

**This Opinion is Not a
Precedent of the TTAB**

Mailed: June 18, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re No Surprises Software, LLC
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Serial No. 85791698
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Theodore R. Remaklus of Wood, Herron & Evans, L.L.P. for No Surprises Software, LLC.

Carolyn A. Pendleton, Trademark Examining Attorney, Law Office 103, Michael Hamilton, Managing Attorney.¹
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Before Zervas, Adlin and Masiello,
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

No Surprises Software, LLC (“Applicant”) seeks registration on the Principal Register of the mark VIEWABILL (in standard characters) for “Providing a website featuring online technology that allows clients of hourly service providers and

¹ Another examining attorney handled earlier prosecution of the application on the Office’s behalf.

hourly service providers to share activity information on a real time basis” in International Class 42.²

The Examining Attorney refused registration of Applicant’s mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that, if used in connection with Applicant’s services, VIEWABILL would be merely descriptive of them because it clearly conveys their purpose and function.³ After the refusal was made final, Applicant filed an appeal. The appeal is fully briefed.

Mere Descriptiveness

A term 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 Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). A term 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; it is enough that the term 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); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). It is well-established that the determination of mere

² Application Serial No. 85791698 was filed on November 30, 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, 15 U.S.C. § 1051(b). On September 16, 2013, Applicant filed a statement of use and on October 9, 2013, the Examining Attorney accepted the statement of use.

³ 8 TTABVUE 5.

descriptiveness must be made not in the abstract, but in relation to the goods or services for which registration is sought. *In re Abcor*, 200 USPQ at 218.

In support of her refusal, the Examining Attorney relies on the specimen of use filed by Applicant with its Statement of Use and webpages from Applicant's website. According to the Examining Attorney, the specimen, consisting of screenshots from Applicant's webpages, is a "live demo' of a legal bill" and states, "with real-time access to outside counsel's billable activity, 'Legal Spend Management' just became meaningful"; and describes the features of the online technology which enables users to "experience peace of mind that outside counsel is using best billing practices" and enables users to "actively review entries and collaborate with outside counsel in real time."⁴ Further, the Examining Attorney highlights the following on Applicant's webpages:

[O]ne screen shot shows what the applicant's services look like on a computer device. The wording VIEWABILL appears on top of the screen, and underneath is the wording "MY DASHBOARD". The graphics are divided into various segments, such as "Total Spend", "Total Hours", "Average Rate", "Daily Activity Graph" and "Average Cramming Delay". This screenshot is entitled "take control of billable hours". Another screenshot states, "[t]here's a reason general counsel[]s value 'transparency' above cost-cutting measures, such as lower rates. When you know exactly how much time is being spent, the opportunities are endless". Another screenshot states, "[a]ccess [sic] anytime, anywhere. Always know when you're being billed, by whom and for how much" ... Build stronger, trusting relationships with outside counsel. That's what happens when you don't have to worry about overbilling". Another screenshot states "[i]nnovative law firms are excited to build stronger, transparent relationships with their clients".⁵

⁴ *Id.*

⁵ *Id.*

One of Applicant’s webpages made of record with the Final Office Action depicts the following image of a tablet computer displaying information about “outside counsel’s activity”:



In the first box titled “Total Spend” is “\$20,576”; in the second box titled “Total Hours” is “274 hrs”; and in the final box titled “Average Rate” is “\$300/hr.”

Applicant argues that “[a] ‘bill’ is, by definition, a document that sets out an amount of money that is owed for goods purchased or services provided. However, the services provided by Applicant relate to providing clients of hourly service providers and hourly service providers with the ability to share activity information

on a real time basis before a bill is generated.”⁶ Applicant adds, “The literal meaning of Applicant’s VIEWABILL mark is that a consumer can ‘View’ (see) his/her ‘Bill’ (invoice). It, therefore, only describes a situation in which a user would be able to see a final bill of charges for services provided.”⁷ According to Applicant, “imagination [is needed] to make a leap from the literal meaning of the mark – see a final bill of charges – to what is actually provided – see time entries from hourly service providers before a bill of charges is issued.”⁸

There are two problems with Applicant’s argument. First, the *Webster’s Dictionary* definition of “bill” offered by Applicant is broad enough to encompass a statement of an amount of money owed on a real time basis, and is not limited to a final bill. The definition does not distinguish between, for example, an interim bill and a final bill. Second, we must make our determination based on the services as they are identified in the application. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). Such services, i.e., “providing a website featuring online technology that allows clients of hourly service providers and hourly service providers to share

⁶ 4 TTABVUE 9. We take judicial notice of the definitions of “bill” submitted by Applicant with its Brief, namely, “an amount of money owed for goods supplied or services rendered, set out in a printed or written statement of charges” (*The New Oxford American Dictionary* (2d Ed. 2005)), and “An itemized list of fees or charges” (*Webster’s II New College Dictionary* (1999)). The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁷ 4 TTABVUE 9.

⁸ *Id.*

activity information on a real time basis,” encompass interim bills, as well as final bills, for any particular billing period.

In summary, because: (i) there is nothing in the definition of “bill” or within Applicant’s recitation of services that restricts Applicant’s services to final bills or precludes interim bills; (ii) the depiction of the tablet on Applicant’s website, with the amount owed, the average hourly rate and the number of hours worked, sets forth key information typical of a bill, whether interim or final, and is consistent with the definition of “bill”; and (iii) the information provided on Applicant’s webpages affirms that consumers of Applicant’s services may view outside legal counsel’s charges on Applicant’s website, we find that the evidence in the record supports a determination that Applicant’s proposed mark, VIEWABILL, when considered in relation to Applicant’s services, immediately informs prospective purchasers of a feature or characteristic of Applicant’s website. We therefore find that Applicant’s proposed mark VIEWABILL for the identified services is merely descriptive of a feature or characteristic of Applicant’s services.

Supplemental Register

Applicant, at pp. 6-7 of its Brief, requests for the first time that the application be amended to seek registration on the Supplemental Register if the Board concludes that Applicant’s proposed mark is merely descriptive.⁹ Such a request,

⁹ The prosecution history reflects that on December 29, 2014, the Examining Attorney issued an Examiner’s Amendment that amended the application to seek registration on the Supplemental Register. The next day, however, the Examining Attorney withdrew her action and restored the application to the Principal Register. Because Applicant filed its Brief on November 14, 2014, it appears that the Examining Attorney misread Applicant’s statement in its brief offering an amendment in the event of an adverse decision as an

which asks that an amendment to the application be considered only after the Board has considered and decided the appeal, is untimely. The proposed amendment would require action by the Examining Attorney, as the Board lacks the power to amend the application to one for registration on the Supplemental Register, and it cannot re-open the application to allow Applicant to propose the amendment to the Examining Attorney. After decision, an application may be amended, if at all, only in accordance with Trademark Rule 2.142(g), 37 C.F.R. § 2.142(g), which states, “An application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer ... or upon order of the Director ...” 37 C.F.R. § 2.142(g). *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE §§ 816.05, 1205.01 and 1218 (January 2015). Applicant’s request is therefor denied.

Decision: The refusal to register Applicant’s proposed mark under Section 2(e)(1) of the Trademark Act is affirmed.

actual amendment to the Supplemental Register. The Examining Attorney’s withdrawal of the amendment was correct because Applicant had not amend its application to seek registration on the Supplemental Register and because the Examining Attorney did not have jurisdiction over the application.