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Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **MetalSite, L.P.**

Serial No. 75/**558,690**

Michael G. Panian of **Buchanan Ingersoll, P.C.** for **MetalSite, L.P.**

Elizabeth M. Seltzer, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

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

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

MetalSite, L.P. has filed an application to register the term "METALSITE" as a service mark for "providing on line information via a web page on the global computer network pertaining to the sale and purchasing of steel, copper, brass and aluminum" in International Class 35; "providing on line

information via a web page on the global computer network pertaining to the trading of steel, copper, brass and aluminum" in International Class 36; and "providing a web page on the global computer network for interactive user exchange of information, news and publications relating to the steel, copper, brass and aluminum industry" in International Class 42.¹

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that, when used in connection with applicant's services, the term "METALSITE" is merely descriptive of them.

Applicant has appealed. Briefs have been filed,² but an oral hearing was not held.³ We affirm the refusal to register.

¹ Ser. No. 75/558,690, filed on September 24, 1998, which alleges a bona fide intention to use such term in commerce.

² Applicant, with its brief, has attached thereto printouts from "the Merriam-Webster Collegiate Dictionary, on-line version[,] of the definition[s] for 'metal' [and 'heavy metal']" and printouts of "several pages from a search conducted in the AltaVista website directed to the term 'metal' and 'Site,'" including "a copy of the references found" by "extending the search under the term 'Learn more about metal site a Britannia.com'." While such evidence is plainly untimely under Trademark Rule 2.142(d), which provides that the record in an application should be complete prior to the filing of an appeal and that the Board will ordinarily not consider additional evidence submitted after an appeal is filed, we have considered the dictionary definitions inasmuch as it is settled that the Board may properly take judicial notice thereof. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 (TTAB 1981) at n. 7. However, as to the remaining evidence offered for the first time with applicant's brief,

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) and 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 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 idea about them. Moreover, whether a term 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 or is intended to be used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or

we note that although the Examining Attorney has not formally objected thereto as being untimely, neither has she discussed such evidence in her brief or otherwise treated it as being of record. Accordingly, such evidence will not be given further consideration. Compare In re Nuclear Research Corp., 16 USPQ2d 1316, 1317 (TTAB 1990) at n. 2. Nonetheless, it is pointed out that even if the additional evidence were to be considered to be of record, consideration thereof would make no difference in the outcome of this appeal.

³ Although applicant requested an oral hearing and a date therefor was scheduled, applicant subsequently submitted a waiver of such hearing.

services because of the manner of such use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Thus, "[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).

Applicant contends that the term "METALSITE" is suggestive of its various services because "it requires imagination, thought and perception to determine that 'METALSITE' refers to an integrated internet service for the exchange of information, as well as the purchase and sale [and trading] of steel, cooper [sic], brass and aluminum over the internet." In particular, applicant asserts that while the on-line version of Merriam-Webster's Collegiate Dictionary defines "metal" as a noun meaning, among other things, "1 : any of various opaque, fusible, ductile, and typically lustrous substances that are good conductors of electricity and heat, form cations by loss of electrons, and yield basic oxides and hydroxides; *especially* : one that is a chemical element as distinguished from an alloy," such dictionary also lists the term as signifying "6 : HEAVY METAL," which, in turn, is defined as connoting "energetic and highly amplified electronic rock music having a hard beat." Thus, according to applicant, "the term 'METALSITE' does not automatically convey to a potential user of the site that it is for the on-line sale of and

providing information for steel, cooper [sic], brass and aluminum via electronic means" and is "not for providing information concerning rock music." In view thereof, applicant "respectfully submits that the mark is highly suggestive and that any doubts as to the 'descriptive' nature of Applicant's mark should be resolved in Applicant's behalf" in accordance with the Board's practice.⁴

The Examining Attorney, on the other hand, maintains that the term "METALSITE, consisting of the combination of two descriptive terms METAL and SITE, when considered in its entirety, directly conveys information about the nature of Applicant's services, i.e., that they pertain to a website (site) pertaining to metal." Of record in support of the Examining Attorney's position is a definition from the electronic version of The American Heritage Dictionary of the English Language (3rd ed. 1992) which lists "metal" as meaning, inter alia, "1. ... Any of a category of electropositive elements that usually have a shiny surface, are generally good conductors of heat and electricity, and can be melted or fused, hammered into thin sheets, or drawn into wires. Typical metals form salts with nonmetals, basic oxides with oxygen, and alloys with one another. 2. An alloy of two or more metallic

⁴ See, e.g., *In re Conductive Systems, Inc.*, 220 USPQ 84, 86 (TTAB 1983); *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981);

elements. 3. An object made of metal." Also of record is a printout of a page from an electronic dictionary, PC Webopaedia, which defines "site" as "[s]hort for Web site" (underlining in original), and a printout of a page from the web site <http://whatis.com>, which, in turn, sets forth a definition of "Web site" as "a collection of Web files on a particular subject that includes a beginning file called a home page" (underlining in original). In addition, the record includes a number of third-party registrations for marks which contain the term "SITE" and are either registered on the Supplemental Register and/or include disclaimers of such term in relation to various on-line services and services offered via web sites.

The above evidence, the Examining Attorney argues, "demonstrates that the common commercial meaning of the term METAL identifies a category of electropositive elements, such as steel, copper, brass and aluminum and that [the term] SITE, in the context of web-based services, means 'web site'." In view thereof, the Examining Attorney concludes that:

The individual terms METAL and SITE are therefore two fairly common words with readily understood meanings. Moreover, when such terms are combined to form the word METALSITE, the overall combined word produces a [merely] descriptive significance, namely identifying a site about metal, particularly in light of the

and In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972).

Applicant's services involving web sites
pertaining to metals.

As to applicant's assertion that the term "METALSITE" may also connote in the abstract a web site devoted to heavy metal music, the Examining Attorney insists that such possible connotation does "not negate the significance of the terms METAL, SITE and METALSITE in relation to the Applicant's web sites pertaining to metals" and correctly notes, as indicated previously, that the question of mere descriptiveness must be considered in relation to the applicant's particular services as recited in the application.

In the present case, we agree with the Examining Attorney that, when used in connection with the services of providing on-line information via a web page on the global computer network which pertains to the sale and purchasing of, and the trading of, steel, copper, brass and aluminum, and a web page on such network for interactive user exchange of information, news and publications relating to the steel, copper, brass and aluminum industry, the term "METALSITE" immediately describes, without conjecture or speculation, significant information concerning the purpose, subject matter or nature of such services, namely, that they are web sites pertaining to metal, which would include steel, copper, brass and aluminum. Plainly, when viewed in the context of

applicant's services, rather than in the abstract as urged by applicant, persons desiring to find information on the Internet which pertains to the sale and purchase of metal, the trading of metal, and/or the interactive exchange of information, news and publications relating to the metal industry will indeed know directly, without the need for the exercise of imagination, cogitation or mental processing or the gathering of further information, that applicant's various "METALSITE" services are web sites on the global computer network which are devoted to aspects of information about metal, such as steel, copper, brass and aluminum. There is simply nothing in the term "METALSITE" which, in the context of applicant's services, is ambiguous, incongruous or susceptible, perhaps, to any other plausible meaning.

Accordingly, because the term "METALSITE" conveys forthwith significant information concerning the purpose, subject matter or nature of applicant's Internet-based services, it is merely descriptive thereof within the meaning of the statute. See, e.g., In re Putnam Publishing Co., 39 USPQ2d 2021, 2022 (TTAB 1996) ["FOOD & BEVERAGE ON-LINE" for "a news and information service updated daily for the food processing industry, contained in a database" held merely descriptive because the term "ON-LINE" describes the mode through which the service is rendered and the term "FOOD & BEVERAGE" describes its

Ser. No. 75/558,690

subject matter; thus, "the relevant class of consumers will immediately understand, without the need for imagination, thought or perception, that applicant's FOOD & BEVERAGE ON-LINE news and information service provides food and beverage news and information via interactive computer access"].

Decision: The refusal under Section 2(e)(1) is affirmed.