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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re International Business Machines Corp.

Serial No. 77074833¹

Gina M. Lyons for International Business Machines Corp.

Jill C. Alt, Trademark Examining Attorney, Law Office 114
(Margaret Le, Managing Attorney).

Before Walsh, Mermelstein and Ritchie, Administrative
Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

International Business Machines Corp. (applicant) has
applied to register the mark WEB ADAPTATION TECHNOLOGY in
standard characters on the Principal Register for goods and
services now identified as:

computer software for use in manipulating and
transforming web content, creating custom
interfaces and personal preference
accommodations; computer software for use in
enlarging text and reducing visual clutter of web

¹ Application Serial No. 77074831 filed January 3, 2007, claiming
a bona fide intention to use the mark in commerce under Trademark
Act Section 1(b), 15 U.S.C. § 1051(b).

pages, reading web page text aloud, and enhancing ease of use of the web browser, mouse and keyboard; computer software for assisting visual, hearing or motor impaired users with access and use of web content and computers; and instruction manuals sold as a unit therewith, in International Class 9;

providing online tutorials, online educational demonstrations, in International Class 41; and

philanthropic and charitable services, namely, providing free or discounted computer technology to schools and not-for-profit organizations; computer consultation and computer systems design services for others; technical support services, namely, troubleshooting of computer hardware and computer software problems; installation, updating and maintenance of computer software, in International Class 42.

The Examining Attorney has finally refused registration on the grounds that WEB ADAPTATION TECHNOLOGY merely describes the identified goods and services under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1). Both applicant and the Examining Attorney have filed briefs. We affirm.

Before addressing the merits of the refusal, we must attend to two evidentiary objections.

First, applicant objects to our consideration of evidence the Examining Attorney submitted only with the office action dated July 17, 2008, and applicant also requests that we not consider any arguments based on that evidence.

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The Examining Attorney characterizes the office action in question as a response to a request for reconsideration. Applicant filed a request for reconsideration on April 2, 2008, at the same time it filed its notice of appeal. On April 8, 2008, the Examining Attorney responded, denied the request and maintained the final refusal. On April 15, 2008, the Board advised applicant that the appeal was resumed and that its brief was due in sixty days. Applicant then submitted its appeal brief on June 11, 2008. On June 12, the Board noted that applicant had filed its brief and forwarded the file to the Examining Attorney for preparation and filing of her brief.

Instead of filing a brief, on July 17, 2008, the Examining Attorney issued another response to a request for reconsideration with more evidence. The Examining Attorney did so after the time for filing her brief had expired. The Board subsequently, based on limited information, reset the time for the Examining Attorney to file her brief, and the Examining Attorney filed her brief within that time.

In her brief the Examining Attorney attempts to explain the second response to a request for reconsideration stating, "At this point there was an electronic glitch in the proceedings that made it appear as if the applicant had the right to file a second request for

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reconsideration." Examining Attorney's Brief at 2. The Examining Attorney does not claim that a second request for reconsideration was ever filed, nor do we find any evidence of such a request in the record. The Examining Attorney's July 17, 2008 Office action begins by stating, "Applicant is requesting reconsideration of a continuation of a final refusal mailed 4-8-08."

The only paper applicant filed between April 8 and July 17 was its appeal brief. Accordingly, we find no evidence of a "glitch," electronic or otherwise, in the record, nor do we find evidence of any other basis for the issuance of the July 17, 2008 office action. Therefore, we sustain the objection and exclude from consideration any evidence which was submitted only with the July 17, 2008 Office action. Furthermore, under the circumstances, we conclude that it would be improper for us to consider the Examining Attorney's brief. If the Examining Attorney had good cause to request additional time to file her brief, she should have filed a request for additional time with the Board, rather than issue an action in response to a "phantom" request for reconsideration.

The Examining Attorney made no such request.² Therefore, we have not considered the Examining Attorney's brief.

Secondly, the Examining Attorney has also objected to evidence she asserts was filed only with applicant's brief on the basis that the evidence is untimely under Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). Applicant has not responded to this objection. The evidence in question consists of a listing of results from a search of the Google Search Engine for the term "web adaptation technology" and web pages from three parties, other than applicant, discussing products similar to those applicant identifies in the application. Applicant had submitted this same evidence previously with its request for reconsideration. The earlier submission was timely. Accordingly, we overrule this objection.

We now turn to the merits. A term is merely descriptive of goods or services within the meaning of Section 2(e)(1) if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See,

² If the Examining Attorney had cause to issue another office action at this point, the Examining Attorney should have requested a remand from the Board for that purpose. Once the Board resumed the appeal, the Examining Attorney lacked jurisdiction to issue a further action. The Examining Attorney did not request a remand.

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e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute or function of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358, 359 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338, 339 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services identified in the application, and the possible significance that the term would have to the average purchaser or user of the goods or services. *In re Polo International Inc.*, 51 USPQ2d 1061, 1062 (TTAB 1999); and *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

Applicant argues that WEB ADAPTATION TECHNOLOGY is not merely descriptive of its goods and services because, "...WEB ADAPTATION TECHNOLOGY could suggest multiple possible meanings when used in connection with Applicant's goods and services." Applicant's Brief at 3. Applicant argues further that, "... consumers will not know which of the various meanings, if any, are intended by the Mark." *Id.*

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at 4. Applicant also argues that when one views WEB ADAPTATION TECHNOLOGY in its entirety, rather than the component words individually, the unitary phrase possesses a unique, nondescriptive meaning, citing cases, such as *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a "snow removal hand tool having a handle with a snow-removing head at one end, the head being of solid uninterrupted construction without prongs"). Applicant specifically disputes the Examining Attorney's determination that "web adaptation" has a common descriptive meaning as applied to applicant's goods and services.

With the first Office action of March 7, 2007, the Examining Attorney provided dictionary definitions of "adaptation" meaning "... the act or process of adapting..." and "technology" meaning "... a manner of accomplishing a task especially using technical processes, methods or knowledge..." Attachments to March 7, 2007 Office Action. We take judicial notice of the fact that "WEB" refers to the "WORLD WIDE WEB" in this context.³ Applicant's

³ We take judicial notice from *Merriam-Webster's Collegiate Dictionary* (11th ed. 2003). *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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identification of goods likewise uses "web" descriptively in this sense.

With the April 8 response to applicant's request for reconsideration, the Examining Attorney provided evidence from various web sites to support her conclusion that WEB ADAPTATION TECHNOLOGY is merely descriptive of the identified goods and services. Applicant correctly points out that the examples fail to show use of either WEB ADAPTATION TECHNOLOGY or WEB ADAPTATION, as such. The evidence does include an example of the use of "adaptation" in the general context of the identified goods and services: an excerpt from webopedia.com states, "The Internet Content Adaptation Protocol (ICAP) enables enterprises to choose the best of breed applications and infrastructure..." Attachment to Office Action of April 8, 2008.

Applicant does not seriously dispute the relevant meanings of the individual words which make up the mark. We find wholly unpersuasive applicant's argument that the combination of the words to form WEB ADAPTATION TECHNOLOGY results in a distinctive mark. Quite the contrary, the phrase WEB ADAPTATION TECHNOLOGY directly describes the identified goods and services. This is a case where the dictionary meanings of the component words are sufficient

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to establish that the entire phrase WEB ADAPTATION TECHNOLOGY is merely descriptive of the identified goods and services.

Applicant's identification of goods includes "computer software for use in manipulating and transforming web content, creating custom interfaces and personal preference accommodations software." This software is "technology" which enables a "web" user to "adapt" his or her computer to certain circumstances. The identification also provides an example of the type of circumstances where the "adaptation" might not only be useful but necessary, that is, in the case of "visual, hearing or motor impaired users."

There is nothing at all incongruous or otherwise distinctive about the combination of words. *See, e.g., In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1317 (TTAB 2002) (SMARTTOWER merely descriptive of commercial and industrial cooling towers). No multistage reasoning process is required to arrive at the plain meaning of WEB ADAPTATION TECHNOLOGY as applied to the identified goods. Accordingly, we conclude that WEB ADAPTATION TECHNOLOGY is merely descriptive of applicant's goods.

Applicant has not raised any specific arguments in relation to the service mark classes covered by the

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application. Nor did the Examining Attorney discuss the services specifically in any of the office actions.

We also conclude that WEB ADAPTATION TECHNOLOGY is merely descriptive of applicant's educational services in Class 41, which are identified as, "providing online tutorials, online educational demonstrations." Although the subject matter of the educational services is not specified, in the absence of any limitation which would exclude applicant's software, we conclude that the subject matter of the education services includes the identified software. Therefore, WEB ADAPTATION TECHNOLOGY is merely descriptive of the Class 41 services also.

We conclude likewise that WEB ADAPTATION TECHNOLOGY is merely descriptive of the Class 42 services, identified as, "philanthropic and charitable services, namely, providing free or discounted computer technology to schools and not-for-profit organizations; computer consultation and computer systems design services for others; technical support services, namely, troubleshooting of computer hardware and computer software problems; installation, updating and maintenance of computer software." For example, the "consulting" and "installation" services could include such services related to the type of software identified in Class 9 in the application. As such, WEB

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ADAPTATION TECHNOLOGY also merely describes those and other services identified in Class 42.

Furthermore, although applicant argues that WEB ADAPTATION TECHNOLOGY could identify many types of technology, this is simply because the term is a broad one. That is, WEB ADAPTATION TECHNOLOGY is broad enough to describe not just the goods and services applicant identified here, but other goods and services in the same general category. That fact in no way contradicts our conclusion that WEB ADAPTATION TECHNOLOGY merely describes the goods and services applicant identified here.

Also, as we stated above, it is axiomatic that we must evaluate the mark in relation to the goods and services identified, not in the abstract. *In re Bright-Crest, Ltd.*, 204 USPQ at 593. Also, the fact that the mark may have meanings, even nondescriptive meanings, in another context is not relevant for purposes of our determination here. *In re IP Carrier Consulting Group*, 84 USPQ2d 1028, 1034 (TTAB 2007).

We likewise reject applicant's arguments that, because others have not used WEB ADAPTATION TECHNOLOGY to identify products similar to those of applicant, the term is not merely descriptive. The Board has stated:

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... a word need not be in common use in an industry to be descriptive, and the mere fact that an applicant is the first to use a descriptive term in connection with its goods, does not imbue the term with source-identifying significance. In re National Shooting Sports Foundation, Inc., 219 USPQ 1018, 1020 (TTAB 1983) (the fact that the applicant may be the first to use a merely descriptive designation does not "justify registration if the term projects only merely descriptive significance.").

In re Hunter Fan Co., 78 USPQ2d 1474, 1476 (TTAB 2006).

Also, the mere absence of a dictionary entry for the relevant term does not establish that the term is not merely descriptive. See *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977).

Decision: We affirm the refusal to register under Trademark Act Section 2(e)(1).