

THIS DISPOSITION IS
NOT CITABLE AS
PRECEDENT OF THE
TTAB

Mailed:
17 May 2004
Paper No. 32
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sarcos Investments LC¹

Serial No. 75150061

Peter M. de Jonge of Thorpe North & Western, LLP for Sarcos Investments LC.

Patty Evanko, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Hairston, Holtzman and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On August 14, 1996, Sarcos Investments LC (applicant), by assignment, applied to register the mark NETCAM in typed form on the Principal Register for goods ultimately identified as "video and/or still camera and transmitter

¹ The application was originally filed by Stephen C. Jacobsen. The application was subsequently assigned to applicant. See Reel and Frame Nos. 1945/0178 and 2749/0881.

Ser. No. 75150061

for transmitting visual and audio information to a remote location for recordation and/or real time display" in International Class 9.

The application (Serial No. 75150061) was originally based on an allegation of a bona fide intention to use the mark in commerce. However, after a notice of allowance issued, applicant eventually filed a statement of use that contained a specimen and an allegation of a date of first use anywhere of February 13, 1999, and first use in commerce of March 15, 2001.

After the statement of use was filed, the examining attorney issued an Office action refusing to register applicant's mark "because the proposed mark is merely descriptive of the identified goods." Office action dated January 18, 2002 at 1.² 15 U.S.C. § 1052(e)(1). The examining attorney argues that "cam" is an abbreviation for "camera" and "the term NET is descriptive of applicant's goods, because it describes a feature thereof, namely, that the cameras are network cameras." Examining Attorney's Brief at 5. Applicant maintains that the term "cam" is "not commonly used to describe any camera" and that its "goods are not network cameras." Reply Brief at 7.

² The Office action also indicated that the "proposed mark appears to be generic as applied to the goods."

After the examining attorney made the refusal final, applicant appealed to this board.

Before we begin our discussion of the merits of the case, we must clarify several points that have been discussed by applicant and the examining attorney. First, in regard to the refusal to register based on the ground of descriptiveness, applicant argues there was no change of circumstances between the time of the initial examination and the examination that occurred after applicant filed its statement of use. The *Trademark Manual of Examining Procedure* addresses the question of whether an examining attorney may raise a new ground of refusal when examining the statement of use. "The examining attorney may not issue a refusal under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), unless the refusal is dictated by changed circumstances from the time of initial examination, or the failure to issue such a refusal would be a clear error." TMEP § 1109.08. Applicant disputes whether there was a change of circumstances between the time of the initial examination (1997) and the examining attorney's Office action after the statement of use was filed (2002). If an applicant is dissatisfied with the procedural actions concerning an examining attorney's refusal, it can seek relief by way of a petition to the Director. 37 CFR

§ 2.146(a)(3); TMEP § 1201.05. However, “[o]n appeal, the Trademark Trial and Appeal Board will review only the correctness of the underlying substantive refusal of registration.” TMEP § 1109.08. Accord In re Sambado & Sons Inc., 45 USPQ2d 1312, 1314 (TTAB 1997) (expanded panel) (“Board’s determination on appeal is to be limited to the correctness of the underlying substantive refusal to register”). Therefore, we will only consider the merits of the examining attorney’s refusal and not whether the examining attorney properly applied the standard for raising a refusal after the filing of a statement of use.

Second, early in the prosecution of this application, the examining attorney and applicant discussed the genericness of applicant’s mark. In her appeal brief (p. 11), the examining attorney clearly stated that “[t]he issue of genericness is not before the Board ... [T]he issue before the Board is descriptiveness. The reference to the generic nature of the mark is part of an advisory Section 2(e)(1) paragraph that advises the applicant that an amendment to Section 2(f) or Section 23 would not be accepted.” Applicant continues to maintain that its “mark is not generic.” Applicant’s Brief at 5. We agree with the examining attorney that the only issue on appeal is whether the mark is merely descriptive. The reference in

the Office action dated January 18, 2002 (p. 1), that "Registration Refused - NETCAM is Generic" was followed by an explanation that the "proposed mark is merely descriptive of the identified goods."³ There was no reason for the examining attorney to address the issue of genericness because applicant was not seeking registration under Section 2(f) or on the Supplemental Register during the prosecution of the application. Therefore, we will only address the question of whether applicant's mark is merely descriptive for the identified goods.

Third, at the end of its reply brief (p. 7), applicant requests that if "the Board find[s] the mark is descriptive for its goods, [it] requests the Board to allow Applicant's mark on the Supplemental Register." Applicant's request is untimely. 37 CFR 2.142(g). Requests to amend to the Supplemental Register in appeal briefs have not been accepted. In re Phillips-Van Heusen Corp., 63 USPQ2d 1047, 1047 n.2 (TTAB 2002); In re Taverniti, SARL, 225 USPQ 1263,

³ Other Office actions have consistently maintained that the refusal was a merely descriptive refusal under § 2(e)(1). See Office action dated November 25, 2002 at 1 ("In the previous Office action, registration was refused under Section 2(e)(1) ... because applicant's mark NETCAM is merely descriptive"); Office action dated July 28, 2003 at 1 ("The applicant should note that the refusal is based upon Section 2(e)(1) and that registration is being refused because the mark is merely descriptive of the goods. The more stringent generic test that the applicant refers to in its request for reconsideration is not applicable in this case").

1264 n.3 (TTAB 1985). Here, applicant's request is particularly untimely inasmuch as it comes in its reply brief. Applicant's relief, if any, is available only by petition to the Director. Ex parte Simoniz Co., 161 USPQ 365 (Comm'r 1969); TMEP § 1501.06 ("[T]he Director will deny a petition to reopen prosecution if granting the petition would require further examination (e.g., to consider a claim of acquired distinctiveness under 15 U.S.C. §1052(f) or an amendment to the Supplemental Register)").

We now address the central issue in this case, which is whether the mark NETCAM is merely descriptive of applicant's goods. For a mark to be merely descriptive, it must immediately convey knowledge of the ingredients, qualities, or characteristics of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); In re Quik-Print Copy Shops, Inc., 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980). Courts have long held that to be "merely descriptive," a term need only describe a single significant quality or property of the goods. Gyulay, 3 USPQ2d at 1009; Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959). Descriptiveness of a mark is not considered in the abstract, but in relation to the particular goods or

services for which registration is sought. In re Abcor Dev. Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

In her brief, the examining attorney has asked that we take judicial notice of two online definitions. We decline the examining attorney's request to take judicial notice of these online dictionaries, however, we do take judicial notice of several other dictionary definitions.⁴ First, "-cam" is defined as an "abbreviation for *camera*, especially a digital or video camera whose images are made available by a computer network. For instance, a camera connected to the World Wide Web is a *webcam*; a camera mounted on a tower is a *towercam*; and a camera strapped to the back of a horse might be called a *horsecam*."⁵ See also *New Oxford American Dictionary* (2001) "cam" - "short for camera" and "net" - "a network, in particular: a communications or broadcasting network ... a network of interconnected computers."

Applicant's goods are "video and/or still camera and transmitter for transmitting visual and audio information to a remote location for recordation and/or real time display." Applicant's goods include a camera and a

⁴ University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁵ *Dictionary of Computer and Internet Terms*, (7th ed. 2000).

transmitter for transmitting information to a remote location. The definitions support the conclusion that "cam" is an abbreviation for camera. "Net" also is a term used to describe a network. Applicant admits that "net" is "commonly used to describe a network." Reply Brief at 7. When the terms are combined, they would immediately inform potential purchasers that applicant's goods are cameras that can be used in association with a network.

Applicant argues that its product is "not necessarily connected to a computer" and applicant's product is "not limited to digital video." Applicant's Brief at 4. In order for a term to be merely descriptive, it does not have to describe all goods or services that are included within applicant's identification of goods or services. In re Pencils, Inc., 9 USPQ2d 1410, 1411 (TTAB 1988) ("We agree with applicant that the sale of pencils is not the central characteristic of applicant's services. Nevertheless, pencils are significant stationery/office supply items that are typically sold in a store of applicant's type, that is, a stationery and office supply store. While applicant's stores may carry a variety of products, pencils are one of those products, and, thus, the term 'pencils' is merely descriptive as applied to retail stationery and office supply services"). Accord In re CyberFinancial.Net Inc.,

65 USPQ2d 1789, 1791 (TTAB 2002) (“[I]f applicant’s mark BONDS.COM is generic as to part of the services applicant offers under its mark, the mark is unregistrable”). Here, applicant’s cameras and transmitters for transmitting video information to a remote location for recordation or real time display would include cameras used to transmit video information over a network for display or recordation. The fact that applicant’s goods “are not necessarily connected to a computer” is not significant to the extent that its goods could clearly be used in association with a network.

Applicant has submitted dictionary excerpts with its reply brief to show that “netcam” is absent in several dictionaries and that “cam” is absent from a dictionary. While we take judicial notice of the absence of the relevant terms from these dictionaries, they are not persuasive on the issue of whether applicant’s mark is merely descriptive.⁶ To the extent that applicant is arguing that the term NETCAM is not generic for its goods,

⁶ We note that the board has been reluctant to consider online dictionaries submitted at the appeal stage. See In re Total Quality Group Inc., 51 USPQ 1474, 1476 (TTAB 1999) (“[T]he definitions have been retrieved from on-line dictionaries which, according to the Examining Attorney, are not available in a printed format. Under this circumstance, the Board is reluctant to take judicial notice of such matter after an ex parte appeal has been filed”). In this case, however, the entries concern the simple absence of terms or definitions that are not in dispute.

we again point out that the issue of genericness is not before us.

The examining attorney also included NEXIS printouts that show use of the term NETCAM in a descriptive manner. See, e.g., Idaho Statesman, October 23, 2000 ("There are more shows, ranging from technology tips to a showcase of netcam-produced videos submitted by viewers"); Christian Science Monitor, October 29, 1999 ("The latest example of this trend is called netcam. It's a tiny video device that plugs into a computer and lets the user send out visual images"); Wall Street Journal, July 19, 1999 ("Tiny, cheap video cameras known as netcams are quickly becoming a hot new accessory for Web users"); Fort Worth Star-Telegram, July 5, 1999 ("The channel's programming incorporates online and television interactivity by encouraging viewers to participate in its programming live via netcam and chat rooms").

We agree with applicant that many of the other references to "net cams" do not show the involved goods. Many of these excerpts involve the use of cameras near the net in sports such as a hockey or tennis. See, e.g., Washington Post, November 26, 2000 ("The puck ricocheted off the netcam"); Sports Illustrated, February 5, 2001 ("After a series of TV gimmicks ranging from the glowing

puck (a failure) to miked players (a plus) to netcams (cool)"); *Orlando Sentinel*, September 1, 2000 ("You can take a virtual tour of the tournament site, watch the netcam and test your tennis knowledge"). However, these excerpts certainly rebut applicant's argument that the term "cam" is "not commonly used to describe any camera." Reply Brief at 7. These references along with the dictionary definitions show that the term "cam" would be understood to mean "camera."⁷

Based on this evidence, we conclude that the terms "net" and "cam" would have clearly descriptive meanings when they are used in connection with cameras that could transmit video information to a remote location over a network. The combining of these terms to form the word NETCAM would be as descriptive in its entirety as the words are individually. Nothing about the combination is incongruous. See In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1017 (Fed. Cir. 1987) (SCREENWIPE generic for a wipe for cleaning television and computer screens); Abcor Dev. (GASBADGE at least descriptive for gas monitoring badges); In re Orleans Wines, Ltd., 196 USPQ 516 (TTAB 1977)

⁷ Regarding the other evidence in the case, the mere fact that an excerpt is from a foreign source does not make the publication per se irrelevant. See In re Remacle, 66 USPQ2d 1222, 1224 n.5 (TTAB 2002).

Ser. No. 75150061

(BREADSPRED descriptive for jams and jellies that would be a spread for bread). Applicant's term NETCAM, when viewed in relation to applicant's goods, immediately informs prospective purchasers of a feature or characteristic of the goods, i.e., that they are cameras that can be used with a network. Therefore, applicant's mark is merely descriptive of the goods.

Decision: The refusal to register is affirmed.