


**UNITED STATES PATENT AND TRADEMARK OFFICE**

SERIAL NO: 76/424030

APPLICANT: Barrister Global Services Network, Inc.

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**BEFORE THE  
TRADEMARK TRIAL  
AND APPEAL BOARD  
ON APPEAL**

MARK: BARRISTER GLOBAL SERVICES NETWORK

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant, Barrister Global Services Network, Inc., has appealed the examining attorney's disclaimer requirement under Trademark Act §6, 15 U.S.C. §§1056.

FACTS

On June 24, 2002, the applicant filed an application to register the mark BARRISTER GLOBAL SERVICES NETWORK for "installation of computer networks and computer hardware for office information exchange and related consulting services, and maintenance and repair of computer networks and computer hardware," and for "consulting services in the field of design, selection, implementation and use of computer networks and computer hardware." On October 22, 2002, the examining attorney issued an Office action refusing registration under §2(d) of the Trademark Act of 1946, citing U.S. Registration 1277325 for the mark BARRISTER, and requiring the applicant to disclaim the wording

GLOBAL SERVICES NETWORK apart from the mark as a whole. On April 22, 2003, the applicant obviated the refusal under §2(d) by claiming ownership and providing evidence of assignment of the cited registration, but failed to comply with the examining attorney's disclaimer requirement. On July 31, 2003, the examining attorney continued and made final his disclaimer requirement. The applicant then timely filed a Notice of Appeal and a brief supporting its argument in favor of publication in the *Official Gazette* without the required disclaimer. The examining attorney then issued a supplemental Office action introducing evidence that was unavailable at the time the final Office action was issued. The applicant submitted a Supplemental Brief on October 24, 2004. The examining attorney herein presents his argument for maintaining the disclaimer requirement under §6 of the Trademark Act.

#### ISSUE ON APPEAL

Whether GLOBAL SERVICES NETWORK when used in connection with "installation of computer networks and computer hardware for office information exchange and related consulting services, and maintenance and repair of computer networks and computer hardware," and "consulting services in the field of design, selection, implementation and use of computer networks and computer hardware" is merely descriptive of the services and of the provider of the services and must therefore be disclaimed apart from the mark BARRISTER GLOBAL SERVICES NETWORK

#### ARGUMENT

GLOBAL SERVICES NETWORK must be disclaimed apart from the mark BARRISTER GLOBAL SERVICES NETWORK, as it is descriptive of both the services and of the provider of the services.

The Office can require an applicant to disclaim exclusive rights to an unregistrable part of a mark, rather than refuse registration of the entire mark. Trademark Act Section 6(a), 15 U.S.C. §1056(a). Under Trademark Act Section 2(e), 15 U.S.C. §1052(e), the Office can refuse registration of the entire mark where it is determined that the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. Thus, the Office may require the disclaimer of a

portion of a mark which, when used in connection with the goods or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). TMEP §1213.03(a). If an applicant does not comply with a disclaimer requirement, the Office may refuse registration of the entire mark. TMEP §1213.01(b).

A mark, or a portion thereof, is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods and/or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP §1209.01(b).

Applicant argues that a mark formed by two or more descriptive terms may be suggestive, i.e., be more than the sum of its parts, even though its separate parts are descriptive. The examining attorney agrees that a mark, or a portion thereof, formed by two or more descriptive terms *may* be more than the sum of its parts. However, if each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive. *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) (SMARTTOWER merely descriptive of “commercial and industrial cooling towers and accessories therefor, sold as a unit”); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer software for use in development and deployment of application programs on global computer network); *In re Putman Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE held to be merely descriptive of news and information service for the food processing industry); *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) (SCREEN FAX PHONE merely descriptive of “facsimile terminals employing electrophoretic displays”); *In re Entenmann's Inc.*, 15 USPQ2d 1750 (TTAB 1990), *aff'd per curiam*, 928 F.2d 411 (Fed. Cir. 1991) (OATNUT held to be merely descriptive of bread containing oats and hazelnuts).

In this case, the applicant has simply combined the descriptive term GLOBAL SERVICES and the equally descriptive term NETWORK into one phrase, which is itself descriptive because the whole is decidedly *not* greater than the sum of its parts. The term GLOBAL SERVICES refers to *the provision of single source, multi-vendor, information technology related services such as the installation of*

computer networks and computer hardware, the maintenance and repair of computer networks and computer hardware, and consulting in the field of the design, selection, implementation and use of computer networks and computer hardware<sup>[1]</sup>, i.e., precisely those services identified by the applicant in this application. The term GLOBAL SERVICES, therefore, has a clearly descriptive and readily understood meaning when used in connection with applicant's services. In fact, the term GLOBAL SERVICES has become a term of art in the industry for providers of services identical to those of the applicant. The examining attorney has made of record ample evidence to this effect, said evidence taking the form of U.S. Registrations<sup>[2]</sup> for the same services in which the term GLOBAL SERVICES was disclaimed, numerous articles obtained from the Lexis/Nexis research database showing descriptive use of the term GLOBAL SERVICES in connection with the same services as those provided by the applicant, as well as multiple articles obtained from the Internet using the Google® search engine also evincing descriptive use of the term GLOBAL SERVICES in connection with the same services as those provided by the applicant. It is well worth noting here that applicant has made no attempt to rebut the readily understood meaning of GLOBAL SERVICES in connection with its own services as shown by this evidence. Applicant has only attempted to show that the term GLOBAL SERVICES NETWORK, as a whole, is not a dictionary term, that it may have other possible meanings in other contexts, or that when combined with the term NETWORK, the term GLOBAL SERVICES somehow, yet inexplicably, sheds its descriptive significance. Turning now to the descriptive significance of the term NETWORK. The relevant definition of the term NETWORK<sup>[3]</sup> is:

“An extended group of people with similar interests or concerns who interact and remain in informal contact for mutual assistance or support.”

In addition to the ordinary dictionary definition of the term NETWORK, the examining attorney has also provided evidence consisting of printouts from applicant's website evincing descriptive use of the term NETWORK in connection with the services identified in the application. It is at this juncture that the examining attorney is compelled to take issue with the applicant's apparent disingenuous remarks in claiming that “a review of the printout did not locate any statement where applicant refers to itself as a network.” Not only did the examining attorney provide as evidence the printouts containing such statements, the statements were quoted verbatim from said printouts. The quotes are repeated here

for expediency:

- Barrister manages a vast network of service partners who deliver on-site services to customers located throughout the United States, Canada, Mexico and Puerto Rico. (<http://www.barrister.com/barristers.html>)
- We manage a vast network of over 15,000 certified technicians through advanced web-based systems, delivering on-site service to every zip code within the United States, Canada, Mexico and Puerto Rico. (<http://www.barrister.com/aboutus.html>)

For applicant to claim, in light of the above quotes, that “there is no support found for the examining attorney’s position that applicant refers to itself as a network” because said quotes “merely refer to managing networks of services partners and technicians,” is an apparent attempt to hide the ball, or at the very least, to create a distinction where none exists. According to the quotes, applicant manages a NETWORK of *service partners* and *certified technicians*. What is it that these *service partners* and *certified technicians* do? Again, according to the quotes, they deliver on-site services. What are the on-site services that these *service partners* and *certified technicians* provide? A mere cursory review of the printouts clearly shows that the services provided by the *service partners* and *certified technicians* are precisely those identified by the applicant in this application. Therefore, while use of the term NETWORK in the printouts may not *technically* be in reference to the applicant itself (when applicant is viewed as a single juristic entity), the use of the term NETWORK in the printouts is clearly an *effective* reference to the applicant as the owner of this application and, therefore, as the provider of the services identified therein. GLOBAL SERVICES NETWORK clearly describes both the identified services and the applicant as the provider of those services. Applicant provides GLOBAL SERVICES via a NETWORK of providers. If the composite formed by the joining of the descriptive terms GLOBAL SERVICES and NETWORK creates any non-descriptive meaning, as applicant seems to suggest, applicant never explains what that meaning is. In fact, applicant has failed at every turn to provide *any indication* as to what non-descriptive meaning the combination of the terms GLOBAL SERVICES and NETWORK might have when viewed in connection with the identified services.

Applicant argues that the disclaimer requirement is improper because the entire phrase GLOBAL SERVICES NETWORK is not found in a dictionary. The fact that a phrase is not found in a dictionary, however, is not controlling on the question of registrability. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977); TMEP §1209.03(b). Moreover, it is a well-established principle that the fact that an applicant may be the first and only user of a descriptive term does not make that term registrable. *In re Interco, Inc.* 29 USPQ2d 2037 (TTAB 1993); *In re Acuson*, 225 USPQ 790 (TTAB 1985). The fact that the applicant may have been the first to use the term GLOBAL SERVICES NETWORK in connection with services commonly known as *global services* is not dispositive where, as here, the phrase unquestionably projects a merely descriptive connotation in connection with said services. *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Applicant further argues that the phrase GLOBAL SERVICES NETWORK is not descriptive because it was coined by applicant and is considered to be arbitrary. Even if applicant's assertion is taken at face value, such argument has little if any merit. It is well established that the determination of whether a mark (or part of a mark) is merely descriptive is considered in relation to the identified services, not in the abstract. *In re Polo International Inc.*, 51 USPQ2d 1061 (TTAB 1999) (Board found that DOC in DOC-CONTROL would be understood to refer to the "documents" managed by applicant's software, not "doctor" as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (CONCURRENT PC-DOS found merely descriptive of "computer programs recorded on disk;" it is unnecessary that programs actually run "concurrently," as long as relevant trade clearly uses the denomination "concurrent" as a descriptor of this particular type of operating system); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985) ("Whether consumers could guess what the product is from consideration of the mark alone is not the test"); TMEP §1209.01(b). The fact that applicant may have adopted the phrase GLOBAL SERVICES NETWORK by chance, whim or impulse, as it seems to suggest, rather than by reason, or that it may have been unaware of the readily understood meaning of the phrase GLOBAL SERVICES NETWORK when considered in relation to the identified services, is irrelevant. It is within the context of the identified services that the descriptiveness of the phrase GLOBAL SERVICES

NETWORK must be considered, not whether applicant believes the phrase to have been coined or to be arbitrary, and it is within said context that the phrase GLOBAL SERVICES NETWORK has clearly descriptive significance.

In further support of its claim that the relevant wording is suggestive rather than descriptive, applicant asserts that "to a business person Global Services Network can suggest a variety of business-related services . . . not necessarily related to computers." This argument is simply a hollow reed since the issue of descriptiveness is considered in relation to the relevant services identified in the application. The fact that a term may have different meanings *in other contexts* is not controlling on the question of descriptiveness. *In re Chopper Industries*, 222 USPQ 258 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Champion International Corp.*, 183 USPQ 318 (TTAB 1974); TMEP §1209.03(e). Applicant also argues that at least some thought, imagination or perception is required to understand the exact nature of the services. The examining attorney disagrees. It is important to note here that although the applicant makes this claim, it never bothers to explain what thought processes, or to describe what imaginative steps would be required to understand the exact nature of the services. Moreover, if any imagination, thought or perception *is* required to reach a conclusion as to the exact nature of the services, it certainly does not rise to the level of that contemplated in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11, 189 USPQ 759, 765 (CA 2 1976).

The applicant finally argues that since the examining attorney referred to separate dictionary definitions of GLOBAL and of SERVICE and of NETWORK and referred to prior registrations and websites showing use of the term GLOBAL SERVICES sans the term NETWORK, the parts were considered separately and therefore constituted an improper dissection of the parts of the mark in conducting the descriptiveness analysis. The applicant, however, is altogether mistaken. While registrability of a designation as a mark must be based on consideration of the whole, there is nothing improper in considering the plain meanings of the component parts, so long as allowance is made for possible alterations or changes in meaning when the parts are combined into a composite. *In re Hester Industries, Inc.*, 230 USPQ 797, 798 n.5 (TTAB 1986) ("**perfectly acceptable** to separate a compound mark and discuss the implications of each part thereof . . . provided that the ultimate determination is

made on the basis of the mark in its entirety"). The examining attorney clearly made every allowance for any possible alteration or change in meaning when the parts GLOBAL SERVICES and NETWORK were combined into the composite GLOBAL SERVICES NETWORK, but alas, none could be found.

If one of the applicant's competitors wished to communicate to prospective purchasers that its *global services* were provided via a *network* of providers, there are not many other ways of communicating that information aside from saying that said services are provided via a *global services network*. §§6 and 2(e)(1) of the Trademark Act represent part of the statutory framework designed to prevent the effective monopolization of descriptive words by single parties. See, e.g., *General Foods Corp. v. Ralston Purina*, 220 USPQ 990 (TTAB 1984). This policy goal, which has been articulated by the Board on many prior occasions, is particularly applicable to the facts of this case. Since the applicant chose to use descriptive matter in its mark, it must carry the extra burden of establishing distinctiveness through use in commerce, but no such claim or evidence has been presented in this case.

#### CONCLUSION

Based on the evidence of record, and for the reasons stated above, the examining attorney respectfully submits that the phrase GLOBAL SERVICES NETWORK, when used in connection with the identified services, falls squarely within the purview of §6 of the Trademark Act, and must therefore be disclaimed apart from the mark as a whole. The examining attorney respectfully requests that the Board affirm the examining attorney's disclaimer requirement.

Respectfully submitted,

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[1] Relevant meanings for GLOBAL SERVICES clearly shown in articles obtained from the Internet using the Google® search engine and attached as evidence to the examining attorney's supplemental Office action. Said articles clearly evince descriptive use of the term GLOBAL SERVICES in connection with the same services as those provided by the applicant.

[2] (2448881 - FLUOR GLOBAL SERVICES, 2498000 - HTC GLOBAL SERVICES, 2498001 - HTC GLOBAL SERVICES, INC, and design, 2629485 - GLOBAL SERVICE SOLUTION)

[3] Definition included in Office action dated 7/31/03.