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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *I. P. International, Inc.*

Serial No. 76/002,131

Douglas W. Sprinkle and Julie A. Greenberg of Gifford, Krass, Groh, Sprinkle, Anderson, & Citkowski, P.C. for Tower Tech, Inc.

Sophia S. Kim, Trademark Examining Attorney, Law Office 106
(Mary I. Sparrow, Managing Attorney).

Before Seeherman, Hanak and Hohein, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

I. P. International, Inc. has filed an application to register the mark "LEARNING.COM" for "computer services, namely, providing on-line information and references in the field of education."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 mark "LEARNING.COM" is merely descriptive of them.

¹ Ser. No. 76/002,131, filed on March 16, 2000, which is based on an allegation of a bona fide intention to use the mark in commerce.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We reverse the refusal to register.

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), if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009-10 (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 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 services because of the manner of its 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).

However, a mark is suggestive if, when the goods or services are encountered under the mark, a multi-stage reasoning

process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See, e.g., In re Abcor Development Corp., supra at 218, and In re Mayer-Beaton Corp., 223 USPQ 1347, 1349 (TTAB 1984). As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See, e.g., In re Atavio, 25 USPQ2d 1361 (TTAB 1992) and In re TMS Corp. of the Americas, 200 USPQ 57, 58 (TTAB 1978). The distinction, furthermore, is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. See In re George Weston Ltd., 228 USPQ 57, 58 (TTAB 1985).

The Examining Attorney maintains that "there is no doubt" that the mark "LEARNING.COM" is merely descriptive because it immediately conveys, without speculation or conjecture, the subject matter of applicant's "computer services, namely, providing on-line information and references in the field of education." Citing, in support of her position, the definition of record of the term "education," which The American Heritage Dictionary of the English Language (3rd ed. 1992) lists as meaning "[t]he knowledge or skill obtained or developed by a learning process," the Examining Attorney insists that "[i]t is clear that the connection between learning and education is immediate and not indirect or vague" as contended by applicant. Although curiously not given any mention in her brief, it is

asserted in the final refusal that the top level domain name ".COM" in applicant's "LEARNING.COM" mark simply "signifies to the public that the user of the domain name constitutes a commercial entity" and, thus, such name "is not a significant element of the mark."

In addition, the Examining Attorney relies on copies which she made of record of several third-party registrations for marks in which the term "LEARNING" was disclaimed in connection with on-line educational services. Such registrations, the Examining Attorney notes in her brief, include those for the following: the mark "MONSTER LEARNING" ("LEARNING" disclaimed) for "online educational services in the nature of providing learning directory services"; the mark "CLASSWELL LEARNING GROUP" ("LEARNING GROUP" disclaimed) for "on-line educational services, namely[,] providing educational materials in the fields of professional development for teachers and teacher training"; the mark "GE CENTER FOR FINANCIAL LEARNING" ("CENTER FOR FINANCIAL LEARNING" disclaimed) for "providing an on-line database featuring educational information in the financial field"; and the mark "THE LEARNING EQUATION" ("LEARNING" disclaimed) for "providing on-line education information about science, math, English, history, geography and social studies geared toward students, parents and teachers." Furthermore, the Examining Attorney points out that the two registrations which were initially cited (and subsequently withdrawn) as a bar to registration of applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground of a likelihood

of confusion, each issued on the basis of a claim of acquired distinctiveness under the provisions of Section 2(f) of the Trademark Act, 15, U.S.C. §1052(f). Those registrations, which are for the mark "LEARNING," in both typed and stylized formats, for "publications, namely[,] magazines--related to teaching," "demonstrate that the wording 'LEARNING' in relation to teaching is not inherently distinctive" according to the Examining Attorney.

We agree with applicant, however, that when considered in its entirety, the mark which it seeks to register "is not in fact merely descriptive, but is, instead, at most suggestive." As applicant notes in its initial brief:

Nothing in the mark LEARNING.COM gives any information that the underlying services relate to information distribution in the field of education. Instead, the most that can be said is that the mark makes a vague, indirect reference to the general goal of education Clearly, there is no actual information given, of any nature, as to the actual underlying services. Instead, mature thought is required to make the association between Applicant's mark and the underlying services of Applicant.

In this regard, we judicially notice that The American Heritage Dictionary of the English Language (4th ed. 2000) defines "learning" as a noun meaning "1. The act, process, or experience of gaining knowledge or skill. 2. Knowledge or skill gained through schooling or study. 3. Psychology Behavioral modification especially through experience or conditioning."²

² It is settled that the Board may properly take judicial notice of dictionary definitions. 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.,

Thus, while in some respects the word "learning" is similar in connotation to the word "education," which as indicated previously denotes "[t]he knowledge or skill obtained or developed by a learning process," such words are not identical in meaning. We therefore concur with applicant's argument in its initial brief that while, when used in connection with its computer services of providing on-line information and references in the field of education, the mark "LEARNING.COM" "indicates that the services have something indirectly to do with learning ..., it gives no information whatsoever that the services relate to collecting and distributing information relating to *education*" (italics in original). As applicant further persuasively points out in its initial brief (italics in original):

Here, not only is the mark not an instantaneous indicator of the nature of the services, but even after analysis and reflection, the words [comprising the mark] cannot be considered as immediately conveying their nature. The mark, instead, is a classic example of a suggestive mark, hinting at the intended goal of enhancing learning, but at the same time failing to provide any specific information whatsoever.

Finally, however, to the extent that the third-party registrations relied upon by the Examining Attorney may serve to create doubt as to our conclusion that the mark "LEARNING.COM," when used in connection with applicant's services, is suggestive rather than merely descriptive, we resolve such doubt, in accordance with the Board's practice, in favor of applicant.

See, e.g., *In re Conductive Systems, Inc.*, 220 USPQ 84, 86 (TTAB

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*

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1983); In re Morton-Norwich Products, Inc., 209 USPQ 791 (TTAB 1981); and In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972).

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

Co., 212 USPQ 852, 860 n. 7 (TTAB 1981).