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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Barrister Global Services Network, Inc.

Serial No. 76424030

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LLP for Barrister Global Services Network, Inc.

David Elton, Trademark Examining Attorney, Law Office 106
(Mary I. Sparrow, Managing Attorney).

Before Bucher, Holtzman and Rogers, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Barrister Global Services Network, Inc., seeks
registration on the Principal Register of the mark

BARRISTER GLOBAL SERVICES NETWORK (*standard form drawing*)

for services recited in the application as follows:

"installation of computer networks and
computer hardware for office information
exchange and related consulting services,
and maintenance and repair of computer
networks and computer hardware" in
International Class 37; and

"consulting services in the field of
design, selection, implementation and use

of computer networks and computer hardware"
in International Class 42.¹

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this mark given applicant's failure to disclaim the term "Global Services Network," as required by the Trademark Examining Attorney.

Applicant and the Trademark Examining Attorney have fully briefed the appeal. Applicant did not request an oral hearing. We affirm the refusal to register in the absence of a disclaimer.

The issue herein is fairly clear. The Trademark Examining Attorney takes the position that the term "Global Services Network" is merely descriptive of applicant's services, and hence, should be disclaimed. By contrast, applicant argues that the Trademark Examining Attorney has failed to prove that the term "Global Services Network" merely describes applicant's services.

As explained by the Trademark Examining Attorney, Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a), states that the Office may require an applicant to disclaim an unregistrable component of a mark. Inasmuch

¹ Application Serial No. 76424030 was filed on June 24, 2002 based upon applicant's allegation of first use anywhere and first use in commerce, in both classes, at least as early as April 9, 1999.

as Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), bars the registration of a mark which is merely descriptive of the services, the Office may require that applicant disclaim a merely descriptive portion of a mark. In the event that applicant does not comply with this disclaimer requirement, the Trademark Examining Attorney may refuse registration of the entire mark.

Applicant takes the position that:

- "Global Services Network" is not a dictionary term, as evidenced by its absence from WEBSTER'S NEW WORLD DICTIONARY OF COMPUTER TERMS, and that applicant does not refer to itself as a "network."
- Rather, the term "Global Services Network" was allegedly coined by applicant, and when used in connection with its recited services, is considered to be arbitrary.
- The term "Global Services Network" does not immediately convey to prospective purchasers information as to the functions, features, purposes or uses of applicant's services.
- Rather, to a prospective purchaser who encounters applicant's mark, at least some thought, imagination or perception is required to understand the exact nature of applicant's services.

- By referring to three separate dictionary definitions (e.g., of the words "Global," "Service(s)" and "Network"), the Trademark Examining Attorney has violated the well-established anti-dissection rule.

In support of his position, the Trademark Examining Attorney points to a number of third-party registrations having composite marks registered for similar services, in which the term "Global Service(s)" is disclaimed:

FLUOR GLOBAL SERVICES

for "personnel recruiting, counseling, and placement services for the construction industry; business management and consultation in the areas of operations and maintenance" in International Class 35; "construction management; construction of commercial and government buildings and chemical processing plants; and construction services, namely, construction equipment rental and leasing, construction machinery maintenance and repair, and installation and maintenance of telecommunications system hardware" in International Class 37; and "consultation in the field of telecommunications, namely design and layout of telecommunications and fiber optic networks" in International Class 38.²

HTC GLOBAL SERVICES

for "information technology services, namely, software development, information technology strategy, technical consultation, planning and implementation, data migration, computer consulting in the areas of e-business applications, client/server applications, and Internet and extranet development; database development services relating to data

² Registration No. 2448881 issued on May 8, 2001.



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warehousing" in International Class 42.³

for "information technology services, namely, software development, information technology strategy, technical consultation, planning and implementation, data migration, computer consulting in the areas of e-business applications, client/server applications, and Internet and extranet development; database development services relating to data warehousing" in International Class 42.⁴

for "repair and maintenance of computer hardware and electronic devices, namely, computers, computer peripherals, office automation products namely, computer hardware, printers for computers, scanners for computers, copying machines, paper shredding machines, facsimile machines, telephones, and telephone answering machines, telecommunications electronics and consumer electronics" in International Class 37.⁵

Then, with his Office action of April 28, 2004, the Examining Attorney cited to applicant's website, as well as several other websites of companies whose services sound similar to those of applicant:

- We offer our customers exceptional multi-vendor management through a single source, while reducing their service costs through extensive warranty programs.
<http://www.barrister.com/aboutus.htm>
- "You can rely on Avaya **Global Services** to design, build and manage your multi-vendor communications networks and applications, regardless of technology or vendor."

³ Registration No. 2498000 issued on October 16, 2001.

⁴ Registration No. 2498001 issued on October 16, 2001.

⁵ Registration No. 2629485 issued on October 1, 2002.

<http://www1.avaya.com/enterprise/news/docs/lp/commgr2-info.html>

- "NCR's multi-vendor service offerings are positioned to provide complete **global services** in support of NCR advocated solutions and leverage our service delivery infrastructure, targeting complementary third party opportunities."

"NCR satisfies customers' 'Single-Source Solution' objectives by including the IBM, Compaq, Dell, and Sun products under the global multi-vendor programs umbrella."

http://www.ncr.com/services/svs_otr_mvs.htm

We also take judicial notice of the following

definition of the word "global": "Pertaining to an entire file, database, volume, program or system." The Computer Glossary at 167 (7th ed. 1995).⁶

As to the word "network," the Trademark Examining Attorney highlights the following quotes extracted from applicant's website:

- Barrister manages a vast **network** of service partners who deliver on-site services to customers located throughout the United States, Canada, Mexico and Puerto Rico.
<http://www.barrister.com/partners.htm>
- We manage a vast **network** of over 15,000 certified technicians through advanced web-based systems, delivering on-site service to every zip code within the United States, Canada, Mexico and Puerto Rico.
<http://www.barrister.com/aboutus.htm>

⁶ The Board may take judicial notice of dictionary definitions. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

The Trademark Examining Attorney contends that:

"'GLOBAL SERVICES NETWORK' clearly describes applicant's services. Applicant provides *GLOBAL SERVICES* through a *NETWORK* of providers. It does not matter that GLOBAL SERVICES NETWORK is not a dictionary term, it is still descriptive of applicant's services."

"Moreover, although the examining attorney has considering the meanings of the component parts of GLOBAL SERVICES NETWORK, there is nothing improper in so doing since allowance has been made for any possible alterations or changes in meaning when the parts are combined into the composite, of which none exist. Rather, since the ultimate determination of the descriptiveness of GLOBAL SERVICES NETWORK was made on the basis of the wording in its entirety, it was perfectly acceptable to separate the wording and discuss the implications of each part thereof."

"The wording 'GLOBAL SERVICES NETWORK,' therefore, clearly describes applicant's services and is properly the subject of a disclaimer requirement ..."

The record shows that applicant's principal activities are to provide its IT customers with multi-vendor computer equipment attached to local-area-networks (LANs) and to provide related maintenance services. These services are provided through a network of certified service providers and technicians in locations throughout North America.



We consider the ordinary meaning of each of the three involved words in the context of the four-word composite. In fact, it is clear from the record that this precise combination of words is not something applicant coined, but rather, that the term "global services" has entered our vocabulary as a readily understood pairing of two pieces of information. That is, the term "global services" is a term of art for Internet and telecommunications companies, and would be perceived as having the same descriptive meaning when used by applicant as when employed in the marks of others. The third-party trademark registrations for related services support the fact that the United States Patent and Trademark Office requires the disclaimer of the words "Global Services," "Global Service" or "Global Services, Inc." under similar circumstances. All that applicant has done is add the word "network" to the end of this term to indicate that applicant has a network of vendors/technicians that can assist in providing these global services.

The word "network(s)" is actually used by applicant in two different ways. In its recitations of services, the word "networks" refers to the design, installation and maintenance of enterprise-wide *computer networks* for its

customers. However, the occurrences highlighted above from applicant website use the term to refer to applicant's *network of service centers*.⁷

Following this latter connotation of "network," when viewing these three words as a unitary phrase, it takes no imagination to conclude that one knows exactly what this describes. Namely, applicant has a "network" of service partners or centers providing what the telecommunications and Internet industries refer to as "global services."

We find that the Trademark Examining Attorney herein has articulated a perfectly defensible position - consistent with logic and English language construction as well as the state of the trademark register.

Other large companies around the world likely assume, and with good reasoning, that they could freely choose such a descriptive term to designate their own global services networks of certified service centers. If this term comprised the entirety of applicant's mark, we would uphold a Trademark Examining Attorney on a refusal under Section 2(e)(1) of the Act.

⁷ In either case, we conclude that the meaning, when considered in connection with global services, would still be merely descriptive inasmuch as neither connotation results in a registrable combination.

This result is certainly consistent with the way the Office has treated these terms in earlier applications for registration. In the context of this composite, BARRISTER GLOBAL SERVICES NETWORK, we conclude that the "Global Services Network" portion of the mark is unitary and needs to stand or fall as a unit. Accordingly, we find that all three words should be disclaimed, as required by the Trademark Examining Attorney.

Decision: The requirement for a disclaimer of the "Global Services Network" portion of the mark herein on the ground that this phrase is merely descriptive in connection with the identified services is affirmed.

However, in accordance with Trademark Rule 2.142(g), this decision will be set aside and this application will be returned to the Trademark Examining Attorney to place in condition for publication for opposition, if applicant, no more than thirty days from the mailing date of this decision, submits an appropriately worded disclaimer, namely:

No claim is made to the exclusive right to use "Global Services Network" apart from the mark as shown.