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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Start-A-Business.Com, Inc.

Serial No. 76158423

Gerard F. Dunne, Esq. for Start-A-Business.Com, Inc.

Leslie L. Richards, Trademark Examining Attorney, Law
Office 106 (Mary I. Sparrow, Managing Attorney).

Before Hanak, Walters and Bucher, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Start-A-Business.Com, Inc. (applicant) seeks to register in typed drawing form START A BUSINESS.COM for "business services, namely, preparing incorporation papers for businesses." The application was filed on November 2, 2002 with a claimed first use date of December 13, 1998.

Citing Section 2(e)(1) of the Trademark Act, the Examining Attorney refused registration on the basis that applicant's mark is merely descriptive of applicant's services. When the refusal to register was made final,

applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing.

A mark is merely descriptive pursuant to Section 2(e)(1) of the Trademark Act if it immediately conveys information about a significant quality or characteristic of the relevant goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986). Of course, it need hardly be said that the mere descriptiveness of a mark is judged not in the abstract, but rather is judged in relationship to the goods or services for which the mark is sought to be registered. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 216 (CCPA 1978). Finally, a mark need describe only one significant quality or characteristic of the relevant goods or services in order to be held merely descriptive. In re Gyulay, 3 USPQ2d at 1010.

At the outset, we note that there is no dispute that applicant's service of preparing incorporation papers for businesses is rendered via the Internet. Applicant's specimen of use is a printout of its web page. The first sentence on this web page reads as follows: "Welcome to START A BUSINESS.COM - your one source on the Internet for

nationwide and offshore incorporation services, domain name registration and much more!"

It is the Examining Attorney's position that when used in connection with preparing incorporation papers for businesses, the "mark" START A BUSINESS.COM will immediately inform prospective customers that they can start a business by the process of incorporation. The Examining Attorney notes that the phrase "start a business" is very frequently used in connection with the process of incorporation. In this regard, the Examining Attorney has made of record dozens of articles from various newspapers and magazines where the common phrase "start a business" is used in connection with the process of incorporation. For example, an article appearing in the July 23, 2001 edition of the Albuquerque Tribune reads, in part, as follows: "So you want to start a business? Then start thinking about incorporation issues, such as share values, voting corporate members, structure ... where to incorporate and preferred stock." An article appearing in the May 7, 1993 edition of the Journal of Commerce reads, in part, as follows: "Unlike ocean freight forwarders, which are regulated by the Federal Maritime Commission, overland freight forwarders need only incorporate themselves to

start a business. They face little federal regulation and no ownership restrictions."

There are numerous articles which discuss how it has become easier and thus more common to start a business by incorporating. For example, the October 30, 2002 edition of The Cincinnati Enquirer contains the following passage: "Since becoming secretary of state in 1998, J. Kenneth Blackwell says he has modernized the office and made it easier for Ohioans to start a business. 'When I took over, it was taking 15 to 18 weeks to incorporate a business in Ohio. With the introduction of new technology we've gotten that down to one to three days,' he said. 'We are now recognized as a technology leader.'" An article appearing in the June 23, 1996 edition of the News and Observer (Raleigh, North Carolina) contains a paragraph conveying a similar message: "The impulse to start a business definitely has caught on in North Carolina. The number of new businesses incorporated statewide in 1994 jumped a robust 10.5 percent to 14,830 according to the U.S. Small Business Administration." Finally, an article appearing in the February 8, 1993 edition of Business First - Buffalo likewise conveys a similar message, as reflected in the following passage: "Western New York entrepreneurs appeared to gain confidence as the year progressed, but

they never seemed to be totally convinced that 1992 was a good time to start a business. The first half of the year mirrored the low number of incorporations in Erie and Niagara counties in 1991."

The foregoing are but a small number of the numerous articles made of record by the Examining Attorney where the common phrase "start a business" is used in connection with the act of incorporating. It is our view that applicant's "mark" START A BUSINESS.COM - as applied to the services of preparing incorporation papers for businesses - clearly informs prospective customers that applicant will assist them in starting a business by preparing the necessary incorporation papers. Accordingly, we find that as applied to "business services, namely, preparing incorporation papers for businesses," the term START A BUSINESS.COM is most decidedly merely descriptive pursuant to Section 2(e)(1) of the Trademark Act. Hence, we affirm the refusal to register.

In an effort to demonstrate that its "mark" is not merely descriptive as applied to its services, applicant raises essentially three arguments. First, at page 1 of its brief applicant states that in order to fully "start a business," an individual(s) would not only need to have prepared the appropriate incorporation papers, but in

addition that individual(s) "would likely need to accomplish many things such as secure financing, devise a business plan, rent space, hire employees, open a checking account, choose a name, and the like." We do not disagree with applicant. However, applicant never disputes the fact that the initial step (the starting step) in establishing a corporation is to have properly prepared the appropriate incorporation papers. Thus, applicant's "mark" START A BUSINESS.COM is clearly descriptive of the initial act (the starting act) in establishing a corporation, namely, the preparation of the appropriate incorporation papers.

Second, at page 2 of its brief, applicant argues that while some of its customers are individuals who have no existing business and come to applicant in order to have prepared the appropriate incorporation papers, other customers of applicant are established businesses who come to applicant for the purpose of "changing a partnership or joint venture to a corporation." Continuing, applicant then argues at page 2 of its brief that applicant's "services, in such cases, would not be provided to those 'starting' a business." Even assuming purely for the sake of argument that applicant's "mark" START A BUSINESS.COM is not merely descriptive of applicant's services of preparing incorporation papers when the businesses have already been

"started" in some other form, nevertheless, applicant's mark is clearly descriptive in the context of those customers of applicant who have no existing business and are literally starting a business by having applicant prepare the incorporation papers. At a minimum, applicant's "mark" START A BUSINESS.COM is merely descriptive of at least one quality or characteristic of applicant's services, namely, when applicant's services are utilized by individuals who have no pre-existing business such as a sole proprietorship or partnership. As noted much earlier in this opinion, a mark need describe only one significant quality or characteristic of applicant's services in order to be held merely descriptive. Gyulay, 3 USPQ2d at 1010. Moreover, we note that even when applicant's services are furnished to existing businesses such as sole proprietorships or partnerships, said services are still described by applicant's "mark" START A BUSINESS.COM. In such situations, applicant's services of preparing incorporation papers result in the "starting" of a new form of business, namely, a corporation.

Third, at pages 2 and 3 of its brief applicant correctly notes that in order to be held merely descriptive, a mark must describe the relevant services with a "degree of particularity." In this regard,

applicant cites In re TMS Corporation of the Americas, 200 USPQ 57 (TTAB 1978) and In re Entenmann's Inc., 15 USPQ2d 1750 (TTAB 1990) aff'd unpublished Fed. Cir. February 13, 1991. However, applicant then proceeds to raise to the following rhetorical question: "How does the term 'start a business' immediately and forthwith convey with a degree of particularity the preparation of incorporation papers?" In raising this rhetorical question, applicant totally ignores a fundamental principle (set forth earlier in this opinion) in determining whether a word or term is merely descriptive. That fundamental principle is that the mere descriptiveness of a mark is not judged in the abstract, but rather is judged in relationship to the goods or services for which the mark is sought to be registered. Abcor, 200 USPQ at 216. We agree that the term "start a business" does not name the services of preparing incorporation papers for businesses. If it did, the said term would not be merely descriptive, but rather would be generic. However, when used in connection with the services of preparing incorporation papers for businesses, the "mark" START A BUSINESS.COM clearly describes at least one significant characteristic of said services.

One final comment is in order. At no time during this proceeding has applicant ever argued that if it were proven

that the phrase START A BUSINESS was merely descriptive of applicant's services, that the addition of .COM would cause the "mark" in its entirety (START A BUSINESS.COM) to be not merely descriptive. However, on the remote chance that applicant should raise this argument on appeal, we wish to note that it has long been held that the addition of a "top level domain indicator like '.com' does not turn an otherwise unregistrable designation into a distinctive, registrable trademark [or service mark]." 1 J. McCarthy, McCarthy on Trademarks and Unfair Competition, Section 7:17.1 at pages 7-28.1 to 7.29 (4th ed. 2002). See also Brookfield Communications v. West Coast Entertainment Corp., 174 F.3d 1036, 50 USPQ2d 1545, 1558 (9th Cir. 1999) ("The '.com' top-level domain [merely] signifies the site's commercial nature.").

Decision: The refusal to register is affirmed.