

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed: August 17, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Point Roll, Inc.

Serial No. 78612631

Jeffrey Zucker of Fisher Zucker LLC for Point Roll, Inc.

Vivian M. First, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before Hohein, Bucher and Taylor,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Point Roll, Inc. has filed an application to register on the Principal Register the mark FOLDOVER (in standard character format) for services identified as "[p]roviding temporary use of non-downloadable computer software for use in creating web-based advertisements" in International Class 42.¹ The trademark examining attorney has refused registration on the ground that applicant's mark is merely

¹ Serial No. 78612631, filed on April 20, 2005, and claiming March 2, 2005 as the date of first use of the mark anywhere and in commerce.

Ser No. 78612631

descriptive of applicant's services pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

After the refusal was made final, applicant appealed. Both applicant and the examining attorney have filed appeal briefs, and applicant has filed a reply brief.

We reverse the refusal to register.

Before turning to the merits of the appeal, we must discuss an evidentiary matter. With its reply brief, applicant has submitted a two-page printout from an Internet website, presumably as an example of how applicant's software program works. This evidence is untimely because it was not properly made of record prior to the appeal. Accordingly, it will not be further considered. See 37 C.F.R. § 2.142(d), which provides that the record in the application should be complete as of the filing of the appeal.

Turning now to the merits of the appeal, the examining attorney contends that the term FOLDOVER is descriptive of applicant's services because, in the advertising industry, the term FOLDOVER merely describes a type of advertisement, and "the purpose and function of the [applicant's] services is the creation of a foldover ad in an electronic environment." (Examining Attorney's brief at 4.) The examining attorney further contends that applicant's

services are directed to professionals in the advertising and publishing fields who are familiar with the nature of foldover advertisements in the print media and will "readily perceive" that the function of the applicant's services is the creation of an electronic version of a foldover ad, where a virtually folded over portion can be pulled away to reveal the full advertisement. (*Id.*)

Applicant, by contrast, contends that "the term 'Foldover' does not immediately express a function that the Applicant performs, [but] instead at most it merely suggests Applicant's services provided." (Applicant's brief at unnumbered p. 3.) Applicant further contends that the examining attorney misreads and takes too narrow a view as to the subject matter and scope of its "activities." In applicant's view, the term "Foldover" is "non-descriptive of the computer software virtual advertising tool which allows for a seamless page transition to reveal the advertiser's promotion. ... [S]ince the advertisement appears in a one dimensional setting, it is impossible for the advertisement to be literally folded over. ... Applicant's service in no way reflects any similarities to the advertising industry's practice that the examining attorney references in the final office action, which is an

advertisement that is unfolded to show a multi-page ad."

(Applicant's brief at unnumbered p. 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 regarding a function, purpose or use of the goods or services. *In re Abcor Development Corp.*, 588 F.2d 811 (CCPA 1978). It is not necessary, in order to find that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).

A term which is suggestive, however, is registrable. A suggestive term is one that suggests, rather than describes, characteristics or attributes of a product, such that imagination, thought or perception is required to

reach a conclusion about the nature of the goods or services. *In re Gyulay*, 820 F.2d 1216, 1217, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). There is often a fine line of distinction between a suggestive and a merely descriptive term, and it is sometimes difficult to determine when a term moves from the realm of suggestiveness into the sphere of impermissible descriptiveness. *In re Recovery, Inc.*, 196 USPQ 830 (TTAB 1977). It is well settled, however, that where there is doubt on the issue, the doubt must be resolved in applicant's behalf and the mark should be published for opposition. *See In re Rank Organization Ltd.*, 222 USPQ 324, 326 (TTAB 1984) and the cases cited therein.

The examining attorney's refusal is premised on her assertion that "[i]n the advertising industry, FOLDOVER merely describes a type of advertising that features a folded over portion which can be unfolded to reveal the advertising material concealed beneath." We find this assertion, however, is not substantiated by the record. Indeed, the meager evidence purportedly showing that the term "Foldover" merely describes advertising material consists of three excerpts from a search of the Internet

Ser No. 78612631

using the Google search engine.² One reference to "fold-over" is found at (www.mindfully.org) in an article entitled "Philip Morris draws fire for anti-smoking freebies to school." The article, in pertinent part, reads as follows (underlining added):

Millions of book covers sent to schools by cigarette maker Philip Morris show children on snow boards and ski's and warn them: "Don't Wipe Out. Think. Don't Smoke."

The free covers have sparked protests from education and health advocates across the country, who call the brightly colored fold-over covers a smoke screen that violates a 1998 ban on tobacco advertising to children.

In this context, "fold-over" refers to book covers as opposed to any type of advertising material. While there may be some dispute whether the illustration on the covers serves as subliminal advertising for smoking, the term fold-over describes a type of book cover.

The screen shots from a second website (www.customdecalsandstickers.com) show a product listing for Cole Industries, Inc. The products include, under the category "Signs and Posters," "Fold-Over Posters." In the absence of any context, it is unclear whether the posters are in the nature of advertisements. Similarly, the third

² This evidence was submitted as exhibits to the examining attorney's November 29, 2005 Office action.

website (www.hirebic.com), appears to show a listing of a variety of goods and services. Under the category "ADVERTISING," there is a listing for a "4 Panel Foldover 5½" x8." Again, in the absence of context, it is unclear what type of advertising product and/or service is being offered. Therefore, the probative value of this evidence is limited, at best, in assessing the consuming public's perception of the term FOLDOVER as a type of advertising format or material.³

Simply put, there is insufficient evidence to find that the term "foldover" is merely descriptive of advertising material.

Further, we are not persuaded by the examining attorney's assertion that applicant's services are directed to professionals in the field of publishing and advertising who are familiar with the nature of foldover advertisements in the print media, and who will "readily perceive" that the function and/or purpose of applicant's services is to create a simulation of a "FOLDOVER" advertisement for use online. Although the press release for applicant's recited

³ As regards Internet evidence, the mere appearance of a term in a brief summary has very limited probative value, especially compared with evidence that provides the context within which a term is used. See e.g., *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828 (Fed. Cir. 2007); and *In re King Koil Licensing Co.*, 79 USPQ2d 1048 (TTAB 2006).

Ser No. 78612631

services under its FOLDOVER mark does address applicant's commitment to serve the needs of the "publisher," there is no evidence that applicant limits its services to publishers. Moreover, even if applicant's services were directed to such professionals, on this record, we cannot conclude that these professionals would recognize the term FOLDOVER as describing a type of print advertising.

The examining attorney also points to descriptive use by applicant of the terms "folds over" and "fold over." In particular, the examining attorney notes:

The applicant's March 2, 2005 press release for its services states: "When a user initiates a mouse-over, the ad visually **folds over** the page, exposing close to a full page ad" [emphasis added]. Applicant's response of December 9, 2005 states that the "software allows for advertiser's promotions to appear as a **fold over**" [emphasis added].

(Examining Attorney's brief at p. 3.)

As regards the press release, applicant seeks to register the term FOLDOVER, not "folds over." Further, when the term FOLDOVER is used in the press release, it appears as FoldOver. The capitalization of the letters "F" and "O" in the compound word FoldOver sets the term apart from the remainder of the text, such that applicant's use of the term FoldOver is in a trademark manner. As such, we

find that applicant has not used the phrase "folds over" to describe its services.

With respect to the December 9, 2005 response, we also find applicant's use of the phrase "fold over" is not descriptive. The response reads more fully:

... The Applicant's activities are not related to the advertising industry in which an advertisement can be literally unfolded that the examining attorney found the mark to be descriptive of.⁴ Rather, the distinguishing and essential feature of the mark is the technology of the advertisement service.

The Applicant's computer software allows for advertiser's promotions to appear as a fold over, when in reality the technology merely simulates the pulling back of a page to expose the advertisement.

(Response at p. 2). Here, applicant is referring to the type of print advertisement that the examining attorney labeled a "fold over." As previously stated, there is insufficient evidence to show that "fold over" is merely descriptive as applied to such print advertisements.⁵

⁴ We note that applicant did not concede that the term "fold over" is descriptive of a type of print advertising material. Indeed, applicant, in its reply brief, states "[w]hile the term 'foldover' may have some significance in the advertising industry, in which the Applicant does not concede this point, it has no obvious meaning in relation to Applicant's services, and as the Board found in TBG [*In re TBG, Inc.*, 229 USPQ 759 (TTAB 1986)], at worse the term is suggestive" (emphasis supplied). (Applicant's reply brief at p. 3).

⁵ Even if we had found the term "FOLDOVER" descriptive of print advertising materials, it would not have changed our decision. We agree with applicant that the facts in this case are analogous

Nor do we find sufficient evidence that the term FOLDOVER is descriptive when used in connection with applicant's services of "[p]roviding temporary use of non-downloadable computer software for use in creating web-based advertisements, particularly given that the examining attorney's basis for refusal hinged on a finding that "foldover" merely describes certain types of print advertisements. We conclude that a multistage reasoning process or imagination would be necessary for purchasers of these services to deduce anything meaningful about the nature of the services from the mark FOLDOVER. That is, the designation FOLDOVER has not been shown to immediately describe any significant feature or purpose of applicant's particular services. While FOLDOVER may be suggestive of

to the facts in *TBG, Inc.* In that case, the Board found that the designation SHOWROOM ONLINE for "leasing computer databases and video disks in the field of interior furnishings and related products of others" is, at worst, suggestive because it has no obvious meaning in relation to that applicant's services - since that applicant did not represent manufacturers of the products, did not sell or lease interior furnishings, and was not otherwise involved in the interior furnishing business. Similarly in this case, the designation FOLDOVER has no immediate significance to applicant's provision of non-downloadable software for use in creating web-based advertisements. Although applicant's software allows an advertiser's promotion to appear on a webpage, applicant is not selling the advertising on the space available for promotion, nor is applicant in the advertising industry. As applicant states, it is "merely facilitating the opportunity to place the promotion on the website through its software." (Applicant's reply brief at p. 3).

Ser No. 78612631

the identified services, it is not merely descriptive thereof.

Decision: The refusal to register under Section 2(e)(1) of the Trademark Act is reversed.