

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed:
September 26, 2003
Paper No. 11
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Physicians Practice, Inc.

Serial No. 76/186,666

Sherry H. Flax of Saul Ewing LLP for Physicians Practice,
Inc.

Sonya B. Stephens, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Simms, Bucher and Rogers, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Physicians Practice, Inc. seeks registration on the
Principal Register for the mark HOUSESTAFF.COM for
services recited as "computer services, namely, providing
on-line magazines in the fields of business, marketing,
financial and general practice management for physicians,
medical students, and medical personnel via a global
computer network," in International Class 42.¹

¹ Application Serial No. 76/186,666 was filed on December 26,
2000 based upon applicant's allegation of a *bona fide* intention
to use the mark in commerce. Applicant has voluntarily agreed to
disclaim exclusive rights "to use 'house,' 'staff,' and
'housestaff' apart from the mark as shown."

This case is now before the Board on appeal from the final refusal to register on the ground that the term HOUSESTAFF.COM is merely descriptive of applicant's services under Section 2(e)(1) of the Lanham Act, 15 U.S.C. §1052(e)(1).

Both applicant and the Trademark Examining Attorney have fully briefed the case. Applicant did not request an oral hearing.

We affirm the refusal to register.

A term is merely descriptive, and therefore unregistrable pursuant to the provisions of Section 2(e)(1) of the Trademark Act, if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services with which it is used or is intended to be used. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978); and In re Eden Foods Inc., 24 USPQ2d 1757 (TTAB 1992). It is well settled that a term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant feature, attribute, function, property, ingredient, quality, characteristic, purpose or

use of the goods or services. In re Opryland USA Inc., 1 USPQ2d 1409 (TTAB 1986); and In re The Weather Channel, Inc., 229 USPQ 854 (TTAB 1985). The question of whether a particular term is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the mark is used or is intended to be used, and the possible significance that the mark is likely to have for the average purchaser encountering the goods or services in the marketplace. See In re Abcor Development Corp., *supra*; In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995); In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991); In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986) and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979).

That is, the question is not whether someone presented with only the term or phrase could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the term or phrase to convey information about them. See In re Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990); and In re American Greetings Corp., 226 USPQ 365 (TTAB 1985). Accordingly, we find most unpersuasive applicant's argument that "'house staff' is used widely to refer to the employees of a state house of representatives"

or that it is used " ... in connection with college residences." (Applicant's brief, p. 3).

The Trademark Examining Attorney has placed into the record thirty-nine stories from the LEXIS/NEXIS database demonstrating that the term "house staff" refers to medical personnel who are employed at medical centers and hospitals. While applicant does not deny that its services are, or will be, directed, *inter alia*, to medical professionals employed at such medical facilities, applicant argues that its services will be used by a broader group of medical personnel. However, as the Trademark Examining Attorney has correctly contended, it is not necessary that a term describe all of the intended users in order to be found to be merely descriptive. Rather, it is enough that the term describes a significant group of the intended users of the services. See In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982); and In re MBAssociates, 180 USPQ 338 (TTAB 1973). And while not itself determinative herein, we find that applicant's voluntary disclaimer of the term "housestaff" also appears to support a finding of descriptiveness of this term.

Applicant argues that the United States Patent and Trademark Office has in the past registered marks that include terms (e.g., "medical staff," "staff physician,"

and "house call") that are far more descriptive than "house staff" in connection with goods or services targeted to medical personnel.

The Examining Attorney, citing In re Scholastic Testing Service, Inc., 196 USPQ 517, 519 (TTAB 1977) and TMEP §1209.03(a), properly notes in her brief that "[t]hird-party registrations are not conclusive on the question of descriptiveness" and that "[a] mark which is merely descriptive is not registrable merely because other similar marks appear on the register." Each case must be determined on its own merits. See In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court"]; In re Broyhill Furniture Industries Inc., 60 USPQ2d 1511, 1514 (TTAB 2001); and In re Pennzoil Products Co., 20 USPQ2d 1753, 1758 (TTAB 1991).

In addition, it is pointed out that because the Board does not take judicial notice of third-party registrations, the mere citation to such purported registrations in applicant's request for reconsideration and appeal brief "is insufficient to make them of record." In re Duofold Inc., 184 USPQ 638, 640 (TTAB 1974). The proper procedure, instead, for making information concerning third-party registrations of record is to submit either copies of the actual registrations or the electronic equivalents thereof,

i.e., printouts of the registrations which have been taken from the PTO's own computerized database. See In re Consolidated Cigar Corp., 35 USPQ2d 1290, 1292 n. 3 (TTAB 1995); In re Smith & Mehaffey, 31 USPQ2d 1531, 1532 n. 3 (TTAB 1994); and In re Melville Corp., 18 USPQ2d 1386, 1388 n. 2 (TTAB 1991).

In any event, even if such information were to be considered, it would be devoid of any probative value because it would not reveal which of the cited registrations issued with a disclaimer of the allegedly similar term under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), and/or pursuant to a claim of acquired distinctiveness in accordance with Section 2(f) of such Act, 15 U.S.C. §1052(f).

Accordingly, we find that the term "house staff" (or "house-staff" or "housestaff") is descriptive for the recited services.

Of course, applicant's entire mark is not just the term "house staff," but is a composite mark presented in the form of an Internet address, HOUSESTAFF.COM. Applicant argues that this combination "is inventive and creates a unique commercial impression that indicates the source of the services" (Applicant's brief, p. 3).

However, we find that no new meaning is created by the combination of the terms "HOUSESTAFF" and ".COM"; rather, the consuming public for services of the kind rendered by applicant would understand the meaning of the term

HOUSESTAFF.COM to be the same as that of its constituent parts combined. Prospective consumers will view applicant's mark as a combination of merely descriptive wording along with a top level Internet domain name ".com." See In re CyberFinancial.Net Inc., 65 USPQ2d 1789, 1792-94 (TTAB 2002) [BONDS.COM for, *inter alia*, "providing information regarding financial products and services via a global computer network ..., with respect to taxable and tax exempt debt instruments," is generic term for such services; it lacks "any meaning apart from the meaning of the individual terms combined"; and it "is properly considered a compound word in this analysis"]; and In re Martin Container Inc., 65 USPQ2d 1058, 1060 (TTAB 2002) [CONTAINER.COM is "incapable of identifying the source of applicant's retail and rental services featuring containers" because "what applicant seeks to register is simply a generic term [CONTAINER], which has no source-identifying significance in connection with applicant's services, in combination with the top level domain indicator [.COM], which also has no source-identifying significance, and ... combining the two does not create a term which has somehow acquired the capability of identifying and distinguishing applicant's services"].

More recently, the Board has had occasion to speak to the combination of a descriptive term and a TLD:

In each of the referenced two cases, the Board held that the applicant was attempting to register a composite of a generic term and a TLD, neither of which had source

indicating significance. In the case at hand, we are only faced with a refusal premised on the combination of a descriptive term and a TLD. We find there is nothing in the combination of a descriptive term and a TLD, as contrasted with the combination of a generic term and a TLD, that renders the composite registrable on the Principal Register without a showing of acquired distinctiveness.

In re Microsoft Corporation, (SN. 78/013,678) __ USPQ2d __ (TTAB September 11, 2003) [OFFICE.NET refused registration under Section 2(e)(1) for a wide range of computer software and hardware products]. Cf. Trademark Manual of Examining Procedure (TMEP) §§ 1209.03(m) and 1215.04 (3rd Ed. 2003).

Similarly, to the extent that the Trademark Examining Attorney has clearly established that the term "house staff" is merely descriptive for applicant's online magazines directed to physicians, medical students and other medical personnel, combining this term with a top level Internet domain name does not add source identifying significance to this composite mark, and hence, this composite is not registrable on the Principal Register absent a showing of acquired distinctiveness.

Decision: The refusal to register under Section 2(e)(1) of the Act is hereby affirmed.