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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Welch

Serial No. 78669946

John L. Welch Pro Se.

Dannean Hetzel, Trademark Examining Attorney, Law Office
106 (Mary I. Sparrow, Managing Attorney).

Before Seeherman, Kuhlke and Walsh, Administrative
Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On July 13, 2005, John L. Welch (Applicant) applied to register the mark THE TTABLOG in standard-character form on the Principal Register for services identified as, "an online blog featuring commentary and information in the field of trademarks; an online blog featuring commentary and information regarding decisions of the Trademark Trial and Appeal (sic) and the courts relating to trademark law." Applicant claims first use anywhere and first use of the mark in commerce on November 9, 2004.

The Examining Attorney refused registration under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), on the ground that the mark merely describes the identified services. Applicant argued against the refusal, and the Examining Attorney made the refusal final. In a request for reconsideration Applicant argued against the refusal again, and in the alternative, presented a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). The Examining Attorney accepted the claim of acquired distinctiveness. Applicant appealed.

In this appeal Applicant asks us to reverse the Examining Attorney's refusal under Section 2(e)(1) so that the mark may be registered without the claim of acquired distinctiveness. If we affirm the refusal, Applicant states that the application may proceed under his alternative position, that is, seeking registration under the provisions of Section 2(f). Therefore, one way or the other, the application will proceed to publication. The Board permits applicants to assert alternative positions in this manner. *See Trademark Trial and Appeal Board Manual of Procedure* (TBMP) § 1215 (2d ed. 2004).

The Examining Attorney and Applicant have filed briefs. We affirm the refusal that the mark is not

inherently distinctive. Therefore, the application will proceed to publication with the claim of acquired distinctiveness under Section 2(f).

Applicant admits that his mark, THE TTABLOG, is a "telescoped" combination of two terms, TTAB and BLOG, each of which applicant concedes to be merely descriptive. Applicant argues, "Applicant submits that the unusual spelling of the word TTABlog and the uncertainty regarding its proper pronunciation, would cause a consumer to exercise some imagination, thought, or preception before reaching any conclusion as to Applicant's services." Applicant's Brief at 6. Later Applicant adds, "With regard to the subject mark TTABLOG, the consumer recognizes the unique, tongue-twisting fusion of the words TTAB and blog. Even though the consumer in all these instances comprehends the meaning of the terms as applied to the goods and services in question, he or she also recognizes that the mark has a unique and memorable aspect that gives the term its source-identifying power." *Id.* at 8.

On the other hand, the Examining Attorney argues:

The registrability of a mark created by combining only descriptive words depends on whether a new and different commercial impression is created or the mark so created imparts an incongruous meaning as used in connection with the goods or services. *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002). However, the mere combination of descriptive words to form a

telescoped mark does not automatically create a new non-descriptive word or phrase. *E.g.*, *In re Wells Fargo & Co.*, 231 USPQ 95 (TTAB 1986) (EXPRESSSERVICE merely descriptive of banking and trust services); *In re BankAmerica Corp.*, 229 USPQ 852 (TTAB 1986) (PERSONALINE is merely descriptive of consumer loan services in which a personal line of credit is provided); *In re U.S. Steel Corp.*, 225 USPQ 750 (TTAB 1985) (SUPEROPE merely descriptive of wire rope); *In re Gagliardi Bros., Inc.*, 218 USPQ 181 (TTAB 1983) (BEEFLAKES is merely descriptive of thinly sliced beef).

Examining Attorney's Brief at 3-4.

The Examining Attorney states further, "No thought process is required to conclude the subject matter (TTAB) and nature (blog) of applicant's services. The combination of these descriptive words creates no incongruity and no imagination is required to understand the nature of the services. Therefore, the mark is merely descriptive under Section 2(e)(1)." *Id.* at 4.

Before proceeding further we note that we find little, if anything, to disagree with in the well presented arguments of the Examining Attorney. We certainly concur in her ultimate conclusion, that is, that THE TTABLOG is nothing more than the sum of its merely descriptive parts and that it is merely descriptive.

Though there is no disagreement between Applicant and the Examining Attorney on the point, for the record we concur in the conclusion that both "TTAB" and "Blog" are

merely descriptive terms. The Examining Attorney identifies the evidence of record to support these conclusions. See Examining Attorney's Brief at 4, citing evidence in February 6, 2006 Office Action. We also concur in the Examining Attorney's point, also not in dispute, that marks which identify the subject matter of blogs are merely descriptive, as in the case of printed publications. See, e.g., *In re Medical Digest, Inc.*, 148 USPQ 570 (TTAB 1965) (OB/GYN DIGEST held merely descriptive of magazine).

We note that 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 mark is used, not in the abstract. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002).

Applicant relies on a number of "double-entendre" cases, for example, *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE held not merely descriptive for bakery goods) and *In re National Tea Co.*, 186 USPQ 63 (TTAB 1965) (NO BONES ABOUT IT held not merely descriptive of fresh precooked ham). However, although Applicant chastises the Examining Attorney for taking a narrow view of these cases, Applicant admits that the THE TTABLOG mark possesses no double meaning such as

those evident in the cited double-entendre cases. It is simply Applicant's argument that his mark possesses an analogous distinctive characteristic to that in the double-entendre cases, namely, its "tongue-twisting" pronunciation.

We reject the proposition that the simple fact that some individuals allegedly experience uncertainty in determining how to pronounce Applicant's mark ipso facto renders it inherently distinctive. Uncertainty in pronunciation in no way implies that anyone experiencing such uncertainty would not perceive the merely descriptive meaning of the mark. Nor does it imply that those individuals perceive some nondescriptive commercial impression.

More importantly, the double-entendre and telescoped-mark cases are but variations in the field of marks where terms, here merely descriptive terms, are combined. We must maintain our focus on the fundamental test: "Whether a term which is created by combining two or more unregistrable words may achieve registration depends on whether, in combination, a new and different commercial impression is achieved and/or the term so created imparts a bizarre or incongruous meaning as used in connection with the goods or services." *In re Associated Theatre Clubs*

Co., 9 USPQ2d 1660, 1662 (TTAB 1988). See also *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001). In this case we conclude that relevant consumers will readily perceive the merely descriptive significance of Applicant's mark, THE TTABLOG, that is, a blog concerned with TTAB matters, and nothing more.

Even if we were to accept Applicant's argument that the alleged uncertainty regarding pronunciation here could suffice to establish that his mark is not merely descriptive, we find that the record does not support Applicant's position.

In his request for reconsideration Applicant provides evidence that there have been 270,000 visits to his blog. Request for Reconsideration at 4. Applicant indicates that 27 individuals responded to the inquiry he posted on the blog asking, "... whether the subject mark has acquired distinctiveness for Applicant's services." *Id.* In his reply brief Applicant cites two examples from these 27 responses where individuals comment on the pronunciation issue:

I find pronouncing TTABlog nearly impossible -- I stumble over it every time. Christopher Turk; and

I am never quite sure how to pronounce the mark either. Ryan W. Corrigan.

Reply Brief at 3, citing evidence attached to Request for Reconsideration.

The more typical responsive messages make no mention of pronunciation, for example:

I recognize "THE TTABLOG" as a specific source of information and discussion about TTAB practice and decisions and other trademark-related matters. Assoc. Professor Rebecca Tushnet, Georgetown University Law Center;

In my view, your mark is certainly distinctive as a source indicator for blogging services featuring information and analysis related to trademarks. Dennis Griggs, attorney, Griggs Bergen LLP; and

The well known and/or famous TRADEMARK TTABLOG in my opinion functions as a single source indicator for the service[s] recited in the application. Leo Stoller, rentamark.com.

Applicant's Request for Reconsideration at 4-5, citing attached evidence. It is evident in many of the messages Applicant provided that those responding to his request regarded his mark as merely descriptive, not inherently distinctive. Applicant's Request for Reconsideration, Exh. 3. Even Mr. Corrigan, who expressed uncertainty regarding the pronunciation of the mark, stated that the mark had acquired distinctiveness, not that it was inherently distinctive. *Id.*

As further evidence in support of his position Applicant also points out that at one time the *Duke Law and Technology Review's* web site referenced his blog as "TTA

Blog" in a listing of intellectual-property-related blogs. *Id.* The reason for and significance of this usage is unclear. Thus, the evidence of pronunciation uncertainty is meager.

On the other hand the Examining Attorney made of record evidence from several web sites showing references to Applicant's blog as the "TTAB Blog" or "John Welch's TTAB Blog." See Examining Attorney's Brief at 5 citing, examples attached to the Examining Attorney's June 13, 2006 Office Action. There are more examples of this usage in the 27 messages Applicant provided with his request for reconsideration. See, e.g., the messages from Mr. Heilbronner (TTABBLOG), Mr. Tambourino (TTABBLOG), and Mr. Tolpin (TTABBLOG). This evidence tends to show that relevant consumers perceive the telescoped or misspelled version of TTAB BLOG (THE TTABLOG) as TTAB BLOG - a merely descriptive term.

On balance, even if we were to adopt Applicant's novel theory that uncertainty regarding pronunciation so alters the commercial impression of the mark as to render it inherently distinctive, on this record, we find no factual support for the position.

We likewise reject Applicant's argument that his mark differs from the marks in the cited telescoped-mark cases -

EXPRESSERVICE, PERSONALINE, SUPEROPE and BEEFLAKES.

Applicant argues that in the marks in the cited cases the pronunciation of the mark is unaltered relative to the two word version, but that in the case of his mark, THE TTABLOG, the pronunciation of the mark differs from the pronunciation of TTAB BLOG as two words. Applicant posits that, because TTAB is an initialism, the "B" in TTAB must be pronounced with a hard sound, while the "B" in blog is a soft sound and would be pronounced as such. We see no meaningful distinction here. Some form of the same strained argument could be made as to any of the marks in the cited cases. For example, one might argue that the BEEFLAKES mark would be seen and pronounced as BEE FLAKES because one "F" is missing. In the case of the marks in the cited cases and Applicant's mark the only reasonable view is that relevant customers will simply fill in the missing letter in their pronunciation without thinking. We find Applicant's arguments to the contrary unpersuasive.

We have also considered Applicant's arguments based on cases, such as, *Sperry Rand Corp. v. Sunbeam Corp.*, 442 F.2d 979, 170 USPQ 37 (CCPA 1971) and find them unpersuasive.

Accordingly, we conclude that THE TTABLOG is merely descriptive of "an online blog featuring commentary and

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information in the field of trademarks; an online blog featuring commentary and information regarding decisions of the Trademark Trial and Appeal (sic) and the courts relating to trademark law."

Decision: The refusal to register under Trademark Act Section 2(e)(1) is affirmed. The mark will proceed to publication with the claim of acquired distinctiveness under Trademark Act Section 2(f).