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Paper No. 12
TLW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re On-Site Trading, Inc.

Serial No. 75/507,347

Kevin P. Crosby of Brinkley, Mcnerney, Morgan, Solomon & Tatum, LLP for On-Site Trading, Inc.

Kenneth Battle, Trademark Examining Attorney,
Law Office 111 (Craig Taylor, Managing Attorney)

Before Simms, Seeherman and Bottorff, Administrative
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

On-Site Trading, Inc. (applicant), a New York corporation, has appealed from the final refusal of the Trademark Examining Attorney to register the mark ON-SITE TRADER for "providing access to a computer network on which securities transactions can be carried out by consumers."¹ The Examining Attorney has refused registration under Section 2(e)(1) Of the Act, 15 USC §1052(e)(1), on the

¹ Application Serial Number 75/507,347, filed June 23, 1998, based upon applicant's bona fide intention to use the mark in commerce.

basis that applicant's mark is merely descriptive of its services. Applicant and the Examining Attorney filed briefs but no oral hearing was requested.²

We affirm.

The Examining Attorney argues that applicant's mark, considered in connection with applicant's services, is merely descriptive because no imagination is needed to understand the nature of applicant's services. In this regard, the Examining Attorney argues that applicant provides remote "on-site trading" which is accessible to traders and that, therefore, the mark ON-SITE TRADER is merely descriptive of applicant's services. The Examining Attorney has made of record definitions of the words "on-site" and "trader."³ The Examining Attorney has also made of record material from the Internet as well as the results of a search conducted on the Nexis computer database. While many of the references to "on-site trading" refer to applicant, the following additional references are noteworthy:

² To its brief applicant has attached, for the first time, a specimen of use of its asserted mark on a piece of promotional literature. We have given no consideration to this piece of evidence. See Trademark Rule 2.142(d).

³ "On-site" is defined in The American Heritage Dictionary of the English Language (3rd ed.) as "done or located at the site, as of a particular activity: *an on-site filming.*" The word "trader" is defined as "one that trades; a dealer..."

Q: Do you think a suitability guideline is needed for the most aggressive day traders, those who go to on-site trading firms?

Los Angeles Times, May 11, 1999

* * * * *

On-site trading, more commonly called day trading, began to take hold in the past two years as shops have spun up to ---

On-site trading makes up about 15 percent of the Nasdaq National Market's daily volume, according to the association..

The association acknowledges that on-site trading isn't for everyone.

The Palm Beach Post, May 10, 1999

* * * * *

...Firsttrade wants to migrate its customers to the Internet because on-site trading requires more resources and space and the firm wants to streamline operations..

Financial Net News, April 5, 1999

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...Thomas Marsico, chief executive officer of Marsico Capital Management, an asset management firm. A state-of-the-art, on-site trading room is now being built in the Hill Herald business school that ultimately will house the activity.

Chapel Hill Herald, October 16, 1998

* * * * *

The NASD Regulation reorganized its division of market regulation in order to increase the focus on its on-site trading and market maker surveillance program (TMMS)..

Compliance Reporter, July 20, 1999

* * * * *

Greenberg said both the Shaw and Security APL services will continue to be used for accounting as Nicholas-Applegate acclimates itself to the new on-site trading system, which should be live in six-to-eight weeks..

Operations Management, February 26, 1996

* * * * *

Besides the due diligence library, Berry-Shino offers a full range of brokerage services, including on-site trading, portfolio management and investment banking..

Arizona Business Gazette, October 26, 1995

* * * * *
...Swiss American Securities, Inc., which
occupies 67,000 square feet, kept its on-site
trading desks in full operation until power was
restored by ConEd on Dec. 17.
Real Estate Weekly, February 24, 1993
* * * * *

Applicant, on the other hand, maintains that its mark is suggestive because some imagination is required to determine the nature of its services. In support of this contention, applicant makes the following arguments: that consumers do not know from applicant's mark what specifically is being traded; that "on-site" implies the existence of a physical location where the activity of trading is carried out but that applicant's activity is conducted remotely via a computer network and occurs "off-site" rather than "on-site" at an office. Since applicant's services may be rendered at whatever location a computer terminal is located, applicant maintains that its asserted mark is an incongruous expression. That is to say, a consumer using applicant's services may conduct securities transactions anywhere he or she has access to the World Wide Web. Applicant maintains that the Nexis references referring to "on-site trading" do not present the incongruous use of applicant's mark for its services. Aside from noting that thirteen Nexis references refer to applicant, applicant also notes that the references are to

"on-site trading" rather than "on-site trader."⁴ Because the Nexis material does not refer to trading at a remote location, applicant maintains that the evidence does not support the refusal. Finally, applicant asks that we resolve any doubts in its favor.

It is well settled that a term is considered to be merely descriptive of goods and/or services, within the meaning of 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 and/or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods and/or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods and/or services for which registration is sought, the context in which it is being

⁴ Applicant also correctly states that some of the uses noted by the Examining Attorney, omitted from the excerpts quoted in this opinion, use the term "on-site trading" in different contexts unrelated to the securities field. Other references, also omitted, contain "noise words" and are irrelevant.

used on or in connection with those goods and/or services, and the possible significance that the term would have to the average purchaser of the goods and/or services because of the manner of its use. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Accordingly, whether consumers could guess what the product [and/or service] is from consideration of the mark alone is not the test. In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

Marks are also merely descriptive if they describe the type of purchasers or users of particular goods or services. See, for example, In re Camel Manufacturing Company, Inc., 222 USPQ 1031 (TTAB 1984)(MOUNTAIN CAMPER) and In re Hunter Publishing Company, 204 USPQ 957 (TTAB 1979)(JOBBER AND WAREHOUSE EXECUTIVE).

From the printout of record of applicant's Web site, it is clear that one may use applicant's services by contacting applicant from a personal computer via the Internet.

Until recently, active stock traders needed to trade out of a professional trading firm to get the benefits of dynamic, real-time stock trading. Now, from any location, remote traders can compete with other professional traders. You will have electronic access to dynamic real-time quotes, charts, the Dow Jones News Service, and executions to provide you the trading edge you want and need. This access is essential for getting better executions.

From another exhibit, made of record by the Examining Attorney, applicant is described as follows:

Formed in 1994, On-Site Trading, Inc. is a leading provider of stock trading services targeted to both the on-premises and remote trader. Our main trading floors in Great Neck, New York are home to our proprietary traders. In addition, we have over 300 traders in 8 branch offices, as well as remote traders around the country. Our business caters to active, professional traders.

It is clear that applicant appears to offer both on-premises and remote trading services. Also, and more importantly, applicant's description of services is not limited to remote access computer services. That is to say, as currently described, applicant's services are simply the providing of access to a computer network on which securities transactions can be carried out by consumers. Because this description is broad enough to include on-premises securities trading, and because we must consider applicant's mark in relation to the services set forth in its application and not the specific services in connection with which it either actually uses or intends to use the mark, applicant's mark must be considered merely descriptive. The mark ON-SITE TRADER merely describes the

user of applicant's computer services provided at a particular location (on-premises).⁵

We note that applicant has, in its brief, offered the alternative request for registration on the Supplemental Register in the event that the Board finds that applicant's mark is not registrable on the Principal Register.⁶ Because applicant raised this alternative request for the first time in its appeal brief, we have no examination of the merits of this alternative request. See TMEP §1212.02(c). Moreover, applicant has not submitted an amendment to the Supplemental Register and the required amendment to allege use. Accordingly, this request is denied.

Decision: The refusal of registration is affirmed.

⁵ We make no finding as to whether the mark would be merely descriptive if applicant's description of services were limited to the provision of computer services at off-premises locations, such that one could only use applicant's services from any location where one could access the World Wide Web. In such a situation, applicant's argument about the incongruous nature of its mark may have more persuasive weight.

⁶ Applicant has also offered to disclaim the word "TRADER" apart from the mark. Because we find that applicant's entire mark is merely descriptive, this offer to disclaim is not appropriate.