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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. 77049437

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

Rudy R. Singleton, Trademark Examining Attorney, Law Office 102 (Karen M. Strzyz, 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) filed an intent-to-use application (Serial No. 77049437) to register the mark ONSITE NETWORK, in standard character form, on the Principal Register for the following services: "broadcasting services and provision of access to video and audio content provided via the Internet" in Class 38. Applicant has disclaimed the term "Network." The examining attorney has refused registration on the

ground that the term "Onsite Network" is merely descriptive of applicant's services. 15 U.S.C. §§ 1052(e)(1). The examining attorney argues that the term "Onsite Network" merely describes applicant's services as "broadcasting related services that originate from the location of the particular activity broadcasted." Brief at unnumbered p. 8.<sup>1</sup> In addition, the examining attorney refused registration on the ground that the identification of goods and services was "unacceptable and required clarification." Brief at 11.

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

Identification of services

Under 15 U.S.C. § 1051(b)(2), a trademark application must include a "specification of ... the goods in connection with which the applicant has a bona fide intention to use the mark." To "specify" means "to name in an explicit manner. The identification of goods or services should set forth common names, using terminology that is generally understood." TMEP § 1402.01 (5<sup>TH</sup> ed. rev. September 2007). In this case, the examining attorney has objected to

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<sup>1</sup> Applicant has also filed application Serial No. 77049419 for the mark ONSITE NETWORK and design for services in Class 35. Inasmuch as the services are not the same and the evidence is different, we will issue separate opinions for these appeals.

applicant's current identification of services ("broadcasting services and provision of access to video and audio content") because the identification "could include goods/services in Classes 9, 38 and" 41. Brief at 12. The examining attorney points out that applicant's identified services can be included in the following classes:

Class 9 - Provision of access to video and audio content provided via the Internet namely downloadable films and TV programs featuring {indicate subject matter} provided via a video-on-demand service

Class 38 - Broadcasting services and provision of telecommunication access to video and audio content provided via a video-on-demand service via the Internet

Class 41 - Provision of access to video and audio content provided via the Internet, namely provision of non-downloadable films and TV programmes [sic] via a video-on-demand service

The Office may require more specificity in an identification of goods or services when the identification as written may be included in more than one International Class. *In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541, 1544 (Fed. Cir. 2007) ("In sum, the scope of the term 'chronographs' is ambiguous for registration purposes, for it includes both watches and time recording devices. Omega states that the only chronographs with which it uses the mark are 'watches.' The PTO has discretion to determine

whether and how a trademark registration should include a more particularized statement of the goods for which the mark is [to] be used").

Applicant relies on *In re Thor Tech Inc.*, 85 USPQ2d 1474 (TTAB 2007) and argues that the examining attorney's "requirement for adoption of a less accurate recitation of the services to match those contained in the Acceptable Identification of Goods and Services Manual should be reversed." Brief at 2-3. However, *Thor Tech* does not provide much support for applicant's argument. In that case, the examining attorney objected to the term "park trailers." The issue in that case was whether these goods could include recreational vehicles in Class 12 and mobile homes in Class 19. The *Thor Tech* applicant submitted evidence that "park trailers" was a term understood to refer to recreational vehicles. Therefore, the goods would not be classified in more than one class. In the present case, applicant has provided no evidence that the "provision of access to video and audio content via the Internet" is understood to refer to services only in Class 38. Indeed, the identification could include access to video content through downloadable and non-downloadable content, which are clearly in two classes.

We add that the examining attorney's basic objection concerns the fact that applicant's services as currently identified may be classified in more than one class. To the extent that applicant does not believe that the examining attorney's suggested changes to the language of the identification of goods and services are accurate, it was incumbent on applicant to propose a more accurate identification of goods and services that would clarify that the services in each class are properly limited.

Inasmuch as applicant's present identification of goods and services includes goods and services in more than one class, we affirm the examining attorney's refusal to register applicant's mark as the services are currently identified.

Descriptiveness

The next question is whether the term ONSITE NETWORK is merely descriptive for the identified services. "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 examining attorney has submitted evidence from the internet (emphasis added) that shows that the term "on-site" is used to describe a type of broadcasting services:

**On-site** broadcasting for your company's major events.  
[www.wsradio.com](http://www.wsradio.com)

The other important matches [computer games], around 100 matches, in four cyber spaces which are dedicated to **on-site** broadcasting for the general spectators will be provided through the website..  
[www.worldcybergames.com](http://www.worldcybergames.com)

He has even expanded his curriculum - complete with a video series of knowledge leaders - through Monterrey Tec's **on-site** broadcasting studio delivering to some 200 sites through Latin America + digital on-line delivery worldwide.  
[www.entovation.com](http://www.entovation.com)

...12 hours broadcasting of the Dubai World Cup, the world's richest horse race and **onsite** broadcasting from Dubai 2005; the ninth international aerospace exhibition and Arabian Travel Market.  
[www.ameinfo.com](http://www.ameinfo.com)

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 local area network, or be global in scope, as the Internet is.

The examining attorney also included the following information from applicant's website  
[www.onsitenetwork.net](http://www.onsitenetwork.net)):

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.

Placed in a variety of high traffic venues including restaurants, bars, colleges & 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 venues additional advertising, marketing and revenue opportunities.

In its response to the examining attorney's first Office action, applicant submitted copies of three registrations. Two registrations (Nos. 2575196 and 2531263) are for the marks ONSITE ACCESS with different tower designs for telecommunications and telecommunication installation services. The registrant in both these cases is the same, OnSite Access, Inc. The other registration is for the mark ONSITE SERVICE GATEWAY (No. 2629495) for telecommunications and electrical and optical transmission services. However, this mark is registered on the Supplemental Register, which is an admission that the term is merely descriptive. *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972) ("We also agree with the observation of the board that, when appellant sought registration of SUPER BLEND on the Supplemental Register, it admitted that the term was merely descriptive of its goods"). See also *In re Consolidated Foods Corp.*, 200 USPQ 477, 478 n.2 (TTAB 1978) ("Registration of the same mark on the Supplemental Register is not prima facie evidence of distinctiveness; in

fact, such a registration is an admission of descriptiveness").

Applicant also argues that it "provided a list of existing registrations including the word ONSITE in a range of fields where no disclaimer was required." Brief at 4. The examining attorney pointed out (Brief at 9) that "only three third-party registrations were properly made of record." We agree that there are only three registrations of record. While applicant did include a list of five additional registrations with its Response dated April 18, 2007 (p. 11), the examining attorney subsequently advised applicant to "make registrations proper evidence of record, soft copies of the registrations ... must be submitted." Final Office Action at 3. "[T]he submission of a list of registrations is insufficient to make them of record." *In re Duofold, Inc.*, 184 USPQ 638, 640 (TTAB 1974). See also *In re Carolina Apparel*, 48 USPQ2d 1542, 1542 n.2 (TTAB 1998) ("The Board does not take judicial notice of third-party registrations, and the mere listing of them is insufficient to make them of record"). Therefore, applicant's list of registrations is not evidence of record.

We add that applicant's evidence that there are two registrations for the same term by the same registrant is

not much evidence that applicant's term is not merely descriptive. "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"). We also point out that the other registration that applicant has made of record actually supports the examining attorney's position inasmuch as the mark is on the Supplemental Register.

In this case, the term, On-site, means to take place at the location where an activity is being carried out. Applicant describes its services as "an internet based broadcasting service." Response dated April 18, 2007 at 9. Applicant's broadcasting services and provision of access to video and audio content takes place at the site of its customers where applicant's broadcasting services provide applicant's "multi-subject play list" as well as programming for "additional advertising, marketing, and revenue opportunities." Applicant's services are "on-site" to the extent that it provides "commercial TV and real-time

content, advertising and marketing" concerning the site's restaurant, bar, bookstore, etc. While applicant argues (Brief at 6) that "on-site" is "not the location or situs of a network," in applicant's case it is because applicant displays commercial television and site-sponsored advertising and promotions.

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.

Applicant's spelling does not appear to be even that unusual inasmuch as the three registrations that applicant has made of record apparently spell the term as one word without a hyphen.

In addition, applicant's services involve a "network" inasmuch as they are conducted "via the Internet" and an "interconnected or interrelated chain, group, or system" of terminals displaying entertainment and advertising content at its customers' sites.<sup>2</sup>

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"). 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,

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<sup>2</sup> "To be fair, Applicant does not and cannot reasonably contest that the word NETWORK is descriptive." Response dated April 18, 2007 at 10.

i.e., that its advertising and similar services are provided through a network for its 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").

Applicant argues that it "has no counterpart in the broadcasting/internet fields" and that the examining attorney did not introduce any evidence of others using the term ONSITE NETWORK. These points do 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").

Ultimately, we conclude that applicant's services include a network that broadcasts a mixture of entertainment programming with on-site advertising and promotional content displayed together. As such, the term ONSITE NETWORK merely describes the on-site advertising feature of applicant's network. Therefore, applicant's mark is merely descriptive of the identified services.

Decision: The refusal to register under Trademark Act § 2(e)(1) is affirmed.