

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re 1-800-Flowers.Com, Inc.

Serial No. 76634212

Thomas M. Galgano of Galgano & Associates, PLLC for 1-800-Flowers.Com.

Dominic J. Salemi, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Hohein, Zervas and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

1-800-Flowers.Com, Inc., by merger with Fresh Intellectual Properties, Inc.,¹ is the owner of a use-based application for registration of the mark SEND-A-MESSAGE, in standard character format, for services ultimately identified as "message delivery services - namely arranging for delivery of and providing access to pre-recorded personalized message intended for recipient of

¹ Fresh Intellectual Properties, Inc. merged into 1-800-Flowers.Com, Inc. The merger was recorded with the Assignment Branch of the U.S. Patent and Trademark Office on January 16, 2008, at reel 3697, frame 0880.

Serial No. 76634212

a gift," in Class 38. Applicant claimed November 1, 1999 as its dates of first use anywhere and first use in commerce.

The Trademark Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act of 1946, 15 U.S.C. §1052(e)(1), on the ground that the mark is merely descriptive and on the ground that the mark is generic. Based on the prosecution history, it is not clear whether the issue on appeal is just whether the mark is merely descriptive or whether the mark is merely descriptive and generic. A summary of the relevant prosecution history is set forth below.

Date	Event
June 19, 2006	Registration is refused on the ground that the mark is merely descriptive.
November 30, 2006	Applicant amends the application to seek registration under Section 2(f) based on applicant's declaration of substantially exclusive and continuous use for five years.
January 17, 2007	The descriptiveness refusal is continued on the ground that the mark is "purely informational, in other words, it is generic."
February 28, 2007	Applicant amends application to the Supplemental Register.
March 4, 2007	Registration is refused on the ground that the mark is generic.

Date	Event
May 16, 2007	Applicant amends the application back to the Principal Register and argues that the mark is suggestive, not descriptive or generic.
June 13, 2007	The refusal to register the mark is made final on the ground that it is merely descriptive.
February 13, 2008	In its brief, applicant argues that the mark is neither merely descriptive nor generic, and therefore it is registrable on the Principal Register, on the Principal Register under Section 2(f), or on the Supplemental Register.
April 17, 2008	In the Examining Attorney's Appeal Brief, the examining attorney argues that registration should be refused on the ground that the mark is merely descriptive.
May 9, 2008	In its reply brief, applicant argues that because the examining attorney did not address the issue of genericness in his brief, he has withdrawn the refusal based on the ground that the mark is generic, and therefore his previous refusal to register the mark on the Supplemental Register was in error. In its conclusion, applicant argues that if the mark is not registrable on the Principal Register, it is registrable on the Supplemental Register.

At various times during the prosecution of this application, applicant has claimed that its mark is inherently distinctive, and if it is not inherently distinctive, then it may be registered on the Principal Register under Section 2(f) of the Trademark Act of 1946 or on the Supplemental Register. While the examining attorney

Serial No. 76634212

has refused registration on the ground that applicant's mark is merely descriptive and generic, in his appeal brief, the examining attorney did not address applicant's alternative grounds for registration.

We note, however, that it is the examining attorney's responsibility to clarify the outstanding refusals and requirements in each Office Action.

When acting on an amended application, the examining attorney should note all outstanding refusals and requirements in every Office action. The examining attorney should indicate whether particular refusals or requirements are withdrawn or whether the applicant's response is acceptable, where appropriate.

To prevent any misunderstanding, every refusal or requirement in the prior action that is still outstanding must be repeated or referred to. Even when suspending action on an application, the examining attorney should note all outstanding refusals or requirements.

TMEP §713.02 (5th ed. 2007). The examining attorney steadfastly refused registration on the ground that the mark is merely descriptive, but never clarified the status of his genericness refusal.

In view of the fact that applicant has argued that its mark is not merely descriptive, that its mark has acquired distinctiveness, and that its mark is registrable on the Supplemental Register, and because the examining attorney

did not clarify the status of his genericness refusal, we use our discretion to find that the applicant has argued the merits of the examining attorney's descriptiveness refusal and, in the alternative, claims that its mark has either acquired distinctiveness and is registrable on the Principal Register under Section 2(f) of the Trademark Act of 1946, or if distinctiveness has not been shown, is otherwise entitled to registration on the Supplemental Register. See TMEP §1212.02(c) (5th ed. 2007).

A. Whether SEND-A-MESSAGE is merely descriptive?

In his January 17, 2007 Office Action, the examining attorney continued his refusal to register applicant's mark SEND-A-MESSAGE for "message delivery services - namely arranging for delivery of and providing access to pre-recorded personalized message intended for recipient of a gift" as being merely descriptive, "notwithstanding applicant's claim of acquired distinctiveness," "because [the mark] is purely informational, in other words, it is generic." In support of his refusal, the examining attorney included the following dictionary definitions for the words "send" and "message."²

² The examining attorney cited "dictionary.reference.com" as his source. This is the only evidence submitted by the examining attorney during the prosecution of the application.

SEND

to cause to be conveyed or transmitted to a designation: *to send a letter.*

MESSAGE

a communication containing some information, news, advice, request, or the like, sent by messenger, radio, telephone, or other means.

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the products or services it identifies. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the products or services for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the question is not whether someone presented only with 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, 1316-1317 (TTAB 2002); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB

Serial No. 76634212

1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

"On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive." *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978). See also, *In re Shutts*, 217 USPQ 363, 364-365 (TTAB 1983); *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980).

Accordingly, we start our analysis of the registrability of SEND-A-MESSAGE by inquiring whether that term describes a characteristic, quality, function or purpose of applicant's message delivery services intended for the recipient of a gift, not whether we can guess what the services are by looking at the mark. Purchasers of applicant's services will immediately understand the mark SEND-A-MESSAGE as describing the fact that applicant's services involve the delivery of a message. They will not have to undertake a multiple step reasoning process to understand from the mark something significant about the services. The term SEND-A-MESSAGE immediately tells consumers exactly what the services are.

Serial No. 76634212

Applicant contends that SEND-A-MESSAGE is a "novel combination of the terms SEND, A and MESSAGE," and therefore is it suggestive, not descriptive. Applicant cites one application and three registrations with a "Send A" prefix and argues that if these marks were "found to be registrable on the Principal Register, so too should Applicant's mark."³ Applicant referenced the following marks:

Reg/App No.	Mark	Goods/Services
78834842 ⁴	SEND A SONG	Entertainment in the nature of personalized, pre-recorded musical telephone messages
2511365	SEND-A-MEAL	Providing the ordering and delivery of food from restaurants to consumers through a global computer information network
2073928 (Canceled)	SEND A GRAM	Telephonic delivery of pre-recorded messages
2496897	SEND A SCENT	Transportation and delivery by air, road, rail and water, of gifts, packages, fragrances, colognes, bath oils, body lotions, soaps and scented products

³ Applicant's Brief, p. 4.

⁴ A third-party application is evidence only of the fact that it was filed; it has no other probative value. Nevertheless, in determining whether applicant's mark is descriptive, we have considered the referenced application as evidence that the USPTO has considered the mark registrable because it was published for opposition. See *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1467 n.6 (TTAB 2003).

First, SEND-A-MESSAGE is not a "novel combination of the terms SEND, A and MESSAGE." The four third-party marks referenced by applicant demonstrate that the term SEND-A followed by a descriptive or generic term is not original.

Second, the third-party registrations submitted by applicant do not rebut our finding that the mark SEND-A-MESSAGE is merely descriptive. Section 20 of the Trademark Act of 1946, 15 U.S.C. §1070, gives the Board the authority and duty to decide an appeal from an adverse final decision of the examining attorney. This duty may not be delegated by the adoption of conclusions reach by other examining attorneys on different records. Suffice it to say that each case must be decided on its own merits based on the evidence of record. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed., Cir. 2001).

Finally, applicant has not provided any examples of a multiple step reasoning process or an incongruity in the combination of words forming the mark SEND-A-MESSAGE. Applicant merely concludes, without any explanation, that "[t]he meaning of SEND-A-MESSAGE when used in connection with a messaging service which allows recording of a personalized message and retrieval by the gift recipient of

it through a pin system, will not be grasped without 'some measure of imagination and mental pause.'"⁵

In view of the foregoing, we find that applicant's mark SEND-A-MESSAGE used in connection with "message delivery services - namely arranging for delivery of and providing access to pre-recorded personalized message intended for recipient of a gift" is merely descriptive.

B. Whether SEND-A-MESSAGE has acquired distinctiveness?

In its November 30, 2006 response, applicant claimed that its mark has acquired distinctiveness and amended its application to seek registration under Section 2(f) of the Trademark Act of 1946, 15 U.S.C. §1052(f). In support of its claim of acquired distinctiveness, applicant submitted the declaration of Christopher G. McCann, applicant's President, who attested to the fact that SEND-A-MESSAGE has become distinctive of applicant's services by the substantially exclusive and continuous use of the mark for five years.

The amount of evidence necessary to establish secondary meaning varies - "the greater the degree of description a term has, the heavier the burden to prove it has attained secondary meaning." *In re Bongrain International Corp.*, 894 F.2d 1316, 1317 n.4, 13 USPQ2d

⁵ Applicant's Brief, p. 4.

Serial No. 76634212

1727, 1728 n.4 (Fed. Cir. 1990); *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 1581, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988). Accordingly, if the mark is highly descriptive of the services in the application, the statement of five years' use alone is insufficient to establish acquired distinctiveness. See *In re Kalmbach Publishing Co.*, 14 USPQ2d 1490, 1492 (TTAB 1989) (applicant's sole evidence of acquired distinctiveness, a claim of use since 1975, held insufficient to establish that the highly descriptive, if not generic, designation RADIO CONTROL BUYERS GUIDE had become distinctive of applicant's magazines); *In re Gray Inc.*, 3 USPQ2d 1558, 1559 (TTAB 1987) ("[T]o support registration of PROTECTIVE EQUIPMENT [for burglar and fire alarms and burglar and fire alarm surveillance services] on the Principal Register a showing considerably stronger than a prima facie statement of five years' substantially exclusive use is required."). Cf. *In re Synergistics Research Corp.*, 218 USPQ 165 (TTAB 1983) (applicant's declaration of five years' use held sufficient to support registrability under §2(f) of BALL DARTS for equipment sold as a unit for playing a target game, in view of lack of evidence that the term is highly descriptive (e.g., no dictionary evidence of any meaning of

Serial No. 76634212

BALL DARTS and no evidence of use of the term by competitors or the public)).

The mark SEND-A-MESSAGE used in connection with message delivery services intended for the recipient of a gift is so highly descriptive that a statement of five years' substantially exclusive and continuous use is not sufficient to establish that the mark has acquired distinctiveness.

C. Whether SEND-A-MESSAGE is generic?

There is a two-part test used to determine whether a designation is generic: (1) What is the class of goods or services at issue? and (2) Does the relevant public understand the designation primarily to refer to that class of goods or services? *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986). The test turns upon the primary significance that the term would have to the relevant public. The examining attorney has the burden of proving that a term is generic by clear evidence. *In re Merrill Lynch, Pierce, Fenner & Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Because the Trademark Examining Attorney produced no evidence at all regarding the public's understanding of the

Serial No. 76634212

phrase SEND-A-MESSAGE as it relates to message delivery services intended for the recipient of a gift, the Examining Attorney failed to carry his burden. The Examining Attorney may not simply cite dictionary definitions in lieu of conducting an inquiry into the meaning of the disputed phrase to hold it generic. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001), *citing In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999). Accordingly, based on this record, the phrase SEND-A-MESSAGE is not a generic term.

Decision: The refusal to register SEND-A-MESSAGE on the Principal Register on the ground that the mark is merely descriptive and that applicant has not shown that the mark has acquired distinctiveness is affirmed.

The refusal to register SEND-A-MESSAGE on the Supplemental Register ground that the mark is generic is reversed. The application is deemed to be amended to the Supplemental Register and the mark will be registered on the Supplemental Register in due course.