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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86184669

MARK: YOURHOSTING



CORRESPONDENT ADDRESS:

YOUR HOLDING BV

CEINTUURBAAN 28

AA ZWOLLE, 8024 NETHERLANDS

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Your Holding BV

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

rs@micta.nl

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the trademark examining attorney's final refusal to register the trademark "YOURHOSTING" for "[p]roviding access to telecommunication networks; information about telecommunication; providing electronic telecommunications connections; telecommunications routing

and junction services; providing telecommunications connections to a global computer network; transfer of data by telecommunications; telecommunications by e-mail” in International Class 38, “[d]esign, creation, hosting, maintenance of websites for others; design, creation, hosting and maintenance of internet sites for third parties; Hosting the software, websites and other computer applications of others on a virtual private server” in International Class 42 and “[d]omain name registration services” in International Class 45 on the grounds of descriptiveness under Trademark Act Section 2(e)(1).

I. FACTS

Applicant applied to register the proposed mark, “YOURHOSTING,” on the Principal Register for services featuring telecommunications, design, creation, hosting and maintenance of websites, software hosting and domain name registrations on February 5, 2014. On July 16, 2014, the examining attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1), because the proposed mark is merely descriptive of the applied for services. On November 26, 2014, applicant submitted arguments against the merely descriptive refusal. A final refusal to register the mark was issued on December 24, 2014, under Section 2(e)(1). This appeal of the Section 2(e)(1) refusal, filed June 23, 2015, follows the examining attorney’s denial of the Request for Reconsideration of July 10, 2015, regarding the Section 2(e)(1) refusal.

II. ARGUMENT

THE PROPOSED MARK “YOURHOSTING” WHEN USED IN CONNECTION WITH APPLICANT’S SERVICES IS MERELY DESCRIPTIVE WITHIN THE MEANING OF SECTION 2(e)(1) OF THE TRADEMARK ACT, 15 U.S.C. SECTION 1052(e)(1).

The mark “YOURHOSTING” is merely descriptive of applicant’s services because the mark conveys an immediate idea of characteristics or features of the services, and these descriptive terms in combined form do not create an incongruous or nondescriptive meaning. A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant’s goods and/or services. TMEP §1209.01(b); *see, e.g., In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543 (1920)). As evidenced by the record, “YOURHOSTING” gives an immediate idea of a feature, characteristic, function, or purpose of the applicant’s services because the individual terms in the mark are merely descriptive, and these terms retain their descriptive significance when combined together

The term “your” is defined as a term “used as a modifier before a noun”. See the attached dictionary definition from *American Heritage Dictionary*¹. The term “hosting” is defined in *American Heritage Dictionary* as “to provide software that offers data or services, hardware, or both over a computer network”. See the dictionary definition from *American Heritage Dictionary*². Thus, the terms that comprise “YOURHOSTING” immediately convey that applicant’s services indicate they all feature a

¹ The examining attorney respectfully requests that the board take judicial notice of the attached definition of “your” from the *American Heritage Dictionary*. The Trademark Trial and Appeal Board may take judicial notice of dictionary definitions that are the electronic equivalent of a print reference work. TBMP §1208.04; *see In re Dietrich*, 91 USPQ2d 1622, 1631 n.15 (TTAB 2009) (taking judicial notice of definition from *Merriam-Webster Online Dictionary* at www.merriam-webster.com); TMEP §710.01(c); *see also* Fed. R. Evid. 201; 37 C.F.R. §2.122(a).

² The examining attorney respectfully requests that the board take judicial notice of the attached definition of “hosting” from the *American Heritage Dictionary*. The Trademark Trial and Appeal Board may take judicial notice of dictionary definitions that are the electronic equivalent of a print reference work. TBMP §1208.04; *see In re Dietrich*, 91 USPQ2d 1622, 1631 n.15 (TTAB 2009) (taking judicial notice of definition from *Merriam-Webster Online Dictionary* at www.merriam-webster.com); TMEP §710.01(c); *see also* Fed. R. Evid. 201; 37 C.F.R. §2.122(a).

computer connected to a network and provide software that offers data or services, hardware, or both over a computer network.

A. THE TERM “YOUR” IS MERELY DESCRIPTIVE WHEN COMBINED WITH DESCRIPTIVE MATTER.

The word “YOUR” in combination with descriptive or generic matter has commonly been held merely descriptive under Section 2(e)(1). *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1338-39 (TTAB 2014); *In re Time Solutions Inc.*, 33 USPQ2d 1156, 1157-58 (TTAB 1994). In particular, the applicant contends *In re Time Solutions Inc.*, 33 USPQ2d 1156, 1157-58 (TTAB 1994) does not support the significance of “YOUR” being a descriptive term because the case “discussion was about the term ‘manager’ which was found merely descriptive.” See Applicant’s Appeal Brief at Page 8. While this case focuses mainly on the definition and treatment of the term “MANAGER”, the applicant’s advertising material was considered in the decision, which states that the software “manages *your* medical records and health insurance”; “organizes *your* medical records”; “helps you understand *your* health insurance” and “maintains *your* family’s immunization and health histories”. (emphasis added). Accordingly, contrary to applicant’s contention, this case does support the overall descriptive significance because it demonstrates that the word “your” simply relates to and modifies the other words in the mark.

Furthermore, in *In re 4YourParty.com, LLC*, 2002 TTAB LEXIS 218, March 15, 2002, the TTAB upheld the Trademark Act Section 2(e)(1) refusal of “4YOURPARTY.COM” for “distributorship service in the field of party and catering supplies”. The Board relied upon the applicant’s specimens, which stated: “the premier on-line source for all *your* catering/party needs” (emphasis added). It was decided that the designation “4YOURPARTY” would be readily understood by the purchasing public as “FOR YOUR PARTY” and as such, the proposed mark was merely descriptive of the relevant services. Thus, considering the above case law, the applied-for mark should be refused under Trademark Act Section

2(e)(1) because “YOUR” relates to and modifies the descriptive wording “HOSTING” and as a result would be readily understood by the purchasing public as merely descriptive of the identified services.

B. THE TERM “HOSTING” IS DESCRIPTIVE OF A FEATURE OF APPLICANT’S SERVICES BECAUSE THEY ARE CARRIED OUT THROUGH A COMPUTER CONNECTED TO A NETWORK PROVIDING FACILITIES TO OTHER COMPUTERS AND THEIR USERS.

As demonstrated by the evidence of record, the wording “hosting” is commonly used by third parties in connection with services featuring telecommunications, design, creation, hosting and maintenance of websites, software hosting and domain name registrations. See third-party web pages attached as pages 10-33 to the Office Action dated July 16, 2014 and pages 2-6 to the Office action dated December, 24, 2014. Specifically, the web pages from HOSTGATOR demonstrate that domain name services and hosting server services are often integrated into domain name registration services because without the hosting service there cannot be an accessible domain name. See evidence from Hostgator.com attached as pages 2-3 to the Office action dated December 24, 2014 supporting domain name and hosting services are related. In particular, HOSTGATOR indicates that “the three basic parts that make up any current day website are: domain names web-hosting services and site files”. See evidence from Hostgator.com attached as page 2 to the Office action dated December 24, 2014. Furthermore, “without the hosting services, you won’t have a place for your files to reside, so your domain would then become like a disconnected phone number in the phone directory and your site files would have nowhere to stay”. See evidence from Hostgator.com attached as page 3 to the Office action dated December 24, 2014. Accordingly, “hosting” immediately conveys to the consuming public that applicant’s telecommunication services, hosting services, domain name registration services are rendered by employing web-hosting servers catered to the specific use. Further, the webpages on WIKIPEDIA on “hosting environment” clarify that “hosting” is used in “telecommunication and internet

businesses” as a “new form of business between a vendor and a telecom operator”. See evidence from Wikipedia.org attached as page 4 to the Office action dated December 24, 2014 supporting descriptiveness of hosting to telecommunication services. Moreover, evidence from WIKIPEDIA describes a typical “hosting environment in telecommunication terms would be a network operating center (NOC) housing the equipment needed to host a service” and “this environment would provide connectivity to one or more telecom networks through gateways”. See evidence from Wikipedia.org attached as page 4 to the Office action dated December 24, 2014. As such, contrary to applicant’s contentions in the context of the services consumers would immediately recognize the descriptive significance of “YOURHOSTING” as describing a feature and characteristic of the services, namely that services provide the connectivity for telecommunication access to hosting services, hosting services and domain name registration services, which are typically provided alongside hosting services. As a result, this evidence of third party usage of the term “HOSTING” demonstrates that consumers will understand that the applied-for mark immediately conveys a salient feature and characteristic of applicant’s services, namely, that they feature a computer connected to a network in order to provide facilities such as telecommunication services and domain name registration services to other computers and their users.

In its brief, applicant asserts that the term “hosting” is not merely descriptive because it “is not a genus definition for the services we supply and is certainly not a synonym for telecom services or domain name registration services.” See applicant’s Appeal Brief at page 7. It is important to note that “[a] mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.” *Oppedahl* 373 F.3d at 1173, (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). A term is descriptive if it describes only one significant function, attribute, or property. See *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b). Here,

applicant's services include telecommunication services, design, creation, hosting and maintenance of websites, software hosting and domain name registration services which all function with a computer connected to a network that provides facilities to other computers and their users. Therefore, the term "hosting" which denotes such technology, is descriptive of an important characteristic of applicant's services.

Applicant further argues against the descriptiveness of the word "hosting" for the identified telecommunication and domain name registration services that while the services are related, they are offered separate from each other and thus, "hosting" does not describe the services. See applicant's Appeal Brief at page 7. This argument is unpersuasive because determining the descriptiveness of a mark is done in relation to an applicant's services, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. See *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b). Descriptiveness of a mark is not considered in the abstract. *In re Bayer Aktiengesellschaft*, 488 F.3d at 963-64, 82 USPQ2d at 1831. Indeed, if telecommunication services and domain name registration services feature access to the provision of hosting or are characterized by hosting technology, then "hosting" can be descriptive of even these services. Accordingly, as demonstrated by the evidence of record, "hosting" clearly has a descriptive meaning to the average purchaser in the context of telecommunication and domain name registration services.

C. WHEN COMBINED INTO A TELESCOPED PHRASE, THE TERMS "YOUR" AND "HOSTING" RETAIN THEIR DESCRIPTIVE MEANINGS.

When combined into a unitary phrase, the words "your" and "hosting" retain their descriptive meaning as established above. A "telescoped mark," which consists of two or more words combined to

create a single word that shares letters, is merely descriptive or generic if the individual words are descriptive or generic and if the words retain their descriptive or generic meaning within the telescoped mark. See *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001) (holding AGENTBEANS merely descriptive of “computer software for use in the development and deployment of application programs on a global computer network”); TMEP §§1209.01(c)(i), 1209.03(d). As established above, the components of “YOURHOSTING” are descriptive and there is no evidence in the record that suggests the combination of the wording creates a different commercial impression. In its arguments, applicant has not shown the combination of “your” and “hosting” to be transformative. Conversely, the record establishes that the wording would continue to be read as two separate descriptors of applicant’s services. Specifically, as stated above combination of the wording “your” with “hosting” is merely descriptive because “your” simply relates to and modifies “hosting” in the applied-for mark. See *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1338-39 (TTAB 2014); *In re Time Solutions Inc.*, 33 USPQ2d 1156, 1157-58 (TTAB 1994). This evidence establishes that the use of the two words “your” and “hosting” when used in combination in the fields of telecommunication, hosting and domain name registration services, retains the same descriptive meaning established above.

Applicant further argues that the “average customer will be left in a state of uncertainty about the intended or “real” meaning of the term ‘YOURHOSTING’ in relation to the offered services” because “hosting” may mean someone is providing an accommodation. See Applicant’s Appeal Brief at page 9. Essentially, applicant’s contends that the applied-for mark does not immediately convey information about the proposed mark with specificity because the terms are capable of many different meanings and so require some imagination and thought to arrive at the features and functions of the applicant’s services. This argument is unpersuasive because the fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness. See *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984); TMEP §1209.03(e). Even if “HOSTING” may have other meanings in different

contexts or in other hypothetical scenarios is not the issue in this case. In the context of the services the descriptive significance of the mark is immediate and clear.

D. THE CITATION OF THIRD-PARTY REGISTRATIONS IS NOT PROBATIVE AS TO THE ISSUE OF DESCRIPTIVENESS IN THIS CASE.

Applicant's citation to third-party registrations does not obviate the refusal. See applicant's Request for Reconsideration filed on June 23, 2015. The fact that third-party registrations exist for marks allegedly similar to applicant's mark is not conclusive on the issue of descriptiveness. See *In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977); TMEP §1209.03(a). An applied-for mark that is merely descriptive does not become registrable simply because other seemingly similar marks appear on the register. *Scholastic* 196 USPQ at 519; TMEP §1209.03(a). Third-party registrations are only probative evidence on the issue of descriptiveness if the relevant word or term disclaimed features the same as or similar to applicant's services. See *Inst. Nat'l des Appellations D'Origine v. Vintners Int'l Co.*, 958 F.2d 1574, 1581-82, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992). While applicant points to other registrations apparently without a disclaimer of the term "HOSTING" or a claim of acquired distinctiveness, these other marks appear distinguishable from the instant application, many showing the terms "your" and "hosting" as part of a unitary mark combined with distinctive matter, or as part of unitary slogans, or in relation to unrelated services. In fact, the following submitted third party U.S. Registration Numbers 4323733, 4161723, 4421105, 4644237, 4674905, 4359912 actually include a disclaimer of "hosting" featuring the same as or similar to applicant's services, thereby reinforcing the descriptive nature of this wording in the context of this application. It is further noted that, prior decisions and actions of other trademark examining attorneys in registering other marks have little evidentiary value and are not binding upon the USPTO or the Trademark Trial and Appeal Board. TMEP §1207.01(d)(vi); See *In re*

Midwest Gaming & Entm't LLC, 106 USPQ2d 1163, 1165 n.3 (TTAB 2013). Each case is decided on its own facts, and each mark stands on its own merits. See *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973).

III. CONCLUSION

The evidence of record shows that the individual components of applicant's mark, "your" and "hosting," are merely descriptive of applicant's identified services. Further, the evidence shows that these terms retain their descriptive significance when combined in the telescoped form YOURHOSTING. For these reasons and those indicated above, the refusal to register the mark YOURHOSTING for use "[p]roviding access to telecommunication networks; information about telecommunication; providing electronic telecommunications connections; telecommunications routing and junction services; providing telecommunications connections to a global computer network; transfer of data by telecommunications; telecommunications by e-mail" in International Class 38, "[d]esign, creation, hosting, maintenance of websites for others; design, creation, hosting and maintenance of internet sites for third parties; Hosting the software, websites and other computer applications of others on a virtual private server" in International Class 42 and "[d]omain name registration services" in International Class 45 under 2(e)(1) of the Trademark Act should be affirmed.

Respectfully submitted,

/Kamal Preet/

Trademark Examining Attorney

Law Office 112

(571) 272-5645

Kamal.Preet@uspto.gov

Angela Bishop Wilson

Managing Attorney

Law Office 112



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your ^{adj} (y ɪ, yə, yu when unstressed)

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- adj. The possessive form of you.
- Used as a modifier before a noun: your boots; your accomplishments.
 - A possessive, case: The light switch is on your right.
 - Informal Used with little or no sense of possession to indicate a type familiar to the listener: your basic three-story frame house.

[Middle English, from Old English *ȝower*, genitive of *gē*, *ye*, see [you](#).]

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host¹ (host)

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n.

1. One who receives or entertains guests in a social or official capacity.
2. A person who manages an inn or hotel.
3. One that furnishes facilities and resources for a function or event; the city chosen as host for the Olympic Games.
4. The emcee or interviewer on a radio or television program.
5. Biology:
 - a. An organism on which or in which another organism lives.
 - b. A cell that has been infected by a virus or other infective agent.
6. Medicine: The recipient of a transplanted tissue or organ.
7. Computers:
 - a. A computer or other device providing data or services that a remote computer

can access by means of a network or modem.
b. A computer that is connected to a TCP/IP network, such as the Internet.
tr.v. **host**-ed, **host**-ing, **hosts**
1. To serve as host to or at: "The garden party he had hosted last spring" (Saturday Review).
2. To provide software that offers data or services, hardware, or both over a computer network.

[Middle English, *host*, *gast*, from Old French, from Latin *hospes*, *hospit-*; see **ghos-t** in the Appendix of Indo-European roots.]

host /hɒst/

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host² /hɒst/

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n.

1. An army.
2. A great number; a multitude. See Synonyms at **multitude**.

[Middle English, from Old French, from Late Latin *hostis*, from Latin, *enemy*; see **ghos-t** in the Appendix of Indo-European roots.]

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host³ also **Host** /hɒst/

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n.

Ecclesiastical

The consecrated bread or wafer of the Eucharist.

[Middle English, from Latin *hostia*, *sacrifice*.]

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