

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Working Woman Network, Inc.

Serial No. 76/053,874

Norman H. Zivin of Cooper & Dunham LLP for Working Woman Network, Inc.

Henry S. Zak, Trademark Examining Attorney, Law Office 108¹ (David Shallant, Managing Attorney).

Before Seeherman, Hohein and Holtzman, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Working Woman Network, Inc. has appealed from the Examining Attorney's final refusal to register WOMEN'S BUSINESS EXCHANGE as a mark for "business marketing consulting services, namely, providing consultation

¹ Mr. Zak represented the Office at the oral hearing. A different Examining Attorney examined the application and wrote the appeal brief.

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relating to the sale of goods and services over a global communications network."² Registration has been refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its identified services.

The appeal has been fully briefed, and an oral hearing was held before the Board.

It is the Examining Attorney's position that the mark is merely descriptive because:

First, the mark describes the way in which the business marketing consulting services offered by applicant are intended to, or designed to, provide women with a business exchange for better access to and understanding of the market place. Secondly, the consultation transaction itself, entered by clients of the applicant and applicant, can be said to constitute a "business exchange" by women or for the benefit of women.

Brief, p. 3.

In support of this position, the Examining Attorney has submitted excerpts of articles taken from the NEXIS database, copies of third-party registrations in which the term "BUSINESS EXCHANGE" has been disclaimed, and dictionary definitions of "business" and "exchange." The

² Serial No. 76/053,874, filed May 22, 2000, based on an asserted bona fide intention to use the mark in commerce.

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Examining Attorney has also pointed out that applicant has disclaimed exclusive rights to use the words BUSINESS EXCHANGE, and he contends that by this disclaimer applicant has acknowledged that the term is "a well known descriptive phrase commonly used in the business world." Brief, p. 4.

We turn first to the effect of applicant's disclaimer of BUSINESS EXCHANGE. In response to the first Office action, applicant offered a disclaimer of the word BUSINESS. After the Examining Attorney made the refusal of registration final, applicant submitted, with its request for reconsideration, a disclaimer of BUSINESS EXCHANGE because this "was done in the registrations referred to by the Examining Attorney." However, applicant did not acknowledge that the term was descriptive, stating in that communication only that the phrase "arguably may bear some relation to Applicant's recited services." In its reply brief applicant reiterated that the term was at most suggestive, that applicant's services do not constitute a business exchange, and that the NEXIS articles submitted by the Examining Attorney do not demonstrate that the term is commonly used or has a well-known meaning. In view of these statements, and the fact that an applicant may voluntarily disclaim even registrable matter, **In re MCI Communications Corp.**, 21 USPQ2d 1534 (Comm'r Pats. 1991),

we cannot regard applicant's disclaimer of BUSINESS EXCHANGE as a concession that this term is merely descriptive of applicant's services.

Turning to the evidence of record, the Examining Attorney has submitted excerpts from five newspaper articles, as follows:³

The Business Exchange [sic] Club meets weekly form 8 to 9 a.m. at Eileen Darling's restaurant, Seekonk. Interested professionals wanting to exchange [sic] referrals, ideas and advice should call
"The Providence Journal-Bulletin,"
November 28, 1999

The Chamber business exchange [sic], 5:30 to 7:30 p.m., Legends Bar & Grille, 2708 N. Hullen St., Metairie.
"The Times-Picayune," April 18, 1999

BUSINESS EXCHANGE, [sic] BEACHWOOD CHAPTER: Michael Klee of Myers-Reese Insurance Agency Inc. received the professional of the year award.
"Crain's Cleveland Business," July 10, 1995

HEADLINE: Business Exchange: [sic] Why Should Blacks Buy American?
"The New York Beacon," June 4, 1993

The story of Project RAFT is a tale of almost unbelievably lucky timing. Ellison hatched the idea a couple of years ago, just as Soviet leaders decided to open their country to

³ There is a sixth submission from the "Central News Agency," but because this appears to be a wire service article, we have no way of knowing whether it was actually published in any newspapers in the United States.

sporting, cultural and business
exchanges. [sic]
"The Washington Post," August 6, 1989

The three third-party registrations in which the words
BUSINESS EXCHANGE were disclaimed were for the following
marks:

BBE BARTER BUSINESS EXCHANGE INC., in
which the phrase BARTER BUSINESS
EXCHANGE INC. was disclaimed, for
"business management services, namely,
managing an organization for third
party members for the promotion and
sale of the goods and services of such
members; referral services for members
seeking to purchase goods and services
of other members; third party record
keeping services, namely, keeping
records of purchases and sales of
individual members and providing
statements of same to such members;
advertising services, namely, promoting
the goods and services of members
through the distribution of brochures,
directories, magazines and newsletters;
business consultation services in the
field of business operations,
maximizing efficiency, profitability
and market share";⁴

WBE-NET WORLD BUSINESS EXCHANGE
NETWORK, in which the phrase WORLD
BUSINESS EXCHANGE NETWORK was
disclaimed, for "leasing access time to
a computer database in the nature of a
computer bulletin board in the field
import/export";⁵ and

NATIONAL BUSINESS EXCHANGE and design,
in which the phrase NATIONAL BUSINESS
EXCHANGE was disclaimed, for

⁴ Registration No. 2,141,901.

⁵ Registration No. 1,920,406.

"educational services, namely, conducting classes and workshops in the field of business management."⁶

The Examining Attorney also submitted dictionary definitions of the words "business" and "exchange," and has specifically pointed to the definition of "business as meaning "commercial, industrial, or professional dealings: *new systems now being used in business,*" and "serious work or endeavor: *got right down to business,*" and the definition of "exchange" as meaning "to give in return for something received; trade: *exchange dollars for francs; exchanging labor for room and board.*"

A mark is merely descriptive, and therefore prohibited from registration pursuant to Section 2(e)(1) of the Trademark Act, if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods or services with which it is used. A mark is suggestive, and therefore registrable on the Principle Register without a showing of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. See **In re Gyulay**, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). It has been recognized that there is but a thin line of distinction between a suggestive and a merely descriptive term, and it

⁶ Registration No. 1,862,832.

is often difficult to determine when a term moves from the realm of suggestiveness into the sphere of impermissible descriptiveness. **In re Recovery, Inc.**, 196 USPQ 830 (TTAB 1977).

In this case, we find that WOMEN'S BUSINESS EXCHANGE falls on the suggestive side of that line. We cannot determine, based on the evidence of record, that BUSINESS EXCHANGE directly conveys information about the nature of applicant's services. The three third-party registrations in which this term has been disclaimed are not for the same services as identified in the application. As for the newspaper articles, we note that all of them use the term "business exchange" rather than "business exchange." It appears that this is a typographical error and, because the Examining Attorney did not submit any articles in which the term "business exchange" is spelled correctly, we suspect that the error was in the searched term itself.⁷ In any event, the excerpts do not show that "business exchange" is a term that describes the activities covered by applicant's identification of services. The first three articles listed above use the term as the name of an organization.

⁷ Because it is the USPTO's burden to prove the mark is merely descriptive, if the Office submits flawed evidence, that obviously affects the value of the case it has made.

The reference to "Business Exchange" [sic] in the headline "Why Should Blacks Buy American?" is simply too terse to show what meaning this term has. And the reference to business in "The Washington Post" article to Soviet leaders opening their country to sporting, cultural and business exchanges does not appear to be the kind of business exchange envisioned by either the Examining Attorney or applicant's identification of services.

Nor do the dictionary definitions show that when the words are combined in the mark WOMEN'S BUSINESS EXCHANGE, the mark has a descriptive connotation.

Although the term "business exchange" has, as applicant acknowledges, some relation to applicant's services, in that the term clearly has something to do with business, we are not persuaded that the mark describes the identified business marketing consulting services. We cannot agree with the Examining Attorney's contention that the identified services would constitute providing women with a business exchange for better access to the marketplace, or that the consultations would constitute a business exchange. Even if this were the case, certainly some degree of thought is required to reach such a conclusion. Because the mark WOMEN'S BUSINESS EXCHANGE does not directly convey information about applicant's

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identified services, but that, when the mark is viewed in the context of the services, a several step thought process is required to understand the nature of applicant's business marketing consulting services, the mark is suggestive and not merely descriptive.

Decision: The refusal of registration is reversed.