

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Spark Networks plc
v.
JewishAmericanSingles.com, Inc.

Opposition No. 91165925
to application Serial No. 78460372
filed on August 2, 2004; and,
Counterclaim to cancel Registration No. 2608475

Victor T. Fu of Richardson & Patel LLP for Spark Networks
plc.

Matthew Schwartz for JewishAmericanSingles.com, Inc.

Before Quinn, Rogers and Bergsman, Administrative Trademark
Judges.

Opinion by Bergsman, Administrative Trademark Judge:

JewishAmericanSingles.com, Inc. filed a use based
application for the mark JEWISHAMERICANSINGLES.com and
design, shown below, for services ultimately identified as
"on-line dating and social networking services," in Class
45. Applicant disclaimed the exclusive right to use
JEWISHAMERICANSINGLES.



Spark Networks plc opposed the registration of applicant's mark on the ground of priority of use and likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d). Specifically, opposer alleged that applicant's mark JEWISHAMERICANSINGLES.com and design for "on-line dating and social networking services" is likely to cause confusion with opposer's registered mark AMERICAN SINGLES for "computer services, namely, providing a web site for facilitating the introduction of individuals," in Class 42.¹

Applicant denied the salient allegations in the notice of opposition and filed a counterclaim to cancel opposer's pleaded registration. As grounds for the counterclaim, applicant alleged that opposer's mark "is at least merely descriptive, geographically descriptive or geographically misdescriptive of the population to whom the services in Registration No. 2,608,475 are directed." Opposer denied the essential allegations in the counterclaim to cancel.

On May 25, 2007, opposer filed a withdrawal of its opposition with prejudice. The opposition was dismissed with prejudice in the Board's August 10, 2007 order. However, applicant elected to continue to prosecute the counterclaim to cancel opposer's pleaded registration.

¹ Registration No. 2608475, issued August 20, 2002.

The Record

By operation of Trademark Rule 2.122, 37 CFR §2.122, the record includes the pleadings and the registration file for opposer's mark. The record also includes the following testimony and evidence:

A. Applicant's Evidence, as plaintiff in the counterclaim.

Applicant filed a notice of reliance on the following items:

1. Opposer's supplemental responses to applicant's first set of interrogatories;
2. Opposer's supplemental responses and objections to applicant's requests for admission; and,
3. Opposer's responses and objections to applicant's supplemental interrogatories.²

Applicant also sought to introduce an excerpt from opposer's web site, namely, opposer's application form for a user of its computer services to complete (*i.e.*, opposer's client application form). Trademark Rule 2.120(e), 37 CFR §2.120(e), provides that printed publications, such as books and periodicals, available to the general public in libraries or in general circulation, may be introduced into evidence through a notice of reliance. However, there is no

² It was unnecessary for applicant to separately proffer its requests for admission and its supplemental interrogatories through its notice of reliance because those documents were encompassed by opposer's responses.

provision for introducing into evidence through a notice of reliance an excerpt from a web site.

Internet evidence is not proper subject matter for introduction by notice of reliance because the evidence is not self-authenticating. As the Board has stated in the past, the element of self-authentication cannot be presumed to be capable of being satisfied by information obtained and printed out from the Internet.

Alfacell Corp. v. Anticancer Inc., 71 USPQ2d 1301, 1302 n.3 (TTAB 2004), *citing Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998). *See also* TBMP §704.08 (2nd ed. rev. 2004). Accordingly, the excerpt from opposer's web site comprising the opposer's client application form has been given no consideration.³

B. Opposer's evidence, as defendant in the counterclaim.

Opposer introduced applicant's answers to opposer's interrogatories through a notice of reliance.

Standing

The fact that opposer filed a notice of opposition against applicant, since withdrawn, is enough to demonstrate applicant's interest in the counterclaim to cancel opposer's

³ Applicant also attached a copy of this exhibit to its brief. Opposer objected to the introduction of the photocopy of the web site as untimely. Opposer's objection is well taken. Exhibits attached to briefs can be given no consideration unless they were previously made of record during the party's testimony period. TBMP §704.05(b) (2nd ed. rev. 2004) and the cases cited therein. Accordingly, opposer's objection is sustained and the excerpt from opposer's web site has been given no consideration.

pleaded registration, and therefore to establish its standing. See *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons, Inc.*, 14 USPQ2d 1879, 1880 - 1881 (TTAB 1990) (opposer, the party who originally brought the proceeding and put the validity of its registration at issue, may not deprive applicant of its standing by withdrawing its opposition).

Issues to be Decided

In its counterclaim to cancel opposer's pleaded registration, applicant alleged that opposer's mark "is at least merely descriptive, geographically descriptive or geographically misdescriptive of the population to whom the services in Registration No. 2,608,475 are directed." However, in its brief, applicant only argued that it sought to cancel opposer's registration pursuant to Section 2(e)(2) of the Trademark Act of 1946, 15 U.S.C. §1052(e). Specifically, applicant asserted that it "takes the position that the above-referenced registered trademark owned by Counter-Defendant Sparks Networks violates the aforereferenced sections (sic) of the Trademark Act as being geographically deceptive and deceptively misdescriptive."⁴ In addition, applicant argued that "[r]egistrant's mark is misdescriptive and deceptive geographically in relation to the services provided and the origin of registrant," and that "[r]egistrant's mark, being deceptively misdescriptive,

⁴ Applicant's Brief, p. 1.

geographically misdescriptive and employing generic terms, is not entitled to be registered.”⁵

Although applicant pleaded that the mark in opposer’s pleaded registration is merely descriptive, it did not present any arguments in support of that claim in its brief. We therefore deem applicant to have waived its pleaded claim that the mark in opposer’s pleaded registration is merely descriptive, and we have given it no consideration. See *Corporacion Habanos S.A. v. Guantanamera Cigars Co.*, 86 USPQ2d 1473, 1474 n.2 (TTAB 2008); *Krause v. Krause Publications Inc.*, 76 USPQ2d 1904, 1906 n.2 (TTAB 2005).

To the extent that applicant has argued that the mark in opposer’s pleaded registration is deceptively misdescriptive pursuant to Section 2(e)(1) of the Trademark Act of 1946, 15 U.S.C. §1052(e)(1), that is not a pleaded claim. Moreover, applicant never sought to amend its counterclaim to assert that opposer’s mark AMERICAN SINGLES is deceptively misdescriptive. Because applicant may not rely on an unpleaded claim, we must determine whether applicant’s attempt to argue that opposer’s mark is deceptively misdescriptive was tried by implied consent.

Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was

⁵ Applicant’s Brief, p. 4.

fairly apprised that the evidence was being offered in support of the issue.

TBMP §507.03(b) (2nd ed. rev. 2004). *See also* Fed. R. Civ. P. 15(b).

We note that in its notice of reliance, applicant indicated that it was introducing opposer's client application form "for the purpose of showing that the use of the term 'American' as modifying 'singles' is not only a descriptive term but in this case misdescriptive." Applicant also stated in its notice of reliance that it was going to rely on opposer's statement that it is "a citizen of the United Kingdom" to show "that if the term 'American' is designed to reflect, as a descriptive term, the citizenship of the users of the name it is in fact a misdesignation." Opposer did not object to the evidence in applicant's notice of reliance on the ground that the evidence was being introduced to prove an unpleaded claim. Nor did opposer object to the references in applicant's brief regarding whether opposer's mark is deceptively misdescriptive. In fact, opposer acknowledged that applicant was seeking to cancel opposer's pleaded registration on the ground that the mark AMERICAN SINGLES is "'geographically deceptive and deceptively misdescriptive' based on Section 2(e)(2) of the Trademark Act," and, in opposition to applicant's claim that AMERICAN SINGLES is deceptively misdescriptive, opposer argued that its mark was

suggestive. In view thereof, we find that opposer was fairly apprised that applicant was seeking to cancel opposer's pleaded registration on the ground that the mark AMERICAN SINGLES is deceptively misdescriptive.

In contrast to the claim applicant pursued at trial, applicant pleaded that the mark in opposer's pleaded registration is "geographically descriptive." However, it did not present any arguments in support of that claim in its brief. We therefore deem applicant to have waived its pleaded claim that the mark in opposer's pleaded registration is primarily geographically descriptive, and we have given it no consideration. See *Corporacion Habanos S.A. v. Guantanamera Cigars Co.*, 86 USPQ2d at 1474 n.2; *Krause v. Krause Publications Inc.*, 76 USPQ2d at 1906 n.2.

In summary, we deem applicant to have waived its claims that the mark in opposer's pleaded registration is merely descriptive or primarily geographically descriptive. We find that the claim that the mark in opposer's pleaded registration is deceptively misdescriptive has been tried by implied consent.⁶ Finally, we find that applicant's claim

⁶ In reconciling the pleadings, proof, and arguments, we note that this case has an unusual litigation history. Given that there has been a trial by implied consent that the mark in opposer's pleaded registration is deceptively misdescriptive, it seems odd that applicant would have waived its pleaded claim that opposer's mark is merely descriptive inasmuch as the same essential questions and proof would apply to both claims. Because applicant did not raise the issue of whether opposer's mark is merely descriptive in its brief, opposer had no reason to address that issue. Therefore, as indicated above, we deem that

that the mark in opposer's pleaded registration is primarily geographically deceptively misdescriptive has been both pleaded and tried.

Findings of Fact

1. Opposer is a public limited company with its principal place of business in London, England.⁷ Opposer also has offices in Beverly Hills, California and Frankfort, Germany.⁸

2. Opposer renders online dating services through eight (8) distinct web sites in over 236 countries.⁹

3. Opposer "does not require its members to provide information concerning their religious affiliation or national origin and several members do not voluntarily provide such information." Accordingly, opposer does not know how many of its members are Americans.¹⁰

4. Opposer "caters to singles of all races, ethnicities and interests and does not require its members to be residents of the United States."¹¹

claim to have been waived even though it may have been applicant's best claim.

⁷ Notice of opposition, ¶1; opposer's response to Interrogatory No. 3.

⁸ Notice of opposition, ¶1.

⁹ Notice of opposition, ¶1; opposer's response to Interrogatory No. 3.

¹⁰ Opposer's response to Interrogatory No. 11. See also opposer's response to Interrogatory No. 18.

¹¹ Opposer's response to request for admission No. 2. See also opposer's response to request for admission No. 3.

Whether AMERICAN SINGLES Is Deceptively Misdescriptive?

The test for determining whether a mark is deceptively misdescriptive as applied to the services involves a determination of (1) whether the matter sought to be registered misdescribes the services and, if so, (2) then whether anyone is likely to believe the misrepresentation. *In re Woodward & Lothrop Inc.*, 4 USPQ2d 1412, 1413 (TTAB 1987); *In re Quady Winery Inc.*, 221 USPQ 1213, 1214 (TTAB 1984).

The word "singles" is the plural form of the word "single" which is defined as "unmarried" or "pertaining to the unmarried state."¹² When used in connection with opposer's on-line dating services, the term AMERICAN SINGLES means unmarried Americans. Opposer's mark, therefore, describes a group or class of consumers/members who may use applicant's services, and to whom applicant's services may be rendered. It is not a false statement. It does not misdescribe opposer's services. Accordingly, opposer's mark AMERICAN SINGLES is not deceptively misdescriptive.¹³

¹² The Random House Dictionary of the English Language (Unabridged), p. 1785 (2nd ed. 1987). The Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

¹³ We note again that although we have found opposer's mark to be merely descriptive, we are unable to cancel the registration. Under the circumstances of this case, applicant waived its claim that opposer's mark is merely descriptive, and therefore it would be unfair to cancel opposer's registration on a ground that neither party argued in its brief. When applicant argued that opposer's mark is deceptively misdescriptive, and not that it is

Whether AMERICAN SINGLES Is Primarily
Geographically Deceptively Misdescriptive?

To prove that AMERICAN SINGLES for "computer services, namely, providing a web site for facilitating the introduction of individuals" is primarily geographically deceptively misdescriptive, applicant must prove the following:

1. The primary significance of AMERICAN SINGLES is a generally known geographic location;
2. The consuming public is likely to believe that AMERICAN SINGLES indicates the origin of the "computer services, namely, providing a web site for facilitating the introduction of individuals," when in fact the services do not come from America; and,
3. The misrepresentation was a material factor in the consumer's decision.

In re California Innovations Inc., 329 F.3d 1334, 66 USPQ2d 1853, 1858 (Fed. Cir. 2003).

In this case, opposer's mark AMERICAN SINGLES does not primarily denote the United States as the origin of the services because AMERICAN SINGLES does not primarily convey geographic significance. As indicated above, the term

merely descriptive, opposer had no reason to address the descriptiveness issue. Therefore, we cannot cancel opposer's registration on the ground that its mark is merely descriptive.

AMERICAN SINGLES means unmarried Americans, not a geographic location. See *Hamilton-Brown Shoe Co. v. Wolf Brothers & Co.*, 240 U.S. 251 (1916) (THE AMERICAN GIRL held not primarily geographically descriptive for shoes); *In re Jim Crockett Promotions Inc.*, 5 USPQ2d 1455 (TTAB 1987) (THE GREAT ALL AMERICAN BASH is suggestive of professional wrestling matches, and not primarily geographically descriptive).

Applicant argued that the primary significance of the mark AMERICAN SINGLES is geographic because "America" is the name of a geographic location and that the use of the descriptive term "Singles" does not detract from the fact that the mark as a whole is geographical.¹⁴ Applicant relied on *In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001) to support its argument. In that case, the Board found the mark MINNESOTA CIGAR COMPANY for cigars, cigar cases, and humidors to be primarily geographically descriptive because the presence of the generic term "cigar company" did not detract from the geographic significance of the mark. In *JT Tobacconists*, the addition of the term "cigar company" did not detract from the geographic significance of the mark because the mark MINNESOTA CIGAR COMPANY engenders the commercial impression of a cigar company in Minnesota. On the other hand, the mark AMERICAN SINGLES used in connection

¹⁴ Applicant's Brief, pp. 3-4.

with a "computer services, namely, providing a web site for facilitating the introduction of individuals" engenders the commercial impression of unmarried Americans, a group or class of people, rather than a geographic location. In essence, the composite does not comprise a dominant term and a less significant term. Rather it is the combination of the two that produce a single commercial impression, and that impression is of a particular group of people.

In view of the foregoing, we find that the primary significance for the mark AMERICAN SINGLES for "computer services, namely, providing a web site for facilitating the introduction of individuals" is not a geographic location, and therefore the mark is not primarily geographically misdescriptive.

Decision: Applicant's counterclaim to cancel opposer's pleaded registration is dismissed with prejudice.