

Oral Hearing held:  
November 18, 2003

**THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB**

*Order mailed:  
March 11, 2005  
GDH/gdh*

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Oppedahl & Larson

Serial No. 75051843

Carl Oppedahl and Marina Larson of Oppedahl & Larson LLP for  
Oppedahl & Larson.

Brett J. Golden, Trademark Examining Attorney, Law Office 102  
(Thomas Shaw, Managing Attorney).

Before Quinn,\* Hohein and Rogers, Administrative Trademark  
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Oppedahl & Larson has filed an application to register  
on the Principal Register the term "PATENTS.COM" as a service  
mark for "on-line information services in the field of

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\* Judge Quinn has been designated to substitute for Judge Cissel, who retired from Federal service after the oral hearing in this case but before an opinion was drafted and did not participate in the disposition or determination of any of the issues herein. See In re Bose, 772 F.2d 866, 227 USPQ 1, 4 (Fed. Cir. 1985), *aff'g* 215 USPQ 1124, 1125 n.\* (TTAB 1982), holding that (*italics in original*): "[T]here was no error in substituting a board member without allowing reargument. The statutory requirement that a case be 'heard' by three board members means *judicially* heard, not *physically* heard."

intellectual property law provided via [an] interconnected computer network linked by common protocols."<sup>1</sup>

Registration has been variously refused on a number of grounds including a final refusal, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that the term "PATENTS.COM" is generic for applicant's services because it designates a commercial website which provides information about patents<sup>2</sup> and a final refusal, under Sections 1, 2, 3 and 45 of

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<sup>1</sup> Ser. No. 75051843, filed on February 1, 1996, which as originally filed seeks registration on the basis of Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), and sets forth a date of first use anywhere of July 1, 1995 and a date of first use in commerce of July 10, 1995. However, with the filing of applicant's second and operative appeal brief (its initially filed brief will not otherwise be considered inasmuch as it pertains to a premature notice of appeal), applicant submitted a "SUBSTITUTION OF BASIS" in which "applicant hereby substitutes §1(b) as a basis pursuant to MPEP [sic] section 806.03(c) and 37 CFR § 2.35." Subsequently, months after the oral hearing herein, applicant submitted an amendment to allege use in which it claims, as it did in the application as originally filed, a date of first use anywhere of July 1, 1995 and a date of first use in commerce of July 10, 1995.

<sup>2</sup> In addition, in the event that such term is not generic, registration has been repeatedly refused, under Section 2(e)(1) of the statute, on the ground that the term "PATENTS.COM" is merely descriptive of the subject matter of applicant's services and that applicant's showing in support of its alternative claim, under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), that such term has acquired distinctiveness through use thereof in commerce is insufficient to overcome a finding of mere descriptiveness. It is pointed out in this regard that while, as set forth in *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 917 (TTAB 1983) at n. 2, the insufficiency of a showing pursuant to Section 2(f) is not itself a statutory basis for a refusal of registration on the Principal Register, the failure to make a sufficient showing of acquired distinctiveness precludes registration of a term which is otherwise barred by the "merely descriptive" prohibition of Section 2(e)(1). However, in the case of a merely descriptive term which is generic, no showing of acquired distinctiveness would suffice for purposes of registration on the Principal Register. *See, e.g., H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 728 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986) and authority cited therein ["A generic term ... can never be registered as a trademark because such term is 'merely descriptive' within the meaning of Section 2(e)(1) and is incapable of acquiring de jure distinctiveness under Section 2(f). The generic name of a thing is in fact the ultimate in descriptiveness"]. Thus, applicant's claim, in the alternative, of acquired distinctiveness would not

the Trademark Act, 15 U.S.C. §§1051, 1052, 1053 and 1127, that such term fails to function as a service mark for applicant's services because, as used on the specimens of record, it would be perceived only as part of an Internet address for applicant's website.

Applicant has appealed. Briefs have been filed and an oral hearing was held.<sup>3</sup> Thereafter, however, it came to the attention of the Board that applicant, in a related case in which it was seeking registration of the identical term "PATENTS.COM" as a trademark for "computer software for managing a database of records and for tracking the status of the records by means of the Internet,"<sup>4</sup> had taken an appeal to the United States Court of Appeals for the Federal Circuit of a decision, by another panel of the Board, affirming a final refusal to register such term as merely descriptive of applicant's goods.<sup>5</sup> In view of the

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suffice to overcome a possible finding that the term "PATENTS.COM" is generic for its services so as to permit registration.

<sup>3</sup> Applicant, noting in particular the Examining Attorney's reliance in his brief upon the Board's decisions in *In re CyberFinancial.net*, 65 USPQ2d 1789 (TTAB 2002) and *In re Martin Container*, 65 USPQ2d 1058 (TTAB 2002), urges in its reply brief that "the issues under consideration in this case are ripe at this time for review by an *en banc* panel of the Trademark Trial and [Appeal] Board ..., rather than a simple panel, so that the issue of the special and frequently hostile treatment afforded by the Trademark Office to domain-name-related trademark applications can be fully ... addressed." Applicant was advised at the oral hearing that, to the extent it was requesting an *en banc* hearing and/or decision in this appeal, such request had been denied by Chief Administrative Trademark Judge Sams and that the denial thereof would be so noted in this opinion.

<sup>4</sup> Ser. No. 78061755, filed on May 3, 2001, which was filed based on an allegation of a bona fide intent to use such term in commerce. Applicant subsequently filed an amendment to allege use, setting forth a date of first use and first use in commerce of December 9, 1999.

<sup>5</sup> Specifically, the Board held that the term "PATENTS.COM" merely describes applicant's computer software which tracks the status of

potential bearing of the anticipated decision of the Federal Circuit, the Board in effect suspended issuance of a decision on the issues herein pending the final disposition of applicant's appeal in the related case.<sup>6</sup>

Inasmuch as a decision in the appeal in applicant's related case has now issued,<sup>7</sup> and such decision appears to be final, we turn to the preliminary matters raised by applicant's filing, with its second and operative appeal brief (hereinafter "main brief"), of its "SUBSTITUTION OF BASIS" and its submission, several months after the oral hearing, of its amendment to allege use. As to the former, applicant states therein that "under penalty of perjury ... applicant had a *bona fide* intention to use the mark in commerce as of the filing date of the application" and asserts that it desires to change the basis of its application from use in commerce to intent to use "[i]n view of the Examiner's continued view that the specimens herein are unacceptable to show function as a mark." Applicant, "[i]n the event this substitution-of-basis paper is refused entry into the application," also noted various arguments in its main brief concerning whether the specimens of record evidence service mark use of the term "PATENTS.COM." Applicant insists that allowance

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patents and is available on the Internet." In re Oppedahl & Larson LLP, slip op. at 4 (TTAB April 16, 2003).

<sup>6</sup> Plainly, both appeals respectively involve the question of whether the term "PATENTS.COM," which is obviously formed by combining the word "PATENTS" with the top level domain designation ".COM," is at a minimum merely descriptive of the subject matter of applicant's goods and services.

<sup>7</sup> In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004).

of the requested change in basis "should eliminate the present disagreement as to whether the specimens as filed show the mark to function as a mark" since, as further indicated in its reply brief, such issue would "no longer [be] in the appeal."

The Examining Attorney, on the other hand, argues that the effect of the requested filing-basis substitution involves more than simply the removal from the appeal of the issue of whether the specimens evidence service mark use. Specifically, he insists in a footnote to his brief that applicant's request to change the filing basis of its application from use in commerce to intent to use "is inapposite in that the mark must be in use in order to claim acquired distinctiveness under Trademark Act Section 2(f)," citing TMEP Sections 1212.05 and 1212.06 (3d ed. 2d rev. May 2003).<sup>8</sup> Aside therefrom, and apparently irrespective of whether such a change in filing basis would additionally

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<sup>8</sup> We further note that TMEP Section 1212.09(a) (3d ed. 2d rev. May 2003), which is entitled "Section 2(f) Claim Requires Prior Use," provides in pertinent part that:

Section 2(f), 15 U.S.C. §1052(f), is limited by its terms to "a mark used by the applicant." A claim of distinctiveness under §2(f) is normally not filed in a §1(b) application before the applicant files an amendment to allege use or a statement of use, because a claim of acquired distinctiveness, by definition, requires prior use.

However, an intent-to-use applicant who has used the mark on related goods or services may file a claim of acquired distinctiveness under §2(f) before filing an amendment to allege use or statement of use, if the applicant can establish that, as a result of the applicant's use of the mark on other goods or services, the mark has become distinctive of the goods or services in the intent-to-use application, and that this previously created distinctiveness will transfer to the goods and services in the intent-to-use application when use in commerce begins. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001).

eliminate the issue of failure to function as a service mark from the appeal, as asserted by applicant, the Examining Attorney maintains that "[i]t is also too late to amend the application at the brief stage." No authority for such proposition is cited in his brief, however, and when asked at oral argument if there was any support for his position, he could only offer that his managing attorney had advised that such a change of filing basis was not permitted once an application was on appeal.

Nonetheless, other than the objection to the timeliness of applicant's request, the Examining Attorney has not raised any deficiencies as to form or substance with respect thereto.

Trademark Rule 2.35, which is entitled "Adding, deleting, or substituting bases," provides in relevant part that:

(b) In an application under section 1 or section 44 of the Act:

(1) Before publication for opposition, an applicant may add or substitute a basis, if the applicant meets all requirements for the new basis, as stated in §2.34. The applicant may delete a basis at any time.

....

(3) When an applicant substitutes one basis for another, the Office will presume that there was a continuing valid basis, unless there is contradictory evidence in the record, and the application will retain the original filing date ... if appropriate.

....

(8) Once an applicant claims a section 1(b) basis as to any or all of the goods or services, the applicant may not amend the application to seek registration under section 1(a) of the Act for those goods or

services unless the applicant files an allegation of use under section 1(c) or section 1(d) of the Act.

Furthermore, as stated in TMEP Section 806.03(c) (3d ed. 2d rev. May 2003):

If a §1(a) basis fails, either because the specimens are unacceptable or because the mark was not in use in commerce as of the application filing date, the applicant may substitute §1(b) as a basis. The Office will presume that the applicant had a continuing valid basis, because the applicant had at least a bona fide intention to use the mark in commerce as of the application filing date. When amending from §1(a) to §1(b), the applicant must submit a verified statement that the applicant had a bona fide intention to use the mark in commerce as of the filing date of the application. 15 U.S.C. §1051(b)(3)(B); 37 C.F.R. §2.34(a)(2)(i).

Currently, moreover, Trademark Rule 2.34(a)(2) provides in full that:

(2) *Intent-to-use under section 1(b) of the Act.* In an application under section 1(b) of the Act, the applicant must verify that it has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. If the verification is not filed with the initial application, the verified statement must allege that the applicant had a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application as of the filing date of the application.

In view of the above authority, the Examining Attorney's objection to the substitution of basis filed by applicant is untenable. Accordingly, and since such substitution otherwise complies with the applicable rules, the application presently stands amended to one seeking registration solely on the basis of an alleged bona fide intention to use.

Nonetheless, by its pending amendment to allege use, applicant seeks to convert its application back to one which seeks registration on the basis of use in commerce. Whether such amendment, which is accompanied by a third specimen of use that differs from each of the other two specimens previously submitted, is acceptable obviously has a direct bearing on the issues in this appeal since, at a minimum, it affects not only whether the refusal on the basis that the term "PATENTS.COM" does not function as a service mark is still part of this appeal, but whether, if so, such ground remains viable.

Accordingly, further disposition of this appeal is hereby suspended and the application is remanded to the Examining Attorney for consideration of the amendment to allege use. See TBMP §1206.01 (2d ed. rev. 2004) [it not only is the case that "an amendment to allege use filed during the pendency of an ex parte appeal to the Board is timely," but "[i]f an applicant which has filed a timely appeal to the Board files an amendment to allege use, in the application which is the subject of the appeal, more than six months after issuance of the appealed action, the Board may, in its discretion, suspend proceedings with respect to the appeal and remand the application to the examining attorney for consideration of the amendment to allege use"].

If the Examining Attorney determines that the amendment to allege use is acceptable, and finds that the specimen which accompanies the amendment evidences use of the term "PATENTS.COM" in such a manner that it functions as a service mark for



applicant's services, the Examining Attorney should so indicate in an Office action and return the application file to the Board for resumption of the appeal, at which point the Board will resume proceedings herein and issue a final decision with respect to the remaining issues before this panel. If, on the other hand, the Examining Attorney finds that the amendment to allege use is unacceptable and/or that the specimen which accompanies such amendment fails to evidence use of the term "PATENTS.COM" in such a manner that it functions as a service mark for applicant's services, then a new final refusal should be issued with respect thereto, and the Examining Attorney should thereafter return the application file to the Board for resumption of the appeal. Once the Board resumes proceedings herein, any refusals or requirements which are the subject of the new final refusal will be treated as part of this appeal and the Board will issue a schedule for supplemental briefing with respect thereto. Following receipt of such supplemental briefs, the Board will issue a final decision with respect to the remaining issues before this panel, including any issues raised by the new final refusal.

It is so ordered.