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Mailed: April 20, 2005

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re NetEnterprise, Inc.

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Serial No. 76219917

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Leighton K. Chong of Ostrager Chong & Flaherty for  
NetEnterprise, Inc.

Dominick Salemi, Trademark Examining Attorney, Law Office  
106 (Mary Sparrow, Managing Attorney).

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Before Chapman, Bucher and Drost, Administrative Trademark  
Judges.

Opinion by Chapman, Administrative Trademark Judge:

On March 1, 2001, NetEnterprise, Inc. (a corporation  
of Hawaii) filed an application to register on the  
Principal Register the mark NETENTERPRISE for services  
ultimately identified as follows:

"computer services, namely connecting  
customer web sites and web applications  
for online access by users through the  
Internet, hosting and managing customer  
web sites and web applications at data  
centers, providing network management

and support services to customers" in International Class 42.<sup>1</sup>

The Examining Attorney made final his refusal to register the mark as merely descriptive of applicant's services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). In response thereto, applicant filed an amendment requesting that its application be amended to seek registration on the Supplemental Register.

Thereafter, the Examining Attorney refused registration under Section 23, 15 U.S.C. §1091, on the ground that the proposed mark is generic and incapable of serving as a source identifier for applicant's services. When the Examining Attorney had twice refused registration on the Supplemental Register, applicant appealed.

Both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

The issue before the Board is whether the term NETENTERPRISE is generic for applicant's services, and thus, is incapable of serving as a source identifier therefor and hence is unregistrable on the Supplemental Register.

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<sup>1</sup> Application Serial No. 76219917, filed March 1, 2001, is based on applicant's claimed date of first use and first use in commerce of October 1996.

The Examining Attorney contends that the Merriam-Webster OnLine Dictionary defines the terms "net" as "5: Internet," and "enterprise" as "1: a project or undertaking that is especially difficult, complicated, or risky ... 3a: a unit of economic organization or activity; especially: a business organization b: a systematic purposeful activity"; that "Applicant's term [NETENTERPRISE], used in connection with the type of services applicant provides, merely serves to inform the public of the type of business [applicant] runs, to wit: an internet business or enterprise" (Office action dated May 20, 2003, p. 1); that the words used together result in a proposed "mark that literally describes the provider of the services: a business providing services electronically or over the internet" (brief, unnumbered page 3); and that allowing applicant to register the term NETENTERPRISE on the Supplemental Register would prevent applicant's competitors from adequately describing their own such services.

The Examining Attorney also submitted (i) printouts of some excerpted stories retrieved from the Nexis database relating to "net enterprise"; and (ii) printouts from several websites on the Internet, generally showing references to "net enterprise" or "Internet enterprise."

Some representative examples of the Nexis and Internet evidence are reproduced below (emphasis added):

Headline: A Simple Plan for Success on the Net  
...competition is being crowded. Building value in a brand will no doubt breed success for a **Net enterprise**. The Internet will continue to evolve and so will marketing strategies... "Video Age International," February 1, 2001;

Headline: NBC Interactive Now A Business Unit  
...Indeed, Yudkowitz readily admits that NBC Interactive, like the majority of '**Net enterprises**,' is not yet a money maker. That will come when penetration, convenience, reliability and transaction security improve, he predicts. "Phillips Business Information," March 5, 1997;

**INTERNET ENTERPRISE STRATEGY & DESIGN**  
A Real-World Introduction to Electronic Commerce  
An Online Guide for Net Entrepreneurs & Managerial End Users  
**STARTING AN INTERNET ENTERPRISE**  
Why? What? How? When?  
...  
[www.brint.com](http://www.brint.com);

Enterprise Cold Reporting Software  
...  
**Internet Enterprise Cold Reporting - for Internet/Intranet Environments**  
...  
[www.winocular.com](http://www.winocular.com);

Internet Security Systems  
CONNECT  
International Security Summit  
The Premiere Conference for **Internet, Enterprise** and Network Security  
[www.issconnect.net](http://www.issconnect.net);

The **Internet Enterprise** System, By Sunil Ciszewski  
www.saleslobby.com; and

Wireless **Internet Enterprise**  
Applications, by Chetan Sharma  
www.shopbarnesandnoble.com.

Applicant's position is set forth below:

While Applicant may concede that the two-word phrase 'net enterprise' is generic, Applicant has submitted proof in the record that 'NETENTERPRISE' is not generic. Using Google searching, Applicant has shown that over 80% of the primary 200 references it found and 90% of those found by the Examiner using the term 'netenterprise' referred to Applicant's own company. The Examining Attorney arguments are directed to generic references to 'net enterprise', but does not respond in any persuasive manner to Applicant's arguments as to the source-identifying nature of 'NETENTERPRISE'.

Furthermore, the Applicant is not applying to register 'NETENTERPRISE' for a generic 'business providing services electronically over the Internet'. Instead, the Applicant's services as described in the application are 'Computer Services, such as services in hosting, maintaining, and supporting Web sites at data centers'. These services are known in the industry as those of a 'hosting data center', which is understood as a specific kind of service that has nothing to do with a 'business providing services electronically or over the Internet'.

(Reply brief, unnumbered page 2.)

Applicant concludes that the Examining Attorney was in error in refusing registration of NETENTERPRISE on the Supplemental Register.

The Office bears the burden of proving that the proposed trademark is generic, and genericness must be demonstrated through "clear evidence." See *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); and *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd*, *unpubl'd*, but appearing at 10 USPQ2d 1879 (Fed. Cir. 1989). The evidence of the relevant public's perception of a term may be acquired from any competent source, including newspapers, magazines, dictionaries, catalogs and other publications. See *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and *In re Leatherman Tool Group, Inc.*, 32 USPQ2d 1443 (TTAB 1994), citing *In re Northland Aluminum Products, Inc.*, 777 F.2d 1566, 227 USPQ 961 (Fed. Cir. 1985).

The test for determining whether a designation is generic, as applied to the goods or as used in connection with the services in an application, turns upon how the term is perceived by the relevant public. See *Loglan Institute Inc. v. Logical Language Group, Inc.*, 962 F.2d 1038, 22 USPQ2d 1531 (Fed. Cir. 1992). Determining whether

an alleged mark is generic involves a two-step analysis: (1) what is the genus of the goods or services in question? and (2) is the term sought to be registered understood by the relevant public primarily to refer to that genus of goods or services? See *In re The American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); and *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

Based on the recitation of services herein, and the screen prints from applicant's website, we find that the answer to the first Marvin Ginn question, namely, the genus of the involved services herein, is "providing Internet access for businesses."

We turn then to the second Marvin Ginn question, namely, whether the term "NetEnterprise" is understood by the relevant public primarily to refer to the service of providing Internet access for businesses.

The Examining Attorney's dictionary evidence shows that "Net" is understood to be a shorthand for "Internet." Similarly, the word "Enterprise" is readily understood as meaning "a business organization." Accordingly, a "net enterprise" is an "Internet business." Applicant seems not to argue this point.

In addition to applicant's argument quoted above from its reply brief, we also have the following statement from the declaration of applicant's vice president, Jason A.

Toth, dated August 29, 2002:

5. Further searches were performed on the generic terms 'net enterprise' and 'network enterprise'. ... These results show that there is a marked difference in public perception of our trademark 'NETENTERPRISE' and the generic term 'net enterprise'.

This recognition, coupled with the Nexis and Internet evidence and dictionary entries placed into the record by the Examining Attorney regarding use of the words "net enterprise," establishes that under either test, American Fertility, supra, or the compound word test of In re Gould Paper Corp., 835 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987), the phrase "net enterprise" is generic of a business operation conducted over the Internet. Whether one focuses on applicant's services "known in the industry as those of a 'hosting data center,'" or on the reason why prospective customers seek out applicant's services, the relevant public will readily understand the term "net enterprise" primarily to refer to an Internet business of which the service of providing Internet access for businesses is an example. See In re Central Sprinkler Co., 49 USPQ2d 1194

(TTAB 1998); and In re Conus Communications Co., 23 USPQ2d 1717 (TTAB 1992).

We are not persuaded by applicant's evidence which it asserts shows "overwhelming recognition of Applicant's own company as the source of the services" (brief, unnumbered page 3). While applicant's methodology is not clear, it is perhaps not surprising that when one searches "netenterprise" as a single run-together term on Google, many of the hits will be to applicant's trade name.<sup>2</sup>

Moreover, applicant's attempts to obtain a registration by emphasizing the fact that it uses the two words without a space between them is unpersuasive. A misspelling of a generic term or terms does not change the generic significance to the purchaser. See Nupla Corp. v.

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<sup>2</sup> Despite its superficial appeal, counting up Google hits can be quite misleading. For example, in reviewing the entire record, we note that Lexis/Nexis entries and the results of Internet searches (e.g., for the term "net enterprise" - having a space between the words "net" and "enterprise" - on the Google search engine) show frequent occurrences of the combination ".NET Enterprise" immediately before words like "server," "architecture," "application," "software," "services," etc. All these excerpts include some references to ".NET Enterprise" for goods and services sold by Microsoft corporation.

While the record does not make clear whether Microsoft's involved development software is related to applicant's services, to the extent this truly represents the majority of Google hits for this combination of terms (i.e., with a space between the words "net" and "enterprise"), it raises the entirely plausible possibility that, contrary to the conclusions applicant would have us draw from its "look at the first 200 Google hits" calculations, that the perceptions of prospective consumers, upon first encountering applicant's alleged mark, may be affected by Microsoft's usage.

IXL Manufacturing Co., 114 F.3d 191, 42 USPQ2d 1711 (Fed. Cir. 1997); Micro Motion Inc. v. Danfoss A/S, 49 USPQ2d 1628 (TTAB 1998); and In re Stanbel Inc., 16 USPQ2d 1469 (TTAB 1990), aff'd unpub'd, but appearing at 20 USPQ2d 1319 (Fed. Cir. 1991). See also, 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §§12:38 and 12:39 (4th ed. 2001). Here the "misspelling" is applicant's deletion of the space between the two separate words "net" and "enterprise." However, the term "netenterprise" remains generic.

We find that the evidence of record establishes that the relevant purchasing public recognizes the words "net enterprise" (or "netenterprise") as indicating a generic Internet business or enterprise, including the specific identified services offered by applicant. Thus, applicant's proposed mark is generic and incapable of distinguishing applicant's services from those of others.

**Decision:** The refusal to register on the Supplemental Register is affirmed.