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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re 21st Century Communications SCP

Serial No. 77650780

Mitchell H. Stabbe of Dow Lohnes PLLC for 21st Century Communications SCP.

Darryl M. Spruill, Trademark Examining Attorney, Law Office 112 (Angela Wilson, Managing Attorney).

Before Bucher, Cataldo and Wellington,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

21st Century Communications SCP filed an application to register in standard characters on the Principal Register the proposed mark WHO'S WHO ONLINE for services subsequently amended to read as follows: "providing an online directory information service in the nature of biographical and professional data about individuals of accomplishment" in International Class 35.¹

¹ Serial No. 77650780 was filed on January 15, 2009, alleging first use anywhere and in commerce as of September 19, 1995.

Procedural History

The trademark examining attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that applicant's mark is highly descriptive of applicant's services. In response, applicant asserted a claim of acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f), and complied with the examining attorney's requirement for a disclaimer of ONLINE and an amended recitation of services.² The examining attorney continued the refusal to register under Section 2(e)(1) and found applicant's showing that its proposed mark had acquired distinctiveness under Section 2(f) was insufficient to overcome the refusal to register. Applicant then amended its application to seek registration on the Supplemental Register. The examining attorney refused registration under Section 23 of the Trademark Act, 15 U.S.C. §1091, on the ground that applicant's mark is generic and thus incapable of identifying applicant's services and distinguishing them from the services of others. When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs on the issue under appeal.

² In support of its Section 2(f) claim, applicant submitted a declaration of one of its officers attesting that its proposed

Arguments and Evidence

Applicant contends that the examining attorney has submitted insufficient evidence that WHO'S WHO ONLINE is a generic name for its services. Applicant further contends that the individual terms comprising WHO'S WHO ONLINE are descriptive of its services and that, as a result, "the WHO'S WHO ONLINE mark is not generic because the individual terms making up the mark, WHO'S WHO and ONLINE, are not generic."³ Finally, applicant argues that it obtained and inadvertently allowed to be cancelled a prior registration for WHO'S WHO ONLINE on the Supplemental Register for substantially identical services, and that "refusal to allow Applicant's application in the instant case on the ground of genericness would lead to completely inconsistent and contradictory results."⁴

In support of its position, applicant made of record the welcome page from its Internet website, excerpted below:

Who's Who Online(SM) is a searchable site on the World Wide Web which contains professional and biographical data about individuals of accomplishment who are part of the worldwide Internet community. Profiles are provided by the individuals themselves, who own the copyrights to their own pages. ...

mark has acquired distinctiveness based upon use in commerce for at least five years immediately prior thereto.

³ Applicant's brief, p. 7.

⁴ *Id.* at 13.

Back in 1995, sites like ours had to gather our own data about visitors to our site in order to approach prospective advertisers with demographics about our visitors. Now that all major advertising agencies have awakened to e-mail/the Internet and are on-line, Who's Who Online(SM) has ceased gathering independent data.
...

Applicant further submitted printed copies of approximately 30 third-party registrations issued on the Supplemental Register for ONLINE-formative marks for various goods and services as well as 9 such registrations for WHO'S WHO-formative marks. The following examples are illustrative:

Registration No. 3322031 for NAUTICAL CHARTS ONLINE (NAUTICAL CHARTS disclaimed) for "providing a website featuring marine navigational maps;"

Registration No. 2893965 for HEALTH CARE BENEFITS ONLINE for "providing a website featuring information on customers' health care benefits accounts, namely, claims status, eligibility for coverage, policy deductibles and limits, and participating health care providers;"

Registration No. 2647413 for BENEFITS ONLINE for "financial services, namely, providing employee benefits account information via a computer network;"

Registration No. 2722771 for WHO'S WHO IN FINE DINING for "promoting the goods and services of restaurants through the distribution of special advertising sections in which the restaurants are rated and acknowledged as fine eating establishments;"

Registration No. 1681665 for WHO'S WHO IN CONGRESS for "pocket guide containing up-to-date profiles of members of Congress including biographical data, addresses and phone numbers, committee assignments, key staff members, election results and interest group ratings;" and

Registration No. 1687391 for WHO'S WHO IN SPORTS for "biographical directories."

In support of the refusal to register, the examining attorney made of record dictionary definitions of WHO'S WHO and ONLINE. According to these definitions, WHO'S WHO is defined as follows: "a compilation of brief biographical sketches of prominent persons in a particular field <a who's who of sports figures>" or "a listing or grouping of notable persons or things."⁵ ONLINE is defined as follows: "the state of being connected to the Internet; used as an adjective, it describes a variety of activities that users do on the Internet, for example, online chat, online shopping, online searching, online communities, and on and on."⁶

The examining attorney further made of record articles and advertisements retrieved from Internet web pages displaying third-party use of various forms of WHO'S WHO ONLINE in connection with their websites. The following

⁵ Merriam-Webster OnLine Dictionary, merriam-webster.com.

⁶ netlingo.com.

representative samples from such web pages are
illustrative:

Who's Who Online Directory

The Who's Who Online Directory is a networking service for the members of the IGTI [International Gas Turbine Institute] Technical Committees, as well as participants in other IGTI leadership groups, such as the GTUS Advisory Group and the Distributed Generation Task Force. This interactive membership database replaces the annual printed Who's Who directory. ...
gti.asme.org;

The Global Directory of Who's Who: Interactive Website Tour

Intro: The Global Directory of Who's Who is an annual hard covered publication and online registry that publishes biographies of accomplished professional men and women. Our selection director chooses candidates based on their current position with information obtained from executive research and professional listings. A true global network designed for helping members grow their business, build relationships, and expand their professional horizons.
theglobalwhoswho.com;

Cambridge Who's Who

Welcome to the Cambridge Who's Who online membership application. Cambridge Who's Who among Executives, Professionals and Entrepreneurs is the fastest-growing publisher of executive, professional and entrepreneur biographies in the world today. Our accomplished members and extensive online database make Cambridge Who's Who a premier resource for networking. ... The online registry provides a state-of-the-art networking forum where executives, professionals and entrepreneurs are able to share information, knowledge and services to stay one step ahead in their careers and business.

cambridge whoswho.com;

Continental Who's Who

CWW has become one of the most trusted publishers around the globe. We spotlight thousands of professionals each year by their specific industry. The men and women published represent every important field of endeavor. Included are executives and officials in business, science, education, philanthropy, religion, government, the fourth estate, finance, law, engineering, and many other fields.

The Continental Who's Who Registry is available in three formats: Online, Hardcover and CD-ROM. The CWW Online forum is an exclusive network of world-class executives and professionals in which they can connect, educate, share information and establish new business relations.
contwhoswho.com.

Finally, the examining attorney submitted 8 third-party registrations issued on the Supplemental Register for WHO'S WHO-formative marks for various goods and services in which the term WHO'S WHO is disclaimed.

Analysis

A generic term is incapable of registration on the Supplemental Register because it does not distinguish the goods and/or services of one entity from others. A mark is a generic name if it refers to the class, genus or category of goods and/or services on or in connection with which it is used. See *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing *H. Marvin Ginn Corp. v. International Association of Fire*

Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The test for determining whether a mark is generic is its primary significance to the relevant public. See Section 14(3) of the Act. See also *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, *supra*. The examining attorney has the burden of establishing by clear evidence that a mark is generic and thus unregistrable. See *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Evidence of the relevant public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. See *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

In *In re American Fertility Society, supra*, our primary reviewing court held that if the USPTO can prove "(1) the public understands the individual terms to be generic for a genus of goods and species; and (2) the public understands the joining of the individual terms into one compound word to lend no additional meaning to the term, then the PTO has proven that the general public would

understand the compound term to refer primarily to the genus of goods or services described by the individual terms." (*Id.* at 1837.)

The court further clarified the test in *In re Dial-A-Mattress Operating Corp.*, *supra*, 1-888-M-A-T-R-E-S-S for "telephone shop-at-home retail services in the field of mattresses," (*Id.* at 1810):

Where a term is a "compound word" (such as "Screenwipe"), the Director may satisfy his burden of proving it generic by producing evidence that each of the constituent words is generic, and that "the separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to those words as a compound." *In re Gould Paper Corp.*, 834 F.2d 1017, 1018, 5 USPQ2d 1110, 1110 (Fed. Cir. 1987). However, where the proposed mark is a phrase (such as "Society for Reproductive Medicine"), the board "cannot simply cite definitions and generic uses of the constituent terms of a mark"; it must conduct an inquiry into "the meaning of the disputed phrase as a whole." *In re The Am. Fertility Soc'y*, 188 F.3d at 1347, 51 USPQ2d at 1836. The *In re Gould* test is applicable only to "compound terms formed by the union of words" where the public understands the individual terms to be generic for a genus of goods or services, and the joining of the individual terms into one compound word lends "no additional meaning to the term."

Id. at 1348-49, 51 USPQ2d at 1837.

We begin by finding that the genus of services at issue in this case is adequately defined by applicant's identification thereof, namely, "providing an online directory information service in the nature of biographical

and professional data about individuals of accomplishment.”
1 Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d
1551, 1552 (Fed. Cir. 1991) (“[A] proper genericness
inquiry focuses on the description of services set forth in
the [application or] certificate of registration”).

Turning to the second inquiry, the public's
understanding of the term, the relevant public consists of
the ordinary consumer interested in viewing, posting or
subscribing to online directory information services in the
nature of biographical and professional data about
individuals of accomplishment. As noted above, the
evidentiary burden of establishing that a term is generic
rests with the USPTO and the showing must be based on clear
evidence. *Merrill Lynch*, 4 USPQ2d at 1143. Based on this
record, we find that there is clear evidence to support a
finding that the relevant public, when they consider WHO'S
WHO ONLINE in conjunction with the class of involved
services, would readily understand the term to identify a
type of directory information service providing online
information regarding biographical and professional data
about individuals of accomplishment. The evidence of
record clearly establishes that the term WHO'S WHO is the
name of a type of listing of biographical and professional
data about individuals of note or accomplishment.

Furthermore, the record clearly establishes that the term ONLINE is the name of a type of information that is available on the Internet. Thus, and contrary to applicant's contention, the record in this case establishes that WHO'S WHO and ONLINE are generic for the recited services. Accordingly, we must consider the effect of combining these terms.

We find the addition of ONLINE to WHO'S WHO in this case to have no significance and the record clearly establishes that the proposed mark is generic. The record shows that WHO'S WHO is a unitary generic term. The record also establishes that the term ONLINE is simply a designation for a type of information available on the Internet, and lacking source-identifying capability. Indeed, the recitation of services in the involved application clearly indicates that the services are "providing an online directory information service" Therefore, WHO'S WHO ONLINE is the combination of two generic terms joined to create a compound. *Eddie Z's Blinds*, 74 USPQ2d at 1041-42. Thus, *Gould*-type evidence showing the generic nature of the two terms is sufficient to establish that the separate terms retain their generic significance when joined to form a compound that has "a meaning identical to the meaning common usage would ascribe

to those words as a compound." *Gould*, 5 USPQ2d at 1111-12. See also *In re Wm. B. Coleman Co.*, 93 USPQ2d 2019 (TTAB 2010).

The circumstances of this case are similar to those in *1800Mattress.com* where the Federal Circuit affirmed the Board's finding that *mattress.com* is generic, because the record demonstrated others' need to use the term. *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 92 USPQ2d 1682 (Fed. Cir. 2009). Here, a competitive need to use "who's who online" is demonstrated by the evidence showing that "who's who" is being used by others as the generic name of such services, and the designation "online" must be free for all to use in combination with the generic name of services provided over the Internet, *i.e.*, "online." Therefore, the generic designation for services provided over the Internet cannot transform the name of the services for which registration is sought into a trademark. See *Wm. B. Coleman*, 93 USPQ2d at 2026.

Applicant's prior, cancelled, registration of the designation WHO'S WHO ONLINE on the Supplemental Register for assertedly highly similar services does not compel reversal of the examining attorney herein. We note that we have no information of record regarding applicant's prior registration, nor are we familiar with the prosecution

history or evidentiary record thereof. While it is unfortunate that applicant's prior registration was not maintained, our precedent is clear; a cancelled or expired registration has no probative value other than to show that it once issued. *Sunnen Prods. Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987). Importantly, the presumptions which benefit a subsisting registration on the Principal Register, see Trademark Act § 7(b), die with the registration. *Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 178 USPQ 46, 47 (CCPA 1973) ("Whatever benefits a registration conferred upon appellee were lost by him when he negligently allowed his registration to become canceled."); and *In re Hunter Publ'g Co.*, 204 USPQ 957, 963 (TTAB 1979) (cancellation "makes the question of registrability 'a new ball game'"). We acknowledge that, had applicant maintained its prior registration, it would have a registration similar to the one it now seeks. However, that did not happen, and the Office must apply the same standard to the examination of applicant's new application as it applies to any other application. Applicant is not entitled to favorable treatment because it inadvertently allowed its prior registration to be cancelled.

Finally, the third-party registrations submitted by applicant are of very limited probative value in our genericness determination herein. It is well-settled that neither this tribunal nor our primary reviewing court is bound by prior determinations by the USPTO and each case must be decided on its own merits. See *In Re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed Cir. 2011). Simply put, the decision to allow the third-party registrations of record to register on the Supplemental Register does not justify registration of the instant application.

In view of the above, the examining attorney has met his burden to establish that WHO'S WHO ONLINE is generic and incapable of registration for "providing an online directory information service in the nature of biographical and professional data about individuals of accomplishment."

Decision: The refusal to register is affirmed.