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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 Onsite Network, Inc.

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Serial No. 77049419

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Maurice U. Cahn of Cahn & Samuels, LLP for Onsite Network,  
Inc.

Steven W. Jackson, Trademark Examining Attorney, Law Office  
107 (J. Leslie Bishop, Managing Attorney).

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Before Holtzman, Drost, and Kuhlke, Administrative  
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On November 22, 2006, Onsite Networks, Inc.

(applicant) applied to register the mark ONSITE NETWORK and

design  on the Principal Register for the following  
services: "Advertising via electronic media and  
specifically the internet; Advertising, marketing and  
promotion services; Dissemination of advertising for others  
via the Internet" in Class 35. The application (Serial No.

77049419) is based on an allegation of a bona fide intention to use the mark in commerce. Applicant has disclaimed the term "Network." The examining attorney has refused registration (Brief at unnumbered p. 2) on the ground that the term "Onsite Network" is merely descriptive of applicant's services and applicant "must disclaim the descriptive wording." 15 U.S.C. §§ 1052(e)(1) and 1056. The examining attorney argues that the term "Onsite Network" merely describes "Internet related services that originate from the location of the particular activity being advertised, marketed or promoted." Brief at 10.<sup>1</sup>

The examining attorney has submitted evidence from applicant's website ([www.onsitenetwork.net](http://www.onsitenetwork.net)) that describes its services as follows:

Onsite Network, Inc., based in Chicago, Illinois, is a full feature advertising, marketing and entertainment digital media company.

Onsite's system is designed to engage customers with an entertaining and interactive viewing experience. Utilizing new proprietary technology, Onsite Network delivers commercial TV and real-time content, advertising and marketing to large HDTV screens simultaneously. We do this without in any way obstructing or interfering with your commercial television program choices. In fact, our system is designed to build upon and enhance the television experience.

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<sup>1</sup> Applicant has also filed application Serial No. 77049437 for the mark ONSITE NETWORK in standard character form for services in Class 38. Inasmuch as the services are not the same and the evidence is different, we will issue separate opinions for these appeals.

Placed in a variety of high traffic venues including restaurants, bars, college & university bookstores, hotels and healthcare facilities, Onsite Network's multi-subject play list offers exclusive programming and targeted content customized to serve each location's individual business needs. In addition to entertainment for patrons, Onsite will provide host venues additional advertising, marketing and revenue opportunities.

The examining attorney, with the first Office action, also included a definition of "On-site" as "at site of activity: taking place or provided at the location where work or some other activity is being carried out." In addition, the same Office action included a definition of "network" as, inter alia: "System of computers: a system of two or more computers, terminals, and communication devices linked by wires, cables, or a telecommunications system in order to exchange data. The network may be limited to a group of users in a local area network, or be global in scope, as the Internet is." Later, the examining attorney included copies of several registrations in which the term "network" in the marks was disclaimed for advertising services. See 2757629 (THETA NETWORK), 3024275 (AUTOBYTEL NETWORK), 3212529 (THE LEAD NETWORK), 3210870 (PAPELMEDIA NETWORK), and 3056584 (LSF NETWORK). "[T]hird-party registrations can be used in the manner of a dictionary definition to illustrate how a term is perceived

in the trade or industry." *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006).

Furthermore, the examining attorney provided internet printouts (emphasis added) that showed the use of the term "on-site" to refer to advertising and marketing services.

Vision Blue will also provide you with **on-site marketing** assistance to help you integrate your web site promotion with new and current advertising programs...  
[www.visionblue.com](http://www.visionblue.com)

Advertising and On-Site marketing will Improve Your Visibility & Results

A recent study from the Center for Exhibition Industry Research (CEIR) reports that **on-site marketing** increases suite traffic by 104%.  
[www.wsashow.com](http://www.wsashow.com)

Dabbling in social media applications like blogs or podcasts can also be effective **on-site marketing** tools, while hip, urban blog sites like Curbed might attract the younger buyer.  
[www.webadvantage.net](http://www.webadvantage.net)

An advantage of **on-site marketing** is that your target audience is there - BUT that doesn't guarantee a "captive" audience.  
[www.iaspromotes.com](http://www.iaspromotes.com)

Our colorful advertising balloons offer **the purest form of advertising there is... ON-SITE**.  
[www.advertisingballons.net](http://www.advertisingballons.net)

In its response to the examining attorney's first Office action, applicant provided a list of five registrations for the marks ONSITE COMMERCIAL (commercial counseling), ONSITE AVIATION (employment agency services), ONSITE SAFETY SYSTEM (retail store, consulting, and renting

services of safety supplies), ONSITE DESIGN and design (floor covering installation), and ONSITEDOCS (educational services in the medical field). Applicant asserts that these marks were registered without a disclaimer of the term "Onsite."<sup>2</sup> Normally, we would not consider a list of registrations without the submission of a copy of the registration. *In re Duofold, Inc.*, 184 USPQ 638, 640 (TTAB 1974) ("[T]he submission of a list of registrations is insufficient to make them of record"). However, the examining attorney did not object to this list when it was first presented or in his brief, but instead simply argued that that "third-party registrations are not conclusive on the question of descriptiveness." Final Office Action at 7. Under these circumstances, we will consider these registrations. TBMP § 1207.03 (2d ed. rev. 2004):

If the applicant, during the prosecution of the application, provided a listing of third-party registrations, without also submitting actual copies of the registrations, and the examining attorney did not object or otherwise advise applicant that a listing is insufficient to make such registrations of record at a point when the applicant could cure the insufficiency, the examining attorney will be deemed to have waived any objection as to improper form.

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<sup>2</sup> Regarding the mark ONSITEDOCS, a disclaimer is not normally appropriate with a compound term. TMEP § 1213.05(a) (5<sup>th</sup> ed. September 2007) ("If a compound word mark consists of an unregistrable component and a registrable component combined into a single word, no disclaimer of the unregistrable component of the compound word will be required").

However, our consideration of this list will be very limited. TBMP § 1208.02 (2d ed. rev. 2004) ("The Board will not consider more than the information provided by applicant. Thus, if applicant has provided only a list of registration numbers and marks, the list will have very limited probative value"). We point out that without copies of the registrations, we cannot ascertain whether these marks might have been registered on the Principal Register under the provision of Section 2(f) or on the Supplemental Register. In addition, even if these registrations were all properly of record and they all supported applicant's argument, nonetheless they would not require that the refusal be reversed. "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 Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). See also *In re Hotels.com L.P.*, 87 USPQ2d 1100, 1108 (TTAB 2008) ("Nor do these third-party registrations establish that there is an Office practice holding such marks are generally registrable").

After the examining attorney made the refusal final, applicant appealed to this board.

"A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used." *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007). See also *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980). Courts have long held that to be "merely descriptive," a term need only describe a single significant quality or property of the goods. *Gyulay*, 3 USPQ2d at 1009; *Meehanite Metal Corp. v. International Nickel Co.*, 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959). "Descriptiveness of a mark is not considered in the abstract. Rather, it is considered in relation to the particular goods for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use." *Bayer*, 82 USPQ2d at 1831. See also *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

The evidence shows that applicant performs its services "on-site." Its advertising, marketing and promotion services are performed "in a variety of high

traffic venues including restaurants, bars, college & university bookstores, hotels and healthcare facilities" which would be the site of applicant's purchasers. The internet evidence refers to the success of on-site marketing and promotions. While applicant argues (Brief at 5) that "on-site" is "not the location or situs of a network," in applicant's case it is the location where applicant's advertising, marketing, and promotional services occur. The term "on-site" would immediately inform merchants and others that were interested in promoting their goods or services on their own premises that applicant's advertising and similar services are performed on their premises.

We add that the fact that applicant spells the word "onsite" without a hyphen is hardly significant. A slight misspelling, particularly the addition or deletion of a hyphen, is not sufficient to change a descriptive or generic word into a suggestive word. See, e.g., *Nupla Corp. v. IXL Manufacturing Co.*, 114 F.3d 191, 42 USPQ2d 1711, 1716 (Fed. Cir. 1997) (CUSH-N-GRIP "which is merely a misspelling of CUSHION-GRIP, is also generic as a matter of law"); *Weiss Noodle Co. v. Golden Cracknel and Specialty Co.*, 290 F.2d 845, 129 USPQ 411 (CCPA 1961) (HA-LUSH-KA held to be the generic equivalent of the Hungarian word

"haluska"). See also *In re Noon Hour Food Products, Inc.*, \_\_\_ USPQ2d \_\_\_ (TTAB April 23, 2008) Serial No. 78618762, slip op. at 2 n.2 ("Certainly an upper-case letter or the addition of a hyphen (or a space) cannot obviate the statutory bar to registration of a generic designation any more than can a slight misspelling of such a term"). The word ON-SITE or ONSITE would have no difference in meaning. Indeed, applicant's list of registrations indicates that there is nothing unusual about applicant's spelling of the term "on-site."

The term "network" similarly describes applicant's advertising services that are performed at its customers' locations. Applicant's services specifically involve advertising using the Internet and it has appropriately disclaimed the term.

The next question becomes whether the combination of the terms "Onsite" and "Network" is merely descriptive. *In re IP Carrier Consulting Group*, 84 USPQ2d 1028, 1030 (TTAB 2007) ("Finally, in determining whether a mark is merely descriptive, we must consider the mark in its entirety"). Applicant argues that the examining attorney has not provided "a single instance of another entity's use of ONSITE NETWORK." Brief at 6. This does not establish that the term is not merely descriptive. Brief at 7-8. Even

novel ways of referring to a product may nonetheless be merely descriptive. *Clairol, Inc. v. Roux Distributing Co., Inc.*, 280 F.2d 863, 126 USPQ 397, 398 (CCPA 1960):

The record shows that "hair color bath" tells the potential purchasers only what the goods are, what their function is, what their characteristics are and what their use is. Even though "color bath" may have been a novel way of describing a liquid for coloring hair, the words were, as used by appellee, nevertheless descriptive of its hair coloring liquid at the time when appellant, to more fully describe the goods, added the common word "hair" thereto. The resultant expression is nothing but the normal use of the English language. The same merchandise may, and often does, have more than one generic name.

*In re Gould*, 173 USPQ 243, 245 (TTAB 1972) ("The fact that applicant may be the first and possibly the only one to utilize this notation in connection with its services cannot alone alter the basic descriptive significance of the term and bestow trademark rights therein").

Here, applicant's literature makes it clear that it provides "exclusive programming and targeted content customized to serve each location's individual business needs." It is a network providing advertising and promotional services at the site of a business. The evidence indicates that on-site advertising, marketing, and promotions are a recognized form of advertising. When we view the term ONSITE NETWORK in relation to applicant's services, we conclude that there is nothing incongruous

about the term. See *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1017 (Fed. Cir. 1987) (SCREENWIPE generic for a wipe for cleaning television and computer screens). Applicant's term immediately informs prospective purchasers of a feature or characteristic of the services, i.e., that its advertising services network are provided for customers on-site. See *In re Kronholm*, 230 USPQ 136, 137 (TTAB 1986) ("It is clear that applicant's cable television network services will have, as their subject matter and intended audience, colleges and universities in this country. The term sought to be registered [COLLEGE CABLE NETWORK] comprises a combination of descriptive words which lose no descriptive significance in the expression, one which aptly describes a significant feature or characteristic of applicant's services").

Therefore, applicant's term ONSITE NETWORK is merely descriptive of the identified services and the term must be disclaimed.

Decision: The refusal to register absent a disclaimer of ONSITE NETWORK is affirmed. However, this decision will be set aside if, within thirty days of the mailing date of this order, applicant submits to the board a proper

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disclaimer of ONSITE NETWORK. See 37 U.S.C. § 2.142(g);  
TBMP § 1218.<sup>3</sup>

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<sup>3</sup> The examining attorney has indicated that "'ONSITE' is intentionally misspelled in the mark; however, this wording must appear in its correct spelling - i.e., 'ON-SITE' - in the disclaimer." Brief at 2 n.1.