THIS DISPOSITION IS
NOT CITABLE AS PRECEDENT
OF THE TTAB

Mailed: November 13, 2002

Paper No. 18
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re University of Washington

Serial No. 75/844,706

Bruce E. O'Connor of Christensen O'Connor Johnson Kindness PLLC for University of Washington.

Rebecca Gilbert, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Cissel, Walters and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On November 9, 1999, University of Washington filed an intent-to-use application to register on the Principal Register the mark RESEARCHCHANNEL for goods and services ultimately identified as follows:

> "video storage media containing video programs relating to academic, business, and scientific research, namely, prerecorded video tapes,

> compact discs, laser discs, DVDs, and memory cards” in International Class 9;
>
> “broadcasting programs via cable television, broadcast television, ITFS television, satellite, global computer network, and wireless video transmission and distribution systems” in International Class 38; and
>
> “production of video programs relating to information of academic, business, and scientific research institutions” in International Class 41.

In the first Office action (dated March 28, 2000), the Examining Attorney refused registration of the mark as merely descriptive of applicant’s goods and services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). In a second Office action, the Examining Attorney reviewed applicant’s Amendment to Allege Use (which had been filed on December 28, 1999) and required specimens which show use of the mark in connection with the identified goods and services. In response, applicant submitted acceptable specimens for each class of goods and services, and argued that the mark is suggestive. The Examining Attorney made the refusal to register under Section 2(e)(1) for the goods and services final on October 26, 2000.

On March 16, 2001, applicant filed an amendment to the Supplemental Register[1]; and on April 25, 2001 (via certificate of mailing) applicant filed a notice of appeal for all three classes of goods and services.

The Board remanded the application to the Examining Attorney, and on June 4, 2001, the Examining Attorney refused registration on the Supplemental Register under Section 23 of the Trademark Act, 15 U.S.C. §1091, on the basis the applied-for mark is generic and incapable of serving as a source identifier for applicant's services. In response applicant argued the mark is registrable on the Supplemental Register and the Examining Attorney has not met her burden of establishing that applicant's mark is generic for the goods and services from the perspective of the relevant purchasers. The Examining Attorney issued a final Office action on October 10, 2001 based on her refusal to register under Section 23 of the Trademark Act

[1] When an applicant originally files based on Section 1(b) (intent-to-use) seeking registration on the Principal Register, the applicant may file an amendment seeking registration on the Supplemental Register only after it has begun using the mark and has filed an Amendment to Allege Use [Section 1(c)] or a Statement of Use [Section 1(d)] which meets the minimum filing requirements. The effective filing date of the application will then become the date on which applicant met the minimum filing requirements for the Amendment to Allege Use or the Statement of Use. See TMEP §§206.01 and 816.02 (Third edition 2002). In the application now before the Board, the effective filing date is December 28, 1999.

on the ground that the applicant's mark is generic for the identified services.

Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

The issue before the Board is whether the term RESEARCHCHANNEL is generic for applicant's services in International Classes 38 and 41[2], and thus, is incapable of serving as a source identifier therefor and hence is unregistrable on the Supplemental Register.

The Examining Attorney argues that the mark "RESEARCHCHANNEL" is a combination of the ordinary words "research" and "channel"; that the dictionary definitions of those words establish that "a 'research channel' is a specified frequency band for the transmission and reception of research" (brief, unnumbered p. 4); that the record shows that "'research channel' is the generic term for a channel providing research information" (brief, unnumbered p. 4); that "the evidence of record, case law and office policy establish that 'research channel' is the generic term for the genus of broadcasting and production services that applicant offers" (brief, unnumbered p. 7); and that

[2] Applicant argued the issue of genericness with respect to all three classes of applicant's goods and services. However, the Examining Attorney had refused registration on the Supplemental Register only with regard to applicant's services.

allowing applicant to register the term RESEARCHCHANNEL on the Supplemental register would prevent applicant's competitors from adequately describing their own such services.

During the examination process for this application, the Examining Attorney submitted (i) dictionary definitions of the terms "research"[3] and "channel"; (ii) photocopies of 22 third-party Supplemental Register registrations, all for broadcast services and all including the term "channel" (e.g., JEWELRY CHANNEL, DOCUMENTARY CHANNEL, THE MUSIC CHANNEL, NEWSCHANNEL 11, THE COMEDY CHANNEL, THE AUTO CHANNEL, THE HISTORY CHANNEL, MILITARY CHANNEL, THE CRIME CHANNEL and THE BUSINESS CHANNEL); (iii) photocopies of 7 excerpted stories retrieved from the Nexis database relating to "research channel"; and (iv) printouts from about 10 web sites on the Internet (including one from applicant's own web site), generally showing references to "research channel."[4] Some representative examples of the

[3] The Examining Attorney attached the dictionary definition of "research" to her brief on appeal, and requested that the Board take judicial notice thereof. The request is granted. See University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). See also, TBMP §712.01.

[4] One of the web sites referred to "research & conservation channel."

Nexis and Internet evidence are reproduced below (emphasis in original):

> (1) Headline: Will the Buyer's Co-op for Lawyers Really Work?
> ...According to Mark Feighery, a spokesperson for Lexis-Nexis, the company will be the exclusive sponsor for LawCommerce.com's **research channel**. "Principally, what we have in mind is our relationships with our customers," says Feighery. "It really gives us some new opportunities with the largest law firms in the country. We think customers will benefit from the purchasing power available on the LawCommerce.com site." "Legal Times," November 27, 2000;
>
> (2) Headline: Pearson Picks Partner for Digital Extravaganza
> ...(Pearson recently did a deal with AOL to provide content and anchor the ubiquitous online service provider's proprietary **research channel**). Pearson-owned by U.K. media conglomerate Pearson Plc (Financial Times, The Economist, Penguin Books, and assorted TV game shows and programs)-publishes 60,000 educational reference and professional development properties in 40 countries. "Min's B-To-B," September 25, 2000;
>
> (3) Headline: DBS Operators Show Diversity in Public Programming
> ...DirecTV public programs also have religious tilt with Eternal Word TV (EWTV), Good Samaritan Network and Trinity Bcstg. (TB) offered along with Brigham Young U., C-SPAN, NASA TV, Northern Ariz U./U. House, PBS You, **Research Channel**. DirecTV has 9 noncommercial networks....
> "Public Broadcasting Report," September 8, 2000;

> (4) New Premium **Research Channel** in Conjunction with NFPA WinServices Technologies is proud to introduce the first true Virtual Law Library.... "www.paralegals.org," May 15, 2001 printout; and
>
> (5) **University joins first 24-hour TV/Internet research channel** Vanderbilt is joining forces with a group of other top universities, research organizations and corporate research centers in establishing the ResearchChannel, the nation's first round-the-clock research television and Internet channel. ..."research institutions now have the opportunity to reach reliable broadcast information, seminars, colloquia, and other important news and events nationally both on-demand and on television," said Amy Philipson, the executive director of the ResearchChannel, who works at the University of Washington.... "www.vanderbilt.edu," May 15, 2001 printout.

Applicant argues that the term RESEARCHCHANNEL is not the generic term for applicant's identified services; that the Examining Attorney has not established either that RESEARCHCHANNEL names the genus or class of services at issue here or that the relevant public understands the term to refer to that class of services; that the generic names for applicant's services are "video broadcasting" and "academic, business, and scientific research program production"; that the relevant public for the purchase of

applicant's services consists of "broadcasters, and other sophisticated entities in the broadcast and video production industry, as well as other purchasers and users..." of these services (brief, p. 6); that these sophisticated purchasers do not refer to the services involved herein as "research channel"; that the term "research"[5] is very broad in meaning and does not name applicant's services; that the evidence of record does not meet the burden necessary to establish genericness; that applicant's use is analogous to that shown in numerous third-party registrations;[6] and that the applied-for mark is capable of functioning as a mark and is entitled to registration on the Supplemental Register.

---

[5] Applicant referred in its brief to a dictionary definition of the term "research" not previously of record. The Board hereby takes judicial notice thereof. See TBMP §712.

[6] Applicant offered for the first time in its brief USPTO printouts of 27 third-party registrations (some on the Principal Register and some on the Supplemental Register, and all consisting of marks including the word "CHANNEL"), and applicant requested that the Board "make the registrations of record." (Brief, p. 10.) The Examining Attorney objected to this evidence. The Board does not take judicial notice of registrations. See In re Smith and Mehaffey, 31 USPQ2d 1531 (TTAB 1994), and TBMP §703.02(b). Moreover, the record should be complete prior to the filing of the appeal. See Trademark Rule 2.142(d). The Examining Attorney's objection is sustained, applicant's request is denied, and the Board has not considered the third-party registrations attached to applicant's brief. However, we note that the record does include the 22 third-party registrations previously put into the record by the Examining Attorney, and those have been considered by the Board.

The Office bears the burden of proving that the proposed trademark is generic, and genericness must be demonstrated through "clear evidence." See In re Merrill Lynch, Pierce, Fenner, & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); and In re Analog Devices Inc., 6 USPQ2d 1808 (TTAB 1988), aff'd, unpubl'd, but appearing at 10 USPQ2d 1879 (Fed. Cir. 1989). The evidence of the relevant public's perception of a term may be acquired from any competent source, including newspapers, magazines, dictionaries, catalogs and other publications. See Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and In re Leatherman Tool Group, Inc., 32 USPQ2d 1443 (TTAB 1994), citing In re Northland Aluminum Products, Inc., 777 F.2d 1566, 227 USPQ 961 (Fed. Cir. 1985).

The test for determining whether a designation is generic, as applied to the goods or as used in connection with the services in an application, turns upon how the term is perceived by the relevant public. See Loglan Institute Inc. v. Logical Language Group, Inc., 962 F.2d 1038, 22 USPQ2d 1531 (Fed. Cir. 1992). Determining whether an alleged mark is generic involves a two-step analysis: (1) what is the genus of the goods or services in question? and (2) is the term sought to be registered understood by

the relevant public primarily to refer to that genus of goods or services? See In re The American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); and H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

As noted earlier, "the correct legal test for genericness, as set forth in *Marvin Ginn*, supra, requires evidence of 'the genus of goods or services at issue' and the understanding by the general public that the mark refers primarily to 'that genus of goods or services.'" *American Fertility Society*, supra.

In this case, we find that there is scant evidence that the term RESEARCHCHANNEL is the name of the genus for the involved specific broadcasting and production services. Although the Nexis and Internet evidence would support a finding of mere descriptiveness, it simply does not establish that the term RESEARCHCHANNEL names the genus of either of applicant's involved services. Some of the excerpted stories retrieved from the Nexis database are the same story published in different sources, and some of the excerpted Nexis articles, as well as some of the web sites, clearly refer to applicant and its broadcasting and production services offered under the mark RESEARCHCHANNEL.

The Examining Attorney argues that Office policy supports the refusal of this mark as generic; however, the evidence previously submitted by the Examining Attorney of 22 third-party registrations on the Supplemental Register (all for marks including the word “channel” for broadcasting and/or production and programming services) appears to point to the contrary.

With regard to the second prong of the genericness test, there is virtually no evidence of record as to how the relevant purchasers and users would perceive this term in relation to applicant’s identified services involving both broadcasting and production services. In fact, the Examining Attorney did not define who the relevant purchasers and users of applicant’s services are. Cf. In re Conus Communications Co., 23 USPQ2d 1717 (TTAB 1992).

Decision: The refusal to register on the Supplemental Register is reversed.