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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Industrial Risk Insurers

Serial No. 76097495

Hugh D. Jaeger for Industrial Risk Insurers.

Ronald E. Aikens, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Quinn, Zervas and Wellington, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Industrial Risk Insurers filed an application to register the mark "industrialrisk.com" (standard character form in lowercase letters) for "insurance underwriting in the field of fire, accident and casualty loss for industries."¹

¹ Application Serial No. 76097495, filed July 27, 2000, alleging first use anywhere and first use in commerce on August 15, 1997. Applicant subsequently changed the filing basis, deleting the use basis under Section 1(a) and substituting therefor an intent-to-use basis under Section 1(b). Applicant later filed a statement of use setting forth the same dates of first use.

The trademark examining attorney refused registration under Sections 1, 3 and 45 of the Trademark Act on the basis that the matter sought to be registered is used by applicant only in the informational designation "industrialrisk.com," which is merely an address or domain name and, as such, fails to function as a service mark.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.

Given the unusual history of the involved application after the appeal, a brief review of this history is in order. When the examining attorney issued a final refusal based on the finding that the specimen of record did not show use of the proposed mark as a service mark, applicant appealed. The original notice of appeal was filed on May 23, 2002, almost six years ago. The notice of appeal included a request for an oral hearing. After receiving extensions of time to file a brief, applicant filed its appeal brief on March 17, 2003. The Board, in an order dated April 30, 2003, indicated that the appeal brief did not conform to the requirements of Trademark Rule 2.142(b)(2). The Board accordingly ruled that it would not consider the nonconforming brief, but that the appeal would not be dismissed. The examining attorney filed a brief and an oral hearing was scheduled. Before the oral hearing was

held, applicant filed a request for remand, asserting that it desired to change the filing basis of its application, from a use-based application under Section 1(a) to an intent-to-use application under Section 1(b).

Notwithstanding the late juncture of the appeal, the Board, on February 27, 2004, remanded the application to the examining attorney due to the fact that the proposed change in filing basis might obviate the refusal to register.

Applicant filed, on March 22, 2004, a communication wherein it noted the suspension of the appeal and remand to the examining attorney, and further stated "it is believed that the oral hearing likewise will be deferred, if even ever necessary." The examining attorney accepted the proposed change in filing basis, and the mark was published as an intent-to-use mark. When no opposition was filed, the Office issued a notice of allowance. Applicant subsequently filed a statement of use, accompanied by a specimen showing the alleged mark as actually used in commerce, and the examining attorney once again issued a refusal based on his view that the matter sought to be registered failed to function as a mark. Applicant responded by submitting a substitute specimen, but the examining attorney was not persuaded, and he issued a final refusal. Applicant filed a new notice of appeal on March

17, 2006. After being granted several requests to extend its time to file an appeal brief, applicant finally filed a "brief" on May 17, 2007. The entirety of the brief is as follows: "Applicant has registered marks, as attached, for IRI INDUSTRIAL RISK INSURERS, Reg. Nos. 1,1740,188 and 2,073,280. The above mark INDUSTRIALRISK.COM is a derivative mark." The examining attorney then filed his brief. Applicant neither filed a reply brief nor a renewed request for an oral hearing.

We affirm the refusal to register.

A mark comprising of an Internet domain name is registrable as a service mark only if it functions as an identifier of the source of the services. As indicated in Section 1215.01 of the Trademark Manual of Examining Procedure (TMPEP) (5th ed. 2007):

A domain name is part of a Uniform Resource Locator ("URL"), which is the address of a site or document on the Internet. In general, a domain name is comprised of a second-level domain, a "dot," and a top-level domain ("TLD"). The wording to the left of the "dot" is the second-level domain, and the wording to the right of the "dot" is the TLD.

Example: If the domain name is "ABC.com," the term "ABC" is a second-level domain and the term "com" is a TLD.

A domain name is usually preceded in a URL by "http://www." The "http://" refers to the protocol used to transfer information, and the "www" refers to World Wide Web a graphical hypermedia interface for viewing and exchanging information.

The mark as depicted on the specimen must be presented in a manner that will be perceived by potential purchasers to indicate source and not merely an informational indication of the domain name address used to access a web site. See *In re Eilberg*, 49 USPQ2d 1955 (TTAB 1998). It is the perception of the relevant ordinary consumer that determines whether the asserted mark functions as a mark, not the applicant's intent, hope or expectation that it does so. See *In re Standard Oil Co.*, 275 F.2d 945, 125 USPQ 227 (CCPA 1960). See also TMEP §§1209.03(m), 1215.02(a). If the proposed mark is used in a way that would be perceived as nothing more than an Internet address where the applicant can be contacted, registration must be refused.

Applicant submitted two different copies of the same webpage. The original specimen of record is a screen capture of the webpage, and the second specimen is a printed copy of the text contained on the screen capture. Applicant's specimens of record show use of the applied-for mark only in the URL of the displayed webpage (in the

address window of the Microsoft Explorer Web browser), and at the bottom left corner edge of a printed copy of the webpage (where printers note the source of the copy). Moreover, in both instances, the applied-for mark appears only in the form "http://www.industrialrisk.com". No other reference to "industrialrisk.com" is found in the specimens.

The applied-for mark is used in the specimens in a way that would be perceived as nothing more than part of applicant's domain name address or location on the Internet. The specimens only show the term embedded in applicant's web site address. The applied-for mark is purely informational in that it is used only to direct one to a particular website, and not as a source indicator. *In re Eilberg*, 49 USPQ2d at 1956.

Applicant's contention that the applied-for mark is a "derivative mark" and, thus, capable of registration, is not understood. Firstly, we are unaware of any special category of mark described as a "derivative mark." Secondly, to the extent that applicant is claiming that its registration of other marks, such as IRI and IRI INDUSTRIAL RISK INSURERS, is relevant to the issue of registrability of the involved mark, this argument is ill founded. The fact that applicant owns these other registrations is

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irrelevant to the issue herein, that is, whether the applied-for mark, that is different in nature from applicant's registered marks, functions as a service mark. Each case must stand on its own merits, and registrability is determined on the record. Further, we would add that the mere registration of a term as a domain name does not establish any trademark rights. *Brookfield Communications Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 50 USPQ 1545, 1555 (9th Cir. 1999).

Decision: The refusal to register is affirmed.