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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Oppedahl & Larson LLP

Serial No. 78/061,755

Carl Oppedahl of Oppedahl & Larson LLP for Oppedahl & Larson LLP.

Aretha C. Masterson, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Simms, Hohein and Drost, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Oppedahl & Larson LLP (applicant), a Colorado limited liability partnership, has appealed from the final refusal of the Trademark Examining Attorney to register the mark PATENTS.COM for services eventually described as "computer software for managing a database of records and for tracking the status of the records by means of the

Serial No. 78/061,755

Internet."¹ The Examining Attorney has refused registration under Section 2(e)(1) of the Act, 15 USC §1052(e)(1), arguing that applicant's mark is merely descriptive of its goods. Applicant and the Examining Attorney have submitted briefs and an oral hearing has been held.²

According to the specimen of record, a page from applicant's Web site, applicant's software can be downloaded from applicant's Web site. The specimen states that, from that page, one can reach download locations for applicant's most popular software, including software for tracking the status of U.S. trademark applications and registered trademarks as well as software for tracking the status of U.S. patent applications and issued patents.

It is the Examining Attorney's position that applicant's mark PATENTS.COM merely describes a characteristic (the subject matter) of applicant's goods, combined with a top level domain (TLD) designation used to access online computer information. More particularly, the Examining Attorney argues that the term "PATENTS" merely

¹Application Serial No. 78/061,755, originally filed as an intent-to-use application on May 3, 2001. Applicant subsequently filed an amendment alleging use of the mark and use of the mark in commerce since December 9, 1999.

²The Examining Attorney objected to a listing in applicant's brief of third-party registrations of marks containing the designation ".COM". The Examining Attorney's objection is well taken. See Trademark Rule 2.142(d)(the record in the application should be complete prior to the filing of an appeal) and *In re Broyhill Furniture Industries, Inc.*, 60 USPQ2d 1511, 1513 n. 3 (TTAB 2001).

Serial No. 78/061,755

describes computer software that tracks patents (applications and issued patents), and that the designation ".COM" is a TLD name, a descriptive non-source designation lacking trademark significance which indicates that the user is a commercial entity. This part of applicant's mark, according to the Examining Attorney, cannot function in a distinctive, source-identifying capacity.

Applicant, on the other hand, argues that PATENTS.COM is suggestive and inherently distinctive because only one entity may use this particular designation as a source indicator on the Internet. Applicant also argues that "PATENTS" in the mark is not descriptive because applicant's software is not a patent. Further, even if "PATENTS" were descriptive of applicant's computer software, applicant maintains that the entire mark is not. In this regard, applicant contends that ".COM" is not descriptive of computer software. Applicant also points out that there is nothing in this record indicating use of its mark by others in a descriptive sense. Finally, applicant asks us to resolve any doubt in favor of publication.

First, it is well settled that a term is merely descriptive, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes a quality,

Serial No. 78/061,755

characteristic or feature of the goods or directly conveys information regarding the nature, function, purpose or use of the goods. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). Also, whether a term is merely descriptive is determined, not in the abstract, but in relation to the goods for which registration is sought and the possible significance that the term may have to the relevant purchasers. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

Upon careful consideration of this record and the arguments of the attorneys, we agree with the Examining Attorney that applicant's mark PATENTS.COM merely describes applicant's computer software which tracks the status of patents and is available on the Internet. Although applicant's description of goods in the application indicates generally that the applicant's software tracks the status of records, it is clear that applicant's goods include software that tracks the status of patent applications and issued patents. Moreover, applicant's general description is broad enough to include software which tracks the status of patents.

Further, it is undisputed that ".COM" is a reference to a TLD designation. As such, it indicates nothing more than a commercial entity. We agree with the Examining

Serial No. 78/061,755

Attorney that ".COM" should be treated no differently than designations like "Inc." and "Co.". Potential purchasers will have no difficulty determining that applicant's mark, when used in connection with its software which tracks the status of various records including patents, merely describes the fact that applicant's software deals with patents and is available on the Internet. Accordingly, we conclude that applicant's mark is merely descriptive of its goods downloadable from the Internet. See *In re Martin Container, Inc.*, 65 USPQ2d 1058 (TTAB 2002)(designation CONTAINER.COM held generic and incapable of registration on the Supplemental Register when used in connection with "retail store services and retail services offered via telephone featuring metal shipping containers" and "rental of metal shipping containers", the Board concluding that what applicant sought to register was a generic term {"container"}, with no source-identifying significance in connection with applicant's services, in combination with the top level domain indicator ".com", which also has no source-identifying significance, and that combining the two does not create a term which has somehow acquired the capability of identifying and distinguishing applicant's services.). See also *In re CyberFinancial.Net, Inc.*, 65 USPQ2d 1789 (TTAB 2002)(BONDS.COM held unregistrable on the

Serial No. 78/061,755

Supplemental Register for such services as the providing of information concerning financial products and services via a global computer information network), and cases cited therein; and 1 J. McCarthy, McCarthy on Trademarks and Unfair Competition, § 7:17.1 at pp. 7-28.1 to 7-29 (4th ed. 2002):

A top level domain indicator like ".com" does not turn an otherwise unregistrable designation into a distinctive, registrable trademark [or service mark]. Thus, for example, adding a ".com" to a generic term, such as <bankingnews.com> would not change the basic generic nature and the composite will probably be found generic and unregistrable for the service of providing information in the field of banking.

Decision: The refusal of registration is affirmed.