

**THIS OPINION IS NOT A  
PRECEDENT OF THE T.T.A.B.**

Mailed:  
March 3, 2010

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Useful Networks, Inc.

Serial No. 77364008  
Serial No. 77364155

Jamie B. Bischoff and Troy E. Larson of Ballard Spahr LLP  
for Useful Networks, Inc.

Geoffrey Fosdick, Trademark Examining Attorney, Law Office  
111 (Craig D. Taylor, Managing Attorney)

Before Bucher, Bergsman and Ritchie,  
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Useful Networks, Inc. ("applicant") filed intent-to-use applications on the Principal Register for the mark USEFUL NETWORKS, in standard character form (Serial No. 77364008), and the mark USEFUL NETWORKS and design, shown below (Serial No. 77364155).



Serial No. 77364008

Serial No. 77364155

Applicant has sought to register its marks for the goods and services set forth below:

Computer software applications which employ the use of location and presence for locating persons, animals, personal property and automobiles; computer software platform for facilitating location and presence information exchange for use in locating persons, animals, personal property and automobiles, in Class 9; and

Computer software consulting services for the development of software employing the use of location and presence, in Class 42.

The Examining Attorney issued a final refusal for the USEFUL NETWORKS application, in standard character form, under Section 2(e)(1) of the Trademark Act of 1946, 15 U.S.C. §1052(e)(1), on the ground that USEFUL NETWORKS, when used in connection with applicant's computer software and software consulting services, is merely descriptive. With respect to the USEFUL NETWORKS and design application, the Examining Attorney issued a final requirement that applicant disclaim the exclusive right to use the term "Useful Networks" on the ground that "Useful Networks" is merely descriptive. See Section 6(a) of the Trademark Act of 1946, 15 U.S.C. §1056(a).

In an order dated August 26, 2009, the Board consolidated the appeals in these applications.

Serial No. 77364008

Serial No. 77364155

The Examining Attorney contends that the term USEFUL NETWORKS is merely descriptive because it directly conveys the fact that applicant's software and software consulting "utilize communication network devices to create useful social networks for its customers and clients."<sup>1</sup> To support the refusal and requirement for a disclaimer, the Examining Attorney submitted the following evidence:

1. A dictionary definition of the word "useful":

1: capable for being put to use;  
*especially:* serviceable for an end or purpose <*useful tools*>  
2: of a valuable or productive kind  
<do something *useful* with your life><sup>2</sup>

2. A dictionary definition of the word "network," with, *inter alia*, the following meanings:

3a: an interconnected or interrelated chain, group or system <a *network* of hotels>  
b: a system of computers, peripherals, terminals and databases connected by communications lines

\* \* \*

5: a usually informally interconnected group or association of persons (as friends or professional colleagues)<sup>3</sup>

---

<sup>1</sup> Examining Attorney's Brief, unnumbered page 5.

<sup>2</sup> *Merriam-Webster Online* (no url or date provided).

<sup>3</sup> *Id.*

Serial No. 77364008

Serial No. 77364155

3. An excerpt from applicant's website that promotes the ability of applicant's software to "[use] location to bring people closer together, a natural extension of the social networking phenomenon."<sup>4</sup> Also, the excerpt from applicant's website describes applicant's software as providing a platform for allowing computer applications to incorporate location data. For example:

Useful Networks is committed to simplifying mobile location for all partners in the mobile content ecosystem.

Location aware marketing allows businesses to increase effectiveness of advertising spend (sic), and lets customers learn about products and services which are relevant to them.

Mobile customers need to know what is going [on] in the world around them. Instant access to locally relevant content makes the mobile experience infinitely more useful.

The UN Platform streamlines the process of on-boarding 3<sup>rd</sup> party content providers who require location.

The UN Platform gives customers total control over who, what, when and how they can be located.

Applicant contends that "Useful Networks" is not merely descriptive because it takes a multiple step reasoning process "to conclude that products bearing this

---

<sup>4</sup> No date or URL provided.

Serial No. 77364008

Serial No. 77364155

mark are for use in physically locating people." In addition, applicant asserts that USEFUL NETWORKS "merely suggests a desirable end result of Applicant's goods and services, without describing the goods and services themselves" and the composite mark "evokes a unique commercial impression apart from any sense conveyed by the individual components."<sup>5</sup> Applicant submitted the following evidence to support its contention that USEFUL NETWORKS is not merely descriptive:

1. An excerpt from applicant's website showing that applicant's software and services employ mobile location technology.<sup>6</sup> Essentially, applicant's software "is a toolset that application developers can apply to use Location Based Services (LBS) across multiple carriers."<sup>7</sup>

2. Copies of nine registrations on the Principal Register for software products and/or services that consist

---

<sup>5</sup> Applicant's Brief, pp. 5-6.

<sup>6</sup> [www.useful-networks.com](http://www.useful-networks.com).

<sup>7</sup> "Location-based service" is "a service provided to a wireless mobile device based on the device's location. Location-based services can range from simple services, such as listing nearby restaurants, to more complex features such as connecting to the Internet to monitor traffic conditions and find the least congested route to a destination." Microsoft Computer Dictionary, p. 316 (5<sup>th</sup> ed. 2002). 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).

Serial No. 77364008

Serial No. 77364155

in part of the words "use," "user," or "useful" without a disclaimer or a claim of acquired distinctiveness.

3. A second excerpt from applicant's website to show that "[a]pplicant's products are location-based software programs that combine multiple different technologies, including mobile communication technologies, geographic positioning, and information systems to find people." Applicant's software applications, *inter alia*, "allow users to get information and find local businesses based on proximity. Maps and turn-by-turn navigation provides (sic) users with not only the what, but the where, and how to get there."

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the products it identifies. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the products or services for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the question is not whether someone presented with only the mark could guess what the goods or

Serial No. 77364008

Serial No. 77364155

services are. Rather, the question is whether someone who knows what the goods and services are will immediately understand the mark as directly conveying information about them (*i.e.*, whether someone familiar with location-based services will understand that the term "Useful Networks" directly conveys information about them). *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1317 (TTAB 2002); *see also In re Patent and Trademark Services, Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998).

Based on the record, it is clear that applicant's location-based software applications and consulting services related to such software applications create "useful networks" (*i.e.*, valuable connections between users and service providers). While the term "useful networks" does not in and of itself directly convey that the software applications and services related thereto involve location-based services, it is a laudatory term and merely descriptive of the goods and services because it describes a quality that all networking software and services aspire to achieve (*i.e.*, to make useful connections for its users). In this regard, a laudatory term that describes the merits of the goods and/or services is merely descriptive because it describes the characteristics or quality of the goods in a condensed form. *In re Nett Designs Inc.*, 236 F.3d 1339,

Serial No. 77364008

Serial No. 77364155

57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (THE ULTIMATE BIKE RACK found to be merely descriptive and, therefore, subject to disclaimer); *see also In re Best Software Inc.*, 63 USPQ2d 1109, 1111 (TTAB 2002) (the term "Best" in the mark BEST! IMPERATIV HRMS is merely descriptive, in a laudatory sense, of applicant's software and, therefore, must be disclaimed); *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 (TTAB 1998) (QUESO QUESADILLA SUPREME for cheese is merely descriptive because "Queso Quesadilla is a generic term for a type of cheese and "supreme" is a laudatory term); *In re Consolidated Cigar Co.*, 35 USPQ2d 1290, 1293 (TTAB 1995) (SUPER BUY merely descriptive of tobacco products). Computer software utilizing location and presence capability and consulting services regarding such location-based technology increases the usefulness the software applications derived by the users of the programs and associated communication devices and, therefore, is the epitome of a "useful network."

Applicant's argument that the term USEFUL NETWORKS does not convey any information regarding software and services related to locating people misses the point. The term USEFUL NETWORKS is a condensed form of describing the outstanding quality of the software and software consulting services to which it is applied (*i.e.*, creating valuable



Serial No. 77364008

Serial No. 77364155

connections between users and service providers). Such a laudatory expression would not be indicative of origin to the purchasing public. For the same reasons, we are not persuaded by applicant's argument that USEFUL NETWORKS merely suggests a desirable result. To the contrary, we find that the term USEFUL NETWORKS directly describes the purpose of applicant's goods and services; that is, the creation of useful networks of mobile communication device users.

Applicant's argument that the term USEFUL NETWORKS "evokes a commercial impression apart from its individual components" is equally unavailing. In determining whether a mark is merely descriptive, we must consider the mark in its entirety. As argued by applicant, common words may be descriptive when standing alone, but when used together in a composite mark, they may become a valid trademark because the combination has a unique commercial impression apart from the individual components.<sup>8</sup> See *Concurrent Technologies Inc. v. Concurrent Technologies Corp.*, 12 USPQ2d 1054, 1057 (TTAB 1989). However, if each component retains its descriptive significance in relation to the goods and services, without the composite term creating a

---

<sup>8</sup> Applicant's Brief, pp. 10-12.

Serial No. 77364008

Serial No. 77364155

unique or incongruous meaning, then the resulting combination is also merely descriptive. *In re Tower Tech., Inc.*, 64 USPQ2d at 1317-18. In this regard, we find that when the words "Useful" and "Networks" are combined together, as applicant has combined them, they retain their laudatory, descriptive meaning in relation to the goods and services without the composite term creating a unique or incongruous meaning.

Finally, applicant argues that the Examining Attorney has not submitted any evidence "that USEFUL and NETWORKS are commonly used in combination with one another, or that they are readily identified as belonging to common or practical word formulations."<sup>9</sup> However, the fact that an applicant may be the first and only user of a merely descriptive term does not justify registration if the only significance conveyed by the term is merely descriptive. *See In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001); *In re Acuson*, 225 USPQ 790, 792 (TTAB 1985).

In view of the foregoing, we find that the term USEFUL NETWORKS for the goods and services identified in the applications is merely descriptive.

---

<sup>9</sup> Applicant's Brief, p. 11.

Serial No. 77364008

Serial No. 77364155

**Decision:** The refusal to register the mark USEFUL NETWORKS, in standard character form (Serial No. 77364008) is affirmed and registration to applicant is refused.

In the application for the mark USEFUL NETWORKS and design (Serial No. 77364155), the requirement that applicant disclaim the exclusive right to use the term "Useful Networks" is affirmed and registration to applicant is refused. However, in the event that applicant submits the required disclaimer within thirty days from the mailing date of this decision, the refusal to register will be set aside and the application will proceed to publication.<sup>10</sup> See Trademark Rule 2.142(g).

---

<sup>10</sup> A proper disclaimer would read: "No claim is made to the exclusive right to use Useful Networks apart from the mark as shown."