

4/19/01

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Paper No. 14
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re IMARK Communications, Inc.

Serial No. 75/769,784

James C. Wray for IMARK Communications, Inc.

M. Catherine Faint, Trademark Examining Attorney, Law
Office 103 (Daniel Vavonese, Acting Managing Attorney).

Before Cissel, Quinn and Rogers, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On August 6, 1999, applicant filed the above-
referenced application to register the mark shown below

on the Principal Register for "providing conferences and
expositions," in Class 41. The application was based on
applicant's claim of use of the mark in interstate commerce
in connection with the services since June of 1998.

The Examining Attorney found the recitation of services to be indefinite and required amendment thereto. Additionally, citing Section 6 of the Lanham Act, she required applicant to disclaim the terms "BROADBAND YEAR" apart from the mark as shown.

Applicant amended the application to recite its services as "arranging and conducting business conferences and expositions," in Class 35, but refused to enter the required disclaimer.

The Examining Attorney repeated and made final the disclaimer requirement, attaching to her second Office Action dictionary definitions of "broadband" as an adjective meaning "of, relating to, or having a wide band of electromagnetic frequencies: broadband communications"; and of "year" as meaning "a period of approximately the duration of a calendar year..." The Examining Attorney quoted the following from the advertisement submitted as a specimen of use with the application: "In just five days under one roof you'll discover how to integrate multiple broadband technologies... for managing and growing network bandwidth." The cover of the brochure characterizes applicant's conference as "The Event for High-Bandwidth Networking." The Examining Attorney reasoned that the words "broadband" and "year" are "merely descriptive of

applicant's services, namely a conference or exposition relating to uses for wide band electromagnetic frequencies held during a specific period of time." (February 28, 2000 Office Action, p. 2).

Applicant responded to the final refusal with a request for reconsideration. In support of its position, applicant included an advertisement for a conference to be held in June of 2000. The mark sought to be registered is used throughout this publication in reference to applicant's services. The heading on the cover of this advertisement is "BROADBAND TECHNOLOGY: What's Next?" The language along the bottom of the cover of the brochure characterizes applicant's conference as "THE MAIN EVENT FOR BUILDING, PROVIDING, AND SELLING BROADBAND SERVICES." Inside the brochure, a headline touts applicant's conference as "The World's Only 100% Broadband Exposition."

The Examining Attorney was not persuaded by applicant's evidence or arguments. The final requirement for a disclaimer of "BROADBAND YEAR" was maintained.

Applicant again requested reconsideration of the requirement for a disclaimer. Included with applicant's second request for reconsideration was a copy of a page from applicant's Website. The first line on this document states that the eighth annual BROADBAND YEAR 2000

conference is "the main event for building, providing, and selling broadband services." Under the heading "The Future of Broadband is in Your Hands," a box contains the following message: "Attention Communications & Network Professionals: Broadband Connections is (sic) for you! Click here."

Applicant timely filed a Notice of Appeal, which was followed by an appeal brief. The Examining Attorney timely filed her responsive brief on appeal, and applicant filed a reply brief. Applicant did not request an oral hearing before the Board.

The sole issue before us in this appeal is the propriety of the requirement for a disclaimer of "BROADBAND YEAR" apart from the mark as a whole. Based on careful consideration of the record in this application and the arguments and authorities on this issue, we find that these terms are merely descriptive in connection with applicant's services and therefore that they must be disclaimed.

The underlying statutory rules which govern this appeal are not in dispute. If a word immediately and forthwith provides prospective purchasers or users of the services with information about a significant feature, characteristic, purpose or function of the services, it is merely descriptive of the services, and hence is

unregistrable under Section 2(e)(1) of the Lanham Act. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-218, (CCPA 1978). Section 6(a) of the Act provides that an applicant may be required to disclaim an unregistrable component of a mark which is otherwise registrable. Therefore, if the words the Examining Attorney has required applicant to disclaim are merely descriptive of the services recited in the application, the requirement to disclaim them is appropriate.

The word "BROADBAND" is merely descriptive of applicant's services because a significant feature or characteristic of applicant's conferences is that they are focused on broadband technology and broadband services. Both advertisements of record, as noted above, make it abundantly clear that the subject of applicant's conferences is broadband technology. The requirement for applicant to disclaim this descriptive term is therefore plainly appropriate.

When the word "YEAR" is combined with the descriptive word "BROADBAND," the resulting combination is also merely descriptive of applicant's services within the meaning of Section 2(e)(1) of the Act. Applicant's use of the word "YEAR" as part of its service mark appears to be in reference either to the particular calendar year in which

applicant's conference is being conducted or to developments in the broadband field in the year since the previous conference was held. It is not necessarily clear which one of these meanings is conveyed by the mark, but in either case, the combined term, "BROADBAND YEAR," immediately and forthwith conveys significant information concerning applicant's services, namely that the subject of the conferences applicant conducts is a year in the development of broadband technology.

DECISION: The requirement for a disclaimer of "BROADBAND YEAR" is affirmed. Applicant is allowed thirty days from the mailing date of this ruling in which to file the required disclaimer under Trademark Rule 2.142(g). If applicant does so, the decision affirming the requirement will be set aside.

Ser No. 75/769,784