

THIS DISPOSITION IS
NOT CITABLE AS PRECEDENT
OF THE TTAB

Mailed: July 15, 2002
Paper No. 14
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Equinix, Inc.

Serial No. 75/831,673

Michael W. Hicks of Blakely, Sokoloff, Taylor & Zafman, LLP
for Equinix, Inc.

Elissa Garber Kon, Trademark Examining Attorney, Law Office
116 (Meryl Hershkowitz, Managing Attorney).

Before Cissel, Chapman and Rogers, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

On October 26, 1999, Equinix, Inc. (a Delaware
corporation) filed an application to register the mark
INTERNET BUSINESS EXCHANGE on the Principal Register for
services amended to read "providing multiple user access to
a global communication network featuring the provision of
unlimited and unrestricted interconnection among the
Internet Service Providers (ISPs), content providers,

carriers and Component Service Providers (CSPs)" in International Class 38. Applicant disclaimed the term "Internet." The application is based on applicant's claimed date of first use and first use in commerce of May 26, 1999.

The Examining Attorney refused registration on the ground that applicant's mark, INTERNET BUSINESS EXCHANGE, is merely descriptive of applicant's services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

When the refusal was made final, applicant appealed to this Board. Both applicant and the Examining Attorney have filed briefs¹; an oral hearing was not requested.

The Examining Attorney contends that the term "Internet" is the generic term which tells consumers the involved services are available on or facilitate use of the global computer network; and that in the context of applicant's services, "Business Exchange" is widely used across an array of industries to identify the service of providing interconnectivity to businesses in order to allow them to conduct business to business (or "B2B") commerce, or put another way, the mark immediately tells consumers

¹ Applicant's motion (filed March 8, 2002) to extend its time to file a reply brief is granted, and we have considered applicant's reply brief.

the function of this online exchange, which is to facilitate the conducting of Internet business.

In support of the descriptiveness refusal, the Examining Attorney has made of record the following definitions from The American Heritage Dictionary (Third Edition 1992):

- (1) "Internet" is defined as "a matrix of networks that connects computers around the world," and
- (2) "exchange" is defined as "a place where things are exchanged."

The Examining Attorney also submitted (i) copies of several third-party registrations to show that the words "Internet," "exchange" and "business exchange" have each been disclaimed or registered on the Supplemental Register when the word(s) was part of a mark for products or services involving the exchange of business information; (ii) copies of numerous excerpted stories retrieved from the Nexis database to show how applicant and others use the words "Internet business exchange" and "online business exchange" to describe the services that facilitate the exchange of e-commerce and business to business on the Internet, (i.e., related interconnectivity services); and (iii) certain pages printed from applicant's website as evidence that applicant itself uses the word "exchange" to

tell consumers that applicant provides an electronic traffic exchange for their Internet business.

Applicant argues that the mark INTERNET BUSINESS EXCHANGE is a coined and unitary expression which is incongruous and at most suggests something about the nature of applicant's services, but has no precise meaning in the context of applicant's identified services; that the term "exchange," when considered as part of the entire mark, "conveys a vague, nebulous notion of Applicant's services" (brief, p. 7), but the words taken together do not have any readily identifiable meaning; that registration of applicant's mark will not deprive competitors of the right to use the words "Internet," "business" or "exchange"; that those considering the mark, taken as a whole, would have to engage in mental gymnastics in order to ascertain the purpose, function or characteristics of applicant's services; that the Examining Attorney's Nexis evidence includes uses which are references to applicant; and that the Examining Attorney has not demonstrated that applicant's mark is merely descriptive of applicant's services.

Applicant specifically argued the following:

The term INTERNET BUSINESS EXCHANGE in its entirety does not have a readily identifiable meaning. In fact, the

combination of the literal definitions of each of the three individual elements of the Applicant's mark demonstrates the mark's incongruity, as the combination of the three elements creates a term with no readily conveyed meaning or understanding. The Applicant's mark, while it may vaguely suggest an image of, among other things, a type of on-line commercial activity, *the reality of the present case is that INTERNET BUSINESS EXCHANGE is not descriptive of anything.* (Brief, p. 13.) (Emphasis in original.)

Applicant submitted copies of six third-party registrations wherein "the term EXCHANGE was determined to be part of an inherently distinctive unitary composite" (brief, p. 3).

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. See *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 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). 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. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990).

We look first to the pages from applicant’s website and made part of the record herein. This information includes the following statements:

IBX™ services are designed not to compete with the service offerings of its customers. In fact, the IBX™ service portfolio enables and fosters interconnection service and traffic *exchange* in the most expedient and cost-effective way so that customers can maximize their own business potential and generate revenue.

The level of excellence and consistency achieved in the architecture and design ensure that Equinix IBX™ centers are the most secure and high quality *exchanges* available. (Emphasis added.)

The dictionary listing for "Internet" as well as applicant's disclaimer thereof establish that the word is at least merely descriptive of applicant's service of providing access to a global communication network with unlimited interconnections among various carriers and providers. See Quaker State Oil Refining Corporation v. Quaker Oil Corporation, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972); and In re Ampco Foods, Inc., 227 USPQ 331, 333 (TTAB 1985).

Further, the Nexis evidence, examples of which are reproduced below, demonstrates that the term "Internet business exchange" immediately conveys information about the purpose and function of applicant's services (emphasis added):

Headline: Marriott, Hyatt Joining Forces on Internet for Hotel Supplies...
...Indeed, the hotel business is part of a growing number of industries in which rivals are banding together to cut costs while competing for the same customers. Elk Grove Township-based UAL Corp.'s United Airlines said last week it is part of a consortium of competing airlines investing \$50 million to create an **Internet business exchange** for aircraft supplies. Both Hoffman Estates-based Sears, Roebuck and Co. and Deerfield-based Walgreen Co. are involved in similar Web sites for retail suppliers. "Chicago Daily Herald," May 3, 2000;

...Six of the world's biggest airlines, including Atlanta-based Delta, are

joining to form an **Internet business exchange** to handle their \$32 billion in annual spending on goods and services, a move they say will drive down supply costs at least 5 percent...

The group will use the **exchange** to buy and sell items such as fuel, aircraft components, avionics equipment and engine parts. "The Atlanta Journal and Constitution," April 28, 2000;

Headline: Energy B-to-B Starts Off With 15 Utilities...

Fifteen of the nation's largest electric and gas companies have formed a consortium to build an **Internet business exchange** with suppliers. The consortium expects to announce the formation of an independent company in June, which will be followed by the creation of the business-to-business online marketplace by year's end... The yet-unnamed, for-profit **exchange** will be open for use by any firm in the energy and utilities industry... "Computerworld," April 3, 2000;

Headline: Start-up Targets Electronic Payments Process

...Clareon will offer its payment service in two ways: The service will be available to a slew of new **Internet business exchanges** because they typically lack this fundamental capability..., "Network World," June 26, 2000;

...The two companies [Commerce One and Oracle] announced they were combining their **Internet business exchanges** for the automakers General Motors, Ford and DaimlerChrysler..., "Chattanooga Times," February 26, 2000; and

Headline: B2B Web Sites: Works in Progress

...Almost every major industry has ventured into creating some type of B2B

Internet marketplace, including the aeronautic, automobile and metal industries. The structures of these **Internet business exchanges** do not follow the exact same model, but many do follow the auction format where buyers and sellers are together competing against one another..., "New York Law Journal," August 15, 2000.

In addition to uses of the phrase "Internet business exchange" such as those listed above, there are also numerous stories of record referring to the same service and various consortiums as engaged in "online business exchange(s)."

When we consider the phrase INTERNET BUSINESS EXCHANGE as a whole, and in the context of applicant's services ["providing multiple user access to a global communication network featuring the provision of unlimited and unrestricted interconnection among the Internet Service Providers (ISPs), content providers, carriers and Component Service Providers (CSPs)"], the phrase immediately informs consumers that applicant's services are intended to provide and facilitate interconnections on the Internet between ISPs, content providers, carriers, and CSPs allowing them to exchange information and business over the Internet. That is, the purchasing public would immediately understand the nature and purpose of the services, knowing that applicant's services involve the provision of multiple user

access to an unrestricted interconnection among these users for the conduct of business-to-business commerce on the Internet in an exchange environment.

The combination of these words does not create an incongruous or creative or unique mark. Rather, applicant's mark, INTERNET BUSINESS EXCHANGE, when used in connection with applicant's identified services, immediately describes, without need of conjecture or speculation, the purpose or function of applicant's services, as discussed above. Nothing requires the exercise of imagination or mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's services to readily perceive the merely descriptive significance of the phrase INTERNET BUSINESS EXCHANGE as it pertains to applicant's services. 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); *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792 (TTAB 1996); and *In re Time Solutions, Inc.*, 33 USPQ2d 1156 (TTAB 1994).

Applicant's argument that competitors in the industry would not be deprived of the use of the words "Internet," "business" and/or "exchange" to describe similar services

is not persuasive. To the contrary, here, the phrase unquestionably projects a merely descriptive connotation. See *In re Tekdyne Inc.*, 33 USPQ2d 1949, 1953 (TTAB 1994), and cases cited therein. We believe that competitors have a competitive need to use this phrase. See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:18 (4th ed. 2000).

The case of *Concurrent Technologies Inc. v. Concurrent Technologies Corp.*, 12 USPQ2d 1054 (TTAB 1989), cited by applicant, does not require a different result herein. In the *Concurrent* case, the Board found the mark CONCURRENT TECHNOLOGIES CORPORATION was not merely descriptive for printed electronic circuit boards based on the absence of evidence of any descriptive uses of the terms "concurrent" or "concurrent technologies." The involvement of goods, not services, and the lack of evidence of any descriptive use in that case, are to be distinguished from the case now before the Board. In the instant case, there is significant evidence of descriptive uses of the phrase "Internet business exchange" as a whole for services such as those involved herein; descriptive uses of "exchange" by applicant in its website specifically referring to interconnection services and exchanges; and dictionary

evidence of the meaning of the terms "Internet" and "exchange."

The third-party registrations submitted by applicant to show examples where the term "exchange" was not disclaimed or was not registered on the Supplemental Register, and the third-party registrations submitted by the Examining Attorney to show examples where the term "exchange" or "business exchange" was disclaimed or was on the Supplemental Register, are not persuasive. While uniform treatment under the Trademark Act is an administrative goal, the Board's task in an ex parte appeal is to determine, based on the record before us, whether applicant's mark is merely descriptive. As often noted by the Board, each case must be decided on its own merits. We are not privy to the records of the third-party registration files, and moreover, the determination of registrability of those particular marks by the Trademark Examining Attorneys cannot control the merits in the case now before us. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to [applicant's application], the PTO's allowance of such prior registrations does not bind the Board or this court.")

Ser. No. 75/831673

Decision: The refusal to register on the ground that the mark is merely descriptive under Section 2(e)(1) is affirmed.