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THIS DISPOSITION IS NOT  
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THE TTAB

Paper No. 9  
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jerry Cairo

Serial No. 75/551,180

Gerald S. Schur of Welsh & Katz for Jerry Cairo.

Sue Carruthers, Trademark Examining Attorney, Law Office  
108 (David Shallant, Managing Attorney).

Before Quinn, Hairston and Bottorff, Administrative  
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

This is an appeal from the Trademark Examining  
Attorney's final refusal to register the mark CERTIFIED FAX  
for "communication services, namely, verification of  
delivery of facsimile and other messages delivered  
electronically through a public switch telephone network by  
means of causing a facsimile machine to output a page of  
the message with indicia of delivery printed thereon."<sup>1</sup>

<sup>1</sup> Serial No. 75/551,180 filed September 10, 1998, alleging a bona  
fide intention to use the mark in commerce.

Registration has been refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that the mark merely describes applicant's services.

Applicant and the Examining Attorney have filed briefs,<sup>2</sup> but no oral hearing was requested.

The Examining Attorney maintains that CERTIFIED FAX immediately describes a feature of applicant's services, namely, the verification that a fax has been delivered. The Examining Attorney argues that CERTIFIED FAX is analogous to the term "certified mail" and has submitted an entry from The American Heritage Dictionary of the English Language (3d. ed. 1992) wherein "certified mail" is defined as "[u]ninsured first-class mail for which proof of delivery is obtained." In addition, she submitted nine excerpts from the NEXIS data base wherein the term "certified fax" appears.

Applicant, in urging reversal of the refusal to register, argues that CERTIFIED FAX is a coined term and is, at most, suggestive of the identified services.

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<sup>2</sup> Applicant, for the first time with its appeal brief, submitted a print out of a third-party registration. As noted by the Examining Attorney, under Trademark Rule 2.142(d), evidence submitted for the first time with a brief on appeal is generally considered untimely and therefore usually given no consideration. In view thereof, we have not considered this evidence in reaching our decision herein. We hasten to add that, even if we had considered the third-party registration, our decision herein would be the same.

Applicant maintains that it is implicit in the definitions of the word "certified" taken from Webster's New Collegiate Dictionary (1981), namely, "to attest authoritatively, to present in formal communication," that "certified" requires "the presence of an author to verify the document."

According to applicant, because its services do not provide written proof of delivery of the facsimile by the author or another individual (such as a mail carrier in the case of certified mail), the mark CERTIFIED FAX is not merely descriptive of applicant's services.

A mark is considered to be merely descriptive of goods 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 or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

We have no hesitation in finding that the applied-for mark is merely descriptive of applicant's services. The mark CERTIFIED FAX immediately describes a feature of applicant's communication services, namely that such services provide verification that a facsimile has been delivered. We agree with the Examining Attorney that

CERTIFIED FAX is analogous to certified mail and that the relevant class of consumers will immediately understand, without any need for imagination, thought or perception, that applicant's communication services provide proof of delivery of facsimiles. Contrary to applicant's contention, it is of no moment that a person does not actually verify that the facsimiles have been delivered, as in the case of certified mail. The fact remains that verification is provided, and it appears that it is simply done in a manner which is conducive to facsimile transmissions, rather than first-class mail.

In reaching our decision, we have given little weight to the nine NEXIS excerpts submitted by the Examining Attorney. Only three of the excerpts appear to pertain to the type of services involved herein, and of these three excerpts, only one is taken from an actual publication. The other two excerpts are from wire services, and inasmuch as it is not clear that these excerpts ever appeared in any publications, such excerpts are not particularly probative of the public's understanding of the term CERTIFIED FAX.

**Decision:** The refusal to register is affirmed.

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