

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

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re West Corp.

Serial No. 78739755

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Michael G. Lewis, Trademark Examining Attorney, Law Office
111 (Craig D. Taylor, Managing Attorney).

Before Hohein, Cataldo and Bergsman,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

West Corp. has applied to register the mark
CONFERENCECALL.COM in standard character form on the
Principal Register for the following services, as amended:
"telecommunications services, namely audio and video
teleconferencing."¹

¹ Application Serial No. 78739755 was filed on October 25, 2005 based upon applicant's assertion of July 7, 2000 as the date of first use of the mark anywhere and in commerce in connection with the services. Applicant subsequently amended the application to seek registration under Trademark Act Section 2(f).

The trademark examining attorney has refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark is generic, and thus incapable of functioning as a source identifier. In response, applicant argued that its mark is merely descriptive of its services and amended its application to seek registration under Trademark Act Section 2(f). The examining attorney rejected applicant's claim of acquired distinctiveness and continued the refusal to register under Trademark Act Section 2(e)(1) on the ground that the mark is generic.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs on the issue under appeal.

Applicant acknowledges that its CONFERENCECALL.COM mark is merely descriptive of the services recited in its subject application, but argues that such mark has acquired distinctiveness as used in connection therewith. In addition, applicant argues that the examining attorney has failed to provide sufficient support for his argument that CONFERENCECALL.COM is generic for applicant's services.

The examining attorney argues that CONFERENCECALL.COM is generic as applied to applicant's recited services and that, as a result, the designation is incapable of

acquiring distinctiveness under Trademark Act Section 2(f) and is unregistrable. The examining attorney further argues that applicant's evidence is insufficient to support its claim of acquired distinctiveness.

Evidentiary Matters

Before turning to the substantive ground for refusal, we note that applicant has submitted several exhibits with its brief. These exhibits consist of a printed "screen shot" from applicant's Internet web page; a printed copy of a portion of the results of a search of "conference call" on the Google Internet search engine; and a copy of applicant's previously submitted declaration in support of its Section 2(f) claim. Inasmuch as the declaration is already of record, its submission as an exhibit to applicant's brief is cumulative and, therefore, unnecessary. With regard to the "screen shot" and Google search results, we agree with the examining attorney that these exhibits are untimely, and they have not been considered. See Trademark Rule 2.142(d) (the record in the application should be complete prior to the filing of an appeal). We note, however, that had we considered these exhibits in our determination of the issue on appeal, the result would be the same.

In addition, the examining attorney submitted a dictionary definition of "genus" in his brief on appeal. It is settled that the Board may take judicial notice of dictionary definitions, including online dictionaries, which exist in printed format. *See In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002); and *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982); *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). However, inasmuch as we have not relied upon the examining attorney's proffered definition of "genus" in our determination herein, we decline to take judicial notice thereof.

Issues on Appeal

The issues on appeal are (1) whether the term CONFERENCECALL.COM is generic for applicant's services under Trademark Act Section 2(e)(1); and, alternatively, (2) if such term is not generic, but rather merely descriptive of applicant's services, whether it has acquired distinctiveness under Trademark Act Section 2(f).

Genericness

A term is generic and not a mark 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.*, *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 this case, the examining attorney has submitted the following definitions of "conference call":

n. a telephone call by which a caller can speak with several people at the same time;² and

² Merriam-Webster OnLine, www.m-w.com.

n. a conference by telephone in which three or more persons in different locations participate by means of a central switching unit.³

The examining attorney also has submitted the following encyclopedia entries (emphasis added) for "conference call":

A **conference call** is a telephone call in which the calling party wishes to have more than one called party listen in to the audio portion of the call. The **conference calls** may be designed to allow the called party to participate during the call, or the call may be set up so that the called party merely listens into the call and cannot speak. It is often referred to as an ATC (**Audio Tele-Conference**);⁴

and "video conferencing":

video conferencing uses telecommunications of audio and video signals to bring people at different sites together for a meeting. This can be as simple as a conversation between two people in private offices (point-to-point) or involve several sites (multi-point) with more than one person in large rooms at different sites. Besides the audio and visual transmission of people, **video conferencing** can be used to share documents, computer-displayed information, and whiteboards.⁵

³ The American Heritage Dictionary of the English Language: Fourth Edition, 2000.

⁴ www.en-wikipedia.org. We have considered this Wikipedia evidence because it essentially is cumulative of and is corroborated by the other evidence of record, and because it was made of record early enough to give applicant the opportunity to challenge or rebut it. See *In re IP Carrier Consulting Group*, ___ USPQ2d ___, 2007 Westlaw 1751192 (TTAB) (Serial Nos. 78542726 and 78542734, June 18, 2007). We note that, in this case, applicant has not challenged such evidence beyond its general contention that the totality of the examining attorney's evidence is insufficient to support his position.

⁵ Id.

In addition, we take judicial notice of the following definition of "teleconference":

n. a conference held among people in different locations by means of telecommunications equipment, such as closed-circuit television. (teleconferencing n.)⁶

The examining attorney further has submitted evidence from commercial Internet websites indicating that the term "conference call" is used to refer to audio or video teleconferencing. See, for example (emphasis added):

StartConferencing.com uses the latest **audio conferencing** technology and clear digital connections to provide the most reliable and highest quality **conference call** experience. Our **audio conferencing** service is very simple to use, but has all the features you need to host a successful **conference call** such as free digital replay, recording your **conference call** to CD, roll call, conference assistance and expanded host controls. ... With the ability to host up to 125 participants in your **conference call** and access to toll free numbers, our service can handle your company's growing **audio conferencing** needs.
(www.starconferencing.com)

AccuConference offers quality **conference call** services with industry-leading customer support. Choose from any **conference call** packages and receive the tools you need to keep your participants engaged. ... **Video conferencing** is also available which will let you meet "face-to-face" regardless of location. Now everyone can see and hear the exact same thing.
(www.accuconference.com)

⁶ The American Heritage Dictionary of the English Language: Fourth Edition, 2000.

Conduct meetings faster and more efficiently with PGI ReadyConference Plus. Our conferencing service is ideal for whatever your **conference call** needs are. We are dedicated to improving your business communications and ensuring your **conference calls** run smoothly each time.

In addition, Premiere Global Services offers many other **conference call** solutions to help you reduce business costs and improve productivity: **Audio Conferencing** - Many more options available including International access.
(www.premiereglobal.com)

From 800 voice mail to flat rate **conference calling**, don't settle for less. . .get the best! We specialize in promotional discounted teleconferencing and flat rate **conference calling** at its best.

Our **teleconferencing services** include everything from 800 **conference calls** and the flat rate **conference call** to web conferencing and **video conferencing**. But there's more. . .we also feature flat rate 800 voicemail services (that's right, toll free voicemail).
(www.bowsconferencecalling.com).

The determination of whether a term is generic involves a two-part inquiry: First, what is the category or class of the goods or services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that category of goods or services? See *H. Marvin Ginn Corp., supra*. With respect to the first part of the genericness inquiry, we find based upon the above evidence that the class or category of services at issue here is "telecommunications services, namely audio and video teleconferencing." Indeed, we note that "screenshots" from applicant's own Internet website,

timely submitted as evidence by the examining attorney,
indicate that applicant is engaged in providing
teleconferencing services.

Organizing a **Conference Call**

To help you plan & organize your **teleconferences**,
try these tools:

Conference Call Checklist

Use this list to make sure you haven't forgotten
anything important, and to improve the way you
manage your **conference calls**!

Meeting Agenda Form

Fill out this form, and keep it in front of you
during your **conference call** to keep you on track!
Or send it to your participants ahead of time so
that they will be better prepared for your
meeting!

Meeting Minutes Form

Keep track of the progress of your **conference
call** agenda and new topics for future meetings
with this form.

Feedback Form

Have your participants fill out this form after
the **conference call** is completed, so that you can
review their impressions of the meeting. This is
also a handy way to field any question that your
participants might have been reluctant to ask
while on the phone!

(www.conferencecall.com).

We next turn to the second step of the *Ginn* inquiry,
that is, whether the relevant public understands the term
CONFERENCECALL.COM to refer to that category of services.
We find that the term is so understood.

There appears to be no dispute that the relevant
public for applicant's services consists of all typical
customers of the services, including those who would need
to arrange and conduct audio and video teleconferences for

business or personal needs. We have considered all the evidence of record bearing on purchaser perception of CONFERENCECALL.COM, including the evidence submitted by applicant in opposition to the refusal to register. See *In re Northland Aluminum Products, supra.*; and *In re The Paint Products Co.*, 8 USPQ2d 1863 (TTAB 1988).

The evidence of record, including evidence from applicant's own Internet website, clearly establishes that conducting a "conference call" is the focus, or a key focus, of applicant's audio and video teleconferencing services. Because the term "conference call" names a key aspect of applicant's services, i.e., a central purpose of applicant's teleconferencing services, the term is generic for such services.

The term CONFERENCECALL.COM is no more registrable than the generic word "conference call" alone. We take judicial notice of the following definition of ".com" as "ABBREVIATION: commercial organization (in Internet addresses)."⁷ We further take judicial notice of the following definition of "TLD" as "(Top-Level-Domain) The Highest level domain category in the Internet domain naming system. There are two types, the generic top-level

⁷ The American Heritage Dictionary of the English Language, (4th Ed. 2000)

domains, such as .com, .org, and .net..."⁸ The term ".com," in itself, has no source-identifying significance. See *In re Hotels.com, L.P.*, 87 USPQ2d 1100 (TTAB 2008). Rather, it serves only to signify that the user of the domain name is a commercial entity, and that the goods or services offered by the entity involve use of the Internet. See *Id.* See also *In re Oppendahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004).

We are not persuaded by applicant's argument that the combination of "conference call" and ".com" "adds distinction to the mark."⁹ "While there is no bright-line rule that appending a top-level domain name such as '.com' to an otherwise generic term will never affect registrability (see *Oppendahl*, *supra*), in this case it does not." See *In re Hotels.com*, *supra*, at 1114. The terms "conference call" and ".com" both have clear and readily understood meanings, and the combined term communicates just as clearly and directly that applicant operates a commercial Internet website that enables users to conduct conference calls. Our primary reviewing court has held that "the PTO has satisfied its evidentiary burden [on genericness] if ... it produces evidence including dictionary

⁸ McGraw Hill Computer Desktop Encyclopedia (9th ed. 2001).

⁹ Applicant's brief, p. 5.

definitions 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." *See In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987).

It is clear from the website of applicant as well as the websites of third-parties that consumers who are interested in arranging or conducting conference calls would immediately understand that CONFERENCECALL.COM identifies a website that provides such services. In addition, this evidence demonstrates a competitive need for others to use as part of their own domain names, trademarks and service marks, the term that applicant is attempting to register. Thus, the designation sought to be registered should not be subject to exclusive appropriation, but rather should remain free for others in the industry to use in connection with their teleconferencing services. *See In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999).

Therefore, we conclude that the examining attorney has met the substantial burden of establishing that CONFERENCECALL.COM is generic and hence incapable of identifying and distinguishing the source of the identified services.

Acquired Distinctiveness

Implicit in our holding that the evidence before us establishes that CONFERENCECALL.COM is generic for applicant's services is a holding that CONFERENCECALL.COM is at least merely descriptive of applicant's services under Section 2(e)(1). "The generic name of a thing is in fact the ultimate in descriptiveness." *H. Marvin Ginn Corp., supra*, at 530.

In finding that the designation CONFERENCECALL.COM is incapable of being a source identifier for applicant's services, we have considered, of course, all of the evidence touching on the public perception of this designation, including the evidence of acquired distinctiveness. As to acquired distinctiveness, applicant has the burden to establish a prima facie case of acquired distinctiveness. *See Yamaha International Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988).

Applicant submitted the declaration under Trademark Rule 2.20 of Robert Wise, its vice-president of marketing, stating that applicant has made substantially exclusive and continuous use of CONFERENCECALL.COM in commerce in connection with the services provided by applicant for over five years prior to the date upon which the claim of

distinctiveness is made. Applicant asserts in addition that its sales in 2006 exceeded \$20 million; that also in 2006, applicant's Internet website received over 100,000 visitors; and that further in 2006, applicant spent nearly \$1 million on advertising on various Internet search engines, including Google, Yahoo, and MSN.

Applicant's long use and revenues suggest that applicant has enjoyed a degree of business success. Nonetheless, this evidence demonstrates only the relative popularity of applicant's services, not that the relevant customers of such services have come to view the designation CONFERENCECALL.COM as applicant's source-identifying service mark. *See In re Bongrain International Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); and *In re Recorded Books Inc.*, 42 USPQ2d 1275 (TTAB 1997). The issue here is the achievement of distinctiveness, and the evidence falls far short of establishing this. Notably, the record is completely devoid of evidence that the relevant classes of purchasers of applicant's services recognize CONFERENCECALL.COM as a distinctive source indicator for such services.¹⁰

¹⁰ We are not implying that an applicant must submit affidavits or declarations asserting recognition of the subject matter sought to be registered as a mark, or that applicant must submit survey evidence, or that any other specific type of evidence is required to prove that a term has acquired distinctiveness. Nonetheless,

Accordingly, even if the designation CONFERENCECALL.COM were found to be not generic, but merely descriptive, given the highly descriptive nature of the designation CONFERENCECALL.COM, we would need to see a great deal more evidence (especially in the form of direct evidence from customers) than what applicant has submitted in order to find that the designation has become distinctive of applicant's services. That is to say, the greater the degree of descriptiveness, the greater the evidentiary burden on the user to establish acquired distinctiveness. See *Yamaha Int'l. Corp. v. Hoshino Gakki Co., supra*; and *In re Merrill Lynch, Pierce, Fenner & Smith, Inc., supra*. The sufficiency of the evidence offered to prove secondary meaning should be evaluated in light of the nature of the designation. Highly descriptive terms, for example, are less likely to be perceived as trademarks and more likely to be useful to competing sellers than are less descriptive terms. More substantial evidence of secondary meaning thus will ordinarily be required to establish their distinctiveness.

we require evidence clearly demonstrating the effectiveness of applicant's use of its designation to cause the purchasing public to identify the subject matter sought to be registered with the source of the product. Such evidence is not present in this case.

Decision: The refusal under Section 2(e)(1) of the Act on the ground that the proposed mark is generic is affirmed; the refusal under Section 2(e)(1) of the Act on the ground that the mark is at least merely descriptive and the Section 2(f) showing is insufficient is likewise affirmed.