

This Opinion is not a
Precedent of the TTAB

Mailed: July 17, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

—————
Trademark Trial and Appeal Board
—————

In re Triad Digital Media, LLC
—————

Serial No. 85631785
—————

Molly B. Markley of Young Basile Hanlon & MacFarlane, P.C.
for Triad Digital Media, LLC.

Kristin Carlson, Trademark Examining Attorney, Law Office 105,
Susan Hayash, Managing Attorney.

—————
Before Bucher, Bergsman and Gorowitz,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Triad Digital Media, LLC (“Applicant”) seeks registration on the Principal
Register of the mark LOCALSHOPPER (in standard characters) for

Advertising and marketing services, namely promoting
the goods and services of others through mobile phone
marketing communications, website advertising and
mobile phone applications, in International Class 35.¹

¹ Application Serial No. 85631785 was filed on May 22, 2012, based upon applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. On January 24, 2014, Applicant filed an Amendment to Allege Use.

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(e)(1) of the Trademark Act of 1946, 15 U.S.C. § 1052(e)(1), on the ground that LOCALSHOPPER is merely descriptive of Applicant's advertising and marketing services. According to the Examining Attorney, LOCALSHOPPER has two possible descriptive meanings:

(1) LOCALSHOPPER merely describes the intended user of applicant's services, namely, the local consumers to whom applicant's advertising and marketing services are directed; and (2) LOCAL SHOPPER merely describes applicant's electronic advertising and marketing services which promote locally available goods and services.²

Applicant argues that LOCALSHOPPER is not merely descriptive because its services are "location based mobile communications that allow consumers to find deals, events and offers at their nearest retailer location. The services will also provide notifications to customers to allow them to search for offers and promotions based on their location."³ In other words, "Applicant's services are for location based shopping and not shopping in a local area."⁴

I. Preliminary Issue

Applicant requests that if the Board finds that its mark is merely descriptive, "the Board remand the case back to the Examining Attorney and amend the application to seek registration on the Supplemental Register."⁵ An applicant may not amend to the Supplemental Register after the Trademark Trial and Appeal

² Examining Attorney's Brief, p. 5 (unnumbered).

³ Applicant's Brief, p. 2.

⁴ Applicant's Brief, p. 3.

⁵ Applicant's Brief, p. 4.

Board has affirmed a refusal of registration on the Principal Register. Trademark Rule 2.142(g), 37 CFR § 2.142(g) (“An application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer under section 6 of the Act of 1946 or upon order of the Director.”). After having elected one of the remedies available for contesting the basis for the refusal, namely, appeal rather than amendment to the Supplemental Register, and having pursued the remedy to a conclusion, the applicant may not return to its previous position and pursue another remedy for the same refusal anew. *See Ex parte Simoniz Co.*, 161 USPQ 365 (Comm’r Pats. 1969); *Ex parte Helene Curtis Industries, Inc.*, 134 USPQ 73 (Comm’r Pats. 1962); *Ex parte Sightmaster Corp.*, 95 USPQ 43 (Comm’r Pats. 1951).

II. Applicable Law

A term is 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 U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). *See also, In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a mark or a component of a mark is merely descriptive is determined in relation to the goods 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). A term need not immediately convey an idea

of each and every specific feature of the goods or services in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of them. *See In re Gyulay*, 3 USPQ2d at 1010; *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). This requires consideration of the context in which the mark is used or intended to be used in connection with those goods, and the possible significance that the mark would have to the average purchaser of the goods in the marketplace. *See In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re Abcor Dev. Corp.*, 200 USPQ at 218; *In re Venture Lending Assocs.*, 226 USPQ 285 (TTAB 1985). The question is not whether someone presented only with the mark could guess the products listed in the description of goods. Rather, the question is whether someone who knows what the products are will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely

descriptive. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004), quoting, *Estate of P.D. Beckwith, Inc. v. Commissioner*, 252 U.S. 538, 543 (1920). See also *In re Tower Tech, Inc.*, 64 USPQ2d at 1318 (SMARTTOWER merely descriptive of commercial and industrial cooling towers); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer programs for use in developing and deploying application programs); *In re Putman Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE merely descriptive of news and information services in the food processing industry). However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, non-descriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods or services. See *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE for “bakery products”); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE for “a snow removal hand tool having a handle with a snow-removing head at one end, the head being of solid uninterrupted construction without prongs”). Thus, we must consider the issue of descriptiveness by looking at the mark in its entirety.

“On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive.” *In re Tennis in the Round, Inc.*, 199 USPQ 496, 498 (TTAB 1978). See also, *In re Shutts*, 217 USPQ at 364-65; *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB

1980). In this regard, “incongruity is one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive from the descriptive mark.” *In re Shutts*, 217 USPQ at 365. *See also In re Tennis in the Round, Inc.*, 199 USPQ at 498 (the association of applicant’s mark TENNIS IN THE ROUND with the phrase “theater-in-the-round” creates an incongruity because applicant’s services do not involve a tennis court in the middle of an auditorium).

III. Analysis

Applicant is seeking to register LOCALSHOPPER to identify the following services:

Advertising and marketing services, namely promoting the goods and services of others through mobile phone marketing communications, website advertising and mobile phone applications.

The word “Local,” as an adjective, is defined as follows:

1. a. Of, relating to, or characteristic of a particular place ...
- b. Of or relating to a city, town, or district rather than a larger area: state and local government.⁶

The word “Shopper” is defined as follows:

1. One who visits stores in search of merchandise or bargains.

* * *

4. A newspaper containing advertisements and some local news, usually distributed free.⁷

⁶ Yahoo!Education website (education.yahoo.com) attached to the October 2, 2012 Office action. *See also* Dictionary.com Unabridged based on the **RANDOM HOUSE DICTIONARY** (2013) attached to Applicant’s October 21, 2013 response to Office Action.

In its specimen of use, Applicant describes its services as follows:

LocalShopper is an easy and engaging location-based mobile application that allows consumers to find deals, events, and offers right at their nearest retailer location.

In its October 21, 2013 response to an Office action, Applicant described its services as follows:

Applicant's services are location-based, and not location specific. ... Applicant's services differ in that the services utilize mobile applications that uses [sic] locations for a customer searching any area for an item or a discount. The services are not offered by a certain location. The customer decides what location they are going to search, whether it be the one that they are in or one in another area. The services can also be directed to the customer's current location. ... Applicant's services are for location based shopping and not shopping in a local area. Additionally the mobile application works based on the location of the user and not based on the location of a city or other area. For example, the application can send a customer product promotions based on the closest retailer to the customer's location.

Pursuant to the dictionary definitions of the words "Local" and "Shopper," the composite term LOCALSHOPPER has two descriptive meanings: (1) a newspaper containing advertisements for a particular area; and (2) a person who visits stores in particular area. The composite term LOCALSHOPPER does not create a new term with a different meaning, engender a commercial impression distinct from the individual words, or create a term with an incongruous meaning. The absence of a space between the words "Local" and "Shopper" is not significant because the absence of a space does not create a different meaning or commercial impression. *In*

⁷ Yahoo!Education website (education.yahoo.com) attached to the October 2, 2012 Office action.

re Planalytics, Inc., 70 USPQ2d 1453, 1455 (TTAB 2004) (“Whether the term appears as GAS BUYER or GASBUYER, it would be understood by the relevant consumers to have the same meaning, a buyer of natural gas.”). *See also* the evidence discussed *infra*.

In addition, Applicant’s specimen (“mobile application that allows consumers to find deals, events, and offers right at their nearest retailer location”) and Applicant’s explanation about its services (“the mobile application works based on the location of the user”) do nothing to dispel the descriptive significance of the term LOCALSHOPPER. As used by Applicant, LOCALSHOPPER is an online version of a newspaper that contains advertisements for any particular trading area relative to the user’s location. In addition, as used by Applicant, LOCALSHOPPER describes the intended user of Applicant’s advertising and marketing services.

The Trademark Examining Attorney submitted the following evidence in her April 19, 2013 Office action showing the term “Local Shopper” used to identify advertising and marketing materials promoting the goods and services of others:

1. The *Tampa Bay Business Journal* website (businessdirectory.bizjournals.com) (St. Petersburg, Florida) has a listing for Local Shopper LLC, identifying itself as a “network of local, independent business and independent-minded shoppers.”

We combine grassroots marketing, social media and traditional advertising to promote independent shopping. We also provide marketing services for individual businesses, including social media, event planning, cross-promotion and more.

2. LocalShopperUSA.com – “The website where you find deals, and let other shoppers know about deals!” The website advertises that readers may “[f]ind or post latest Florida local money saving coupons and store-service deals.”

3. The Local Shopper Magazine (thelocalshopper.net)



Local shopping, FREE classifieds, coupons and business ads in Bakersfield, Arvin, Lake Isabella, Tehachapi, Mojave, California City and most of Kern County. Affordable advertising rates in your monthly magazine.

The Local Shopper Magazine is also on FACEBOOK.



4. Another Local Shopper magazine (westbankconnection.com)



The mission statement for this organization is set forth below:

1. Educate communities on the importance of local commerce.
2. Provide connection between the local businesses and the communities they serve.

3. Motivate them to interact.
4. Maintain Eco. and socially conscious practices.

The final sentence on the webpage states the following: “LocalShopper looks forward to helping you promote your local business and preserve the character of your community.”

5. LocalShopper.com: Your Community Shopping Guide

LocalShopper started out as a Newspaper where Local Business could advertise. During 1995 we added an Online website for local Businesses that advertised with us. While it’s no longer possible to print a newspaper for all the areas we now cover, LocalShopper.com continues to innovate since 1995. To get your company on our new mobile app send your request to APP@LocalShopper.com.

6. The Local Shopper website (local-shoppers.com)



The foregoing evidence shows that Local Shopper magazines are using online versions to render their local shopping advertising and marketing services. In fact, the Mobile Rated website (mobilerated.com) posted an advertisement for the Slifter – Local Shopper, “the first mobile shopping tool that can help you find products at local stores.”⁸

⁸ November 15, 2013 Office action.



Applicant's services are the mobile communications device version of local shopping newspapers that advertise the goods and services of retailers and vendors in a particular trading area. When consumers encounter Applicant's mark LOCALSHOPPER used in connection with promoting the goods and services of others through mobile phone marketing communications, website advertising and mobile phone applications, the mark directly conveys to consumers the nature of Applicant's services without the need for any mental cogitation or a multiple step reasoning process. In view thereof, we find that Applicant's mark LOCALSHOPPER is merely descriptive.

In addition, LOCALSHOPPER is merely descriptive of the intended user of Applicant's services (i.e., one who seeks merchandise or bargains in a particular locality is a local shopper). *See In re Planalytics, Inc.*, 70 USPQ2d at 1456 (with respect to the mark GASBUYERS for "providing on-line risk management services in the field of pricing and purchasing decisions for natural gas," the Board held that "Applicant's identification of services makes it clear that its services are directed to those who are in the field of making purchasing decisions for natural gas. The evidence supports the conclusion that these people would be referred to as gas buyers."). *See also Hunter Publ'g Co. v. Caulfield Publ'g Ltd.*, 1 USPQ2d 1996 (TTAB 1986) (SYSTEMS USER found merely descriptive of a trade journal directed

toward users of large data processing systems; evidence sufficient to establish distinctiveness under §2(f); *In re Camel Mfg. Co., Inc.*, 222 USPQ 1031 (TTAB 1984) (MOUNTAIN CAMPER held merely descriptive of retail mail-order services in the field of outdoor equipment and apparel). The evidence discussed below in the November 15, 2013 Office action shows that there are smartphone applications for “local shoppers” to research the availability of shopping opportunities in their current location (*emphasis* supplied).

1. Goodzer website (goodzer.com) advertising a smartphone application providing marketing information for a specific trading area:



2. WebProNews website (webpronews.com) posting a news article titled “New ShopLocal.com Allows Shoppers to Research Local Specials and Sales.” The article reports the following:

... ShopLocal, an online resource that allows shoppers to research local specials and sales items at stores close to home.

* * *

For retailers, ShopLocal is an extremely efficient way to reach *local shoppers* with targeted sales promotions.

3. PeoriaMagazines.com posted an article in February 2012:

Optimizing Your Visibility To So-Lo-Mo Status⁹

Regardless of the size of your business or the number of locations from which you sell your products, the majority of your sales are likely to consumers who live and work within 15 to 20 miles of your locations.

Given this premise that the majority of business transactions are initiated near your locations, it becomes fundamental that your organization should optimize its visibility to any **local shopper**.

4. ePower Marketing website (epower.com):

Local Search Marketing – Concentrate Locally & Steal the Spotlight

The Mobile Revolution & Local Search Marketing

Local Search Marketing can increase your search visibility with this new, growing audience. If a **local shopper** can't find you when they are out and about, you are missing out.

5. The Blinder Group website (blindergroup.com):

Blinder Group Helps Blend Classified Sponsorships with Local Online Search for Significant New Revenue

While newspapers have long competed against Yellow Pages in the print arena, they are now finding themselves in heated battles in the online space as well. ... "Newspapers already have the relationships with local advertisers – they just need to offer them a single multimedia option to help them better target **local shoppers** with traditional offerings, as well as enhance their marketing exposure on search platforms such as Yahoo! and Google."

* * *

⁹ Social, local and mobile.

And since many of the ads include time sensitive offers and other marketing messages, the results can have more value for a **local shopper**, who will see the results of their search having more information than just a list of all businesses within the area as provided by Google and the many Yellow Pages websites available online.

6. The Local Corporation survey of local shopping habits:

Mobile Momentum:

Spotlight on the Mobile **Local Shopper**

Highlights from the 2013 Research & Buying Behavior Survey:

I. Executive Summary

What You Will Learn from this White Paper

... second annual mobile **local shopper** study, exploring the continued evolution of smartphone shopping and the physical store, with emphasis on pre-purchase research and buying behaviors. The report explores how and when consumers access mobile devices for shopping throughout the path to purchase and gauges shopper dependence on key information resources and customer conveniences access through various channels. This paper is a valuable resource for retail and brand marketers looking to better engage consumers via their smartphones and provide a superior mobile local shopping experience.

Key Questions About the Mobile **Local Shopper**

Key questions addressed in this survey aim to provide answers on how to best meet customers' evolving mobile behavior.

* * *

Evolving Mobile **Local Shopper** Strategies

Many studies have examined customers' general research and buying behavior via smartphones. This study, however, looks at the evolving role of the smartphone on the path to a local purchase, when consumers are

ultimately looking to make a purchase at a nearby retail store.

In view of the foregoing, we find that the mark LOCALSHOPPER is merely descriptive when used in connection with “advertising and marketing services, namely promoting the goods and services of others through mobile phone marketing communications, website advertising and mobile phone applications” because the mark forthwith conveys an immediate idea of the nature of the services as a source of advertising and marketing materials promoting the goods and services of others and the intended user of the services.

Decision: The refusal to register Applicant’s mark LOCALSHOPPER is affirmed.