

Mailed:
September 14, 2007

This Opinion is Not a
Precedent of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re IronPort Systems, Inc.

Serial No. 78611699

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Inc.

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Before Hairston, Rogers and Kuhlke,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

IronPort Systems, Inc. (applicant) has applied to
register FIXING EMAIL as a mark on the Principal Register.
Registration is sought in standard character form for goods
identified, following amendment, as "Computer hardware
configured as mail transfer agents; computer software for
protecting e-mail messages against computer viruses, and
for prevention of unwanted e-mail messages." The

application is based on applicant's stated intention to use the proposed mark in commerce.

The examining attorney refused registration under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), on the ground that, when used for the identified goods, FIXING EMAIL will be descriptive of them, and also required applicant to submit "advertisements or promotional materials for goods of the same type." (Office action of November 21, 2005.) Applicant responded with arguments in support of registration and with numerous reprints of its web pages and marketing brochures to illustrate the nature of its goods. (Response of May 19, 2006.) Unpersuaded by the arguments and submissions, the examining attorney issued a final refusal of registration. (Office action of June 26, 2006.) Applicant then appealed and briefs have been filed.

The briefs of applicant and the examining attorney ably set forth relevant statements of the law governing analysis of the issue of descriptiveness and we will not repeat the case law unnecessarily in this decision. Rather, we will focus on the case law that is applicable to the key issues in this case.

One issue not in dispute is that "email" (the term used in applicant's proposed mark) and "e-mail" (a term

appearing in the identification of goods) are synonymous. Further, there can be no reasonable argument that "email" is not descriptive when used for the identified goods, which include, inter alia, software for screening out unwanted email messages or spam. As revealed by the definitions of "email" put into the record by the examining attorney, email can mean electronic messages or the computerized messaging system through which such messages are transmitted.¹

In essence, applicant and the examining attorney differ as to the significance of the term "fixing" in the proposed mark, when used for the identified goods. This is understandable, if for no other reason than that the examining attorney's evidence shows at least seventeen

¹ Applicant, for the first time in its reply brief, asserted that the examining attorney had not relied on an "ordinary" meaning for "email" but does not specify the non-ordinary meaning on which the examining attorney has relied. Applicant does contend that, "Email threats are external to the email system, and not part of the email system. Therefore, email threats are not within the ordinary meaning of EMAIL." Reply brief, p. 5. However, this argument is a red herring.

The examining attorney's earlier discussion of email threats was responsive to, and in part quoted from, a marketing brochure submitted by applicant that discusses applicant's efforts to combat email threats. Further, the distinction applicant attempts to draw between what may be part of an email system and what may be external to it is belied by applicant's own marketing material. As applicant's brochure explains, users of its anti-spam product will be protected from, inter alia, "spyware threats distributed over email." See attachment 9 to applicant's May 19, 2006 response. A spyware threat distributed by email must necessarily be within the email system.

meanings for "fix" as a verb and seven meanings as a noun. (Office action of November 21, 2005.) To facilitate our assessment of which of these meanings, if any, would immediately come to mind for prospective purchasers or users of applicant's identified goods, we must first consider the nature of the goods, as illustrated by the web pages and marketing brochures provided by applicant. See *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998) (question whether a proposed mark is merely descriptive is not determined by asking whether one can guess, from the mark itself, what the goods or services are, but rather by asking, when the mark is seen on or in connection with the goods or services, whether it immediately conveys information about their nature).

Applicant has applied to register its mark for the identified goods under the intent to use provisions of the Trademark Act and has not, to date, filed an allegation of use. However, applicant has made of record reprints of some of its web pages and marketing brochures. We note in particular applicant's submission of web pages said by applicant to contain a "general company description" and to use the proposed mark "in a trademark sense." (Attachment 1 to applicant's May 19, 2006 response.) On these pages, as well as on other submitted web pages, applicant utilizes

the statutory registration symbol adjacent to its company name and the "TM" designation adjacent to various other terms.² Applicant does not, however, utilize the TM designation next to "Fixing Email," which is not associated with any generic product name, and which appears as a section heading for a discussion of applicant's business and products. Thus, we do not agree with applicant's contention that "Fixing Email" is used on this web page "in a trademark sense."

Prospective customers of applicant viewing this page would find "Fixing Email" to mean one of two things. They may find it to mean that applicant and its products are dedicated to fixing the email system:

While email has become the #1 online application, the infrastructure with which email is sent, received, and managed hasn't evolved much in over 20 years. IronPort is driving new standards and providing breakthrough products for those faced with the monumental task of managing, protecting, and growing this mission-critical business communication system.

² Attachment 1 (www.ironport.com/uk/company/) is headed "IronPort® Company" and includes references to the "IronPort C-Series™" email security appliances and its proprietary operating system "AsyncOS™." Attachment 12 (www.ironport.com/products/ironport_compliance_solutions.html) is headed "IronPort® Compliance Solutions" and includes discussions of "IronPort Compliance Filters™" and the "IronPort Mail Flow Monitor™" and Mail Flow Central™."

The reader of this passage under the heading "Fixing Email" would take the heading to mean that applicant is involved in making the email system "stable, firm or secure." See the ninth definition of "fixing" attached to the Office action of November 21, 2005 ("*9. transitive and intransitive verb **make or become secure:** to make something stable, firm or secure, or become so.*") (italics and bold in original). Certain of the NEXIS excerpts introduced by the examining attorney with the June 26, 2006 final Office action illustrate this same meaning (emphasis in excerpts):

<http://www.opera.com/>), which popularized tabbed browsing, has been upgraded to version 7.21 and now sports an undo feature and fixes to the e-mail client. *Belleville News-Democrat*, October 20, 2003.

The work is doubly discouraging for the information technology crews here because the very technicians who are fixing the E-mail worm and virus problems are slated to be laid off amid budget cuts, Mainord said. *The Commercial Appeal (Memphis, TN)*, August 23, 2003.

He didn't have a target date for repairs, but he said some temporary steps have been taken to fix the e-mail problems. *The Oregonian*, February 26, 2001.

The result: Amerinet's information technology department no longer fusses with fixing the e-mail system when it crashes or upgrades it when it needs improvement. *St. Petersburg Times (Florida)*, September 10, 2000.

Yahoo Mail producer Lisa Pollock said the company added a fix to its e-mail service last week in which an account will "lock up after a certain

amount of failed logons." *InternetWeek*, February 22, 1999.

Each of the foregoing excerpts refers to fixing a problem with an email system or some component thereof. While applicant's company profile may discuss its products as fixing the email system in a broad sense, and the NEXIS excerpts may be focused on more particular or specific email systems or issues, the context of use is clearly the same and equally descriptive. *In re Fiduciary Special Services, Inc.*, 226 USPQ 48, 50 (TTAB 1985) ("That applicant's mark describes the general category of its services rather than particular features of its services does not render the mark any less descriptive".)

The other possible meaning that customers familiar with applicant's existing products will ascribe to "Fixing Email," when used for the identified goods, is that one or more of these products enhances security by allowing the source or location of email messages to be "fixed," i.e., pinpointed with some degree of accuracy. Indeed, applicant acknowledges the potential for customers to ascribe such a meaning to its proposed mark when it discusses in its main brief the NEXIS excerpts on which the examining attorney relies. In particular, applicant acknowledges the October 6, 2006 excerpt from the *New York Times* as illustrating

this meaning, but contends it is the only excerpt illustrating this meaning. (Brief, pages 5-6.) We find, however, that the November 12, 2001 excerpt from *Computer Reseller News* also illustrates this meaning. Moreover, applicant's discussion of its "email traffic monitoring" products and services on its web pages and in its product brochures shows that applicant's products fix the location or source of email:

"SenderBase has the most accurate view of the sending patterns of any given mail sender"
(attachment 1, Response of May 19, 2006)

"IronPort's reputation filtering technology identifies suspicious email senders" and
"Reputation filters are extremely high performance, processing messages at the IP address level" (attachment 3)

"The IronPort X1000 contains DomainKeys technology to digitally sign each outgoing message and establish your identity with receivers on the Internet" (attachment 4)

"a new scanning technology that enables multi-vendor signature-based spyware filtering"
(attachment 5)

"see which users are sending the most mail" and
"End-to-end communications auditing enables administrators to know where, and when, a communication took place" (attachment 6)

"Mail Flow MonitorTM delivers complete real time visibility into who is sending you email" and
"Mail Flow CentralTM allows you to find the status of any message that has traversed your infrastructure" (attachment 9)

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"Some of the filters are reputation-based, examining the source of the email" (attachment 10)

"Instantly track messages for compliance audits" (attachment 12)

Because applicant filed its application based on its stated intention to use the proposed mark and has not alleged actual use and filed a specimen showing use for the identified goods, we cannot be more precise as to which of the two possible meanings consumers will be more likely to ascribe to the proposed mark when used for the identified goods. However, both meanings carry with them only descriptive significance. See *In re Vehicle Information Network Inc.*, 32 USPQ2d 1542, 1544 (TTAB 1994) (involving the proposed mark "The Nation's Local Electronic Classifieds"):

We are left to consider whether a reasonable interpretation of the proposed mark would provide information about a feature or characteristic of the services as they are specified in the application. A typical purchaser of applicant's computerized advertising service would not be unreasonable in understanding the words used in the proposed mark to mean that the service consists of providing, on a nationwide basis, classified advertisements for vehicles available in particular local areas. Other possible interpretations could be that as far as local electronic classifieds are concerned, applicant claims to be the only one in the nation providing such services or the favorite or preferred one in the whole nation. None of these possible interpretations involves elaborate reasoning or

consideration, and none is consistent with applicant's theory of incongruity. More important is the fact that as to each of these possibilities, the words sought to be registered would be immediately understood to convey information concerning the nature of the services, and the services are encompassed within applicant's identification.

Finally, applicant does not contend that the combination of "fixing" and "email" in some way creates incongruity, ambiguity, vagueness or some other result that makes the combination more distinctive than the individual parts. *Compare Minnesota Mining and Manufacturing Co. v. Johnson and Johnson*, 454 F.2d 1179, 172 USPQ 491 (C.C.P.A. 1972) (combination of "skin" and "visible" into SKINVISIBLE for transparent adhesive tape for medical and surgical use is highly suggestive of skin that is visible when product is used but is also suggestive of invisibility of tape and therefore not merely descriptive) and *In re Sweet Victory, Inc.*, 228 USPQ 959 (TTAB 1986) (while French term GLACE and English term LITE each were descriptive of involved goods, juxtaposition of terms resulted in incongruity sufficient to avoid refusal on mere descriptiveness grounds) with *In re Intelligent Instrumentation, Inc.*, 40 USPQ2d 1792, 1794-95 (TTAB 1996) ("there is nothing in the term 'VISUAL DESIGNER' which is incongruous, indefinite or susceptible to multiple connotations" when used for particular computer

programs) and *In re Bongrain International Corp.*, 229 USPQ 67, 69 (TTAB 1985) (while some meanings for BABY would be considered incongruous in relation to cheese, when combination BABY BRIE used for brie cheese, ordinary purchaser would take BABY as size designation and would not be expected to search for alternative incongruous meanings).

Accordingly, we conclude that the proposed mark FIXING EMAIL will be descriptive when used for the identified goods. Consumers would view products so identified either as products suitable for fixing up the email system or as products which include among their functions fixing the location or source of email messages. Indeed, some consumers might think both things about the products and the ideas would be complementary and equally descriptive.

Decision: The refusal of registration under Section 2(e)(1) is affirmed.