of September 9, 1994.

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Further, the Examining Attorney has required that applicant amend the identification of goods to specify the subject matter of its publication.

Applicant and the Examining Attorney have filed briefs, but no oral hearing was requested.

We turn first to the requirement to amend the identification of goods. TMEP §804.03 provides, in relevant part, that:

When the goods for which registration of a mark is sought are publications, the identification must indicate both the specific physical nature and the literary subject matter of the publication.

The Examining Attorney maintains that, while applicant has indicated the physical nature of its publication, it has failed to indicate the subject matter of the publication.

Applicant, however, argues that:

The field of applicant's publication, namely, a reference directory, is definite. Applicant's publication is a reference directory of various goods and services.
(Brief, p.3)

Notwithstanding applicant's argument, it is clear that the identification of goods does not specify the subject matter of the publication. Also, applicant's publication is not simply a directory of various goods and services. Rather, as evidenced by the specimen of record, it is a directory of buyers and sellers of used machinery and equipment. Thus, we find the requirement to amend the identification of goods to be proper.

We turn next to the refusal to register under Section 2(e)(1) of the Trademark Act. The Examining Attorney maintains that SECONDARY MARKET GUIDE immediately conveys information about the subject matter of applicant's directory, namely that it is a guide to used machinery and equipment.

In support of the refusal to register, the Examining Attorney has submitted, inter alia, entries from Webster's New Collegiate Dictionary defining the words "secondary"; "second hand"; and "used". "Secondary" is defined therein as "of second rank, importance, or value; immediately derived from something original, primary or basic." "Second hand" is defined as "acquired after being used by another, not new;" and "used" is defined as "that has endured use; second hand."

Also, the Examining Attorney submitted excerpts from the Nexis data base which show that the term "secondary market" has been used to refer to used merchandise and equipment, for example:

From auctions to the classified, buyers and sellers in the **secondary market** resort to creative tactics. (The San Francisco Examiner, October 19, 1994);

Sale of new, discontinued equipment is another profit-center, as is refurbishing of used equipment for **secondary market** resale by original manufacturers. (Teleconnect, September 1994); and

But he soon sees why the salesman wants the

deal: Green's used Honda can fetch top dollar in today's hot **secondary market**. (Medical Economics, July 25, 1994).

Applicant, in urging reversal of the refusal to register, essentially argues that the term secondary market does not describe certain of the listings in its directory, e.g., exporters and appraisers, nor does the term describe buying or selling new or used equipment.

A mark is considered to be merely descriptive of goods or services, under Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Moreover, it is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

In this case, we find that SECONDARY MARKET GUIDE, as applied to applicant's directory, immediately conveys to the relevant consumers that it is a guide to used, i.e., secondary market, machinery and equipment. No amount of imagination or speculation is necessary for customers and

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prospective purchasers to readily perceive the descriptive significance of the term SECONDARY MARKET GUIDE as applied to applicant's goods. In this regard, we note the following on the cover of applicant's publication:

THE
SECONDARY
MARKET
GUIDE

YOUR SOURCE FOR BUYING
OR SELLING EVERY
USED MARKET FROM
AIRPLANES TO X-RAY MACHINES

Accordingly, we conclude that applicant's mark, as applied to the specified goods, is merely descriptive of them.

Decision: The requirement to amend the identification of goods and the refusal to register are affirmed.

E. J. Seeherman

E. W. Hanak

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

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