

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Hearing:  
March 16, 2000  
10/02/00

Paper No. 16  
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re H. Lee Browne

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Serial No. 75/267,810

Laurence R. Hefter and B. Brett Heavner of Finnegan,  
Henderson, Farrabow, Garrett & Dunner, L.L.P. for H. Lee  
Browne.

Anne T. Madden, Trademark Examining Attorney, Law Office  
103 (Michael Szoke, Managing Attorney).

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Before Quinn, Chapman and McLeod, Administrative Trademark  
Judges.

Opinion by Chapman, Administrative Trademark Judge:

On April 2, 1997, H. Lee Browne filed an application  
to register the mark SIGNATURE-MAIL on the Principal  
Register for "computer software which enables the user to  
insert images in electronic mail messages" in International  
Class 9. Applicant asserted a bona fide intention to use  
the mark in commerce.

The Examining Attorney has finally refused  
registration under Section 2(e)(1) of the Trademark Act, 15  
U.S.C. §1052(e)(1), on the basis that the mark SIGNATURE-

MAIL, when applied to the identified goods of the applicant, is merely descriptive of them.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, and both were present at an oral hearing before this Board.

The Examining Attorney contends that a term need only describe one function or aspect of the goods in order to be considered merely descriptive; that the mark SIGNATURE-MAIL describes "the primary function of applicant's goods," "which is to insert an individual's handwritten signature and other images into e-mail, computer faxes and documents" (brief, pp. 2-3); and that, in fact, applicant's website information (filed by applicant on March 8, 1999) emphasizes the use of applicant's software to insert a literal handwritten signature, with less emphasis on inserting other images into e-mail or other documents. Further, the Examining Attorney argues that the terms "signature" and "mail" have commonly understood dictionary meanings, and when combined the terms do not create a unique or incongruous mark; and that the fact that applicant may be the first (and possibly only) user of a merely descriptive term does not justify registration of said term.

The Examining Attorney submitted in support of her refusal to register under Section 2(e)(1) dictionary definitions of the words "signature" and "electronic mail"<sup>1</sup>; and twenty excerpted stories of 3845 total stories found from a search (framed as "signature mail or signature w/s mail") of the Nexis database.

The American Heritage Dictionary (1992) defines "signature" with six definitions, including "1. Abbr. sig. One's name as written by oneself. 2. The act of signing one's name. 3. A distinctive mark, characteristic, or sound indicating identity: A surprise ending is the signature of an O. Henry short story." There are also meanings specific to the fields of medicine, music and printing.

The Examining Attorney specifically contends that in relation to this mark in this application "the term MAIL refers to electronic mail." (Final Office action, October 20, 1998, p. 2.) Applicant disagrees that "'mail' is synonymous with 'e-mail' in the 1990s." (Reply brief, p. 4, footnote 2.) "E-mail" is defined in The Computer Glossary: The Complete Illustrated Dictionary as "The transmission of memos and messages over a network...."

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<sup>1</sup> She submitted with her brief dictionary definitions of the words "electronic mail," "e-mail" and "mail system," and she requested that the Board take judicial notice thereof. The request for judicial notice is granted. See TBMP §712.01.

Applicant contends that it does not offer an e-mail service or e-mail software, but rather, its computer software "is used to add special features to electronic documents"<sup>2</sup>; that its mark SIGNATURE-MAIL is suggestive that applicant's computer software "relates in some way to special messages or correspondence" (brief, p. 6.)<sup>3</sup>; that the Examining Attorney's position regarding applicant's goods and the term "signature" is flawed because she treats the term as if it were interchangeable with the term "images" in applicant's identification of goods; that applicant's use of the term "signature" is intended to refer to the traditional meaning of the word<sup>4</sup>; that the term "mail" at most suggests a type of document into which images may be inserted, especially inasmuch as the term "mail" is normally used to describe the method of delivery of the mail (e.g., electronic, first class, overnight); that applicant's particular juxtaposition of these two

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<sup>2</sup> Applicant stated in the record that its goods are neither (i) a password (or "signature") needed to log onto one's e-mail, nor (ii) an electronic signature which accompanies data transmitted over a network and which cannot be forged and prevents tampering with the e-mail message while en route (a "digital signature").

<sup>3</sup> Applicant stated that the point of its product "is to personalize communications and documents." (Reply brief, p. 2.)

<sup>4</sup> Applicant referred to Webster's Ninth Collegiate Dictionary wherein "signature" is defined as, inter alia, "a person's name written by himself ... [or] an identifying characteristic or mark." (Applicant's Response, May 18, 1998, p. 4).

common terms, viewed as a whole, creates a unique impression resulting in a suggestive mark; and that in view of the multiple meanings of the term "signature" purchasers must use imagination and thought to determine that the mark SIGNATURE-MAIL relates to imaging computer software.

Applicant further contends that the Nexis evidence submitted by the Examining Attorney is not persuasive because there are no references to the words "signature mail" together, but rather, all of the stories include only separate uses of the words "signature" and "mail" or "e-mail"; one excerpt is from a foreign publication; several of the remaining 19 excerpted stories are not relevant uses of the words in the context of applicant's goods (e.g., those stories relating to Versace "signature" style and mesh chain-mail, signature guarantees and certified mail, obtaining signatures in a vote-by-mail election, mail order and Signature Design International Inc., and a forged signature at the Post Office routing a person's home mail to New York); and none of the stories reflects a descriptive use of the words "SIGNATURE-MAIL" with regard to applicant's identified goods. Finally, applicant argues that there is no evidence of use by others of the combination of words "SIGNATURE MAIL"; and that doubt is resolved in applicant's favor.

It is well settled that "a term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]." (Emphasis added). In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). Moreover, the immediate idea must be conveyed with a "degree of particularity." In re TMS Corporation of the Americas, 200 USPQ 57, 59 (TTAB 1978); and In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd, unpub'd, Fed. Cir. February 13, 1991. As the Court stated in In re Abcor Development, supra: "Although a mark may be generally descriptive, if it also functions as an indication of origin, it is not 'merely descriptive.'" See also, In re Quik-Print Copy Shop, Inc., 616 F.2d 523, 205 USPQ2d 505 (CCPA 1980).

Of course, whether a term or phrase is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term or phrase would have to the average purchaser of the goods or services because of the manner of its use. See In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). See also, In re Consolidated Cigar Co.,

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35 USPQ2d 1290 (TTAB 1995); and In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991).

It has long been acknowledged that there is often a very narrow line between terms which are merely descriptive and those which are suggestive, and the borderline between the two is hardly a clear one. See In re Atavio Inc., 25 USPQ2d 1361 (TTAB 1992).

Viewing the record in its entirety, we find that the Examining Attorney has not established a prima facie showing that the mark SIGNATURE-MAIL, taken as a whole, is merely descriptive of applicant's computer software products. We agree with the Examining Attorney that in the context of applicant's goods, as identified, consumers will relate the term MAIL in applicant's mark to "e-mail". (We note that applicant is the owner of several other pending applications, including one for the mark (Serial No. 75/611,030<sup>5</sup>. Of course, our determination in this appeal is not binding with regard to applicant's other applications.)

However, the term "signature," as evidenced by the dictionary submissions, is a term with several different yet commonly understood meanings, and the evidence of

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<sup>5</sup> Action on applicant's application Serial No. 75/611,030 has been suspended in Law Office 103.

record does not establish that this mark SIGNATURE-MAIL conveys an immediate idea of a primary function of applicant's goods. The Nexis excerpts submitted by the Examining Attorney are unpersuasive for the reasons asserted by applicant, and set forth above.

Moreover, we note that the Examining Attorney did not submit any evidence whatsoever demonstrating that the term "signature mail" is used in a descriptive sense.

The burden of proving that applicant's mark is merely descriptive rests with the Examining Attorney. The record before us does not show that the term SIGANTURE-MAIL has a readily recognized meaning with regard to the involved goods. That is, the mark SIGNATURE-MAIL does not readily and immediately evoke an impression and an understanding of the function or purpose of applicant's imaging insertion software. Rather, on this ex parte record, we conclude that the mark SIGNATURE-MAIL requires a degree of imagination or perception to determine the function or purpose of applicant's goods. Applicant's mark is indeed a juxtaposition of two common words which, when viewed as a whole, and in relation to the involved goods (computer software which enables the user to insert images in electronic mail messages), is creative, and the mark has not been shown to be merely descriptive.

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Finally, if doubt exists as to whether a term is merely descriptive, it is the practice of this Board to resolve doubts in favor of the applicant and pass the application to publication. See *In re Gourmet Bakers Inc.*, 173 USPQ 565 (TTAB 1972). In this way, anyone who believes that the term is, in fact, descriptive, may oppose and present evidence on this issue to the Board.

Decision: The refusal to register under Section 2(e)(1) is reversed.

T. J. Quinn

B. A. Chapman

L. K. McLeod  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board