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PRECEDENT OF
THE T.T.A.B.**

Mailed: September 8, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Internet Promise Group LLC

Serial No. 85747739

Internet Promise Group LLC, *pro se*.¹

Ronald E. Aikens, Trademark Examining Attorney, Law Office 112 (Angela Wilson, Managing Attorney).

Before Zervas, Wellington, and Ritchie,
Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Internet Promise Group LLC (“Applicant”) seeks registration on the Principal Register the mark MOBILE SEARCH² in standard character format for “computer software in smart phone and, namely, the software permits a hybrid search interface using a combination of both or either touch

¹ Papers and briefs filed by Applicant were signed by Tara Chand, President.

² Application No. 85747739, filed October 7, 2012, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use the mark in commerce.

or voice commands as decided by a user [sic],” in International Class 35.³ The Examining Attorney has refused registration of the application under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that it is merely descriptive of the applied-for goods. After the refusal was made final, Applicant filed an appeal and a request for reconsideration.

As further explained below, we also address the Examining Attorney’s refusal to accept Applicant’s latest proposed amendment to the identification of goods because it is beyond the scope of the existing identification of goods. *See* Rule 2.71(a); 37 C.F.R. § 2.71(a).

Accordingly, the issues before us are whether the mark is merely descriptive, and whether the Examining Attorney should have accepted the amendment to the identification of goods. Both Applicant and the Examining Attorney filed briefs, and Applicant filed a reply brief. Upon careful consideration of the relevant arguments and evidence, we affirm the refusal to register under Section 2(e)(1) as well as the refusal to amend the identification of goods.

Amendment to the Identification

Applicant’s initial identification of goods was not accepted by the Examining Attorney, and Applicant submitted an amendment with its June 1, 2013 Response to Office Action that included the current identification of goods:

_____ computer software in smart phone and, namely, the software permits a

³ Applicant’s request to further amend is discussed *infra*.

hybrid search interface using a combination of both or either touch or voice commands as decided by a user.

The amendment was expressly accepted by the Examining Attorney in the June 29, 2013 Final Office Action, although the Section 2(e)(1) refusal to register was made final.

On December 26, 2013, Applicant filed a request for reconsideration of the refusal to register and offered the following proposed amendment:

Computer software application for use in computing and communication devices that provides a hybrid interface by a user using a combination of both or either touch or voice commands for interacting with the functions of the device.
(December 26, 2013 Request for Reconsideration at 2)

The Examining Attorney did not enter the proposed amendment, explaining that the proposed amendment “seeks to broaden the protection” of the accepted identification of goods. In particular, the proposed amendment 1) is not limited to “smartphones” but rather includes all “computing and communication devices”; and 2) does not specify a specified use of the “hybrid interface” for “interacting with the functions of the device.” So, while the proposed amendment continues to potentially include smartphones and a possible search function within the hybrid interface, it is not so limited.

Applicant argues that the proposed amendment is not broadening because 1) a smartphone is just slang for a “computing and communication device” (appl’s brief at 4); and 2) it makes no difference whether the “hybrid interface” includes the term “search.” (*Id.* at 5). We find, however, that a

smartphone is but one type of “computing and communication device,” which may include such other devices as personal computers, and automobile communication devices, among others. Furthermore, the “hybrid interface” that “interacts with the functions of the device,” which is contemplated in the proposed amendment, may perform functions other than searching, such as playing music or adding calendar entries. Accordingly, both of these aspects, as pointed out by the Examining Attorney, broaden the scope of the accepted identification of goods in violation of Rule 2.71(a); 37 C.F.R. § 2.71(a).

We affirm the examining attorney’s denial of Applicant’s request to further amend its identification of goods.

Section 2(e)(1)

We next consider the refusal as to whether Applicant’s mark is merely descriptive of the identified goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used. *See In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012), *citing In re Gyulay*, 820 F.2d 1216, 1217, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a term 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 those goods or services, and the possible significance that the term would have to the average purchaser of the goods

or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Moreover, 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); *See also In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

The Examining Attorney argues that the applied-for mark MOBILE SEARCH describes a feature or function of Applicant’s goods, namely that the software may be used to provide a search function for smartphones, which are also known as “mobile” devices. We consider a composite mark in its entirety. A composite of descriptive terms is registrable only if it has a separate, non-descriptive meaning. *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (holding SUGAR & SPICE not merely descriptive of bakery products). Accordingly, we look to the plain meaning of the words. The Examining Attorney submitted definitions of the relevant terms used in Applicant’s applied-for mark, “mobile,” and “search,” as well as

the term “smartphone,” as used in the identification of goods. We note the following relevant definitions of those terms:

“mobile”: remote, portable, on-the-go. A ‘mobile’ is a cellphone; however, a ‘mobile device’ can refer to any portable device including a phone, PDA, digital music player, tablet computer, netbook or laptop. See mobile computing, mobile platform, online app store and mobile Web site.

http://encyclopedia2.thefreencyclopedia.com

“mobile”: The ability to move around, it also refers to anything that can be moved around (or transported) and still functioning properly. It usually describes handheld devices, such as PDAs and cell phones (that is, mobile phones), but it can also refer to laptops or other portable devices.

www.netlingo.com

“mobile”: mobile often refers to:
Mobile phone, a portable communications device
Mobile, Alabama, a U.S. port city
Mobile (sculpture), a hanging artwork (or toy)

http://en.wikipedia.org

“search”: 1. To look for specific data in a file or an occurrence of text in a file. A search implies either scanning content sequentially or using algorithms to compare multiple indexes to find a match. A search on the Web yields a list of Web pages that contain all the words in the search criteria.; 2) The field of search engine technologies. See search engine.

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“search”: 1. The process of attempting to acquire information or data. In the case of the Internet, it is usually done with a search engine. 2. The result of the use of a search engine.

Csgnetwork.com

“search”: The process of locating information on the Internet, whether it is to be found on a Web site, a newsgroup, or in an archive. In order to do a search, users often begin at search engines, search directories, or portals.

www.netlingo.com

“smartphone”: A smartphone, or smart phone, is a mobile phone built on a mobile operating system, with more advanced computing capability and connectivity than a feature phone.

<http://en.wikipedia.org>

The Examining Attorney also submitted definitions of the relevant composite terms “mobile computing” and “mobile operating system” to show that the term “mobile” is understood as referring to computers and computing systems, as follows:

mobile computing: Mobile computing is a human-computer interaction by which a computer is expected to be transported during normal usage. Mobile computing involves mobile communication, mobile hardware, and mobile software.

<http://en.wikipedia.org>

mobile operating system: A mobile operating system, also referred to as mobile OS, is the operating system that operates a smartphone, tablet, PDA, or other digital mobile devices. Modern mobile operating systems combine the features of a personal computer operating system with a touchscreen, cellular, Bluetooth, WiFi, GPS mobile navigation, camera, video camera, speech recognition, voice recorder, music player, Near field communication, infrared Blaster, and other features.

<http://en.wikipedia.org>

In addition, the Examining Attorney submitted a definition of the composite term “mobile search” as well as a third-party use of the term showing use of the term with online and computing, as follows:

mobile search: Mobile search is an evolving branch of information retrieval services that is centered on the convergence of mobile platforms and mobile phones, or that it can be used to tell information about something and other mobile devices [sic]. Web search engine ability in a mobile form allows users to find mobile content on websites which are available to mobile devices on mobile networks. As this happens mobile content shows a media shift toward mobile multimedia. Simply put, mobile search is not just a spatial shift of PC

web search to mobile equipment, but is witnessing more of treelike branching into specialized segments of mobile broadband and mobile content, both of which show a fast-paced evolution.

<http://en.wikipedia.org>

eMarketer™: Mobile Search in the US: Still waiting for a market leader. Competition for a US mobile search market promises to be fierce, thanks to the large US online ad market and strong pushes by portals.

eMarket projects that by 2011, mobile search will account for around \$715 million, or almost 15% of a total mobile advertising market worth nearly \$4.7 billion.

emarketer.com

Finally, the Examining Attorney points to Applicant's identification of goods, which contains the terms "search" and "smartphone," which is also defined as a "mobile" phone.

Applicant argues that its applied-for mark is not merely descriptive of its goods because the use of the term "mobile search" together is incongruous (appl's brief at 20). However, the definitions of record, including the definition of "mobile search" show that consumers would understand a "mobile search" clearly and directly in relation to the identification of goods as referring to a search function on a smartphone.

Applicant further argues that:

An objective person being exposed to the mark "MOBILE SEARCH" alone cannot come up with any sensible identification of the goods, as the goods have nothing to do with a search or a browse function as used in the Internet industry for data and web searches; and vice versa, an objective person reading the identification of the goods alone cannot come up with the mark. (appl's brief at 18).

This, however, is not the legal test. As noted above, we must not consider the mark in a vacuum, but rather how consumers would view the mark in relation to the identification of goods. *In re Tower Tech Inc.*, at 1316-17. Accordingly, we have no doubt that a consumer would understand “MOBILE SEARCH,” used in connection with Applicant's goods, as directly conveying information about them, namely, that they may be used to perform a search on a mobile device, including a smartphone.⁴ Although Applicant asserts that the contemplated search function it intends to offer is unlike that of an Internet search (an assertion reiterated in the reply brief), there are many types of searches that may be undertaken on a mobile device. We further note that Applicant has argued in its reply brief that its mark is not merely descriptive because its identification is “unlike other commercially available goods being used by others in the industry and therefore the identification is not merely descriptive of commercially available goods referred to as with words that may include MOBILE and or SEARCH.” (reply brief at 9). It is, however, well established that merely because an applicant is the first to use a descriptive term or phrase does not make it non-descriptive. *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018, 1020 (TTAB 1983).

⁴ Although we undertake the Section 2(e)(1) analysis as to the accepted identification of goods, we note that, as discussed *supra*, Applicant's proposed identification is simply broader and also includes both “mobile” devices and “search” functions. As such, if we were to undertake the analysis with regard to the proposed amendment, our conclusion would be the same.

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Therefore, we find that the applied-for mark is merely descriptive of the identified goods, and we affirm the Section 2(e)(1) refusal to register.

Decision: The refusal to register under Section 2(e)(1) is affirmed, and the refusal to amend the identification of goods is also affirmed.