

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Oral Hearing:
April 30, 2009

Mailed:
May 26, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Interactive Media Communications

Serial No. 76668415

Steven A. Gibson of Gibson Lowry Burriss LLP for Interactive Media Communications.

Janice Kim, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Rogers, Kuhlke and Taylor, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

On November 1, 2006, Interactive Media Communications, applicant, filed a use-based application under Trademark Act Section 1(a), 15 U.S.C. §1051(a), to register the mark shown below for "computer services, namely, hosting online web facilities for members for interactive discussions; computer services in the nature of customized web pages featuring user-defined information, personal profiles,

photographs and information; providing a search engine for members to locate other members" in International Class 42.¹



Registration has been refused pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), based on applicant's failure to comply with the requirement to disclaim the descriptive wording STRIPPER SOCIETY.COM on the ground that it is merely descriptive of applicant's services within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1).

When the refusal was made final, applicant appealed. The appeal is fully briefed and an oral hearing was held on April 30, 2009. We affirm the refusal of registration in the absence of a disclaimer.

An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6(a). Merely descriptive terms are unregistrable, under Trademark Act Section 2(e)(1) and, therefore, are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of

¹ The application includes a statement that color is not claimed as a feature of the mark.

registration. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (CCPA 1975); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977); and *In re Pendleton Tool Industries, Inc.*, 157 USPQ 114 (TTAB 1968).

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or

services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Finally, "[a] mark can be descriptive if it describes the intended users of the goods or services." In re Planalytics, Inc., 70 USPQ2d 1453, 1454 (TTAB 2004).

The examining attorney argues that the wording STRIPPER SOCIETY.COM:

...merely describes the intended users and the nature of Applicant's computer services...the members of applicant's computer services who 'engage in the interactive discussions,' 'who customize their web pages with user-defined information, personal profiles, photographs and information,' and 'who use the search engines to seek other members' will be a social circle of STRIPPERS with common interests, or a STRIPPER SOCIETY. Moreover, STRIPPER SOCIETY.COM also conveys the overall nature of applicant's computer services. Applicant's 'hosting of online web facilities for members for interactive discussions' and 'search engines for members to locate other members' create a forum or outlet for STRIPPERS to gather and interact with one another on the basis of common interests. In other words, the computer services facilitate the voluntary association of STRIPPERS online, and thus create an online STRIPPER SOCIETY.

Br. pp. 4-5.

In support of the refusal, the examining attorney referenced the following dictionary definitions for the word STRIPPER submitted by applicant:

A person who performs a striptease.
Dictionary.com based on the Random House Unabridged Dictionary (2006);

One who performs a striptease. The American Heritage Dictionary of the English Language (4th ed. 2006); and

A performer who provides erotic entertainment by undressing to music. WordNet (2006)
www.dictionary.com retrieved September 13, 2007.

In addition, we grant the examining attorney's request that we take judicial notice of the following definition for SOCIETY, and therefore consider this definition also to be of record in support of the refusal:²

1) a voluntary association of individuals for common ends, especially an organized group working together or periodically meeting because of common interests beliefs, or professions; or
2) a social circle or group of social circles having a clear marked identity. Merriam-Webster's Dictionary of the English Language (2008).

We find that the examining attorney has made a prima facie case that the wording STRIPPER SOCIETY.COM used in

² The Board may take judicial notice of dictionary definitions. *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); see also *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006). We have also considered the various alternative definitions submitted by applicant in its reply brief but find the definition above to be the most relevant.




connection with applicant's online services is descriptive. This wording clearly describes both a category of users or members, namely, strippers, and a subject matter of the computer services, namely, an online society of strippers. Each element of the proposed mark is descriptive and when combined these elements do not lose their descriptive significance. In the context of applicant's services, contrary to applicant's argument, the other meanings of STRIPPER (e.g., a chemical compound to remove paint or varnish) are not relevant. Moreover, because the identification of services is not limited to a particular field, while it could encompass services in the field of paint stripping, it also encompasses the relevant field in which applicant makes actual use of the designation, namely a website for strippers, i.e., exotic dancers. The word SOCIETY informs the consumer that the website is designed for people defined by a common interest and the .COM portion is simply a TLD or top-level-domain which is "the highest level domain category in the Internet domain naming system [of which t]here are two types: the generic top-level domains, such as .com, .org, and .net...." McGraw Hill Computer Desktop Encyclopedia 977 (9th ed. 2001). University of Notre Dame, 213 USPQ 514.

Applicant's argument that the examining attorney "inappropriately based her conclusion of descriptiveness on the Examining Attorney's perceptions of the use of the STRIPPER SOCIETY.COM mark in commerce and not on the language set forth in Applicant's mark registration," Br. p. 3, is not persuasive. It is appropriate for an examining attorney to review an applicant's website for context "to inform [her] understanding of the term." In re Reed Elsevier Properties Inc., 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007), citing, In re Steelbuilding.com, 415 F.3d 1293, 75 USPQ2d 1420 (Fed. Cir. 2005). In the case before us, the examining attorney used the specimen of use submitted by applicant to "inform" her understanding of applicant's services. Below are excerpts from the specimen of use:

StripperSociety.com :: Ultimate Place for Strippers, Entertainers and Clubs to Connect



StripperSociety.com :: Ultimate Place for Strippers, Entertainers and Clubs to Connect

<p>» What Is Your Favorite Club? by Osito on Mon Oct 02, 2006 12:34 am</p>		<p>Click here to see our pictures from the AVN convention!</p>
<p>» Las Vegas brings down the hammer on Crazy Horse Too by Administration on Sat Sep 30, 2006 6:13 am</p>		<p>StripperSociety and Private Dancer at Club Paradise For Post AVN Party</p>
<p>» Housing Market by LVBanker on Fri Sep 29, 2006 10:22 pm</p>		<p>StripperSociety Radio Guests</p>
<p>» Hi Everyone! by LVBanker on Fri Sep 29, 2006 10:17 pm</p>		
<p>» Saying hey by Summer on Fri Sep 29, 2006 9:29 pm</p>		
<p>» New club? by Juicy on Fri Sep 29, 2006 9:12 pm</p>		
<p>» Rules for Single Women by Superspice on Fri Sep 29, 2006 7:25 pm</p>		
<p>» My Gift Back to You Girls by LVBanker on Fri Sep 29, 2006 5:52 pm</p>		
<p>» What entices a client to get a dance? by sweetcheeks on Fri Sep 29, 2006 4:02 pm</p>		
<p>» Stage shows by crazygirl on Thu Sep 28, 2006 6:57 pm</p>		

As can be seen from the specimen of use, applicant's services are, at least in part, directed to the interests of and provide information about strippers.

The facts of this case are similar to those presented in *In re DNI Holdings Ltd.*, 77 USPQ2d 1435 (TTAB 2005) (SPORTS BETTING.COM held to be generic for "provision of casino games on and through a global computer network wherein there are no actual monetary wagers; provision of contests and sweepstakes on and through a global computer network; providing a web site on and through a global computer network featuring information in the fields of

gaming, athletic competition and entertainment").³ In DNI Holdings, the Board characterized applicant's argument as follows:

Applicant argues that even if it is true that applicant is providing services through its website wherein consumers are actually able to wager money on sports, applicant is not seeking registration for these services. In fact, it specifically limited the claimed services so as to exclude monetary wagering. As a result, applicant argues that the Trademark Examining Attorney's refusal to register its mark, based upon genericness for services not claimed by applicant, cannot stand.

DNI Holdings, 77 USPQ2d at 1437.

In response to this argument the Board stated, "[I]t is clear that the analytical focus on the recitation of services is based on the premise that the recitation accurately reflects actual conditions of use of the involved term." Id. at 1438. Finally, the Board noted that even if it were "constrained to ignore the realities of use actually made by applicant because applicant has purposely drafted a description omitting that use ... applicant's recitation of services includes the providing of a website 'featuring information in the fields of gaming, athletic competition and entertainment'...[and this

³ It appears the attorney representing the applicant in DNI Holdings may be the same as applicant's attorney here. We note this application was filed nearly a year after the decision in DNI Holdings issued.

recitation] still clearly includes that of providing information regarding sports and betting." Id. at 1438.

Similarly, here, as noted above, even without looking at applicant's actual use, the broadly defined services in the identification encompass the uses for which the wording STRIPPER SOCIETY.COM is descriptive. As applicant states, the "application sets forth no restrictions regarding the categories into which users of Applicant's services must fall, e.g., 'STRIPPERS, clubs, and[/or] clientele'..." Br. p. 6. Thus, strippers are not excluded from being a category of users or "members" of applicant's services. Applicant argues that "the Claimed Services do not contain any aspect of the Text, nor are any parts of the definitions of the texts 'STRIPPER' or 'SOCIETY' incorporated into the Claimed Services, even as the Examining Attorney attempted to define those terms." Reply Br. p. 8. However, because they are not excluded they are encompassed by the "Claimed Services."

Applicant is correct in its statement of the law that our determination must be made "in relation to the goods or services for which registration is sought, not in the abstract." Reply Br. p. 3, quoting, TMEP §1209.01(b). We add that an application for registration must be made in relation to the goods or services which applicant uses or

has a bona fide intent to use, not in the abstract.

Following applicant's logic, applicant would be allowed to register the mark based on non-descriptive uses of its services that could occur, for example, a florist using the website STRIPPER SOCIETY.COM to engage in interactive discussions about flowers, despite the fact that its primary use is by strippers to engage in interactive discussions about the business of stripping. However, applicant may not in good faith sign a document swearing to use in connection with services it does not actually provide.

Applicant also argues that "the examining attorney did not provide any evidence that an average purchaser would likely perceive that the term 'STRIPPER' 'describes the intended user or the subject of the website.'" Br. p. 7. However, as noted above, applicant provided such evidence in its specimen of use.

Applicant further argues that "the components of the Mark, when juxtaposed with one another, are inventive and require at least a mental leap in the mind of the consumer to understand that the services to be provided under the Mark consist of web hosting or search engines." Br. p. 8. We find that it does not take any mental leap to conclude that STRIPPER SOCIETY.COM describes who the members are in

the identified services and that the services are computer related. Moreover, the combination of these terms does not create a unique or incongruous phrase.

Finally, both applicant and the examining attorney submitted third-party registrations to show that the USPTO has alternatively treated the word SOCIETY as descriptive or not descriptive by sometimes requiring a disclaimer of the term and sometimes not requiring a disclaimer. The most that can be said of this evidence is that it is inconclusive. In fact, these registrations highlight why prior decisions in other applications are not binding on the Board and underscore the need to evaluate each case on its own record. In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

Applicant correctly states that in cases of refusals under Section 2(e)(1) we must resolve doubt in favor of applicant; however, we have no such doubt in this case.

Thus, the disclaimer requirement is appropriate. In view of the above, the requirement to provide a disclaimer for the wording STRIPPER SOCIETY.COM is affirmed.

Decision: The refusal to register based on the requirement for a disclaimer of STRIPPER SOCIETY.COM is affirmed. However, if applicant submits the required disclaimer of STRIPPER SOCIETY.COM to the

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Board within thirty days, this decision will be set aside as to the affirmance of the disclaimer requirement.⁴ See Trademark Rule 2.142(g), 37 C.F.R. §2.142.

⁴ The standardized printing format for the required disclaimer text is as follows: "No exclusive right to use STRIPPER SOCIETY.COM is claimed apart from the mark as shown." TMEP 1213.08(a) (5th ed. 2007).