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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re eMarkmonitor Inc.

Serial No. 78199415

Caroline L. Keller and Kevin T Kramer of Pillsbury Winthrop Shaw Pittman for eMarkmonitor Inc.

John M. Wilke, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Quinn, Hohein and Zervas, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

eMarkmonitor Inc. has filed an application to register the mark EARLY WARNING SYSTEM (in typed or standard character form) for services ultimately identified as "[e]lectronic monitoring services in the field of domain name registration, where brand owners are notified of a

potential infringing domain name registration via electronic mail" in International Class 45.¹

The examining attorney has finally refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark, if applied to applicant's services, would be merely descriptive of them.

Applicant has appealed the final refusal. Both applicant and the examining attorney have fully briefed the appeal. An oral hearing was held before the Board on January 24, 2006.²

A mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information

¹ Application Serial No. 78199415, filed January 2, 2003, alleging a bona fide intention to use the mark in commerce under Trademark Act § 1(b), 15 U.S.C. §1051(b).

² Applicant mentioned, but did not submit a copy of, three third-party registrations in its request for reconsideration (filed October 29, 2004). Later, with its appeal brief, applicant submitted a copy of the three third party registrations. The examining attorney objected to the submission of the registrations with applicant's brief, citing Trademark Rule 2.142(d). Applicant submitted a request to remand the application back to the examining attorney with its reply so that it could properly submit copies of the three registrations. In an order mailed on September 16, 2005, the Board denied the request to remand and stated that "[t]he copies of third-party registrations which were submitted as an exhibit to applicant's reply brief will not be considered." We confirm that in view of Trademark Rule 2.142(d), the registrations were not timely submitted, and we do not further consider the three registrations submitted initially with applicant's appeal brief, and again with applicant's request to remand.

regarding a function, purpose, or use of the goods or services. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). See also *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). To be merely descriptive, a term need only describe a single significant quality or property of the goods or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Also, “[t]he perception of the relevant purchasing public sets the standard for determining descriptiveness. Thus, a mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service. On the other hand, if a mark requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods or services, then the mark is suggestive.” *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) (citations and internal quotation marks omitted).

The examining attorney has located the following definition of the phrase “early warning system” in *The American Heritage Dictionary of the English Language* (4th ed. 2000): “1. A network of sensing devices, such as satellites or radar, for detecting an enemy attack in time to take defensive or counteroffensive measures. 2. A

system or procedure designed to warn of a potential or an impending problem.”³ The examining attorney relies on the second definition, which does not limit the phrase to a particular context such as the military context, as is the case in the first definition of the phrase.⁴

Applicant's services are most certainly part of a “system ... which is designed to warn” - opposer's identification of services states that its electronic monitoring services “notif[y brand owners] of a potential[ly] infringing domain name registration.” Of course, a “potential[ly] infringing domain name registration” is a potential problem to any person or entity that owns a domain name or is a “brand owner.” Applicant has acknowledged this potential problem in its

³ The examining attorney submitted the definition for the first time with his brief. Because the Board may take judicial notice of dictionary definitions, *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), we take judicial notice of the entire definition submitted by the examining attorney.

⁴ In its reply brief at unnumbered p. 3, applicant points to the first definition of “early warning system” and argues that “any person in the United States, including consumers of Applicant's products, would associate these words with [a] system providing early warning of something in the nature of a disaster, or a natural or physical threat.” Applicant's argument is not well taken because applicant attributes limitations to the second definition that are not there. The second definition, which is the only definition the examining attorney relies on, only refers a “potential or an impending problem,” without characterizing the nature of the problem, and not “something in the nature of a disaster, or a natural or physical threat.”

promotional material submitted in response to the first

Office action:

Over the past few months several high-profile corporations have been victimized by cyber-criminals who have redirected customers to fraudulent websites resulting in identify theft, consumer confusion and lost revenue.

Stolen business, angry customers, damaged reputations and legal battles are just some of the problems that can ensue if preemptive measures are not taken.

Further, there is a temporal element to applicant's services, which is highlighted by the appearance of the word EARLY in applicant's mark and by the reference to "email" in the identification of services. Email is an extremely fast system for sending a message electronically to another person. Applicant points out the temporal nature of the services, i.e., that they are rendered "early" or "within 24 hours," in its promotional material, stating:

[T]he MarkMonitor Early Warning System notifies subscribers, via email within 24 hours, of the registration of top-level domains (gTLDs) and international domains (ccTLDs), which may be confusingly similar to a company's brand name or trademark.

...

By utilizing MarkMonitor's Early Warning System corporations can proactively respond to planned or potential domain name abuse.

Thus, the mark certainly describes a feature or characteristic of applicant's services, which provide early warning of an impending problem.

Applicant maintains that its mark is suggestive, not descriptive, because it does not *immediately* convey knowledge of applicant's services. According to applicant:

... a consumer would have to exercise mature thought and follow a multi-stage reasoning process when looking at the mark EARLY WARNING SYSTEM to determine that the services involve electronic monitoring of domain name registration or notification of a potentially infringing domain name registration via electronic mail. There is no indication by the mark alone that domain name registrations or electronic mail are involved with the services. The consumer would have to first relate the words "early warning system" with some sort of notification service. Then the consumer would have to choose from among the many notification services to determine that electronic mail was involved. Finally, the consumer would have to pull the relation to domain name registrations out of the blue, because there is not even a slight indication from the mark that domain name registrations are involved. Thus, assuming it is even possible for a consumer to determine the characteristics of Applicant's services from the mark EARLY WARNING SYSTEM, it would take mature, multi-step reasoning to come to that determination.

Brief at pp. 6-7.

Applicant's argument is not persuasive because applicant's mark need not indicate that "domain name registrations or electronic mail are involved with the services" to immediately convey information of applicant's

services. Whether a term is merely descriptive is determined not in the abstract or in a vacuum, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Moreover, it is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). See *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985).

The examining attorney also relies on various articles taken from the Nexis database to support his refusal. He has conducted several searches for various terms used in connection with "early warning system" and "warning system." In a search for "early warning system" and "trademark," the examining attorney has located the following two excerpts of Nexis stories:

Intellectual Property Today

November 1996

... Thomson, the world leader in trademark and copyright services, introduced its T&T(R) Trademark Management Service at the INTA Paralegal Forum (September 16-18) held in Crystal City, VA. The service is designed to act as an early warning system for the trademark attorney, paralegal, or marketing brand manager.

The Recorder

March 18, 1996

Datalytics, a Chicago-based Internet consulting company, this month launched a service that monitors the use of its clients' trademarks and brand names on the Internet for possible infractions.

"It's an early warning system that really alerts clients to potential abuse of trademarks or brand names in cyberspace," says company spokesman Sam Tatel.⁵

Applicant states that these excerpts and others submitted by the examining attorney with his first Office action which use the phrase "early warning system" "do not give any impression that the service is related to the Applicant's service." Brief at pp. 9-10. According to applicant, "accompanying words" are needed "to inform the reader what the service is"; and that "[e]ach of these articles uses the word 'early warning system' in varied

⁵ The examining attorney also located an excerpt from the *Bangkok Post* containing the words "trademarks" and "early warning system." This excerpt has no probative value because there is no evidence that it was circulated in the United States. As noted above, the determination of mere descriptiveness must be based on the perception of the relevant consuming public, which is located in the United States. *MBNA America Bank*, 67 USPQ2d at 1780.

ways and use[s] the word in an ambiguous manner. They are not used in a manner that is descriptive of one thing, certainly not of Applicant's services under its mark." Brief at p. 10. We disagree. These two excerpts, albeit ten years old, are significant because they show use of "early warning system" with respect to the services provided by two different entities that are the same or similar to those services applicant has identified in its identification of services. The meaning of the phrase "early warning system" is immediately apparent in these excerpts, and no explanation is needed nor provided in order to determine the meaning of the phrase in the context of the services referred to in the articles.

In a Nexis search for "electronic mail" and "warning system," the examining attorney also located the following:

*The Boston Globe*⁶
April 15, 1999

The memo was distributed to military bases and other sensitive federal installations, such as nuclear weapons labs, through a special electronic mail warning system, officials said.

⁶ Three duplicate excerpts from the same *Boston Globe* story are included in the record. Two are from two different publications and one is from a newswire service. Also, the examining attorney has submitted an excerpt from the April 15, 1999 edition of the *Chicago Sun-Times*, which is substantially similar to the *Boston Globe* article. Because these excerpts are duplicates or near duplicates, we do not repeat them herein.

Additionally, in a Nexis search for "email" and "warning system," the examining attorney located the following:⁷

The Atlanta Constitution Journal

January 29, 2004

Rus Cooper of TruSecure Corp. was more blunt about the government's e-mail warning system [regarding a federal initiative to warn computer users about Web Threats].

The Oregonian

December 31, 2003

The city has an e-mail warning system that flashes messages to a list of subscribers "one second after we get information about a problem," he said.

Sun-Sentinel

December 24, 2004

He said he would like to see the city create an e-mail warning system, so all residents with e-mail addresses can be alerted during emergencies.

⁷ The examining attorney submitted additional excerpts, but they do not support the examining attorney's contention that the mark is merely descriptive. Specifically, the excerpt dated May 9, 1994 from *InfoWorld* refers to "Early Warning Systems" in a trademark sense ("This gives SMART the capability to pass alerts to Frye's Net Ware Early Warning Systems that monitors network service activities and performance"); and the excerpt dated March 28, 1994 from *Network World* is irrelevant to the issues herein ("Target Alert is a fault management package that issues warnings of system failures ...").

Also, the excerpt from *PR Newswire*, dated May 5, 2003, submitted by the examining attorney with his denial of applicant's request for reconsideration, does not support the examining attorney's refusal; it discusses applicant and its "[n]ew features like ... Early Warning System and Domain Consolidator ...," and uses "Early Warning System" in a trademark sense. Moreover, there is nothing in the record to indicate that this wire report was distributed; thus, it is entitled to only minimal probative value in that we cannot judge the public's exposure to the use of the phrase in the newswire. See *In re Cell Therapeutics Inc.*, 67 USPQ2d 1795 (TTAB 2003).

The Indianapolis Star

June 17, 2002

He announced the creation of a telephone and e-mail warning system to alert parents and other residents when sewer overflows are expected in their neighborhood.⁸

Applicant argues that these excerpts with "electronic mail" or "email" proximate to "warning system" do not include the entire phrase "early warning system"; that "[t]hese uses show that in order to describe to the consumer the use of electronic mail in a service, the term 'electronic mail' or 'email' must be included"; and that the excerpts do not "describe what type of service is being offered in conjunction with these phrases." Brief at p. 10. Applicant, at p. 11 of its brief, emphasizes that the articles "are not used in a manner that is descriptive of one thing, certainly not of Applicant's services under its mark." While these excerpts do not use all of the wording of the mark and do not show use of "warning system" for services that are the same as, or similar to, applicant's services, they still have some probative value because they

⁸ The examining attorney also submitted several additional similar excerpts using "email" and "warning system," which we have considered. Two of these additional excerpts are from newswire services. We have considered these excerpts, but we have given the newswire excerpts minimal probative value because there is nothing in the record to indicate that these newswire reports were distributed. See *Cell Therapeutics Inc.*, 67 USPQ2d at 1798.

show that email or electronic mail - which is included in applicant's identification of services - is used as part of a "warning system" "of a potential or an impending problem."

Applicant also maintains that "early warning system" is not merely descriptive of applicant's services because the phrase is defined broadly and the excerpts from the Nexis stories show that the phrase can be used in conjunction with a large number of goods and services. Brief at p. 9. Further, applicant compares this case to *In re Hutchinson Technology Inc.*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988), where, according to applicant, the Federal Circuit held that "TECHNOLOGY was not descriptive of computer components, because even though the term 'technology' is used in connection with computer products, many other goods possibly may be included within the broad term 'technology.'" Applicant states that "[a]s in In re Hutchinson, many other unrelated goods possibly may be included within the broad term 'early warning system.'" Brief at p. 7. We are not persuaded by applicant's arguments and its comparison to *Hutchinson Technology*. Applicant has not introduced any evidence of any other uses of "early warning system" and the evidence submitted by the examining attorney does not demonstrate widespread use of

"early warning system." Also, as noted above, whether a term is merely descriptive is determined in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *Bright-Crest*, 204 USPQ at 593.

Upon consideration of the foregoing and the evidence of record in this case that we may properly consider, we reject applicant's contention that "early warning system" does not convey immediate knowledge of the services and requires consumer imagination to reach a conclusion as to the nature of the services. "Early warning system" is defined in an English language dictionary, and its definition is not restricted to a particular context such as the military context. The excerpts of record with "early warning system" in the "brand" or trademark context use this phrase in a descriptive manner for a service that notifies others of "abuse" or unauthorized use by others of trademarks "in cyberspace." Also, many of the Nexis excerpts show that email or electronic mail is used as part of a "warning system" to notify people by email of an

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emergency or dangerous condition. In view of the foregoing, we conclude that the examining attorney has established prima facie that the phrase "early warning system" when used in connection with "electronic monitoring services in the field of domain name registration, where brand owners are notified of a potentially infringing domain name registration via electronic mail," immediately describes, without speculation or conjecture, a significant feature or characteristic of applicant's services and hence is merely descriptive. Applicant has not rebutted the examining attorney's prima facie showing through its arguments or evidence.

Decision: The refusal to register is affirmed.