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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Telescan L.L.C.<sup>1</sup>

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Serial No. 76414674

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Paul M. Denk for Telescan L.L.C.

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(K. Margaret Le, Managing Attorney).

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Before Seeherman, Kuhlke and Cataldo, Administrative  
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Telescan L.L.C. (applicant) has filed an application  
to register VMAIL (in standard character form) on the  
Principal Register for goods ultimately identified as  
"computer for a voice message system and a computer program  
for operating a voice messaging system for use in [sic]

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<sup>1</sup> The assignment of the application from Telescan Corporation,  
the original applicant, to Telescan, L.L.C. is recorded at  
reel/frame 2970/0507.

with a computer voice messaging system" in International Class 9.<sup>2</sup>

The examining attorney originally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C.

§1052(d), on the ground that applicant's mark, VMAIL, when used on its identified goods, so resembles the registered mark OPTIMAL V-MAIL (in standard character form V-MAIL

disclaimed) for "telecommunication services, namely, providing voice mail services" in International Class 38,<sup>3</sup>

as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. After applicant filed its appeal brief, the examining attorney

requested remand of the application for issuance of an

additional refusal under 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 goods. When the

additional refusal under Section 2(e)(1) was made final and

the Section 2(d) refusal maintained, the appeal was resumed

and applicant filed a supplemental brief. Applicant did

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<sup>2</sup> Application Serial No. 76414674, filed June 3, 2002, alleging May, 1989 as the date of first use and first use in commerce. If appeal is taken and applicant is ultimately successful, applicant should file an amendment to correct the typographical error in the identification of goods prior to publication.

<sup>3</sup> Registration No. 2385238, issued September 12, 2000.

not request an oral hearing. We affirm the refusal to register under Section 2(e)(1).

Refusal Based on Mere Descriptiveness Under Section 2(e)(1)

"A mark is merely descriptive if it 'consist[s] merely of words descriptive of the qualities, ingredients or characteristics of' the goods or services related to the mark." In re Oppendahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir., 2004), quoting, Estate of P.D. Beckwith, Inc. v. Commissioner, 252 U.S. 538, 543 (1920). See also In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003). The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and In re Venture Lending Associates, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of

mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. In re Abcor Dev. Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

In support of the refusal under Section 2(e)(1), the examining attorney submitted the following definitions:

V-MAIL (2) short for voice mail. The New Oxford American Dictionary, Oxford University Press (2001);

V-MAIL (2) See voice mail. CDE Computer Desktop Encyclopedia (Ver. 17.3, 3<sup>rd</sup> Quarter 2004);

VMAIL voice mail (computer science). Acronyms, Initialisms & Abbreviations Dictionary (33<sup>rd</sup> ed. 2004).

We take judicial notice of the definition of VOICE MAIL:<sup>4</sup>

VOICE MAIL An interactive computerized system for answering and routing telephone calls, for recording, saving, and relaying messages, and sometimes for paging the user. The American Heritage Dictionary of the English Language (4<sup>th</sup> ed. 2000).

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<sup>4</sup> University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) (Board may take judicial notice of dictionary definitions).

The record also includes excerpts from third-party websites where VMAIL is used to describe voice mail goods and services. See, e.g., aurora.edu ("This feature allows for users to automatically direct all incoming calls to another number...enter destination. If vmail, press <MESSAGE> or dial..."); archive.cpsr.net ("On the other hand, vmail is a term for voice message switching. Using computers, the telephone system, and other electronic means to store and forward voice messages.").

Applicant argues that use of VMAIL with its computer "is suggestive that the entire combination of the computer, and its software, might be used in a voice mail setting, or have some ability to be used in that manner, but it really does not per se describe a function, or purpose, of the operations of a computer." Supp. Br. p. 2. Further, applicant states that its computer "can be used by a live operator or under a stand alone option, provides visual administrative interface, provides automatic down-file of associated text message, provides client notification, provides client announcement recording, and does provide automated e-mail delivery of messages. But, the computer, and its program, just is not alone a voice messaging system." Supp. Br. p. 3.

Considering the mark VMAIL in connection with the identified goods, as we must, and keeping in mind that it need only describe a single significant quality, characteristic, function, ingredient, attribute or feature of the goods, there is no question that VMAIL, a recognized alternative for voice mail, describes a significant function of applicant's goods, namely, its voice messaging function. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for prospective purchasers of applicant's goods to perceive readily the merely descriptive significance of the term VMAIL as it pertains to applicant's goods. Applicant's argument that details how the computer operates and clarifies that it alone does not comprise a voice messaging system, does not change the ultimate purpose of applicant's goods which is the provision of voice mail to users.

We further note that the question of registration under Section 2(f) based on acquired distinctiveness is not before us. Applicant did make reference to its prior registration, Reg. No. 1587594, for the mark VMAIL in stylized form in a box design,<sup>5</sup> but this was in response to

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<sup>5</sup> Applicant did not make this registration of record.

the original Section 2(d) refusal. Applicant also filed a post appeal "Amendment C" that included a declaration wherein applicant states that "Usage of this trademark has been made by the Applicant for many years, well over five years of substantially exclusive and continuous of this mark in commerce, upon the equipment, and it is believed that the mark as coined by applicant herein deserves registration and protection as the exclusive trademark rights of the Applicant Telescan Corporation." However, this amendment was filed at the time the only ground for refusal was likelihood of confusion, and therefore applicant's statements appear to have been made with respect to its priority, vis-à-vis the rights of the registrant. In its first appeal brief, applicant argues in traversing the Section 2(d) refusal that:

Continuous and substantial usage of the mark, apparently exclusively up to 1999, the date of first use alleged by the registrant, should provide the Applicant with benefits that inure to it, notwithstanding the fact that another registrant may have [been] issued a mark and disclaimed [the] portion of its mark that is related to, but not identical with, the mark of this current application. It is believed that registration under §2(f) (15 U.S.C. 1052) of the act is warranted. In fact, the examiner in this current application has never really issued any rejection of this current mark upon any grounds relating to descriptiveness, and rejection based upon descriptiveness does not enter into these discussions as a basis for rejection, such as may have occurred during the prosecution of the mark

of the cited registration No. 2,385,238. Thus, the issue becomes is Applicant's mark so likely to be confused with the mark of a cited registration where the related terms of the cited registration, have been disclaimed, while Applicant can show substantial and continuous usage, and application of its mark to a product, for at least fifteen years, far earlier than the registration of the same mark to another. Br. p. 6.

As we noted, at the time these statements were made the only refusal in issue was based on likelihood of confusion under Section 2(d). After the application was remanded to the examining attorney for issuance of the refusal based on mere descriptiveness, the examining attorney did not suggest the possibility of registration under Section 2(f) and the applicant did not request it. To the contrary, applicant argued that its mark is not merely descriptive. See, e.g., Amendment D, After Appeal (June 21, 2005) ("It is Applicant's contention that VMAIL, is not merely descriptive of voice messaging. VOICE MAIL may be descriptive, but VMAIL, the partial acronym, it is submitted, is not merely descriptive.").

Refusal Based on Likelihood of Confusion Under Section 2(d)

Although we have found applicant's mark to be merely descriptive and therefore unregistrable, we will, in order to render a decision on all the issues before us, now turn to a consideration of the refusal based on the ground of

likelihood of confusion. Because a descriptive mark would not be registrable in any event, in our analysis of the likelihood of confusion ground we must treat applicant's mark as being highly suggestive.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to a consideration of the goods identified in the application and the services identified in the cited registration. It is well settled that goods or services need not be similar or competitive in nature to support a finding of likelihood of confusion. The question is not whether purchasers can differentiate the goods or services themselves, but rather whether purchasers are

likely to confuse the source of the goods or services. See Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 USPQ2d 1618 (TTAB 1989). Further, we must consider the cited registrant's goods or services as they are described in the registration and we cannot read limitations into those goods or services. See Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987). If the cited registration describes goods or services broadly, and there is no limitation as to the nature, type, channels of trade or class of purchasers, it is presumed that the registration encompasses all goods or services of the type described, that they move in all channels of trade normal for these goods, and that they are available to all classes of purchasers for the described goods or services. See In re Linkvest S.A., 24 USPQ2d 1716 (TTAB 1992).

Applicant's identified goods are "computer for a voice message system and a computer program for operating a voice messaging system for use in [sic] with a computer voice messaging system." Registrant's identified services are "telecommunication services, namely, providing voice mail services." Applicant argues that applicant "is not in the

service category" but rather that it "simply markets its computer, and program, which may be used in a computer voice messaging system, marketed as a product, under this trademark, in International Class 009." Br. p. 5.

Further, applicant argues that registrant's services and applicant's goods are marketed in "two distinct channels of trade." Id. Applicant has not provided any evidence to support its position.

The examining attorney has made of record an article from an online business journal and excerpts from several third-party websites to show that goods and services that are encompassed by applicant's and the registrant's identifications are offered in the same trade channels to the same potential customers, i.e., businesses or large institutions seeking voice mail goods or services. The following are relevant examples, including one from applicant's website:

Smaller companies face spending thousands of dollars to buy and install a voice-messaging system, which often triggers the replacement of existing telephone equipment, requiring thousands more. Many companies end up facing a \$5000 to \$10,000 investment to add voice mail to their phone systems. One alternative to buying a voice mail system is to rent mailboxes from a service bureau. This can be particularly helpful for companies that do not have phone systems that work with voice mail. Voice mail service bureaus, such as AccessDirect, and local telephone service providers, such as Southwestern

Bell...provide voice mail to customers on a monthly subscription basis. The Business Journal, [kansascity.bizjournals.com](http://kansascity.bizjournals.com);

On February 1, IST Telecommunications will activate a new voice messaging system, replacing the voice mail service the campus has used since 1990. While the original system was provided through an outside service provider, the new system was purchased by Telecommunications, which will operate and maintain the system internally. [istpub.berkeley.edu](http://istpub.berkeley.edu);

The CommWorks Message Delivery System is designed to let service providers offer voice mail services without investing in new hardware and software, and the system conserves network space by working "on the fly." CommWorks Corporation, a company that builds softswitch-based networks, is offering its new voice mail service to service providers. CommWorks says that its voice mail service lets service providers offer voice mail services to its existing customers to increase revenue and doesn't require an investment in new hardware and software...CommWorks says that installation only requires a minimal expense compared to the cost of hardware and software that's needed to install a traditional voice messaging system. [isp-planet.com](http://isp-planet.com);

Telescan provides the most reliable systems for the TAS (Telephone Answering Service) industry with the singular goal of "Keeping Your Business in Business." Telescan designs hardware and software solutions that provide a full range of services for inbound message call centers. [telescancorp.com](http://telescancorp.com).

The record also includes a third-party registration, Registration No. 2588670, that includes both voice mail and voice messaging services in International Class 38 and computers and computer software for use in voice mail and

voice messaging in International Class 9 under the same mark.

Based on the record before us, we find that applicant's goods and registrant's services are directed at the same purpose, that is, the provision of voice mail capability to potential purchasers. Applicant's goods, as identified, can be an alternative to registrant's services or can be used in the provision of registrant's services. Further, inasmuch as the recitation of services in the registration is not limited to any specific channels of trade, we presume an overlap and that the services would be offered in all ordinary trade channels for these services and to all normal classes of purchasers. See *In re Linkvest S.A.*, supra. Thus, we find that the goods and services are related and that the channels of trade overlap.

We note, however, that the overlapping potential purchasers of applicant's goods and registrant's services appear to be businesses and large institutions rather than general consumers and, therefore, would be somewhat more sophisticated in the purchasing of applicant's equipment or registrant's services and such purchases would not be made on impulse.

We turn now to the first du Pont factor, i.e., whether applicant's mark and registrant's mark are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression.

Applicant's mark VMAIL and the term V-MAIL in registrant's mark are highly similar and have a similar connotation, i.e., voice mail, when used in connection with the identified goods and services. However, as noted above, we have found this term to be descriptive as it pertains to applicant's mark and it is disclaimed in the cited registration. See *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012 (TTAB 1988) (by its disclaimer applicant conceded term is descriptive). Although we must for the likelihood of confusion analysis assume that applicant's mark is highly suggestive, rather than descriptive, the source-indicating capacity of this term is extremely limited. Accordingly, the mere fact that both marks contain the term VMAIL is not a sufficient basis on which to find that confusion is likely. While we recognize that even weak marks are entitled to protection against registration by a subsequent applicant of the same or similar mark for the same or closely related goods or services, *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974), they are

accorded a narrow scope of protection. See *In re Box Solutions Corp.*, \_\_\_ USPQ2d \_\_\_, Serial No. 76267086 (May 23, 2006). Under the circumstances of this case, we find that the additional word OPTIMAL in the registrant's mark is sufficient to create a different commercial impression such that applicant's mark is distinguishable from the cited mark.

Thus, we find that despite the relatedness of the goods and services, the marks are sufficiently dissimilar, particularly in view of the very weak nature of the common element VMAIL and the sophistication of the purchasers, that confusion is not likely between applicant's mark VMAIL and registrant's mark OPTIMAL V-MAIL.

Finally, to the extent applicant is arguing that the refusals under Sections 2(d) and 2(e)(1) would constitute a collateral attack on applicant's prior registration, the mark in the prior registration and the standard character mark applicant now seeks to register are not identical and are not legal equivalents. We do not regard the refusal to register the application now before us as an attack on applicant's prior registration. See *In re Best Software Inc.*, 63 USPQ2d 1109 (TTAB 2002) (prior registration does not give applicant right to register a different mark with different commercial impression for similar goods); and *In*

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re BankAmerica Corp., 231 USPQ 873 (TTAB 1986) (prior registration does not give applicant right to register mark for different services). See also In re Merrill Lynch, 230 USPQ 128 (TTAB 1986), reversed and remanded on other grounds, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); and In re Loew's Theatres, Inc., 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985).

**Decision:** The refusal to register under Section 2(e)(1) of the Trademark Act is affirmed but the refusal to register under Section 2(d) of the Trademark Act is reversed.