

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

Mailed: November 21, 2011

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Georgia Department of Administrative Svcs.

Serial No. 77792242

Peter J. Pawlak Jr. of The Pawlak Law Firm for Georgia  
Department of Administrative Svcs.

Jessica A. Powers, Trademark Examining Attorney, Law Office  
104 (Chris Doninger, Managing Attorney).

Before Holtzman, Cataldo and Lykos,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Georgia Department of Administrative Svcs.,  
has filed an application to register as a trademark on the  
Principal Register the standard character mark TEAM GEORGIA  
MARKETPLACE for the following services, as amended:

Ordering and procurement services, namely,  
procuring of contracts for others for the  
purchase of goods and labor contracting services,  
and managing budgets, creating and managing bid  
activity, collecting and centralizing purchasing  
information, providing data on purchasing habits,  
and integrating processes with other parties,  
namely, business assistance, advisory services  
and consultancy all offered via the Internet;

business services, namely, registering, screening, credentialing and organizing third-party vendors, suppliers, and contractors, and documentation and information on behalf of others; assisting with the management of government contracts with public sector entities

in International Class 35.<sup>1</sup> In response to the examining attorney's requirement for a disclaimer of GEORGIA MARKETPLACE, applicant submitted a disclaimer of GEORGIA.

The examining attorney refused registration pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a), based on applicant's failure to comply with the requirement to disclaim the word MARKETPLACE on the ground that it is merely descriptive of applicant's services within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). When the refusal was made final, applicant appealed.<sup>2</sup> Applicant and the examining attorney have filed

---

<sup>1</sup> Application Serial No. 77792242, filed on July 29, 2009, based on an allegation of January 1, 2009 as a date of first use of the mark in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a). Applicant divided additional services in Class 42 into a "child" application with a disclaimer of GEORGIA.

<sup>2</sup> In its brief on appeal, applicant cites to TBMP § 1204 (3d ed. 2011) in support of its argument that because it did not address the disclaimer issue in its request for reconsideration, the examining attorney's arguments and evidence on the issue submitted with her denial thereof should be inadmissible. However, none of the authorities cited in § 1204 support applicant's apparent position that it may prevent the examining attorney from presenting arguments and evidence on an outstanding issue on final refusal by declining to address that issue in its request for reconsideration. Nor has applicant cited any additional authority for its position. Accordingly, applicant's request to strike the examining attorney's arguments and evidence directed toward the disclaimer of MARKETPLACE in her denial of applicant's request for reconsideration is denied.

briefs on the issue under appeal.

We affirm the refusal of registration in the absence of a disclaimer in the application.

An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6(a). Merely descriptive terms are unregistrable, under Trademark Act Section 2(e)(1) and, therefore, are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (CCPA 1975); *In re Ginc UK Ltd.*, 90 USPQ2d 1472 (TTAB 2007); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977); and *In re Pendleton Tool Industries, Inc.*, 157 USPQ 114 (TTAB 1968).

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). A term need not immediately convey an idea of each and

every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

The examining attorney argues that

...the wording GEORGIA MARKETPLACE is merely geographically descriptive in relation to the applicant's ordering, procurement and business services taking place in or specifically targeting businesses that operate in the state of Georgia and further that the term MARKETPLACE is itself descriptive of a characteristic of those services, namely, buying, selling and general economic activity.<sup>3</sup>

In support of the refusal, the examining attorney made of record with her Office actions a number of dictionary definitions for the word MARKETPLACE. According to these definitions, MARKETPLACE may be defined as follows:

sphere of trading: the commercial sphere where buying and selling takes place and the laws of supply and demand operate  
Encarta World English Dictionary  
([encarta.msn.com](http://encarta.msn.com));

a competitive or commercial arena  
Compact Oxford English Dictionary  
([askoxford.com](http://askoxford.com));

a set of trading conditions or the business environment

---

<sup>3</sup> Examining attorney's brief, p. 4.

Cambridge Advanced Learners Dictionary  
(dictionary.cambridge.org);

the world of trade and commerce  
Wordsmyth  
(wordsmyth.net); and

the world of trade, business, economic affairs,  
etc., often used figuratively  
Your Dictionary  
(yourdictionary.com).

The examining attorney further made of record copies of pages from commercial and informational Internet websites in which the term GEORGIA MARKETPLACE is used in connection with various business-related services. The following examples are illustrative:

There are many reputable residential lenders in the Georgia marketplace. However, there appears to be enough fraud and predatory mortgage originations to make both Congress and state legislators pass anti-predatory mortgage laws. Predatory brokers and lenders can, and do, cause problems for reputable brokers and lenders, as well as consumers.  
(hansonmortgagecompany.com);

Community Publications  
Middle Georgia Guidebook - The Middle Georgia Guidebook is The Telegraph's comprehensive guide to life in middle Georgia. The Guidebook contains information on community, work, religion and sports.  
Forecast - Get the new year off to a great start by utilizing the power of Forecast. This annual business and industry guide features eight themed sections from automotive to health to the middle Georgia marketplace.  
(mcclatchy.com);

Ser. No. 77792242

WestGEORGIA MARKETPLACE  
SHOP. SAVE. SMILE.  
Home/Douglas County Sentinel/Times-  
Georgian/Advertiser A-Z/Stores/Special  
Sections/E-mail Alert/View Saved Ads  
(print2webcorp.com);

Countdown To Buy Now Features Foreclosed Homes in  
Georgia With Prices That Reduce 1% Per Day.  
Countdown to Buy, a next generation online real  
estate marketplace that offers fair and effective  
solutions to buy and sell properties, announced  
today that it has entered the Georgia marketplace  
and will be featuring recently foreclosed  
properties in 17 communities to potential home  
buyers.

(kansascity.dbusines.com); and

... An especially significant accomplishment for  
the Company was our entry into the Georgia  
marketplace with the opening of 'Seasons at  
Laurel Canyon.' 'Seasons at Laurel Canyon' is an  
active adult community located just outside  
Atlanta in Canton and will offer 766 single-  
family one-story homes.

(webcache.googleuserscontent.com).

Finally, the examining attorney made of record copies of  
third-party registrations in which the term MARKETPLACE is  
disclaimed in marks on the Principal Register or registered  
on the Supplemental Register as used in connection with  
services similar to those recited in the involved  
application. The following examples are illustrative:  
Registration No. 3097056 on the Principal Register for the  
mark MY FLORIDA MARKET PLACE and design with FLORIDA  
MARKETPLACE disclaimed for services including

Ser. No. 77792242

promoting the sale of goods and services to the State of Florida by providing information on State of Florida procurement practices; information in the field of government affairs;

Registration No. 3374897 on the Principal Register for the mark G GENCO MARKETPLACE with MARKETPLACE disclaimed for

On-line, multichannel inventory disposition services, namely, inventorying merchandise, ordering and inventory monitoring of electronics, apparel, toys, hardware, jewelry, baby goods, general merchandise, furniture, sporting goods, shoes, food, auto goods, computer/IT goods, domestic/home goods, marketing of merchandise for others, infomediary services, namely, facilitating transactions between buyers and sellers through providing buyers with information about sellers, goods and/or services with respect to liquidated, returned, discontinued and overstocked inventories, and operating on-line marketplaces for sellers of goods and/or services; and

Registration No. 3034422 on the Principal Register under Section 2(f) for the mark EMARYLAND MARKETPLACE with MARKETPLACE disclaimed for

On-line procurement, namely purchasing of computer equipment and supplies, sanitary supplies, office equipment, office supplies, food, personal hygiene supplies, and homeland security purchases for first responders, lawn and garden tools, hand tools, and the like, and services namely maintenance of State owned and leased properties including guard, janitorial, snow removal and trash removal services, architectural and other professional services, public improvements including any construction, maintenance, or repair of any building, structure or other public work, for local governmental entities and independent contractors doing

business with the State of Maryland, all in accordance and in compliance with applicable laws and regulation.

We find that the examining attorney has made a prima facie case that the word MARKETPLACE used in connection with applicant's services is descriptive. In this case, the word MARKETPLACE clearly and unambiguously describes a significant feature of the services, namely, ordering and procuring, business assistance, and assisting with government contract management within a set of trading conditions or business environment or commercial sphere. We also find that the word MARKETPLACE when combined with the word GEORGIA does not lose its descriptive significance. To the contrary, the wording GEORGIA MARKETPLACE merely describes the provision of ordering and procuring, business assistance, and assisting with government contract management within the business environment or commercial sphere comprising the State of Georgia.

Applicant argues "[w]ithout any specificity or even mention of any good or service in the definitions, it will surely take some imagination and reasoning to conclude that 'MARKETPLACE' is related to Applicant's government-run



contract-management software services.”<sup>4</sup> In short, it is applicant’s position that MARKETPLACE is too vague to describe applicant’s services. However, our determination of whether MARKETPLACE, either alone or in connection with GEORGIA, merely describes applicant’s services is based upon the services recited in the involved application. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). The evidence made of record by the examining attorney shows use of MARKETPLACE as a descriptive term in connection with a variety of business-related services of a type similar to applicant’s recited services. In addition, the evidence shows that GEORGIA MARKETPLACE is a geographically descriptive term identifying the business or commercial sphere comprising the State of Georgia in connection with real estate mortgage lending, the provision of business and industry information, and real estate sale and development. Applicant provides, *inter alia*, contract procurement, purchasing information, screening, credentialing and organizing of vendors, business assistance and advice directed to the Georgia commercial sphere or GEORGIA MARKETPLACE. As a result, the term MARKETPLACE is not so vague that consumers will not understand its meaning in relation to applicant’s services.

---

<sup>4</sup> Applicant’s brief, p. 8.

In addition, applicant contends that the word MARKETPLACE "does not merely describe a feature of the services, but rather at most suggests or alludes to a characteristic or feature."<sup>5</sup> Applicant concludes that while "the term 'MARKETPLACE' conveys some information to the consuming public regarding a feature or characteristic of Applicant's services, the term does not merely describe the nature of Applicant's services."<sup>6</sup> In the context of applicant's services, contrary to applicant's argument, we find the term MARKETPLACE to be sufficiently specific as to be descriptive rather than one step removed and suggestive. The word MARKETPLACE in the mark simply describes a significant feature of the services as discussed above, namely, that they are directed toward a specific business environment or commercial sphere. Because that commercial sphere comprises the State of Georgia, the wording GEORGIA MARKETPLACE is geographically descriptive of that feature of applicant's services.

With its response to the examining attorney's Office actions, applicant submitted lists of third-party registrations and applications for various MARKETPLACE formative marks. This is not the proper way to make such

---

<sup>5</sup> Id. at 12.

<sup>6</sup> Id. at 13.

applications and registrations of record. See *In re Volvo Cars of North America Inc.*, 46 USPQ2d 1455 (TTAB 1998). However, because the Examining Attorney did not advise applicant that the listing was insufficient at a point where applicant could have corrected the error, the listings of applications and registrations are deemed to have been stipulated into the record, to the extent that the specific data provided by applicant has been considered. See TBMP §1208.02 (3d ed. 2011). We also point out, however, that the lists have no probative value since they do not show the goods or services for which the marks were registered. In addition, many of the listed marks are for applications, rather than registrations. Third-party applications have no evidentiary value other than to show that they were filed. *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1699 (TTAB 1992).

Finally, applicant submitted a third-party registration on the Principal Register for the mark TEXAS MARKETPLACE with no disclaimer for services including "business resource referral services"<sup>7</sup> to show that the USPTO has treated the word MARKETPLACE as not descriptive by not requiring a disclaimer. The most that can be said

---

<sup>7</sup> Registration No. 1788409.

of this evidence is that it is inconclusive. In fact, this registration highlights why prior decisions in other applications are not binding on the Board and underscore the need to evaluate each case on its own record. *In re Nett Designs Inc.*, 57 USPQ2d 1564.

**Decision:** The refusal to register based on the requirement for a disclaimer of MARKETPLACE is affirmed. However, if applicant submits the required disclaimer of MARKETPLACE to the Board within thirty days, this decision will be set aside as to the affirmance of the disclaimer requirement.<sup>8</sup> See Trademark Rule 2.142(g), 37 C.F.R. § 2.142.

---

<sup>8</sup> The standardized printing format for the required disclaimer text is as follows: "No exclusive right to use GEORGIA MARKETPLACE is claimed apart from the mark as shown." TMEP § 1213.08(a) (8<sup>th</sup> ed. 2011).