

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed: March 19, 2003
Paper No. 15
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pharmacy Fulfillment Services, LLC (by change of name from Rx Store Mail, LLC) having interests assigned from Joseph S. Rosson (original applicant) via Rx.com, Inc.

Serial No. 75/537,127

Mack Ed Swindle, Clark R. Crowley and Thomas F. Harkins, Jr. of Whitaker Chalk Swindle & Sawyer LLP for Pharmacy Fulfillment Services, LLC.

Gwen P. Stokols, Trademark Examining Attorney, Law Office 107 (Thomas Lamone, Managing Attorney).

Before Hairston, Chapman and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Pharmacy Fulfillment Services, LLC is the current owner of an application to register the term RX.COM on the Principal Register as a mark for services recited, as amended, as "on-line retail pharmacy services; drug prescription fulfillment services via the Internet,"¹ in International Class 35.

¹ Application Serial No. 75/537,127 was filed by Joseph S. Rosson on August 14, 1998 based upon applicant's allegations of a *bona fide* intention to use the mark in commerce. An amendment to allege use was filed in August 2001 by Mr. Rosson's successor-in-interest, Rx.com, Inc., claiming first use and first use in commerce at least as early as March 1999.

The Trademark Examining Attorney has refused registration on the ground that the term RX.COM, when used in connection with the recited services, is merely descriptive thereof. 15 U.S.C. §1052(e)(1). After the Trademark Examining Attorney made the refusal to register final, applicant filed a notice of appeal.

Both applicant and the Trademark Examining Attorney have filed briefs.² Applicant did not request an oral hearing.

We affirm the refusal to register.

The Trademark Examining Attorney's position is that the mark RX.COM is merely descriptive of applicant's services "because the term RX is a widely known abbreviation for a medical prescription" (Trademark Examining Attorney's brief, p. 4) and "[t]he term '.com' is a top-level domain and merely acts as an Internet entity designation." (Trademark Examining Attorney's brief, p. 6). She then concludes that "[a]ccordingly, the descriptive term (RX), combined with a term that is not a source-identifier (.COM) produces a merely descriptive mark in connection with the identified services." (Id.)

² As will be discussed later in this opinion, applicant requested in its brief that the Board permit amendment to the Supplemental Register in the event that we find this mark to be merely descriptive under Section 2(e)(1) of the Act.

By contrast, applicant argues: that in common parlance, the term "Rx" has come "to refer to a remedy or cure for any type of problem, not just health related problems" (applicant's brief, p. 11); that applicant plays the part of a "middle man," not that of "filling prescriptions" in the traditional sense (Id.); and that the combined term only suggests some connection with pharmaceuticals and the Internet.

The Trademark Examining Attorney relies on the following dictionary definitions for the significance of the term "Rx":

RX Prescription <http://www.acronymfinder.com>

Rx a medical prescription [Cambridge University Press' English Language Teaching Dictionaries Online]

Rx prescription <http://www.allwords.com>

The test for determining whether a mark is merely descriptive is whether the term or phrase immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used or is intended to be used. See In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978); and In re Eden Foods Inc., 24 USPQ2d 1757 (TTAB

1992). It is not necessary that a phrase describe all of the properties or functions of the goods or services in order for it to be considered merely descriptive thereof; rather, it is sufficient if the phrase describes a significant attribute or idea about them. Moreover, it is well-established that the determination of mere descriptiveness must be made, not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used or is intended to be used on or in connection with those goods or services, and the possible significance that the phrase would have to the average purchaser of such goods or services. In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995); In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991); and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979).

Consequently, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985). Rather, the question is whether someone who knows what the goods or services are will understand the term or phrase to convey information about them. In re Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990).

Upon careful consideration of this record and the arguments of the attorneys, we agree with the Trademark Examining Attorney that the asserted mark RX.COM is merely descriptive of applicant's services.

First, as noted, we must consider the question of descriptiveness in the context of actual or prospective use, not whether potential consumers or users will be able to guess what the services are but rather whether the mark, as used in connection with the services, describes a quality, feature or characteristic of the services. Therefore, we consider the mark RX.COM as used on or in connection with a website providing drug prescription fulfillment services.

Applicant is correct in noting that the term "Rx" is sometimes used to refer to a remedy for a variety of problems, not just health related problems.³ However, as explained, the Board must evaluate the significance of the term "Rx" in the context of a website providing drug prescription fulfillment services. Moreover, applicant attempts to characterize its "middle man" role as quite different from the way one's local druggist traditionally

³ A dictionary entry submitted by the Trademark Examining Attorney contained, as a second entry, this more general meaning of a remedy for non-medical problems.

filled prescriptions. However, the very terms of the recital of services herein differ from traditional retail pharmacy or drug prescription fulfillment services only in that these services, as recited, involve the use of the Internet. And of course, the .COM suffix portion of the mark makes it clear that this designation identifies a commercial site on the Internet.

While the only issue herein is whether the term RX.COM is merely descriptive, we have recently found similarly constructed marks comprising generic matter plus a top-level domain name to be *incapable* of achieving distinctiveness. Compare *In re CyberFinancial.Net, Inc.*, ___USPQ2d___, Serial No. 75/482,561 (TTAB August 28, 2002) [BONDS.COM held unregistrable for, among other things, online informational services regarding such financial products as debt instruments and related investments]; and *In re Martin Container, Inc.*, 65 USPQ2d 1058 (TTAB 2002) [CONTAINER.COM held generic and incapable of registration on the Supplemental Register when used in connection with "retail store services and retail services offered via telephone featuring metal shipping containers" and "rental of metal shipping containers"].

Finally, we turn to the question of whether applicant still has the option of salvaging a Supplemental Registration from this application. Applicant never

actually filed an amendment requesting that the application be amended to seek registration on the Supplemental Register, even as an alternative argument to the refusal under 15 U.S.C. §1052(e)(1). Accordingly, the Trademark Examining Attorney was never faced with the issue of whether this mark would even be acceptable for registration on the Supplemental Register. In fact, in opposing this tardy option, the Trademark Examining Attorney noted that RX.COM might well be incapable of achieving trademark significance in light of recent Board decisions in CyberFinancial.Net, *supra* and Martin Container, *supra*. Inasmuch as this option was not raised by applicant until the time of its appeal brief and hence this option was not considered by the Trademark Examining Attorney, we agree with the Office's contention that this request came too late in the proceeding to remain an option for this particular application. See In re Petite Suites, Inc., 21 USPQ2d 1708 (Comm'r Pats. 1991).

Decision: The refusal to register is affirmed.