Mailed: January 12, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Olawale Mafolasire

Serial Nos. 85895010, 85895067, 85895083 and 85895103

Akins Doherty, The Doherty Law Firm,
for Olawale Mafolasire

David C. Reihner, Trademark Examining Attorney, Law Office 111,
Robert L. Lorenzo, Managing Attorney.

Before Ritchie, Adlin and Hightower,
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

Olawale Mafolasire ("Applicant"), a Nigerian individual, seeks registration on the Principal Register of four proposed marks including the term 1-TAP for computer application software for mobile phones and portable electronic devices enabling a user to send or donate money to a recipient, in International Class 9. The proposed marks are:

- 1-TAP GIVE[1]
- 1-TAP GIVE NOW[2]
- 1-TAP DONATE[3] and
- 1-TAP DONATE NOW.[4]

All four of the subject terms are in standard characters. Each application was filed on April 4, 2013, under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), based on Applicant's allegation of first use anywhere at least as early as October 24, 2012, and first use in commerce at least as early as April 1, 2013.

The Trademark Examining Attorney refused registration of all of the subject terms under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that they are merely descriptive of Applicant's goods. After the Trademark Examining Attorney made each refusal final, Applicant appealed to this Board.

I. Appeals Consolidated

We have considered all arguments and evidence filed in each case. These appeals present common questions of law and fact and nearly identical records,[5] despite the

[1] Application Serial No. 85895010. Applicant's goods are identified in this application as: "Computer application software for mobile phones, namely, software for enabling a user to use a mobile phone to send or donate money to a recipient; Computer application software for mobile phones or portable electronic devices, namely, software for enabling a user to use a mobile phone or a portable electronic device to send or donate money to a recipient."

[2] Application Serial No. 85895067. Applicant's goods are identified in this and the next two applications as: "Computer application software for mobile phones or portable electronic devices, namely, software for enabling a user to send or donate money to a recipient using the mobile phone or portable electronic device."

[3] Application Serial No. 85895083.

[4] Application Serial No. 85895103.

[5] Citations in this decision are to the Office Action in which the cited evidence was submitted for each application.

variations among the proposed marks and, in one instance, variation in the identification of goods. Therefore, in the interest of judicial economy, we consolidate the cases and decide them in this single opinion. *In re Country Music Ass'n Inc.,* 100 USPQ2d 1824, 1827 (TTAB 2011).

We affirm the refusal to register as to each application.

II. Mere Descriptiveness

A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods 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); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Descriptiveness determinations are made in relation to an applicant's identified goods, the context in which the proposed mark is being used, and the possible significance the term would have to the average consumer because of the manner of its use or intended use. *See Chamber of Commerce*, 102 USPQ2d at 1219. Words that are merely descriptive must be left free for competitive use. *See In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (C.C.P.A. 1978) ("The major reasons for not protecting [merely descriptive] marks are . . . to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products."); *In re Styleclick.com Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001).

A. Meaning of the Proposed Marks

The four terms before us are 1-TAP GIVE, 1-TAP GIVE NOW, 1-TAP DONATE, and 1-TAP DONATE NOW. Dictionary definitions show that "give" means "[t]o make a present of,"[6] while "donate" means "to give (money, food, clothes, etc.) in order to help a person or organization."[7] The terms GIVE, GIVE NOW, DONATE, and DONATE NOW are highly descriptive in association with Applicant's identified goods, which are computer application software for mobile phones and portable electronic devices enabling users to send or donate – i.e., give – money to recipients.

The only other element in each term is the shared leading phrase 1-TAP. The Examining Attorney introduced evidence that the definitions of "tap" when used in association with computers, including mobile phones and portable electronic devices, comprise the following:

- "A tap is the rapid movement of a stylus or finger on a display screen as input on a handheld device. Taps are equivalent to a mouse click on a PC display screen."[8]
- "To lightly touch a touch-sensitive screen."[9]

[6] We grant the Examining Attorney's request to take judicial notice of this definition from The American Heritage Dictionary of the English Language (ahdictionary.com/word/search.html?g=give), attached to his brief for Application Serial No. 85895083, 6 TTABVUE 13. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1355 n.10 (TTAB 2015).

[7] We take judicial notice of this definition from the Merriam-Webster online dictionary (2015) (merriam-webster.com/dictionary/donate).

[8] February 5 and 6, 2014 Office Actions (from techopedia.com/definition/24930/tap-digital-input-method).

[9] *Id.*, Computer Desktop Encyclopedia (from yourdictionary.com/tap).

Based on the record evidence, we find that the plain meaning of the phrase 1-TAP is to touch a screen one time. In the context of Applicant's identified goods, 1-TAP means to touch the screen of a mobile phone or portable electronic device as input.

The Examining Attorney also submitted evidence that third-parties use the term 1-TAP in association with payments made via mobile phone or portable electronic devices. This evidence includes:

- An app called "Pounce 1-Tap Ordering" that "allows you to buy directly from newspapers and magazines in just a few taps";[10]
- "Skrill 1-Tap," which allows customers of an online gambling company "to make quick and easy payments by depositing in 'one tap' on any device";[11] and
- A 2010 press release announcing the launch of an in-app mobile billing solution by mobile payment company Boku, Inc., providing users "with a simple 1-Tap™ purchase process" and 2011 update.[12]

Although the third reference may indicate, by using the "TM" symbol once with the term 1-Tap in text, that common-law trademark rights are claimed in the term, that is merely Boku's assertion, while its use of the term in the cited passage corroborates the other evidence of record revealing the term to in fact be descriptive of Applicant's goods.

In relation to Applicant's identified goods, the subject terms immediately convey touching a mobile phone screen to give or donate money to a recipient (1-TAP GIVE

[10] July 18, 2013 Office Action (from download.cnet.com/Pounce-1-Tap-Ordering/3000-31713_4-75855778.html, added July 16, 2013).

[11] *Id.* (from comporate.skrill.com/2012/10/skrill-1-tap-offers-bet365-customers-frictionless-mobile-payments/57572/, posted October 3, 2012).

[12] *Id.* (from Google's cache of boku.com/press/releases/boku-enables-1-tap-mobile-payments-for-android-apps-with-launch-of-developer-toolkit/ and boku.com/press/releases/boku-1-tap-billing-for-android-is-now-live-in-56-countries/).

and 1-TAP DONATE), with two of the phrases adding the term NOW, which is merely descriptive of immediacy (1-TAP GIVE NOW and 1-TAP DONATE NOW). The individual components of each phrase Applicant seeks to register are merely descriptive, and they retain the same descriptive significance in combination; thus, the resulting combinations also are merely descriptive. *See, e.g.*, *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004). We find that the terms, considered as a whole, immediately convey knowledge about the function of Applicant's goods.

B. Applicant's Arguments

In each of his appeal briefs, Applicant essentially makes two arguments against the refusals: first, that the terms he seeks to register are suggestive rather than descriptive; and second, that certain third-party registrations support registrability. We address each argument in turn.

1. Whether the Terms Are Suggestive

Applicant contends that the terms he seeks to register do not "immediately tell the story" of the nature of his goods, and that users "would have to use a multi-level reasoning process to determine" their meaning.[13] For each application, Applicant argues, the term he seeks to register has several other meanings. Applicant contends that 1-TAP GIVE, for example, could mean "giving blood in one-tap; it could mean giving your household goods in one-tap; it could mean giving your sky

[13] Appeal Brief, 4 TTABVUE 3-4.

miles with one tap, and so on."[14] Applicant offers the same examples for each application, substituting "donating" for "giving" in the appeal briefs for 1-TAP DONATE and 1-TAP DONATE NOW.

The shortcoming in Applicant's argument is that descriptiveness determinations are not made in the abstract, but rather, in relation to the identified goods. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007). "The 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). Furthermore, "[i]t is well settled that so long as any one of the meanings of a term is descriptive, the term may be considered to be merely descriptive." *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984); *see also In re IP Carrier Consulting Group*, 84 USPQ2d 1028, 1034 (TTAB 2007); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

We find that consumers who know that Applicant's goods are an app for donating money through a mobile phone or portable electronic device will understand the terms Applicant seeks to register to convey information about them. Applicant's argument is not persuasive.

[14] Appeal Brief for Application Serial No. 85895010, 4 TTABVUE 4.

2. Significance of Third-Party Registrations

Finally, in each of his appeal briefs, Applicant included a list of registrations consisting of or containing the phrases 1-TAP, ONE-TAP, DONATE, or GIVE NOW. Applicant argues: "If one-tap standing alone qualifies to be registered as a mark, then it is axiomatic that one-tap in combination with another word qualifies to be registered as a mark."[15]

In two of his briefs,[16] the Examining Attorney correctly notes that mere submission of a list of registrations in a brief does not make the underlying registrations of record. *See In re Promo Ink*, 78 USPQ2d 1301, 1304 (TTAB 2006); Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 1208.02 (2015). Applicant, however, also listed three of those registrations in his January 18, 2014 Response to Office Action and June 2, 2014 Request for Reconsideration for each application. The Examining Attorney's failure to advise Applicant during examination that such lists are insufficient to make the listed registrations of record constituted a waiver of any objection to consideration of the lists. *In re City of Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013), *cert. denied*, 134 S. Ct. 1325 (2014); TBMP § 1207.03. Therefore, we will consider the information provided about these three third-party registrations "for whatever limited probative value such evidence may have." *In re Broyhill Furniture Indus. Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001). We note,

[15] Appeal Brief, 4 TTABVUE 4.

[16] Application Serial No. 85895083, 6 TTABVUE 5; Application Serial No. 85895103, 6 TTABVUE 4-5.

however, that the Board does not consider any information regarding those registrations other than that provided in the list. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372 (TTAB 2006).

The information of record concerning the third-party registrations cited by Applicant is, in its entirety:

Mark	Goods and/or Services	Registration No.
1TAPPS	Computer software for mobile phones	4220482
ONE TAP	Software	4192078
ONE TAP	Plastic cable masonry	1364482

Considering the last listed registration first, ONE TAP for "Plastic cable masonry" is not relevant to our analysis because the identified goods are not related to Applicant's goods.

The second registration, No. 4192078, already was of record because the Examining Attorney initially refused registration of each of the subject applications on the ground of a likelihood of confusion with this mark. The mark is registered on the Supplemental Register for "Software for authenticating personal and card identification information relating to electronic payment and financial transactions."[17] By virtue of being registered on the Supplemental Register, this mark is presumed to be merely descriptive for the identified goods, at least at the time of registration, further supporting the refusals to register in this case. *See Otter Prods. LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1255 (TTAB 2012); *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975).

[17] The basis for the registration is a claim of foreign priority in a Canadian registration; no U.S. use is claimed.

There is insufficient information to evaluate the impact, if any, of the remaining registration, No. 4220482 for 1TAPPS. The record, moreover, does not demonstrate whether the listed mark is in use, or whether customers in any segment of the marketplace are aware of it. In any event, even if this registration supported the conclusion that the Office has found 1TAPPS inherently distinctive, that does not mean that Applicant's different terms also are. Each case must be decided on its own merits, and the determination of the registrability of other marks cannot control the results in the case now before us. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to [Applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court.").

For these reasons, we find Applicant's arguments unavailing and unsupported by the record and the applicable law.

III. Conclusion

Based on careful consideration of all record evidence, we find that 1-TAP GIVE (Application Serial No. 85895010), 1-TAP GIVE NOW (Application Serial No. 85895067), 1-TAP DONATE (Application Serial No. 85895083), and 1-TAP DONATE NOW (Application Serial No. 85895103) are merely descriptive in association with the goods identified in each application in that they immediately convey knowledge of the function of the goods with which they are used. Specifically, each term immediately conveys that Applicant's computer application

software allows users to send or donate money to a recipient by tapping the screen of a mobile phone or portable electronic device.

Decision: The refusal to register pursuant to Trademark Action Section 2(e)(1) is affirmed as to each application.