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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tofasco of America, Inc.

Serial No. 85069228

Reid Eric Dammann of Musick Peeler LLP for Tofasco of America, Inc.

Dominick J. Salemi, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Cataldo, Taylor and Shaw,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Tofasco of America, Inc. has applied to register the mark IPEN, in standard character form, on the Principal

Register for the following goods and services:

"digital pen" in International Class 9; and

"online retail store services featuring computer peripherals, namely, digital pens" in International Class 35.¹

¹ Application Serial No. 85069228 was filed on June 23, 2010 based upon applicant's assertion of its bona fide intent to use the mark in commerce in connection with the recited goods and services.

The trademark examining attorney refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark is merely descriptive of a feature or quality of applicant's goods and services. When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs on the issue under appeal.²

A mark is merely descriptive if "it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]." *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976) (emphasis added). See also *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); and *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). The question is not whether someone presented only with the mark could guess the products listed in the description of goods. Rather, the issue is whether someone who knows what

² With its appeal brief, applicant has attached approximately fifty pages of exhibits consisting of materials previously made of record during prosecution of the involved application. Applicant is reminded that the application file is before the Board when it decides an appeal, and there is no need to resubmit materials that are already in the file. See *In re SL&E Training Stable Inc.*, 88 USPQ2d 1216, 1220 n. 9 (TTAB 2008). It is of far more utility to the Board for the applicant and examining attorney to provide citations directly to the record and, when there are a large number of attachments to an Office action or response, to the specific page number where the attachment may be found.

the goods or services are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); and *In re Patent & Trademark Servs. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998).

If, however, when goods or services are encountered under a mark, a multistage reasoning process, or resort to imagination, is required in order to determine the attributes or characteristics of the product or services, the mark is suggestive rather than merely descriptive. See *In re Abcor Development Corp.*, 200 USPQ at 218; and *In re Atavio*, 25 USPQ2d 1361, 1362 (TTAB 1992). To the extent that there is any doubt in drawing the line of demarcation between a suggestive mark and a merely descriptive mark, such doubt is resolved in applicant's favor. *In re Atavio*, 25 USPQ2d at 136. The examining attorney bears the burden of showing that a mark is merely descriptive of the identified goods or services. See *In re Merrill, Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 21567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

With his Office actions, the examining attorney submitted a dictionary definition from dictionary.com of "pen." Based upon this definition, "pen" may be defined as

"any of various instruments for writing or drawing with ink or a similar substance." In addition, the examining attorney made of record an article from LuckyRegister.com excerpted below:³

POPULAR DOMAIN NAMES PREFIXES - "E" AND "I"

The two primary prefixes are "E" for electronic, and "I" for Internet. Both indicate the word or phrase to be accessible online. Because of that, in terms of branding, an I or E combined with a commercial term are highly desirable. ...

In addition, we hereby take judicial notice of a definition at acronymfinder.com that "I" may be defined, *inter alia*, as a shorthand for "Internet."⁴

Applicant, for its part, submitted a screenshot from the chacha.com webpage, containing the following definition of "digital pen" - "a digital pen is a battery-operated writing instrument that allows the user to digitally capture a handwritten note." Applicant also submitted a

³ The examining attorney further made of record a Wikipedia.org article discussing "Internet-related prefixes" including "E," "cyber" and "virtual;" third-party registrations reciting digital pens among the listed goods; and an Internet article from translegal.com discussing the iPad.

⁴ The Board may take judicial notice of online dictionary definitions if the dictionary is readily available and verifiable. *See, e.g., In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006), where the Board took judicial notice of the Encarta Dictionary because it was a widely known reference that was readily available in specifically denoted editions via the Internet and CD-ROM, holding that it was "the electronic equivalent of a print publication and applicant may easily verify the excerpt."

Wikipedia.org article, excerpted below, discussing digital pens:

Digital pen

A digital pen is an input device which captures the handwriting or brush strokes of a user, and digitizes them so that they may be downloaded to a computer and displayed on its monitor. The data can then be interpreted by handwriting software (OCR) and used in different applications or just as graphics.

A digital pen is generally larger and has more features than a stylus. Digital pens typically contain internal electronics, and have features such as touch sensitivity, input buttons, memory, Bluetooth transmission capabilities, and electronic erasers. ...

The above evidence supports a finding that IPEN is an abbreviation for "Internet pen." The evidence further supports a finding that "digital pen" is recognized as a term describing an electronic input device that may be used in connection with a computer in a manner similar to that of a traditional ink pen. Turning to applicant's recited goods and services, we must determine whether IPEN or "Internet pen" merely describes a function, feature or characteristic of digital pens or online retail stores featuring digital pens.

The examining attorney argues (brief, unnumbered p. 3) that

Applicant has merely taken the "I" prefix which signifies the Internet and merely added to it the

generic term "pen." And it is now well established that when a mark consists of this prefix coupled with a descriptive word or term for Internet-related goods or services, then the entire mark may be considered merely descriptive.

However, the evidence of record fails to establish that a digital pen is an "Internet pen" or that the mark IPEN merely describes a function, feature or characteristic of applicant's digital pens or retail store services featuring digital pens. In other words, while the evidence supports a finding that IPEN is the equivalent of "Internet pen," there is no evidence that such term is synonymous with the term "digital pen" or merely describes an attribute the recited goods and services.

The examining attorney relies upon this tribunal's decision in *In re Zanova, Inc.*, 59 USPQ2d 1300 (TTAB 2001) in support of the refusal to register. In that case, however, the evidence made of record by the examining attorney clearly established that the mark ITOOL is the equivalent of "Internet tool" and that such term "not only describes a wide array of software and related services, but also aptly describes applicant's goods and services." *Id.* at 1304. Further, this tribunal's decision in the following non-precedential decision, while not binding, nonetheless is instructive: *In re PSI Systems, Inc.*, Ex Parte Appeal No. 78648563 (TTAB August 21, 2007) (evidence

of record clearly establishes that iPOSTAGE is equivalent of "Internet postage" and such term merely describes a feature of the recited goods and services).

In the case before us, on the other hand, the evidence of record simply indicates that IPEN is the equivalent of "Internet pen," but not that such term merely describes a function, feature or characteristic of the recited goods and services. As a result, we find that the evidence fails to support the refusal of registration under Section 2(e)(1).

Finally, if doubt exists as to whether a term is merely descriptive, it is the practice of this Board to resolve doubts in favor of the applicant and pass the application to publication. *See, e.g., In re Gourmet Bakers Inc.*, 173 USPQ 565 (TTAB 1972). In this way, anyone who believes that the term is, in fact, descriptive, may oppose and present evidence on this issue to the Board.

Decision: The examining attorney's refusal of registration is reversed. Accordingly, the involved application will be forwarded for publication for opposition in due course.