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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Mark Deitch & Associates, Inc.**

Serial No. 75/857,971

Thomas I. Rozsa of Rozsa & Chen LLP for **Mark Deitch & Associates, Inc.**

Ronald L. Fairbanks, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before **Hohein, Chapman** and **Bucher**, Administrative Trademark Judges.

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

Mark Deitch & Associates, Inc. has filed an application to register the term "WEBSITEDESIGNS.COM" as a service mark for "computer services, namely, designing and maintaining websites for others."¹

¹ Ser. No. 75/857,971, filed on November 24, 1999, which alleges a date of first use anywhere and in commerce of March 4, 1997. Although originally registration was sought on the Principal Register, the application was amended, when registration was refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground of

Registration has been finally refused under Section 23 of the Trademark Act, 15 U.S.C. §1091, on the basis that the term "WEBSITEDESIGNS.COM" is generic and thus is not capable of distinguishing applicant's services.²

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

It is well settled that a term must be capable of serving as an indicator of source in order for it to be registrable on the Supplemental Register. Whether a term has the capacity necessary for registration on the Supplemental

mere descriptiveness, to seek registration on the Supplemental Register.

² In addition, the Examining Attorney made final his initial refusal to register such term on the ground of mere descriptiveness, finding that applicant's claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), on the basis of an assertion by its counsel of "over four years of continuous use," was an insufficient showing. It is pointed out, however, that after an application has been amended to the Supplemental Register, neither a refusal on the ground of mere descriptiveness nor a possible showing of acquired distinctiveness is relevant to whether registration is permissible on the Supplemental Register. See, e.g., In re Simmons Co., 278 F.2d 517, 126 USPQ 52, 53 (CCPA 1960) [test for registration on the Supplemental Register is "not whether the mark, when registration is sought, is actually recognized by the average purchaser, or is distinctive of the applicant's goods [or services] in commerce, but whether it is *capable of becoming so*. In fact a mark which has become distinctive of an applicant's goods [or services], if not otherwise barred, is registrable on the principal register, [and] hence is expressly barred from the supplemental register" (italics in original)]. The only issue properly before us, in view of the amendment of the application to the Supplemental Register, is thus whether the term "WEBSITEDESIGNS.COM" is capable of distinguishing applicant's services.

Register is determined by considering the meaning thereof as applied to the goods or services, the context in which it is used on any specimens filed with the application, and the likely reaction thereto by the average customer upon encountering the term in the marketplace. See *In re Cosmetic Factory, Inc.*, 208 USPQ 443, 447 (TTAB 1980). "The test is not whether the mark is already distinctive of the applicant's goods [or services], but whether it is capable of becoming so." *In re Bush Brothers & Co.*, 884 F.2d 569, 12 USPQ2d 1058, 1059 (Fed. Cir. 1989). However, as noted in *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 728 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986), if a term is generic, it is incapable of registration on the Supplemental Register.

Additionally, it is well established that, in the case of a term asserted to be incapable because it is generic, the burden is on the United States Patent and Trademark Office ("USPTO") to show the genericness of the term by "clear evidence" thereof. *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). As to the correct legal test for genericness, our principal reviewing court in *Marvin Ginn*, supra at 530, stated that:

Determining whether a mark is generic [and thus not capable of distinguishing an applicant's goods or services] ... 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?

In applying such standard, the Board in *In re Leatherman Tool Group Inc.*, 32 USPQ2d 1443, 1449 (TTAB 1994), noted among other things that "evidence of the relevant public's understanding of a term may be obtained from any competent source, including newspapers, magazines, dictionaries, catalogs and other publications," citing *In re Northland Aluminum Products, Inc.*, 777 F.2d 1566, 227 USPQ 961, 963 (Fed. Cir. 1985). Furthermore, in the case of a compound term, our principal reviewing court in *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999), pointed out that as set forth in *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111-12 (Fed. Cir. 1987), not only does the test of whether a term is generic involve a determination of its primary significance to the purchasing public, but the burden of proof of genericness, which is on the USPTO, is satisfied by dictionary definitions showing that separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to those words as a compound.³ That is, if the USPTO can prove that the public understands the individual

³ It appears that both applicant and the Examining Attorney agree that "WEBSITEDESIGNS.COM" is a compound term for the purpose of determining whether it is generic for applicant's services.

terms to be generic for a genus of goods or services and that the public also understands the joining of the individual terms into one compound word lends no additional meaning to the term, then the USPTO has proven that the public would understand the compound term to be generic in that it refers primarily to the genus of goods or services described by the individual terms.

In re American Fertility Society, supra at 1837.⁴

Applicant, in its initial brief, maintains that "WEBSITEDESIGNS.COM" is "a fanciful combination term which does not by itself describe the Applicant's services." Specifically, applicant urges that "there is no reason to dissect the mark into several components and argue that 'WEBSITE' is one word, 'DESIGNS' is the second word and '.COM' is a third word and therefore, dissecting it in this way, the mark is descriptive." We observe, however, that as shown by the printouts from its website which were submitted as specimens of use, applicant actually uses the term "WEBSITEDESIGNS.COM" in the format "WebsiteDesigns.com," a manner of use which plainly highlights the components of such term. Nonetheless, applicant contends that when viewed in its entirety, "the fanciful combination [of]

⁴ The Court went on to point out, however, that "*Gould* is limited, on its facts, language, and holding, to compound terms formed by the union of words" and that it is "legally erroneous" to apply the test therein for genericness of such terms "to phrases consisting of multiple terms, which are not 'joined' in any sense other than appearing as a phrase." In re American Fertility Society, supra at 1836.

terms make the mark sufficiently fanciful to be at least allowable on the Supplemental Trademark Register and definitely not generic."⁵

We agree with the Examining Attorney, however, that the record contains clear evidence that the term "WEBSITEDESIGNS.COM" is generic and, hence, is incapable of identifying applicant's computer services, namely, designing and maintaining websites for others. In this regard, it is apparent with respect to the first prong of the genericness test, as set forth in *Marvin Ginn*, supra at 530, that the class or category of services at issue herein is that of designing and maintaining websites for others, that is, website design services or the providing of website designs. Applicant, we note, does not contend otherwise.

With respect to the second step of the inquiry required by *Marvin Ginn*, which is whether the relevant public understands the term "WEBSITEDESIGNS.COM" to refer to the category or class of services at issue, namely, the computer services of designing and maintaining websites for others, we find that such term would be so understood. As the Examining

⁵ Although applicant adds that such is especially so since "[n]owhere is the combination 'WEBSITEDESIGNS.COM' found in any dictionary or any other place where words are defined," it is pointed out that the fact that a term is not found in a dictionary or other reference work is not controlling on the question of registrability. See, e.g., In re

Attorney, citing definitions of record from The American Heritage Dictionary of the English Language (3rd ed. 1992), points out in his brief, the word "website" is defined as "a set of interconnected Web pages, usually including a home page, generally located on the same server, and prepared and maintained as a collection of information by a person, group, or organization," while the word "design" is listed as variously meaning:

(a) (as a transitive verb) "**1.** ... **b.** To formulate a plan for; devise: *designed a marketing strategy for the new product.* **2.** To plan out in systematic, usually graphic form: *design a building; design a computer program.* **3.** To create or contrive for a particular purpose or effect: *a game designed to appeal to all ages.* **5.** To create or execute in an artistic or highly skilled manner.";

(b) (as an intransitive verb) "**3.** To create designs."; and

(c) (as a noun) "**1.** ... **b.** A graphic representation, especially a detailed plan for construction or manufacture. **2.** The purposeful or inventive arrangement of parts or details **3.** The art or practice of designing or making designs."

As also noted by the Examining Attorney in his brief, the record shows that "[t]he top level domain [name] '.COM' simply signifies to the public that the use of the domain name constitutes a commercial entity" and thus, in a manner analogous

Gould Paper Corp., supra at 1112; and In re Orleans Wines, Ltd., 196

to such terms as "INC.," "CO." or "CORP.," has no trademark or service mark significance.

Moreover, as additional evidence, the Examining Attorney has included in the record instances showing widespread third-party uses of the term "website design(s)" (and variants thereof) in a generic fashion. Specifically, the Examining Attorney contends, as stated in his brief, that he has furnished "numerous excerpts from the *Lexis/Nexis* computerized database and a random sampling of excerpts from the *Google* search engine--both evidencing the generic usage of the wording 'website designs' for website design services."⁶

Representative examples of the "LEXIS/NEXIS" excerpts include the following (emphasis added):

"iPathfinder is a full-service company that specializes in **website design**, ... site maintenance, ... and technical support." -- Indian Country Today, (June 11, 2001) (article headlined: "Web Site Developer Aids Indian Country Entrepreneurs with Technology");

"IBS also has been developing its **Website design** services" -- Black Enterprise, (July 2000);

USPQ 516, 517 (TTAB 1977).

⁶ While the record also contains copies of several third-party registrations for marks which include the disclaimed words "WEBSITE DESIGN(S)" or "WEB DESIGN" for website or computer site design services, the Examining Attorney has not referred to such in his brief, apparently viewing the third-party registrations as cumulative or superfluous in light of the other substantial evidence in the record.

"Lina Trivedi, 25, co-founded VX2 Inc., an Addison-based Internet marketing and **Web site design** company" -- Chicago Sun-Times, (April 25, 1999);

"Bringing Cargill aboard will allow Sullivan to concentrate on building her company's **Web site design** arm The new entity, called websites2go, targets small and mid-sized businesses for which the cost of designing a site would be prohibitive." - ADWEEK (New England edition), March 22, 1999;

"Health care organizations have two options when it comes to developing interactive Web sites: designing and developing the interactive functions on their own using their own information systems specialists, or hiring an Internet service provider or **Web site design** company." Health Data Management, December 1998;

"Her **Web site designs** range from \$500 to \$3,500

In addition to designing Web sites, FireGirl also offers Web hosting and online commerce tools." -- Central Maine Morning Sentinel, June 8, 1998; and

"'I believe WebPainter will be right up there with Adobe PhotoShop and Illustrator as one of the required tools for effective **Web site design**,' said Terry Kluytmans of Stairway to Webbin' Design Services." -- GUI Program News, September 1997.

The excerpts of record from the "GOOGLE" search engine, including in some instances printouts from certain websites located thereby, demonstrate extensive generic usage of the term "website design(s)" (and variants thereof) for website

design services. The following examples, all of which were retrieved on July 23, 2001, are representative (emphasis added):⁷

"**Website Designs** ... Description: Provides **website design**, development and hosting." -- www.truenz.co.nz-/designs/;

"Dark Horse **Website Designs** - Website designers Description: Piscataway, NJ based firm offering custom web design, creation, promotion and hosting." -- www.-dhdesign.com ;

"arielView **Website Designs** Creative and Innovative **Website Designs**" -- www.arielview.com;

Project WWW **Website Designs** Our services include: ... **Web Site Design** and Strategy" -- www.projectwww.com;

"A-FIRST **Website Designs** is a full-featured Internet **web site design** company." -- www.afirst.com;

"MPX **Web Site Designs** Description: Maryland **website designs**, hosting service by MicroPlex. Specializing in **Website Designs** and Hosting." -- www.microplexcomputers.com; and

"Affordable **website designs** by Vintage Gardens Productions ... We specialize in **Website Designs** for Small and Mid-sized Businesses. Description: **Website design** and management for individuals and businesses." -- www.vintage-gardens.com; and

Based upon the above, we concur with the Examining Attorney's conclusion that the term "WEBSITEDESIGNS" is "clearly

⁷ In addition to such examples, a host of similar excerpts was retrieved and made of record with the final refusal as a result of

generic" for the computer services of designing and maintaining websites for others and that the mere addition of the top level domain name ".COM" is "insufficient to create source-identifying significance." Plainly, when considered in its entirety, the compound term "WEBSITEDESIGNS.COM" has been shown by the dictionary definitions of its component elements and the excerpts retrieved from the "LEXIS/NEXIS" database and by the "GOOGLE" search engine to be a generic term and, as such, is not capable of identifying applicant's computer services of designing and maintaining websites for others. The primary significance of the term is simply to designate a class or category of Internet-based commercial entities which provide website designs, or website design services, for others. No new meaning is created by the combination of the terms "WEBSITE," "DESIGNS" and ".COM"; rather, the consuming public for services of the kind rendered by applicant would understand the meaning of the term "WEBSITEDESIGNS.COM" to be the same as that of its constituent parts combined. See, e.g., In re Gould Paper Corp., supra at 1112 ["SCREENWIPE" is generic term for "pre-moistened, anti-static cloth for cleaning computer and television screens" inasmuch as component terms "SCREEN" and "WIPE" "remain as generic in their compound as individually, and the compound thus

another *Google* search on March 4, 2002.

created is itself generic"]; In re CyberFinancial.Net Inc., 65 USPQ2d 1789, 1792-94 (TTAB 2002) ["BONDS.COM" for, inter alia, "providing information regarding financial products and services via a global computer network ..., with respect to taxable and tax exempt debt instruments," is generic term for such services; it lacks "any meaning apart from the meaning of the individual terms combined"; and it "is properly considered a compound word in this analysis"]; and In re Martin Container Inc., 65 USPQ2d 1058, 1060 (TTAB 2002) ["CONTAINER.COM" is "incapable of identifying the source of applicant's retail and rental services featuring containers" because "what applicant seeks to register is simply a generic term [CONTAINER], which has no source-identifying significance in connection with applicant's services, in combination with the top level domain indicator [.COM], which also has no source-identifying significance, and ... combining the two does not create a term which has somehow acquired the capability of identifying and distinguishing applicant's services"].

Furthermore, even if the term "WEBSITEDESIGNS.COM" were to be analyzed under *American Fertility Society*, supra at 1836, as constituting a phrase composed of multiple terms rather than as a compound term under *Gould*, supra at 1111-12, it is still the case that such term has been shown by clear evidence to be generic for website design services rendered by a

commercial entity. Specifically, the record additionally contains many instances of third-party usages of the term "websitedesigns.com" as part of the domain names for commercial firms which offer the services of providing website designs. The following examples, retrieved by the "GOOGLE" search engine, are representative (emphasis added):

"Main corporate pages of **Website Designs**, specialist [in] Internet design, development and consultancy services." -- www.website-designs.com;

"Georgia **Website Designs** was founded on the idea that not all business owners need to pay for skills that will not be utilized on their site." -- www.georgiawebsitedesigns-.com;

"Affordable **Website Designs**
Description: **Website design** ... services for individuals and small businesses." -- www.a-websitedesigns.com;

"Imagine **Website Designs**

We are proud to offer professionally designed websites" -- www.imagine-websitedesigns.com/newhome.htm;

"NJ **Website Designs** will provide all pieces to the puzzle in order to create a successful commercial website for you.
Description: **Web site design**, commercial web site sales," -- www.njwebsitedesigns.-com;

"American **Website Designs** ... Creators of custom designed websites built exclusively for you." -- www.americanwebsitedesigns.com;

"Welcome to Market America
Services include web hosting, **web design** and **site** management" -- www.acewebsite-designs.com;

"Janelle Morris **Website Designs**" -
- www.jmwebsitedesigns.com; and

"Texas **Website Designs** is an Independent **web design** company. We strive to provide excellent **web design services**." -
- www.texas-websitedesigns.com/main.htm.

It is plain therefrom that the purchasing public for applicant's computer services, namely, designing and maintaining websites for others, would regard the term "WEBSITEDESIGNS.COM" as primarily signifying a category or class of commercially available website design services available through the Internet. The record thus establishes that the term "WEBSITEDESIGNS.COM" is indeed generic for any commercial entity's website design services. As such, it is not capable of identifying applicant's services and is not registrable on the

Supplemental Register. See, e.g., In re CyberFinancial.Net Inc., supra at 1794 [in finding compound term to be generic for, inter alia, providing information regarding taxable and tax exempt debt instruments via a global computer network, the Board "add[ed] that even if the designation BONDS.COM were viewed as a phrase, we would reach the same result here"]; and In re Martin Container Inc., supra ["CONTAINER.COM" held generic for retail and rental services featuring containers inasmuch as such term "indicate[s] a commercial web site on the Internet which provides containers"].

Decision: The refusal under Section 23 is affirmed.