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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re IP Carrier Consulting Group

Serial No. 78542702

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Carrier Consulting Group.

Sung In, Trademark Examining Attorney, Law Office 103
(Michael Hamilton, Managing Attorney).

Before Bucher, Holtzman, and Bergsman, Administrative
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

IP Carrier Consulting Group filed an intent-to-use
application for the mark ipTUNES (standard character
format) for services ultimately identified as
"telecommunications access services, namely subscription-
based access services featuring a device that allows the
user to access high speed transmission of audio and data
via a global computer network, computers and wireless
devices."¹

¹ Application Serial No. 78542702, filed January 5, 2005.

Registration has been refused on the ground that the mark is merely descriptive pursuant to Section 2(e)(1) of the Lanham Act, 15 U.S.C. §1052(e)(1). The examining attorney contends that ipTUNES "is understood to mean an Internet Protocol-based means of selecting or playing music and videos, and this immediately describes applicant's telecommunications access services featuring a device for high-speed transmission of audio and data via a global computer network." (Examining Attorney Brief, p. 3).

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the services with which it is used. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the services for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the issue is whether someone who knows what the services are will understand the mark to convey information about the services. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002); *In re Patent & Trademark Services Inc.*,

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49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 UPSQ 365, 366 (TTAB 1985).

"On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive." *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978). *See also, In re Shutts*, 217 USPQ 363, 364-365 (TTAB 1983); *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980).

Finally, in determining whether a mark is merely descriptive, we must consider the mark in its entirety. As argued by applicant, common words may be descriptive when standing alone, but when used together in a composite mark, they may become a valid trademark. *See Concurrent Technologies Inc. v. Concurrent Technologies Corp.*, 12 USPQ2d 1054, 1057 (TTAB 1989). However, if each component retains its descriptive significance in relation to the services, without the composite term creating a unique or incongruous meaning, then the resulting combination is also merely descriptive. *In re Tower Tech., Inc.*, 64 USPQ2d 1314, 1317-1318 (TTAB 2002).

The examining attorney submitted the following evidence to show that "IP" means "Internet Protocol" or "Internet Provider":²

1. Definition of "IP" from the Acronym Finder at www.acronymfinder.com identifying one of the meanings of "IP" as "Internet Provider" and one as "Internetworking Protocol";
2. Definitions of IP as an abbreviation or acronym for "Internet Protocol" from multiple sources.³
3. Excerpts from newspaper articles referencing providers of Internet access as "Internet Providers";
4. Definition of "Internet Service Provider" as "Companies that provide Internet access, email, etc. for fee. Also called: Point-of-Presence, ISP, and Internet Providers" from www.bitpipe.com, an IT information website that provides a dictionary of terms;
5. The "About Us" webpage from applicant's website (ipcarrier.com) discussing applicant's "forward looking concept for marketing advanced technologies and IP-based services to ordinary consumers. . . In this online, always-on, soon to be speech-enabled, personalized world of communications, the most valuable brand is the literal word itself, preceded with your, my, and IP."; and,
6. The website for the Miami Internet Telephony Conference & Expo, February 22-25, 2005

² Applicant has acknowledged that IP is an acronym for Internet Protocol. (December 9, 2005 Response).

³ Bartleby.com derived from The American Heritage Dictionary of the English Language (4th ed. 2000); Encarta (<http://encarta.msn.com>); Microsoft Computer Dictionary, p. 287 (5th ed. 2002); Newton's Telecom Dictionary, p. 450 (2005); The Computer Glossary, p. 201 (9th ed. 2001); The Dictionary of Computer and Internet Terms, p. 270 (9th ed. 2006).

(tmcnet.com), with featured sessions on VoIP.⁴ Applicant's Managing Partner made a presentation entitled "Selling Services: The IP Carrier Agent Opportunity" including a discussion regarding "the pace of innovation unfolding in VoIP services."

The Examining Attorney submitted dictionary definitions to prove that "tunes" means "music" or "songs."⁵

The Examining Attorney submitted the following evidence to demonstrate that Internet providers transmit music through the Internet:

1. A 2003 press release posted on the Real website (realnetworks.com) announcing that "Comcast, the nation's leading broadband Internet provider, and RealNetworks, the global leader in digital media services and software," reached an agreement allowing Comcast to transmit RealNetworks' music library to its subscribers; and,
2. A January 22, 2003 article posted on the *NewScientist.com* website, "The World's No. 1 Science & Technology News Service," regarding a court order requiring Verizon, an internet service provider, to reveal the identity of a

⁴ VoIP is an acronym for "Voice over Internet Protocol" which is "a protocol for transmitting the human voice in digital form over the Internet or other networks as an audio stream, instead of using traditional telephone lines." The American Heritage Science Dictionary (2002) accessed through www.dictionary.com. The Board may take judicial notice of an online dictionary which is the electronic equivalent of a print publication that applicant may easily verify. *In re Red Bull GmbH*, 78 UPSQ 1375, 1378 (TTAB 2006). See also the entries from SearchVoIP.com, "The Web's best VoIP information resource for enterprise IT professionals."

⁵ The American Heritage Dictionary of the English Language, *supra*; Encarta, *supra*; Merriam-Webster Online (www.m-w.com). Applicant concedes that "tunes" is commonly understood as meaning music, but does not agree that tunes is descriptive. (Applicant's Brief, p. 5).

user accused of illegally downloading hundreds of copyrighted songs. The author reports that "many thousands of individuals" are suspected of copyright infringement through peer-to-peer file sharing networks.⁶

We start our analysis of the registrability of ipTUNES by inquiring whether ipTUNES describes a function or purpose of "telecommunications access services, namely subscription-based access services featuring a device that allows the user to access high speed transmission of audio and data via a global computer network, computers and wireless devices," not whether we can guess what the services are by looking at the mark.

The evidence shows that "ip" is an abbreviation or acronym for "Internet Provider" or "Internet Protocol," and that when used as a prefix for a mark, "ip" means through the Internet. The evidence regarding VoIP (Voice over Internet Protocol) shows that "ip" is understood to mean through the Internet (*i.e.*, voice communications through the Internet). In addition, applicant's website refers to applicant's concept for marketing IP-based services and how "the most valuable brand is the literal word itself, preceded with your, my, and IP." In this instance, the

⁶ We are not considering this information for the truth of the matter asserted in the article, only that the author reported it as such and, therefore, as evidence of what readers may perceive.

"literal word" is "tunes" preceded by "ip." "Tunes" is a slang expression for "songs" or "music." When combined, ipTUNES means music or songs through the Internet.

Applicant's services comprise providing high-speed transmission of audio and data through the Internet. Both components of the mark, "ip" and "tunes," retain their descriptive meaning when combined and used in connection with the high-speed transmission of audio and data. The combination of "ip" and "tunes" does not create a new term with an incongruous meaning. Thus, the mark ipTUNES directly conveys to consumers that applicant's services involve the transmission of music (*i.e.*, audio and data) through the Internet.

In responding to the descriptiveness refusals applicant submitted the Wikipedia entry for "Internet Service Provider" to show that the most common abbreviation for "Internet Provider" is "ISP."⁷ "Internet Service Provider" is defined as follows:

⁷ "[T]he Board will consider evidence from Wikipedia so long as the non-offering party has an opportunity to rebut that evidence by submitting other evidence that may call into question the accuracy of the particular Wikipedia information. Our consideration of Wikipedia evidence is with the recognition of the limitations inherent with Wikipedia (*e.g.*, that anyone can edit it and submit intentionally false or erroneous information). *In re IP Carrier Consulting Group*, ___ USPQ2d ___ (Serial Nos. 78542726 and 78542734, TTAB June 18, 2007). In this case, the Examining Attorney has had an opportunity to rebut the evidence.

A company or organization that provides access to the Internet through its servers, usually for a fee.⁸

Applicant argues that ipTUNES is not descriptive because it takes a "significant leap of imagination" to connect ipTUNES with the high-speed transmission of audio and data. Applicant reasons that the most common acronym for "Internet Provider" is "ISP," not "IP." Therefore, consumers encountering the mark ipTUNES would have to translate "ip" to "ISP," and "the presumed association between 'ip' and Internet provider would at least require a step of imagination." (Applicant's Brief, p. 3-5). The problem with applicant's analysis is that it starts with the term "Internet Provider," a term that is not a component of the mark, and asks what is the most common acronym for "Internet Provider." An analysis of the mark should start with the mark at issue (ipTUNES) and inquire whether that term describes the high-speed transmission of audio and data, not the inquiry whether "ip" is the most common acronym for "Internet Provider." The evidence shows that "IP" means "Internet Provider" or "Internet Protocol." In either case, ipTUNES directly engenders the commercial

⁸ American Heritage Dictionary of Cultural Literacy (3rd ed. 2005).

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impression or meaning of music transmitted through the Internet. See *In re IP Carrier Consulting Group, supra*.

In view of the foregoing, we find that ipTUNES is merely descriptive of the purpose or function of applicant's services for transmitting audio and data through the Internet.

Decision: The refusal to register is affirmed.