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BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sterling Vision, Inc.

Serial No. 75/702,714
Serial No. 75/702,715

James David Jacobs of Baker & McKenzie for Sterling Vision, Inc.

Ronald McMorrow, Trademark Examining Attorney, Law Office 105 (Thomas Howell, Managing Attorney).

Before Chapman, Bucher and Rogers, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On May 11, 1999, Sterling Vision, Inc. filed two applications, both for the following services, identified as amended: "on-line retail store services, mail order services, and retail stores featuring contact lenses, eyeglasses and accessories" in International Class 35. Each application is based on applicant's assertion of a bona fide intention to use the mark in commerce.

Application Serial No. 75/702,714 is for NATIONAL

CONTACTS.COM, and application Serial No. 75/702,715 is for NATIONAL CONTACT LENSES.COM.

Registration of both marks was 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 marks are merely descriptive of the services.

In each application, when the refusal to register was made final, applicant appealed. Briefs have been filed in both cases, and applicant did not request an oral hearing in either case.

In view of the common questions of law and fact which are involved in these two applications, and in the interests of judicial economy, we have consolidated the applications for purposes of final decision. Thus, we have issued this single opinion.

The Examining Attorney contends, with regard to each mark, that it consists of the term "national" which is descriptive of the nationwide scope of applicant's services, and the word "contacts" or the words "contact lenses," respectively, which are highly descriptive or generic when used in connection with the identified services featuring contact lenses, and the generic top level domain (TLD) indicator ".com"; that the combination retains an entirely descriptive meaning which consumers

would easily understand without need of deliberative thought or exercise of imagination; and that each mark is unregistrable on the Principal Register absent a showing of acquired distinctiveness.[1]

Applicant contends that it is improper to dissect a mark and separately analyze the individual words; and that a combination of words, each of which is descriptive or generic, may result in a mark which is not descriptive or generic. Specifically, with regard to its applied for marks, applicant contends that the word "national" has many different dictionary meanings, and even if taken to mean relating to a government or nation, the ".com" suffix is associated with the world wide web and means the opposite (unlimited in terms of nationality) thereby creating an incongruity; that "national" is not descriptive in any way of applicant's services especially in light of the ".com"

[1] In its respective briefs on appeal, applicant offered to "disclaim the words 'National' and 'Contacts'" in application Serial No. 75/702,414, and to "disclaim the words 'Contact Lenses' and 'Contact Lenses.com'" in application Serial No. 75/702,415. In the Examining Attorney's briefs (p. 3), he noted applicant's offers of disclaimers, but he did not accept the disclaimers. Moreover, in arguing the descriptiveness issue, the Examining Attorney interpreted them as applicant's concessions that the involved terms are descriptive. (We note that applicant offered to disclaim all but the ".com" portion of NATIONAL CONTACTS.COM, while applicant offered to disclaim all but the "national" portion of NATIONAL CONTACT LENSES.COM.) Applicant's offer of the disclaimers in the briefs on appeal is untimely because the record should be complete prior to the filing of the appeal pursuant to Trademark Rule 2.142(d).

portion of applicant's marks which evidences the international scope of applicant's business; and that the purchasing public would need to make a mental leap to perceive any descriptive significance of the combination NATIONAL CONTACTS.COM or NATIONAL CONTACT LENSES.COM in relation to applicant's services.

The test for determining whether a term or phrase is merely descriptive under Section 2(e)(1) of the Trademark Act is whether the term 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 (CCPA 1978); In re Venture Associates, 226 USPQ 285 (TTAB 1985); and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). The determination of mere descriptiveness must be made, not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the term or phrase is being or will be used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995); and In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991). That

is, the question is not whether someone presented with only the term or phrase could guess what the goods or services are. 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. See In re Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990); and In re American Greetings Corp., 226 USPQ 365 (TTAB 1985).

We agree with the Examining Attorney that each of applicant's applied-for marks, NATIONAL CONTACTS.COM and NATIONAL CONTACT LENSES.COM, immediately and directly conveys information about significant features of applicant's "on-line retail store services, mail order services and retail stores featuring contact lenses, eyeglasses and accessories."

A descriptive term or phrase does not have to provide information regarding every aspect of an applicant's goods or services. See In re Opryland USA Inc., 1 USPQ2d 1409 (TTAB 1986); and In re The Weather Channel, Inc., 229 USPQ 854 (TTAB 1985). Inasmuch as "contacts lenses" appears in applicant's identification of services, there is simply no question that one of the central features of applicant's on-line, retail and mail order services is the sale of contact lenses (and accessories). Moreover, as to NATIONAL

CONTACTS.COM, the Examining Attorney made of record The American Heritage Dictionary (Third Edition 1992) definition of "contact" as "6. A contact lens." Thus, as to that term "contacts" will readily be understood to refer to contact lenses. The fact that "contacts" may have other meanings in other contexts is not persuasive because the determination of descriptiveness must be made in relation to the identified services.

The term "national" has been held by this Board to be descriptive of the geographic extent of the offering of the goods or services. See In re Integrated Resources, Inc., 220 USPQ 1067 (TTAB 1983); In re National Rent A Fence, Inc., 220 USPQ 479 (TTAB 1983); and National Fidelity Life Insurance v. National Insurance Trust, 199 USPQ 691 (TTAB 1978). See also, National Automobile Club v. National Auto Club, Inc., 365 F.Supp. 879, 180 USPQ 777 (SDNY 1973). That is, "national" is a common English word which can be used to describe goods and services. It is not likely, in the circumstances of these cases, to be considered by the purchasing public as a word of source identification.

We find unpersuasive applicant's argument that "national" and ".com" convey such a geographical incongruity (one relating to a nationwide scope and one referring to a worldwide scope), that the composite terms

sought to be registered are rendered suggestive thereby. There is no convincing evidence of record that consumers would perceive these elements as possessing anything other than their common everyday meanings, i.e., the word "national" as meaning nationwide in scope, and ".com" as being a top level domain address.

The ".com" portion of applicant's respective terms lacks trademark significance. This portion of a domain name is merely part of an address. Particularly, the top level domain indicator (e.g., .com, .org, .edu) adds nothing to the distinctiveness of the designation coupled therewith, so as to create a trademark or service mark. While we recognize that applicant's applied-for marks include spaces between the words, which would not generally be used in a domain name, nonetheless, the applied-for marks closely resemble domain names, and would be so recognized by the purchasing public. That is, the average consumer will readily recognize that these applied-for marks are presented in the format for a domain name and they would understand that the top level domain portion is a part of every complete domain name. See 555-1212.com, Inc. v. Communication House International, Inc., 157 F.Supp. 2d 1084, 59 USPQ2d 1453 (N.D.CA. 2001); and 1 J. Thomas McCarthy, McCarthy on Trademarks and Unfair

Competition, §7:17.1 (4th ed. 2000). See also, In re Page, 51 USPQ2d 1660 (TTAB 1999); and In re Patent & Trademark Services Inc., 49 USPQ2d 1537 (TTAB 1998).

In these two applications, we find that the juxtaposition of the words, in relation to applicant's identified services does not evoke a unique commercial impression, nor does this combination of the elements give either applied-for mark, considered as a whole, an incongruous meaning in relation to applicant's services such that the elements lose their descriptive significance in the combined expression. Rather, applicant's applied-for marks, NATIONAL CONTACTS.COM and NATIONAL CONTACT LENSES.COM, if used in connection with applicant's identified services, would immediately describe, without conjecture or speculation, significant features of applicant's services, as discussed above. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Omaha National Corporation, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); and In re Time Solutions, Inc., 33 USPQ2d 1156 (TTAB 1994).

Decision: The refusal to register the proposed mark as merely descriptive under Section 2(e)(1) is affirmed in each application.