

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

Mailed: October 6, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Integrity News Media, Inc.

Serial No. 77292701

Joseph Page for Integrity News Media, Inc., *Pro Se*

Rebecca L. Gilbert, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Walters, Bucher and Cataldo, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Integrity News Media, Inc. has filed an application to register on the Principal Register the standard character mark FASHION TOOLS for "providing a website featuring information and content in the fields of personal relationships, dating and fashion," in International Class

45.¹ The application includes a disclaimer of the word FASHION apart from the mark as a whole.

The examining attorney has issued a final refusal to register, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive in connection with its services.

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

The examining attorney contends that "applicant provides information and also 'content' which encompasses all types of content, including news and resources" (brief, unnumbered p. 4) and that information and content are "tools"; that the subject matter of these tools is fashion; and that the combination of the two words, fashion tools, merely describes a significant feature of applicant's website, namely that it provides information and content about fashion.

In support of her position, the examining attorney submitted definitions of "tool," "information" and "resource" as follows:

"tool" - "anything used as a means of accomplishing a task or purpose ..." (*Random House Unabridged Dictionary*, 2006, at

¹ Serial No. 77292701, filed October 1, 2007, based on use of the mark in commerce, alleging first use and use in commerce as of October 1, 2007.

www.dictionary.com) and "something regarded as necessary to the carrying out of one's occupation or profession: *Words are the tools of our trade*" (*American Heritage Dictionary of the English Language*, 4th ed. 2006, at www.dictionary.com).

"information" - "knowledge derived from study, experience, or instruction; ... a collection of facts or data: *statistical information*; the act of informing or the condition of being informed - communication of knowledge: *Safety instructions are provided for the information of our passengers*" (*American Heritage Dictionary of the English Language*, 3rd ed. 1992).

"resource" - "something that can be used for support or help: *The local library is a valuable resource*" (*Id.*).

The examining attorney also submitted copies of ten third-party registrations of marks containing the word "tools" for a variety of services. All but one of these registrations is either on the Supplemental Register or includes a disclaimer of "Tools." One of the registrations, no. 3348229 for the mark LOBBY TOOLS for a news clipping service, includes a disclaimer of "Lobby."

Additionally, the examining attorney submitted excerpts of articles from the Lexis/Nexis database demonstrating use of the term "tool." Several examples follow:

Information is the single most important thing that moves the global economy, influences political regimes, and constructs human behavior. It is a **tool** of our trade and a powerful ally..."
(www.metasecurity.net)

Murdoch is not interested in the goal of reporting the news to reveal the truth, but rather in the goal of using the news as a **tool** to manipulate the public to promote his right-wing agenda.
(www.politico.com)

The Chicago Manual of Style Online also provides convenient Tools, such as sample forms, letters, and style sheets. (www.chicagomanualofstyle.org)

Applicant contends that the examining attorney is applying an overly-broad definition of "tool"; that simply because "information and content" can be *used*, it does not follow that such is a "tool" or that the mark is merely descriptive. Rather, applicant contends that its use of "tools" is "highly figurative" and applicant makes the following argument:

It is entirely possible to use the adjective "tools" in conjunction with a noun whereby it would in fact be descriptive One might consider the fictitious trademark "Skate Tools." If the goods and services associated with the mark were those hand tools configured with particular regard for the hardware commonly used in skateboards - this trademark could be excluded as "merely descriptive." However, if the trademark "Skate Tools" were used in conjunction with special shoes used for skating, the mark would be quite interesting and fanciful; i.e., this use of the word "tools" would be *highly figurative* - and almost certainly not a literal meaning. Despite the fact that the shoes were indeed *used* for skating - and thus arguably meeting the extremely broad definition the examining attorney has allocated the word "tools" - "Skate Tools" is not descriptive of shoes. (*emphasis in original.*) (Brief, p. 5.)

In its brief, applicant included a list of third-party registered marks that include the word "tool," with registration numbers, and the examining attorney has objected thereto. We agree that this evidence is untimely and, therefore, it has not been considered. Moreover, this

list is not the proper form for submission of third-party registrations and, as such, it would be of little probative value. The list contains no information about the registrations, such as goods or services, disclaimers, or claims of acquired distinctiveness.

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). 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 Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). 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 Recovery*, 196 USPQ 830 (TTAB 1977).

As identified, applicant's website contains information about fashion. The evidence clearly establishes that the word "tool" is regularly used to refer to the use of various types of information. Because applicant's website contains fashion information, the website itself is a tool for those persons seeking fashion information. As such, FASHION TOOL is merely descriptive in connection therewith.

We are not convinced otherwise by applicant's argument about the fictional mark SKATE TOOLS for special shoes for skating. First, we do not necessarily agree that this fictional mark is not merely descriptive for the posited goods. Even if we were to agree with this assumption, we note that the word "tools" is not an adjective in either the fictional mark or the applied-for mark; rather, it is a noun. Moreover, it is the term "skate" in the fictional mark, not the term "tools," that could render the fictional mark suggestive because the proper phrasing of a descriptive term for special shoes for skating would be "skating tools." Finally, we do not have evidence about the use of the term "tools" in connection with shoes for skating from which to draw a conclusion about the likely perception of that term by the relevant purchasing public in connection with the posited goods. On the other hand, the record before us contains a substantial amount of evidence about the use of the term "tools" to describe the use of information, which

is relevant to the connotation of the term "tools" in connection with applicant's website services. As our primary reviewing court has stated, "a term may tilt towards suggestiveness or descriptiveness depending on the context and any other factor affecting public perception." *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Therefore, this is a classic example of the well established principle that registrability must be determined based on the facts in each particular case. *Id.*

In conclusion, when applied to applicant's services, the term FASHION TOOLS immediately describes, without conjecture or speculation, a significant feature or function of applicant's services, namely that applicant's website is a tool for obtaining fashion information and/or that applicant's website contains tools in the nature of information and content about fashion. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of, and prospective customers for, applicant's services to readily perceive the merely descriptive significance of the term FASHION TOOLS as it pertains to applicant's services.

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