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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Applications Online, LLC

Serial No. 76684479

David R. Schaffer of Miles & Stockbridge P.C. for
Applications Online, LLC.

Aretha Somerville, Trademark Examining Attorney, Law Office
107 (J. Leslie Bishop, Managing Attorney).

Before Cataldo, Mermelstein and Wellington,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applications Online, LLC filed an application to
register on the Principal Register the mark
APPLICATIONSONLINE in standard characters for the following
services, as amended¹:

Computer services, namely, development and
creation of software for web based applications
to allow prospective college students to submit
admissions applications online via a global
computer network,

¹ Serial No. 76684479 was filed on November 29, 2007, based on
an allegation of 1998 as a date of first use of the mark anywhere
and in commerce.

in International Class 42.

The examining attorney refused registration on the ground that the mark is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). After applicant amended its application to seek registration on the Supplemental Register, the examining attorney refused registration, under Section 23 of the Trademark Act, 15 U.S.C. §1091, on the ground that applicant's mark is incapable of identifying applicant's services and distinguishing them from those of others. When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs on the issue under appeal.

A mark is a generic name if it refers to the class, genus or category of goods and/or services on or in connection with which it is used. *See In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The test for determining whether a mark is generic is its primary significance to the relevant public. *See* Section 14(3) of the Act. *See also In re American Fertility Society*, 188

F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, *supra*. The examining attorney has the burden of establishing by clear evidence that a mark is generic and thus unregistrable. See *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Evidence of the relevant public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. See *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

In the case of *In re American Fertility Society*, *supra*, our primary reviewing court stated that if the United States Patent and Trademark Office (USPTO) can prove "(1) the public understands the individual terms to be generic for a genus of goods and species; and (2) the public understands the joining of the individual terms into one compound word to lend no additional meaning to the term, then the PTO has proven that the general public would understand the compound term to refer primarily to the genus of goods or services described by the individual terms." (*Id.* at 1837.)

In the case of *In re Dial-A-Mattress Operating Corp.*, *supra*, 1-888-M-A-T-R-E-S-S for "telephone shop-at-home retail services in the field of mattresses," the court further clarified the test as follows (*Id.* at 1810):

Where a term is a "compound word" (such as "Screenwipe"), the Director may satisfy his burden of proving it generic by producing evidence that each of the constituent words is generic, and that "the separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to those words as a compound." *In re Gould Paper Corp.*, 834 F.2d 1017, 1018, 5 USPQ2d 1110, 1110 (Fed. Cir. 1987). However, where the proposed mark is a phrase (such as "Society for Reproductive Medicine"), the board "cannot simply cite definitions and generic uses of the constituent terms of a mark"; it must conduct an inquiry into "the meaning of the disputed phrase as a whole." *In re The Am. Fertility Soc'y*, 188 F.3d at 1347, 51 USPQ2d at 1836. The *In re Gould* test is applicable only to "compound terms formed by the union of words" where the public understands the individual terms to be generic for a genus of goods or services, and the joining of the individual terms into one compound word lends "no additional meaning to the term." *Id.* at 1348-49, 51 USPQ2d at 1837.

The court concluded that "1-888-M-A-T-R-E-S-S," as a mnemonic formed by the union of a series of numbers and a word, bears closer conceptual resemblance to a phrase than a compound word, and the court reiterated that the USPTO must produce evidence of the meaning the relevant purchasing public accords to the proposed mnemonic mark "as a whole."

We find that, in this case, APPLICATIONSONLINE is more analogous to the phrase considered by the court in *American Fertility* than it is to the compound word considered in *Gould*. That is to say, unlike the term SCREENWIPE contemplated by the Federal Circuit in *In re Gould, supra*, APPLICATIONSONLINE appears to be a phrase comprising its constituent words, and not a compound word. Thus, dictionary definitions alone cannot support a refusal to register the proposed mark.

The examining attorney submitted with her first Office action definitions of "application"² and "online."³ According to these definitions, "application" is defined, inter alia, as "a request, as for assistance, employment, or admission to a school; the form or document on which such a request is made;" and "online" is defined, inter alia, as "accessible via a computer or computer network." Based upon these definitions, APPLICATIONSONLINE may be defined as a request for admission to a school or the form for such a request accessible via a computer or computer network.

² The American Heritage® Dictionary of the English Language: 4th ed. 2006.

³ Id.

In accordance with the direction provided by the Federal Circuit in *In re Dial-A-Mattress Operating Corp.* as discussed above, we look to the record of this case to determine whether the Office has produced evidence of the meaning the relevant purchasing public accords to APPLICATIONSONLINE "as a whole." In this case, the examining attorney submitted with her Office actions articles from the Lexis/Nexis computer database as well as commercial and informational Internet web pages. The following examples are illustrative (emphasis added):

Kathy Pattison understands the value of online applications not only as the mother of a high school senior currently applying to college, but also as a member of the admissions office at The College of William & Mary, where she works in the School of Business Administration. ... She explains that her son needs to spend more time applying to schools that haven't yet offered their **applications online.**⁴ ...

Russell thinks that these concerns are unfounded. But she admits that she, too, was reluctant at first to endorse the online application. ... You know, they get their SAT scores, they're lower than they thought, but they still go home and drum out six or seven **applications online** that night without consulting anyone.⁵ ...

To further trim wasted time from the process, submitting your **applications online** allows you to

⁴ Encarta.msn.com/college_article_onlinecollegeapplications/online_applications_guide

⁵ Id.

download essays created in most word-processing applications ...⁶

So how do you complete the FAFSA? "It looks complicated, but it's really not" Walker said. Log on to www.fafsa.ed.gov to fill out an **application online**. The Web site provides instructions to help you through the process, including the paperwork you need, as well as federal and state deadlines. The U.S. Department of Education, which administers the FAFSA, said it generally takes less than an hour to complete an **application online**. And applications received electronically are processed as much as two weeks quicker than paper versions sent by mail.⁷ ...

"Seniors and their families who attend will have two options," says Cox. "They can either participate in the presentation, which will explain the FAFSA process in detail, or they can bring the necessary paperwork with them and work on their **applications online**. Those students and their parents who would like to work on their FAFSA **applications online** should bring copies of their completed 2008 tax returns, copies of the student's and parents' W-2 forms, and balance statements from the family's non-retirement investment accounts. ...⁸

College admission offices across the country are increasingly receiving **applications online**, and some are even moving to completely paperless systems. But what does "paperless" mean? ...⁹

Candidates interested in attending the open house should submit an **application online** prior to attending. To submit an **application online**,

⁶ Id.

⁷ Chicago Tribune January 28, 2007.

⁸ US States News, February 2, 2007.

⁹ University Wire, October 3, 2007.

readers should ... click on "Careers" under the "About GEICO" tab.¹⁰

Based upon the recitation of services in the involved application, we find that that "computer services, namely, development and creation of software for web based applications to allow prospective college students to submit admissions applications online via a global computer network" is the name of a genus of services. Next, we must determine based upon the above-excerpted evidence of record whether the designation APPLICATIONSONLINE is understood by the relevant purchasing public primarily to refer to that genus of services.

On this record, we are constrained to find that the examining attorney has failed to show that the relevant purchasing public understands the designation APPLICATIONSONLINE primarily to refer to development and creation of software for web based applications to allow prospective college students to submit their admissions applications online via a global computer network. That is to say, the record falls short of establishing that the phrase APPLICATIONSONLINE is a generic term for these services. As it appears in the evidence of record, APPLICATIONSONLINE clearly describes a function, feature or

¹⁰ Business Wire, February 1, 2008.

characteristic of the services, namely, that the object of the identified services is to develop applications online. However, the evidence falls somewhat short of demonstrating that the public recognizes APPLICATIONSONLINE as a generic name for such software development services.

We find, based on the limited evidence of record, that the Office has not met the difficult burden of establishing by clear evidence that the designation APPLICATIONSONLINE, is generic for the identified services. *See In re Merrill Lynch, supra*. Genericness is a fact-intensive determination, and the Board's conclusion must be governed by the record that is presented to it. To the extent there remains any doubt about the genericness of applicant's designation, it is the record evidence bearing on purchasers' perceptions that controls the determination, not general legal rules or our own subjective opinions. Any doubts raised by the lack of evidence must be resolved in applicant's favor. *Id.* Further, on a different and more complete record, such as might be adduced by a competitor in an opposition proceeding, we might arrive at a different result on the issue of genericness.

Decision: The refusal of registration on the Supplemental Register, under Section 23 of the Trademark Act, is reversed.