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OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re F. Merrill Matlovich, dba iCam Productions

Serial No. 75/795,407

David L. Garrison of Garrison & Associates PS for F.
Merrill Matlovich, dba iCam Productions.

Maria-Victoria Suarez, Trademark Examining Attorney, Law
Office 102 (Thomas V. Shaw, Managing Attorney).

Before Simms, Holtzman and Rogers, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

F. Merrill Matlovich, dba iCam Productions (applicant)
has appealed from the final refusal of the Trademark
Examining Attorney to register the mark DOTSEX for
promoting the goods and services of others in the fields of
soft-core and hard-core pornographic photography by
providing a Web site at which members can link to the Web

sites of others.¹ The Examining Attorney has refused registration under Section 2(e)(1) of the Act, 15 USC §1052(e)(1), on the basis that applicant's mark is merely descriptive of his services.² Applicant and the Examining Attorney have submitted briefs³ and an oral hearing was held.

The Examining Attorney argues that applicant's mark DOTSEX is the phonetic equivalent of .sex and would be pronounced dot sex, much like .com is pronounced dot com. Here, the Examining Attorney contends that the term SEX in applicant's mark immediately describes a significant feature or characteristic of applicant's services in that it tells users that applicant provides services of a sexual nature or with adult content. Moreover, the addition of the word DOT does not detract from the mere descriptiveness of the word SEX in applicant's mark, the Examining Attorney contends.

¹Application Serial No. 75/795,407, filed October 4, 1999, based upon applicant's allegation of a bona fide intention to use the mark in commerce.

²The Examining Attorney has withdrawn an earlier refusal that applicant's asserted mark does not function as a service mark.

³The Examining Attorney has objected to the new evidence (printouts from Office records of third-party registrations and applications) submitted with applicant's brief. The Examining Attorney correctly observes that, under Trademark Rule 2.142(d), the file in the application should be complete prior to the filing of the notice of appeal. Accordingly, because this evidence is untimely, the objection is sustained and the evidence has not been considered. Similarly, applicant's recently obtained registration of the mark DOTXXX for similar services (Reg. No. 2,610,275, issued Aug. 20, 2002), offered at the oral hearing and objected to by the Examining Attorney, will not be considered.

Marks that contain the phonetic equivalent of a top-level domain (TLD) (e.g., ABC DOTCOM) are treated in the same manner as marks composed of a TLD (e.g., ABC.COM). Hence, the presence or absence of the punctuation, whether in a symbolic or literal form, does not change the meaning of the mark. The term "DOTSEX" is, in fact, the equivalent of ".SEX," and is still merely descriptive.

Consequently, the public will recognized [sic] the wording "DOTSEX" as signifying an adult-oriented website. Although The Internet Corporation for Assigned Names and Numbers (ICANN) has not adopted ".sex" as an acceptable TLD, it strongly has been proposed as a future TLD designating adult-oriented websites. Accordingly, to the extent potential consumers view the mark as a TLD, the mark clearly names the nature of the website provided by the applicant. Whether or not the TLD ".sex" is available is not relevant in a trademark sense if potential consumers will view the mark as accurately describing a significant characteristic of the applicant's services.

Examining Attorney's appeal brief, 4.

The Examining Attorney has made of record excerpts from the Nexis database showing that ".sex" or "dot sex" has appeared in numerous stories, and a dictionary definition from High-Tech Dictionary indicating that ".com" is pronounced "dot com." Some of the evidence is quoted below:

...for new TLDs from registry operators and received 44 proposals representing hundreds of possible TLDs ranging from dot-kids to dot-sex...

The Record, March 5, 2001

...Even the Internet pornography industry would agree that there could be many benefits in having all pornography-related web sites end in "dot sex"...

Newsday, December 3, 1999

...That means the dot-coms will likely be joined by dot-biz, dot-sex and other combinations...

The Seattle Times, November 4, 1999

...Child Online Protection Commission discussed the extremely controversial notion of creating an adults only Internet domain such as .xxx or .sex.

Newsbytes, June 9, 2000

...adult sites could voluntarily station their web sites at this new domain. What would be the incentive to move them off .com to maybe .sex or .xxx?

The Orange County Register, September 29, 1999

Proponents of such a proposal contend that by creating a ".xxx" or ".sex" Internet domain "harmful" pornographic material could be isolated in a single Internet neighborhood...

Newsbytes, June 8, 2000

Applicant, on the other hand, argues that his mark is suggestive of the goods and services featured on his Web

site because it merely suggests that applicant's services may involve matter with sexual content, but does not immediately convey the idea, quality or characteristic of applicant's services.

The service mark "DOTSEX" might reasonably be thought by the ordinary observer to suggest that the services with which it is associated has [sic] to do with products and services having a sexual connotation, but the mark DOTSEX is not merely descriptive thereof. The addition of the "DOT" might also suggest, to the perceptive observer, that it has [to] do with computer-based activities and services. But the mark clearly "requires the consumer to exercise the imagination in order to draw a conclusion as to the nature of goods and services"... The mark itself does not convey any specific information about applicant's services or its intended consumers; rather it requires imagination to connect the term "DOTSEX" to the service of providing a website...

Clearly, the reason for rejecting the applicant's mark is the presence of SEX as a part of the mark. This rejection is without basis other than the unsupported concept that a mark should not contain these three letters. The Patent and Trademark Office should not undertake the role of societal censor without a clear statutory requirement to do so. [Emphasis in original]

Applicant's appeal brief, 2-3, 6. Applicant states that he has been using the applied-for service mark since December

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29, 1999, although applicant has not filed an amendment to allege use.

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. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Eden Foods Inc.*, 24 USPQ2d 1757 (TTAB 1992); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). Further, 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 impact that it is likely to make on the average purchaser of such goods or services. *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991). 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

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(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 Examining Attorney that the asserted mark DOTSEX 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 DOTSEX as used on or in connection with a Web site providing links to other Web sites containing matter of a sexual nature.

Although applicant is not using or intending to use the asserted mark as a top level domain name, we note in passing what the Trademark Manual of Examining Procedure states with regard to the question of mere descriptiveness of terms such as Internet domain names:

Internet domain names raise some unique trademark issues. A mark comprised of an Internet domain name is registrable as a trademark or service mark only if it functions as an identifier of the source of goods or services. Portions of the uniform resource locator (URL) including the beginning, ("http://www.") and the top level Internet domain name (TLD) (e.g., ".com," ".org," ".edu,") function to indicate an address on the World Wide Web, and therefore generally serve no source-indicating function. See TMEP §§1215 et seq. regarding marks comprising domain names. TLDs may also signify abbreviations for the type of entity for whom use of the cyberspace has been reserved. For example, the TLD ".com" signifies to the public that the user of the domain name constitutes a commercial entity. See *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602 (1888) ("The addition of the word 'Company' [to an otherwise generic mark] only indicates that parties have formed an association or partnership to deal in such goods" and does not render the generic mark registrable).

If a proposed mark includes a TLD such as ".com", ".biz", ".info", the examining attorney should present evidence that the term is a TLD, and, if available, evidence of the significance of the TLD as an abbreviation (e.g. ".edu" signifies an educational institution, ".biz" signifies a business).

Because TLDs generally serve no source-indicating function, their addition to an otherwise unregistrable mark typically cannot render it registrable. See *Goodyear*, 128 U.S. at 602 (the incorporation of a term with no source-indicating function into an otherwise generic mark cannot render it registrable). For example, if a proposed mark is composed of merely descriptive term(s) combined with

a TLD, the examining attorney must refuse registration on the Principal Register under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), on the ground that the mark is merely descriptive. See TMEP §1215.04.

Similarly, if a proposed mark is composed of generic term(s) for the applicant's goods or services and a TLD, the examining attorney must refuse registration on the ground that the mark is generic. See TMEP §§1209.01(c)(i) and 1215.05.

See TMEP §1209.03(m).

Here, while applicant's mark does not function as a top level domain name such as ".com" (or, as pronounced, "dot com"), nevertheless there is no question but that applicant's mark DOTSEX is the literal equivalent of the expression ".SEX" or ".sex". The computer literate, and presumably the users of applicant's services would be in that category, would, of course, be familiar with the pronunciation of such expressions as ".com", ".org", ".net", etc. Moreover, the evidence of possible future use of ".sex" as a top level domain name is significant, not because it may become one, but rather because a significant segment of the relevant public may view applicant's mark as having the descriptive significance of an Internet site providing connections of a sexual nature.⁴

⁴We note that some of the excerpts of record discussing possible use of ".sex" as a top level domain name precede applicant's filing date. The

It is our opinion that the character ".", or the word "dot," when used in connection with the promotion or display of a Web site (rather than as part of the Web site's address), does not serve to alter the essential significance thereof. The character "." or its literal equivalent "dot," has significance, according to this record, of indicating an online or Internet connection. The word "dot" (or "DOT") along with the word "SEX," used in conjunction with applicant's online services, immediately tells prospective customers and users that applicant's Web site provides access to content of a sexual nature. The fact that applicant does not use the asserted mark as a TLD but rather only to identify a Web site that provide links to other sites of a sexual nature, does not serve to detract from the direct information conveyed by the term. The term DOTSEX, used in connection with a Web site that provides links to other sites of a sexual nature, does not require the use of imagination or perception to understand the term's descriptive significance. The term is more than suggestive; it is merely descriptive. We conclude that the asserted mark DOTSEX merely describes a significant quality, feature or characteristic of

application was filed on the basis of an allegation of bona fide intention to use the mark in commerce.

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applicant's services of providing a Web site with links to other sites of a sexual nature. 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)(where the Board found the designation CONTAINER.COM to be 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."

Decision: The refusal to register is affirmed.