Hearing: February 11, 2013 Mailed: March 13, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re OnForce, Inc.

Serial No. 85422547

Timothy D. Pecsenye of Blank Rome LLP for OnForce, Inc.

Jennifer Button, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Cataldo, Wolfson and Kuczma,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

OnForce, Inc. ("applicant") filed an application to register on the Principal Register the mark FIELD SERVICES CLOUD (in standard characters) for

> Providing a virtual marketplace connecting businesses and consumers with providers of goods and services via global computer networks, wireless networks, email or telephone; promoting the goods and services of others via global computer networks, wireless networks and email; providing a website whereby buyers and sellers transact business, monitor progress of goods and services, and provide evaluative feedback; providing real-

> time business information about companies, industries and markets; providing online business information directories featuring service providers and service buyers such as computer manufacturers and retailers; providing an interactive website on a global computer network for service providers to post information about their services and qualifications for providing the services, respond to service requests from third parties, and place and fulfill orders for products, services and business opportunities (in International Class 35).[1]

The trademark examining attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that applicant's proposed mark, when used in connection with applicant's services, is merely descriptive thereof.[2]

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs, and also presented arguments before this panel of the Board at an oral hearing held on February 11, 2014.

A mark 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. *In re Chamber of Commerce of the United States of*

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[1] Application Serial No. 85422547, filed September 14, 2011, based upon applicant's assertion of a bona fide intent to use the mark in commerce. On April 20, 2013, applicant filed an amendment to allege use, asserting first use anywhere and first use in commerce at least as early as June 2011.

[2] Based upon the prosecution history, it does not appear that applicant requested, or the examining attorney suggested, amendment of the involved application to seek registration under Section 2(f) based upon a claim of acquired distinctiveness or amendment to the Supplemental Register.

America, 675 F.3d 1297, 102 USPQ2d 1217 (Fed. Cir. 2012); *In re Abcor Development*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); and *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828 (TTAB 2007). A mark 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; rather, it is sufficient that the mark describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a mark is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with the goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services because of the manner of its use. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). It is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002).

In this case, applicant's mark consists of the wording FIELD SERVICES CLOUD. Based upon evidence made of record by the examining attorney, the term "cloud" is defined as:

> a communications network. The word "cloud" by itself may refer to any local area network (LAN) or wide area network (WAN). However, append the word "computing," and "cloud computing" refers to services offered on the public Internet or to a private network that uses the same protocols.

(www.answers.com).[3] The examining attorney further made of record pages from applicant's internet website (www.onforce.com) that include the following:

> Efficiency. Quality. Confidence.
> The next generation of field services.
> Don't get left behind.
>
> Get 100% complete IT labor utilization.
> Did you know that 40% or more of field services employee time is nonproductive? Find and pay for tech talent only when you need it and eliminate downtime for good.

However, the most probative evidence in this appeal comprises excerpts from a press release, also from applicant's website, submitted by the examining attorney. This evidence shows use of the terminology "field services cloud" in connection with providing or facilitating IT, (defined as information technology)[4] services via a local or wide area computer network. A representative sample of the excerpts includes the following:

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[3] It is immaterial to our analysis that other definitions of the term "cloud" bear no relation to applicant's services. Descriptiveness must be determined in relation to the goods or services for which registration is sought. Therefore, that a term may have a different meaning in a different context is not controlling. *See In re RiseSmart Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012).

[4] Random House Dictionary, Random House, Inc. (2014). We hereby take judicial notice of this definition of "IT." The Board may take judicial notice of evidence in dictionaries, encyclopedias and other standard reference texts. *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). *See also B.V.D. Licensing*

OnForce Awarded U.S. Patent for Innovative Technology Process

OnForce's Field Services Cloud receives Patent that Simplifies On-Site Service Management and Negotiation through Innovation

Boston – July 26, 2011 – OnForce, the #1 source for on-site tech talent in the cloud, today announced that it has been awarded a U.S. patent for a work order development, online negotiation and payment processing systems. This patented technology is embedded in its field services cloud, which connects enterprises and IT service businesses with local certified technicians. … Highlights of OnForce's IT field services cloud include:
…
Access to hyper-local tech talent, reducing travel time and overhead that is often necessary in a pure employee-based field services organization.
…
"This patented process represents more than seven years of technical innovation. Built from the ground up it helps our IT field services cloud ensure that enterprises, service businesses and field services technicians gain instant access to IT service jobs and technical talent easily and cost effectively," said Peter Cannone, CEO of OnForce.
…
OnForce's widely used IT field services cloud is proven to get on-site work done in all categories within the IT and consumer electronic space.

About OnForce
OnForce is the #1 source for on-site tech talent in the cloud.

Corp. v. Body Action Design Inc., 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988) (encyclopedias may be consulted); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1590 n.8 (TTAB 2008) (online reference works which exist in printed format or have regular fixed editions); and *Sprague Electric Co. v. Electrical Utilities Co.*, 209 USPQ 88 (TTAB 1980) (standard reference works).

Applicant's own use of the wording comprising its mark in a descriptive manner is strong evidence that the combined term is descriptive. *See, e.g., In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987) ("[applicant's] own submissions provided the most damaging evidence that [the word SCREENWIPE is generic]"); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) ("Evidence of the context in which a mark is used ... in advertising material ... is probative of the reaction of prospective purchasers to the mark"); and *In re Educational Communications, Inc.*, 231 USPQ 787, 790 (TTAB 1986) ("applicant's own highly descriptive usages of the components of its asserted mark ... is strong evidence of its generic nature").

> The services recited in the involved application include, *inter alia*,
>
> > a virtual marketplace connecting businesses and consumers with providers of goods and services via global computer networks, wireless networks, email or telephone;
> >
> > a website whereby buyers and sellers transact business, monitor progress of goods and services, and provide evaluative feedback;
> >
> > online business information directories featuring service providers and service buyers such as computer manufacturers and retailers;
> >
> > an interactive website on a global computer network for service providers to post information about their services and qualifications for providing the services, respond to service requests from third parties, and place and fulfill orders for products, services and business opportunities.

As discussed above, printouts from applicant's own website, including its specimen of record, indicate that it provides an online marketplace for "field

services" performed by information technology technicians by means of a "cloud," or wide area or local network. The broadly worded services recited in the involved application clearly include providing such a marketplace. *See In re Oppendahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004); and *In re Reed Elsevier Properties Inc.*, 77 USPQ2d 1649 (TTAB 2005). Thus, the proposed mark FIELD SERVICES CLOUD merely describes a function, feature or characteristic of the recited services. Furthermore, it is well settled that where a mark is merely descriptive of one or more items identified in the description of services but may be suggestive or even arbitrary as applied to other items, registration is properly refused if the mark sought to be registered is descriptive of any of the service. *In re Canron, Inc.,* 219 USPQ 820, 821 (TTAB 1983); *Electro-Coatings, Inc. v. Precision National Corp.,* 204 USPQ 410, 420 (TTAB 1979); and *In re Brain Research Foundation*, 171 USPQ 825, 826 (TTAB 1971).

Where each component term comprising a mark retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. *See, e.g. DuoPross Meditech Corp. v. Inviro Medical Devices, Ltd.* , 695 F.3d 1247, 103 USPQ2d 1753 (Fed. Cir. 2012) (SNAP SIMPLY SAFER merely descriptive for medical devices); *In re Oppedahl & Larson LLP*, 71 USPQ2d at 1372 (Fed. Cir. 2004) (PATENTS.COM merely descriptive of computer software for managing a database of records that could include patents for tracking the status of the

records by means of the Internet). In this case, evidence of record establishes that applicant's mark, comprised of the descriptive terms FIELD SERVICES and CLOUD, merely describes a feature or characteristic of applicant's services. Moreover, when there is evidence that the components in a composite mark have been used together, by applicant itself in this case, to form a phrase that is as a whole descriptive of the goods or services, it is unnecessary to engage in an analysis of each individual component. *In re Shiva Corp.*, 48 USPQ2d 1957, 1958 (TTAB 1998) (TARIFF MANAGEMENT merely descriptive of computer hardware and computer programs to control, reduce, and render more efficient wide area network usage).

These uses persuade us that the terminology "field services cloud" is used in the industry, at least by applicant, in the information technology field to describe applicant's marketplace for seekers and providers of information technology technician services, or "field services." While neither applicant's website nor its identification of services indicates that applicant provides "cloud computing" services, it is clear that applicant's marketplace services are performed by means of a local or wide area computer network, or "cloud."

Even if applicant is the first and/or the only user of the term FIELD SERVICES CLOUD in connection with its information technology services provided by means of a local or wide area network, it is well settled that such does not entitle applicant to the registration thereof where, as here, the term has been shown to immediately convey only a merely descriptive significance

in the context of applicant's services. *See, e.g., In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018, 1020 (TTAB 1983); and *In re Mark A. Gould, M.D.*, 173 USPQ 243, 245 (TTAB 1972).

In summary, we find based upon the evidence of record that no imagination is required by a prospective purchaser or user to discern that a function, purpose or feature of applicant's services is to provide services related to coordinating the provision of information technology repair, or "field services" by means of a local or wide area network, or a "cloud." That is, applicant's various services bring together field services technicians and their customers by means of a computer network cloud. Based on the record, we find that the proposed mark FIELD SERVICES CLOUD, when considered as a whole, is merely descriptive of applicant's services.

Decision: The refusal to register is affirmed.