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IS NOT CITABLE AS PRECEDENT
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Paper No. 22
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re IDG Books Worldwide, Inc.

Serial No. 75/975,176

Mark B. Harrison and Marcia A. Augerger of Venable Baetjer
Howard & Civiletti for IDG Books Worldwide, Inc.

Gerald T. Glynn, Trademark Examining Attorney, Law Office 102
(Thomas Shaw, Managing Attorney).

Before Simms, Hohein and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

On February 9, 1995, International Data Group Inc. filed an intent to use application on the Principal Register for a trademark depicted as "----FAQS" for "books in the field of computers, computing and computer software." After receiving repeated refusals under Section 2(e)(1) of the Act, 15 USC §1052(e)(1), applicant filed an amendment to allege use, and also amended the application to seek registration on the Supplemental Register. At that time, the Trademark Examining Attorney refused registration on the ground that the phantom mark (shown above) as depicted on the original typed drawing

was impermissible, and furthermore, that the asserted mark was incapable of identifying applicant's books and distinguishing them from the books of others. A subsequent amendment of the mark to merely "FAQS" was accepted by the Trademark Examining Attorney, but applicant¹ has appealed from the Section 23 refusal. Applicant and the Trademark Examining Attorney have submitted briefs. Applicant did not request an oral hearing.

We affirm the refusal to register.

Applicant argues, in urging that the refusal be reversed, that the mark sought to be registered is not a generic name for applicant's books. The totality of applicant's argument in its appeal brief is as follows (brief, unnumbered page 2):

It is the applicant's position that, while the term FAQS may be descriptive of the subject matter of applicant's books, it is not a generic designation for those books.

There is no evidence that the term FAQS identifies a category of books rather than the subject matter of the books.

As a descriptive designation, the term FAQS should be registrable on the Supplemental Register, and the refusal of registration should therefore be reversed.

By contrast, it is the Trademark Examining Attorney's position that the alleged mark, "FAQS," is not capable of

¹ The assignment records of the USPTO reflect the fact that this application was assigned with the entire interest and goodwill to IDG Books Worldwide, Inc. (a Massachusetts corporation), and then subsequently assigned by merger with IDG Books Worldwide, Inc. (a Delaware corporation).

identifying applicant's books and distinguishing them from the computer books of others. He claims that the record shows that "FAQ" is the generic acronym for "frequently asked question" (or the pluralized form "FAQs"² for "frequently asked questions"). Further, he argues that the evidence of record demonstrates that there exists an entire category of publications and/or books, now seen in a wide variety of fields, comprising compilations of frequently asked questions. This is especially true for books targeted to the computer industry, where this acronym³ was coined and popularized.

As our principal reviewing court has stated:

...[D]etermining whether a mark is generic ... involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?

H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986). Generic terms are by definition incapable of indicating source and thus can never attain trademark status.

² While the title pages of virtually all of applicant's books consistently show the letters "FAQ" larger than the trailing letter "s," and many of the LEXIS-NEXIS stories show upper-case letters "FAQ" followed by a lower-case letter "s," this is a distinction never discussed by applicant or the Trademark Examining Attorney, so for purposes of this decision, we will consider "FAQs" and "FAQS" as legally identical.

³ While several dictionary entries do show the term pronounced as a single-syllable acronym, in our experience, the term is sometimes also spoken as an initialism, or "F-A-Ques."

However, with respect to genericness, the Office has the burden of proving the refusal with "clear evidence" of genericness. In re Merrill, Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). As seen above, the critical issue in genericness cases such as this one is whether members of the relevant public primarily use or understand the term sought to be registered to refer to the genus or category of goods in question. H. Marvin Ginn Corporation, supra, and In re Recorded Books, Inc., 42 USPQ2d 1275 (TTAB 1997). Evidence of the relevant public's perception of a term may be obtained from any competent source, including newspapers, magazines, dictionaries, trade journals, catalogs and other publications. In re Leatherman Tool Group, Inc., 32 USPQ2d 1443, 1449 (TTAB 1994), citing In re Northland Aluminum Products, Inc., 777 F.2d 1566, 227 USPQ 961, 963 (Fed. Cir. 1985).

The Examining Attorney supports his position with excerpts from a number of dictionary definitions of the term, from applicant's specimens of record, from dozens of articles obtained from the LEXIS/NEXIS® database as well as from multiple Internet sites.

The dictionary definitions read as follows:

FAQ Acronym for **frequently asked question**.
Any of a number of questions that might be asked by newcomers to a source of information

on the *Internet*, typically a USENET *newsgroup*. A list of FAQs and their answers is compiled by each newsgroup and is freely available to Internet users.⁴

FAQ Frequently Asked Questions (ACRL)⁵

Frequently asked questions (FAQs): Short lists of common questions - and their answers - that are provided to users of a given Internet site. Pronounced "facks," these lists are designed to explain to a novice (or newbie) the scope of information available at the site, and the basics on how to use it. They are common on Usenet newsgroups. Because regular group members are bored silly by newbies asking the same old things, newbies are expected to familiarize themselves with a site's FAQs before joining an on-line discussion there.⁶

FAQ 1. A Frequently Asked Question. 2. A compendium of accumulated lore, posted periodically to high-volume news groups in an attempt to forestall such questions...⁷

The first definition above focuses on the dynamic origins of the term FAQ in the interactive world of on-line users. The last definition shows that the same term is also used to refer to a "compendium" of such entries. It is clear from applicant's own specimens of record that many companies have

⁴ American Heritage Dictionary of Computer Words: An A to Z Guide to Today's Computers, p. 100.

⁵ Acronyms, Initialisms and Abbreviations Dictionary, Gale Research, 1997, p.29; the specific source for this acronym is identified as ACRL, an acronym reference list dated January 13, 1997, and found at <http://mailme.com/acronyms> .

⁶ Cyber Dictionary: Your Guide to the Wired World, Knowledge Exchange, LLC 1996, p. 119.

⁷ The New Hackers Dictionary, Eric S. Raymond, 1996, p. 181.

moved this helpful technique into the world of bound volumes, especially useful for those who prefer books in solving their computing problems. The record contains copies of the front covers of applicant's own books wherein the trade dress incorporates the term "FAQs" into the book titles. Beneath the titles and sub-titles are examples of the prominent blurbs shown on the respective covers:

- PC FAQs: Frequently Asked Questions & Answers form Compaq Customer Service;

Answers to Your Most Frustrating PC Questions,
from the Experts at Compaq Customer Service

Save Time & Money with Instant Help on PC
Hardware, Software the Internet, Laptops, Modems,
Printers, & Much More

- Internet FAQs: Answers to the Most Frequently Asked Questions;

Answers to the Most Frustrating Internet Questions
at Your Fingertips - for Windows, Mac, & UNIX
Users

Save Time & Money with Instant Help on Using the
World Wide Web, E-mail, Usenet, Gopher, FTP, &
Much More

- Macworld Mac FAQs: Answers to the Most Frequently Asked Questions";

Your Burning Macintosh Questions, Expertly
Answered

Find Out How to Do It, When to Buy It, And How to
Solve it - Including Instant Help on Power Macs,
System 7.5, Performas, Word 7, and More!

Written by the hottest Macintosh author around, David Pogue, Macworld Mac FAQs gives users the ultimate Mac reference. Hundreds of Mac questions and answers side-by-side, right at your fingertips, and organized into six easy-to-reference sections with lots of sidebars and diagrams.

- 1001 Computer FAQs: Frequently Asked Questions & Answers from Compaq Customer Service;

The people who staff the world's most reliable customer-support lines team up to answer the questions that vex every new computer owner. Not just for owners of Compaq systems, this unique offering is geared toward people who demand instant help as they install and explore their machines. Every answer in this book is the result of countless hours of phone consultation with average users. IDG Books and Compaq have put together the definitive book of Frequently Asked Questions.

- OS/2 Warp FAQs

At last, the ultimate answer book for every OS/2 Warp user. Direct from IBM's Service Hotline, OS/2 Warp FAQs is a comprehensive question and answer guide that helps you optimize your system and save time by putting the answers to all your questions right at your fingertips.

Applicant, in its response filed on January 17, 1996, confirms the origin of the acronym as follows:

As is clear from the covers of applicant's books, the designation FAQs is used by applicant as an abbreviation for the phrase FREQUENTLY ASKED QUESTIONS.

The NEXIS evidence clearly establishes that a "FAQ" is a widely known type of book compiling frequently asked

questions. As representative examples of the uses of the term by others in the publishing fields, we note the following:

As most smart novices and savvy computer professionals know, often the fastest way to get an answer is to head for a Web site or USENET group's FAQ (frequently asked questions) file. Well-maintained FAQs are priceless (Isn't it ironic that they are free?). In the MFC Answer Book, *Kain has taken the FAQ format and turned it into a book.* The San Diego Union Tribute, January 12, 1999.

In recent weeks, Nolo Press's most popular book has not been sold but given away, as a gift to mark its 25th anniversary. It's "Nolo's Little Law Book," a 92-page paperback with answers to scores of "everyday legal questions" about 25 subjects, from buying a house to legal malpractice. For a copy, write to Nolo Press, Attn. *FAQ Book*, 950 Parker St., Berkeley, Calif. 94710... The Atlanta Journal and Constitution, August 5, 1996.

Every business has FAQs, frequently asked questions. Customer representatives know all of them. *Why not publish the FAQs and the answers?* Not only does this reduce the number of telephone calls, it makes customers feel better informed. American Salesman, October 1996.

Every newsgroup has an FAQ, a file of frequently asked questions. *This group has an FAQ that would make a book publisher drool.* Hundreds of firsthand reports have been compiled into a list of practical advice, creative suggestions and calming reassurances. "Parents look for help and share advice in Cyberspace," The Dayton Daily News, June 12, 1995.

When I train others in NetWare, I usually start by having them read the FAQ document first and then the red books (the NetWare manuals), because the materials make much more sense if they are read in that order. "Creating DOS and

NetWare Batch Files," LAN Magazine, January 1, 1997.

Finally, we note that the record in this case (from the LEXIS/NEXIS® database as well as specific Web sites) contains multiple references to the availability of bound books (ones published and distributed by third parties) entitled The Adobe FAQ book, The SGML FAQ book, "C++ Faq, Java Faqs, etc.

Question #1: What is the genus of these books?

In the language of H. Marvin Ginn Corporation, supra, what is the precise genus of applicant's books? The identification of goods involved herein reads simply "books in the field of computers, computing and computer software." Hence, the broad category of goods involved here is computer-related books. In the abstract, this might be read to include textbooks or technical journals targeted to computer professionals knowledgeable in a certain field or application. However, all the evidence of record points to simpler, abbreviated texts compiled for the mass-market of computer "newbies." As shown by applicant's own literature and by the LEXIS-NEXIS® articles, books within this sub-category of computer publications share a number of common features or characteristics. Succinctness, simplicity and brevity are paramount. The category is characterized by sensibly

organized and well-indexed books on "how-to" accomplish the most frequently used tasks in a computer application. If successful in this category, these bound resources necessarily promote fast, easy and visual learning. The computer novice quickly finds general but vital information in easy-to-follow steps. Each volume contains specific tips, diagnostic checklists, problem-solving techniques and troubleshooting guides. Some desktop collections comprise compilations of on-line forums or the republication of electronic newsletters. An increasingly popular format for all of these books targeted to computer users is that of grouping together the most commonly asked questions on a given topic, with each question followed by the correct answer - a format known as FAQs.

Question #2: Is the term "FAQS" understood by the relevant public primarily to refer to this class of goods

The target audience for these goods is made up of computer users, perhaps including some computer professionals, but certainly intended for the computer user who is new to a particular application. Here the Trademark Examining Attorney maintains that FAQs is a term of art used by those in the forefront of computer innovation, to identify a compilation of frequently asked questions with their answers. Consistent with applicant's identification of goods, and as further demonstrated by applicant's specimens of record, this is

precisely the product applicant is marketing. Inasmuch as the term "FAQs" alerts the computer user to the fact that applicant's books have the format of "frequently asked questions," we agree that the evidence clearly demonstrates that "FAQS" will be readily understood by the relevant public primarily to refer to this class of books. Without a doubt, whether the term under scrutiny for the format of a computer book would be "quick reference guide," "checklist," "tips" or "frequently asked questions," we note that "[a]ll of the generic names for a product belong in the public domain." In re Sun Oil Company, 426 F.2d 401, 165 USPQ 718, 719 (CCPA 1970).

Accordingly, we find that under the second part of the Marvin Ginn test, the designation "FAQS" is one of the terms that would be readily understood by the computer user as primarily referring to the category of computer-related books into which applicant's products fall. That is, FAQs will be understood as referring to the format of applicant's books, and thus is incapable of functioning as a mark indicating applicant as the source of goods of this type. See In re Sun Oil Co., 426 F.2d 401, 165 USPQ 718 (CCPA 1970) [CUSTOM BLENDED was held generic for gasoline]; J. Kohnstam, Ltd. v. Louis Marx & Co., 280 F.2d 437, 126 USPQ 362 (CCPA 1960) [MATCHBOX for toy vehicles was held generic because that

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category of toy cars was sold in matchbox-sized boxes]; and In re Central Sprinkler Co., 49 USPQ2d 1194 (TTAB 1998) [ATTIC held generic for automatic sprinklers for fire protection].

Decision: The refusal to register under Section 23 is affirmed.