

PTO Form (Rev 4/2000)

OMB No. 0651-.... (Exp. 08/31/2004)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77661323
LAW OFFICE ASSIGNED	LAW OFFICE 107
MARK SECTION (no change)	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
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GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	036
DESCRIPTION	
Providing and updating indexes of securities values; providing financial services in the nature of investment securities and funds	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	036
DESCRIPTION	Providing and updating indexes of securities values

FILING BASIS	Section 1(b)
SIGNATURE SECTION	
RESPONSE SIGNATURE	/jmb/
SIGNATORY'S NAME	Jay M. Burgett
SIGNATORY'S POSITION	Attorney of record, Illinois bar member
DATE SIGNED	07/06/2010
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Tue Jul 06 22:49:42 EDT 2010
TEAS STAMP	USPTO/RFR-38.106.150.164- 20100706224942073277-7766 1323-460e35ccaba96da36aad 6cd17b9770643-N/A-N/A-201 00706224427764120

PTO Form (Rev 4/2000)

OMB No. 0651-.... (Exp. 08/31/2004)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **77661323** has been amended as follows:

EVIDENCE

Original PDF file:

http://tgate/PDF/RFR/2010/07/06/20100706224942073277-77661323-001_001/cvi_38106150164-224427764_100706_OA_Response_IBASKETS_-FINAL.pdf

Converted PDF file(s) (23 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

- Evidence-9
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- Evidence-21
- Evidence-22
- Evidence-23

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 036 for Providing and updating indexes of securities values; providing financial services in the nature of investment securities and funds

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed: Class 036 for Providing and updating indexes of securities values

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /jmb/ Date: 07/06/2010

Signatory's Name: Jay M. Burgett

Signatory's Position: Attorney of record, Illinois bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77661323

Internet Transmission Date: Tue Jul 06 22:49:42 EDT 2010
TEAS Stamp: USPTO/RFR-38.106.150.164-201007062249420
73277-77661323-460e35ccaba96da36aad6cd17
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: CME Group Index Services, LLC Serial No.: 77/661,323 Filing Date: February 2, 2009 Mark: IBASKETS	Examining Attorney: Aretha Somerville Law Office 107
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**REQUEST FOR RECONSIDERATION IN RESPONSE TO
FINAL OFFICE ACTION
DATED JANUARY 3, 2010**

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1450

I. INTRODUCTION

Applicant filed an application to register the mark IBASKETS (the "Mark") in connection with "providing and updating indexes of securities values" in International Class 36, as amended. In an Office Action dated January 3, 2010, the Examining Attorney refused registration under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1) on the basis that Applicant's Mark is merely descriptive of the applied-for services.

In response to the contents of the Office Action, Applicant hereby submits that the Mark is, at the very least, suggestive of the applied-for services. In view of the following remarks, Applicant requests that the Examining Attorney withdraw the refusal and approve the Mark for publication in the *Official Gazette*.

II. ARGUMENT

A. The Mark IBASKETS is at the Very Least Suggestive of the Applied-For Services.

A mark is merely descriptive, and therefore unregistrable pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), if it immediately conveys information of significant ingredients, qualities, characteristics, features, functions, purposes or uses of the specified goods or services. *In re Abcor Development Corp.*, 588 F.2d 811 (CCPA 1978) (holding the mark GASBADGE merely descriptive of a “gas monitoring badge”). There is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. *See In re Atavio*, 25 USPQ2d 1361 (TTAB 1992). If one must exercise thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the mark indicates, the mark is suggestive rather than merely descriptive. *See In re Tennis in the Round*, 199 USPQ 496, 498 (TTAB. 1978). A mark is registrable if the combination of terms creates a unitary mark with a unique, nondescriptive meaning. *See In re Shutts*, 217 USPQ 363, 364 (TTAB 1983); TMEP §1209.03(d). As demonstrated below, prior TTAB decisions fully support the conclusion that Applicant’s Mark is not merely descriptive. Finally, any doubt as to whether a mark is merely descriptive or suggestive is resolved in favor of the Applicant by allowing publication of the mark for opposition. *In re Morton-Norwich Prods., Inc.*, 209 USPQ 791(TTAB 1981).

1. Applicant's Mark IBASKETS is a Unitary Mark with a Unique, Nondescriptive Meaning.

Applicant's Mark, viewed in its entirety, is a unitary, coined mark that creates a unique, non-descriptive meaning when applied to Applicant's services. The Mark does not immediately convey information about significant ingredients, qualities, characteristics, features, functions, purposes or uses of Applicant's services. At best, upon presentment of the Mark, a consumer must utilize imagination, thought or perception to reach any conclusion as to the nature of Applicant's services. Indeed, the Mark is original to Applicant as applied to Applicant's services, and the Mark has no generally accepted meaning in Applicant's trade. As a result, the Mark cannot be merely descriptive.

2. Examining Attorney Failed to Demonstrate the Mark is Merely Descriptive.

The Examining Attorney attempts to dissect Applicant's Mark and argue that it is simply the combination of two descriptive words, which, in combination, yield a merely descriptive compound mark. For the foregoing reasons, Applicant disagrees with the Examining Attorney's analysis and submits that the Mark is not merely descriptive.

- i. Examining Attorney offers no evidence that the initial "I" would be understood by the public to mean "Internet."

The Examining Attorney improperly concludes that the initial "'I' used as a prefix would be understood by the purchasing public to refer to the Internet when used in relation to Internet-related products or services." However, the Examining Attorney offers no evidence to substantiate her conclusion. First, the Examining Attorney assumes that consumers will readily recognize the Mark as having a prefix "I", as opposed to simply viewing "I" as the first letter in the mark. There is no basis for this conclusion. Second, the general rule

pertaining to initials is that they cannot be descriptive unless they have become so generally understood as representing descriptive words that they are accepted as substantially synonymous with those words. *See Modern Optics, Inc. v. The Univis Lens Co.*, 234 F.2d 504 (CCPA 1956). In addition, TMEP §1209.03(d), which the Examining Attorney cites, states that “with appropriate evidence, the prefix “i” or “I” was held to be understood by purchasers to signify Internet, when used in relation to Internet-related products or services. . . . [T]he examining attorney should provide evidence of use of the prefix “e” or “i” in relation to the goods or services.” Here, the Examining Attorney offered no evidence to support her conclusion.

Instead, the Examining Attorney cited to *In re Zanova, Inc.*, which concluded that the prefix “I” in the mark ITOOL referred to “Internet.” 59 USPQ2d 1300 (TTAB 2001). However, the TTAB states in *Zanova* that applicant expressly conceded the initial “I” meant “Internet.” Applicant has made no such concession here. Accordingly, the Examining Attorney must proffer evidence that, in the context of Applicant’s Mark, consumers would understand the prefix “I” to be synonymous with “Internet.” Indeed, the TTAB has expressly rejected the proposition that the initial “I” is generally recognized to mean “Internet”, without substantiating evidence. *See In re ILine, LLC*, 2002 WL 1275659 (TTAB 2002) (concluding the Examining Attorney failed to establish that the letter “I” is substantially synonymous with the term “Internet”). As the Examining Attorney bears the burden to supply this evidence, she has clearly failed in meeting this burden.

ii. The term “Baskets” at least suggests Applicant’s services.

The letter “I” may not immediately convey Internet, and on this basis alone, the term cannot be merely descriptive. Even assuming that the initial “I” means “Internet” and the

term “Internet” is descriptive, which Applicant does not concede, the term “Baskets” is at least suggestive of Applicant’s services. The Examining Attorney states that the term “Basket” refers to a “group of securities.” However, a group of securities is not merely descriptive of “providing and updating indexes of securities values”. The term “Basket” does not immediately convey any information about “providing updating indexes of securities values.” Similarly, the term “IBASKETS” does not immediately convey any information about these services. Instead, consumers must exercise imagination, thought or perception to reach a conclusion on the nature of Applicant’s services. As a result, Applicant’s Mark is at the very least suggestive of these services. In addition, Applicant submits that the addition of the prefix “I” to the non-descriptive term “Baskets” further removes the Mark from a descriptiveness categorization, as the Mark IBASKETS forces consumers to exercise thought or follow a multi-stage reasoning process.

iii. The *In re Zanova* case is distinguishable from Applicant’s Mark.

The Examining Attorney cites to *In re Zanova* to support her conclusion that Applicant’s Mark is merely descriptive. In *Zanova*, the TTAB held that the mark ITOOL was merely descriptive of computer software for use in creating web pages and custom designing websites for others. However, as mentioned, the *Zanova* case is easily distinguishable from the circumstances presented in this case. In *Zanova*, the record was “clear that the phrase ‘Internet Tools’ is a commonly used term and can refer to a wide variety of computer programs or computer-based services related to the Internet.” *Id.* In contrast, the Mark IBASKETS (or even the term “Internet Baskets”) is not commonly used,

nor does it have a generally accepted meaning in Applicant's trade, as applied to Applicant's services.

Instead, Applicant submits that the case *In re Brainlab AG* is analogous to this case. 2003 WL 22719383 (TTAB 2003). There, the TTAB found the "evidence submitted by the Examining Attorneys does not establish a prima facie case that the mark 'iPlan' ... is merely descriptive of applicant's identified goods...." *Id.* at *5. Even assuming the initial "I" meant "Internet", the TTAB concluded that "the dictionary definitions of 'plan' and 'planning' are insufficient to establish the term 'plan' as it appears in the mark is merely descriptive of a significant feature of applicant's goods." *Id.* The TTAB stated that "when considered in connection with applicant's planning software and programs for various medical uses . . . the mark 'iPlan' does not readily and immediately evoke an impression and an understanding of the specific nature of or a feature of applicant's identified . . . goods." *Id.*

Applicant submits that a similar reasoning should be applied in this case. In short, even assuming the initial "I" refers to "Internet" and the term "Internet" is merely descriptive, the definition of "Baskets", offered by the Examining Attorney, is insufficient to establish that the Mark, viewed in its entirety, is merely descriptive of Applicant's services. When considered in connection with Applicant's services, the Mark IBASKETS does not readily and immediately evoke an impression and understanding of the specific nature or features of these services.

3. Applicant's Mark IBASKETS Need Not Be Devoid of Any Meaning.

In addition to considering how immediate and direct is the thought process from the mark to the particular characteristics of the goods or services, a mark need not be devoid of

all meaning in relation to the goods or services to be deemed suggestive and registrable. *See* TMEP §1209.01(a). A minor degree of descriptiveness does not destroy the suggestive, or trademark significance. Gilson on Trademarks, Section 2.04; TMEP §1209.01(a). There must be a shade of descriptive meaning present or the suggestion process will not occur. *Id.* For example, the following marks have been found to be suggestive rather than merely descriptive:

- IPHARMACIST for PDA-related goods and services for use by pharmacists (*In re Apotex Technologies Inc.*, 2007 WL 411948, *7-8 (TTAB 2007));
- IPLAN for planning software and programs for various medical uses (*In re Brainlab AG*, 2003 WL 22719383, at *5-6); and
- ILINE for telecommunications services (*In re ILine, LLC*, 2002 WL 127659, at *3-4).

In the present case, Applicant's Mark need not be devoid of all meaning in relation to the services to be a suggestive mark. The "shade of descriptive meaning" present in the Mark IBASKETS allows for the suggestive process to occur. It does not "destroy the suggestive" nature of the Mark and transform the Mark into being merely descriptive. Like the marks IPHARMACIST, IPLAN and ILINE, referenced above, Applicant's Mark only suggests some meaning of the identified services.

4. Any Doubt Must be Resolved in Applicant's Favor.

The TTAB has stated several times that any doubt in reaching a conclusion about the "merely descriptive" character of a mark must be resolved in the applicant's favor. *See In re Altavio*, 25 USPQ2d 1361, 1363 (TTAB 1992); *In re The Rank Org. Ltd.*, 222 USPQ 324,

326 (TTAB 1984); and *In re Morton-Norwich Prods., Inc.*, 209 USPQ 791, 791 (TTAB 1981). Accordingly, after considering Applicant's remarks, if the Examining Attorney is in doubt as to whether the Mark is merely descriptive or suggestive, Applicant requests that the doubt be resolved in favor of Applicant by allowing the Mark to publish for opposition. See *In re Morton-Norwich Prods., Inc.*, 209 USPQ at 791.

III. CONCLUSION

In light of the foregoing, Applicant respectfully requests the Examining Attorney to withdraw the refusal to register and pass Applicant's mark for publication in the *Official Gazette*.

2007 WL 411948 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board
Patent and Trademark Office (P.T.O.)

IN RE APOTEX TECHNOLOGIES INC.

SERIAL 76449597 AND 78429952

January 29, 2007
Hearing: November 7, 2006

Carla C. Calcagno of Holland & Knight LLP for Apotex Technologies Inc.

John M. Gartner, Trademark Examining Attorney
Law Office 102
(Thomas V. Shaw, Managing Attorney)

Before Hohein, Walters and Bucher
Administrative Trademark Judges
Opinion by Bucher
Administrative Trademark Judge:

Apotex Technologies Inc., a Canadian corporation, seeks registration on the Principal Register of the mark **IPHARMACIST** (*in typed or standard character formats*) for goods and services identified in the application, as amended, as follows:

“pre-recorded video tapes featuring training in the use of personal digital assistants preprogrammed with pharmaceutical information and handheld personal digital assistant computers preprogrammed with computer database software containing pharmacy and pharmaceutical-related proprietary and publicly available information, both of which are intended for use by pharmacists and pharmacy technicians in the practice of pharmacy” in International Class 9;

“printed matter containing pharmacy and pharmaceutical-related information, namely, books, fliers, brochures, manuals, guides, pamphlets and trade journals” in International Class 16; and

“custom design for others of personal digital assistant software programs for use by a pharmacist or pharmacy technician in the practice of pharmacy, not including Internet access software” in International Class 42;^[FN1]
and the same mark **IPHARMACIST** for substantially the same goods and services.^[FN2]

These consolidated cases are now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation under Section 2(e)(1) of the Trademark Act based upon the ground that the mark, **IPHARMACIST**, when considered in relation to applicant's identified goods and services, immediately describes their nature. Specifically, the Office argues that the letter “I” refers to the Internet, which in turn is a significant feature of applicant's personal digital assistants (PDAs), supporting literature and software, as well as the service of custom designing the PDAs for use by pharmacists.

Both applicant and the Trademark Examining Attorney have fully briefed this appeal, and both appeared at an oral hearing before a video-conferenced panel of the Board.

We reverse the consolidated refusals to register.

Refusal under Section 2(e)(1) of the Act

A mark is merely descriptive, and therefore unregistrable pursuant to the provisions of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), if it immediately conveys information of significant ingredients, qualities, characteristics, features, functions, purposes or uses of the goods or services with which it is used or is intended to be used. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978) [GASBADGE merely descriptive of a "gas monitoring badge"]. See also *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) [MONTANA SERIES and PHILADELPHIA CARD merely descriptive of "credit card services." The Court found that a "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service"]. Hence, the ultimate question before us is whether the term **IPHARMACIST** conveys information about a significant feature or characteristic of applicant's goods and services with the immediacy and particularity required by the Trademark Act.

*2 A mark is suggestive, and therefore registrable on the Principal Register without a showing of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. See *In re Gvilay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) [APPLE PIE merely descriptive of potpourri mixture: "Whether a given mark is suggestive or merely descriptive depends on whether the mark 'immediately conveys ... knowledge of the ingredients, qualities, or characteristics of the goods ... with which it is used,' or whether 'imagination, thought, or perception is required to reach a conclusion on the nature of the goods.'" (citation omitted)].

The question of whether a particular term is merely descriptive is not decided in the abstract. That is, when we analyze the evidence of record, we must keep in mind that the test is not whether prospective purchasers can guess what applicant's goods are after seeing applicant's mark alone. *In re Abcor*, *supra* at 218 ["Appellant's abstract test is deficient — not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as required by statute"]; *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990) [NEW HOME BUYER'S GUIDE merely descriptive of "real estate advertisement

NewHome
BUYER'S GUIDE

services"]; and *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985) [APRICOT is merely descriptive of apricot-scented dolls]. Rather, the proper test in determining whether a term is merely descriptive is to consider the alleged mark in relation to the goods or services for which registration is sought, the context in which the mark is used, and the significance that the mark is likely to have on the average purchaser encountering the goods or services in the marketplace. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987)

 **FirstTier**

[the term "first tier" describes a class of banks]; *In re Pemzoi Products Co.*, 20 USPQ2d 1753 (TTAB 1991) [MULTI-VIS is merely descriptive of "multiple viscosity motor oil"]; *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986) [DESIGN GRAPHIX merely descriptive of computer graphics programs]; and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979) [COASTER-CARDS merely descriptive of a coaster suitable for direct mailing].

*3 The Trademark Examining Attorney herein argues that the letter "I" refers to the Internet, and the word "Pharmacist" refers to the users of the goods and services, and furthermore, that when these two descriptive terms are combined into **IPHARMACIST**, the components retain their descriptive meanings. He argues from an initialism dictionary and applicant's own website that **IPHARMACIST** immediately describes the nature of applicant's goods and services, i.e., that applicant's PDAs, as well as the service of custom designing the PDAs, and the supporting literature and software, are for use by pharmacists who in turn utilize the Internet as a feature of the goods.

By contrast, applicant contends that the Office has failed to prove that **IPHARMACIST** merely describes any feature or characteristic of applicant's goods or services, summarizing its arguments as follows:

1. The initial letter "I" has meanings other than "Internet," including "interactive" and "information" — connotations more applicable to applicant's goods than the suggested term "Internet";
2. "Internet pharmacist" is a common, ordinary English-language phrase meaning a person who dispenses drugs based upon orders placed over the Internet; and
3. "Internet pharmacists," as defined above, are not the targeted users for applicant's goods and services.

Evidence of Record:

We begin our analysis by looking at the evidence of record in this case. The Trademark Examining Attorney argues that it is significant that in advertising the **IPHARMACIST** goods and services on its website, applicant points out that Internet access is a feature of its goods and services, in that customers can automatically update the software and obtain technical support:



Always up-to-date

Tired of trying to keep all your information up-to-date manually? Using your Internet connection, the NetUpdate feature automatically checks for new and updated versions of your iPharmacist software each time you HotSync

and

iPharmacist users have access to a wide range of Web-based and real time support options. To fully assist you, our dedicated iPharmacist support system is offered for both hardware and software.^[FN4]

The originally-assigned Trademark Examining Attorney had placed into the record entries from the online "Acronym Finder" for the letter "I" that included an entry for "Internet."^[FN5] as well as an entry containing a dictionary definition of "pharmacist" as meaning "a person trained in pharmacy; a druggist."^[FN6]

Analysis:

We turn then to look at this evidence in light of the mark that applicant seeks to register, **IPHARMACIST**.

Is the letter "I" in applicant's mark synonymous with "Internet"?

As noted above, the Office argues from the "Acronym Finder" that the leading letter "I" in applicant's mark will be viewed as a shorthand for "Internet." In response, applicant notes that the most commonly-used meanings of the letter "I," sorted by decreasing rank, are 1 One (the Roman Numeral), 2 interest, 3 incomplete (school) and 4 italic. Further down the list are meanings arguably more closely related to the current goods and services, such as "information," "international," "Internet," "interactive," "informative," and "instructional."^[FN7] For example, given that applicant's goods are *interactive* devices (e.g., PDAs) designed to provide *information* to the pharmacist so that she can check into

possible drug *interactions* for her patient, applicant argues that entries such as “interactive,” “information” or “interactions” would arguably be better fits here — grammatically and content wise — than the word “Internet.”

*4 Nonetheless, the Trademark Examining Attorney maintains that the meaning of the letter “I” as used in applicant’s mark is made clear from the context of the goods and services. As indicated by the entire record herein, including applicant’s website, the Trademark Examining Attorney argues that access to the Internet is a significant feature of applicant’s goods and services. He contends that when **IPHARMACIST** is used in connection with software and PDAs for pharmacists, software design and related literature, it is clear that users of the goods and services would readily understand that the letter “I” in this case refers to the Internet.

We agree with the general point proffered by the Trademark Examining Attorney at oral argument that in making our determination, we are not required to turn a blind eye to the reality of what is being offered on applicant’s website, thereby artificially restricting our purview solely to the description of goods and services in the application itself. See *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1438 (TTAB 2005) [SPORTSBETTING.COM is generic for sports wagering services and provision of information regarding sports and betting], citing to *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991); and *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420 (Fed. Cir. 2005).

On the other hand, we agree with applicant that under the rule enunciated in *Modern Optics, Incorporated v. The Univis Lens Company*, 234 F.2d 504, 110 USPQ 293, 295 (CCPA 1956) [initial letters CV not merely descriptive for trifocal lenses known as “Continuous Vision lenses”: “... as a general rule, initials cannot be considered descriptive unless they have become so generally understood as representing descriptive words as to be accepted as substantially synonymous therewith ...”], there is insufficient probative evidence that the relevant purchasers of applicant’s goods and services would understand that the Trademark Examining Attorney’s suggested meaning (i.e., that the initial letter “I” means “Internet”) is the one that will immediately come to mind when these consumers encounter the involved mark.

If “I” is synonymous with “Internet,” is the word INTERNET alone merely descriptive of these goods and services?

It is a fact that access to the Internet by way of a personal computer does permit pharmacists who are applicant’s customers to update the software on their PDAs and to obtain technical support from applicant. Nonetheless, the issue remains whether these features are so significant that the word “Internet” alone would have to be considered to be merely descriptive of the named goods and services. The Office argues that these are significant features. By contrast, applicant contends they are nothing more than incidental features of its products and services:

*5 Indeed, when taken to its logic and extreme, would the undersigned be considered an “Internet lawyer” because she researches cases on LEXIS? Given that using the Internet to obtain information is ubiquitous, virtually any professional in the country could be termed an “Internet doctor” or “Internet farmer,” under the Examiners’ argument, were that professional to rely on the Internet in any significant way for the practice of the profession. Applicant’s appeal brief, pp. 3 - 4.

As the Trademark Examining Attorney points out, the term Internet is certainly capable of being analyzed in the context of these goods and services. However, that fact alone is not sufficient to determine that the word Internet is descriptive of these goods and services. See *In re The Rank Organization Limited*, 222 USPQ 324, 326 (TTAB 1984) [The “fact that the term ‘LASER’ is capable of being analyzed does not render the term merely descriptive”]. Even taking into consideration the marketplace realities gleaned from applicant’s website — the involved PDAs “hot sync” with data files contained on the disk drive of ones PC, and participating pharmacists can ask for technical support over the web — we find that the evidence in the record before us does not support the conclusion that the term “Internet” alone, when used in connection with applicant’s products, merely describes a significant feature of applicant’s goods or services.

The word “Pharmacist” alone for these goods and services:

Applicant's identification of goods and recital of services are replete with words like "pharmacy," "pharmaceutical," and even "pharmacist." Arguably, then, as the targeted uses of these products, the term "Pharmacist" alone must be considered to be merely descriptive for its PDA-related goods and services. See *In re Hunter Publishing*, 204 USPQ 957 (TTAB 1979) [JOBBER AND WAREHOUSE EXECUTIVE merely descriptive for trade magazine directed to jobber and warehouse managers or executives in the automotive aftermarket]; and *In re Camel Manufacturing Co.*, 222 USPQ 1031 (TTAB 1984) [MOUNTAIN CAMPER merely descriptive of retail and mail order services in field of outdoor equipment and apparel].

The term "Internet Pharmacist"

The Trademark Examining Attorney has submitted excerpts from the web demonstrating that the term, "Internet Pharmacist," has a readily understood meaning to health care patients seeking pharmaceutical products online. In fact, applicant does not deny that "Internet Pharmacist" is a term of art describing someone who dispenses drugs through prescriptions or orders placed over the Internet:

Applicant readily concedes that the mark INTERNET PHARMACIST might be merely descriptive of one who dispenses drugs over the Internet, but Applicant is not applying for these services.

*6 Applicant's brief, p. 3. In this context, we note that the three classes of goods and services in this application are training videotapes and PDAs in class 9, related printed matter in class 16, and services involving the custom design of PDAs in class 42.

The term "Internet Pharmacist" may well be merely descriptive, if not generic, for a hypothetical recitation of services such as "online retail store services featuring pharmaceuticals." Similarly, the term "Internet Pharmacist" may well be merely descriptive for goods or services specifically directed to pharmacists who dispense drugs over the Internet. However, those are not the involved goods and services herein.

As applied to products and services designed to provide up-to-date information on possible drug interactions to one's local druggist, we agree with applicant that the combined term "Internet Pharmacist" is just too nebulous in meaning and non-specific in nature for consumers to immediately associate it with a quality or characteristic of the involved products or services. See *In re Sundown Technology Inc.*, 1 USPQ2d 1927, 1928 (TTAB 1986) ["[W]e find that 'GOVERNOR' applied to applicant's [controls used to modulate the output of a musical amplifier] is nebulous in meaning"]; *In re WSI Corporation*, 1 USPQ2d 1570, 1572 (TTAB 1986) [SUPER SAT is suggestive of services involving weather information services inasmuch as the SAT element might well suggest satellite involvement, but still requires imagination, perception or reflection on the part of potential customers]; and *In re TMS Corp. of the Americas*, 200 USPQ 57, 59 (TTAB 1978) [THE MONEY SERVICE falls short of describing applicant's financial services with the requisite degree of particularity].

In his brief, the Trademark Examining Attorney takes the position that the term "Internet Pharmacist" could include the pharmacist in one's local brick-and-mortar drug store who uses the Internet in any significant way in connection with her pharmaceutical practice. We disagree. There is nothing in the record to demonstrate that the term "Internet Pharmacist" would be interpreted in this manner. See *In re Harrington*, 219 USPQ 854, 856 (TTAB 1983) [COLLEGE ACADEMY "is at most suggestive of special summer learning programs for gifted and talented children in grades 4 to 8"].

The term "IPHARMACIST"

The actual mark before us is IPHARMACIST (*in typed or standard character formats*). We have seen in applicant's specimens actual use of "iPharmacist" (a lower case letter "i" followed by upper case letter "P"). In any case, we assume that prospective customers of applicant's goods and services will undoubtedly view this coined mark as a run-together combination of the letter "I" and the word "Pharmacist."

*7 We have already determined that it is unlikely that the letter "I" will be seen as synonymous with the word "In-

ternet.” and if it is, the word “Internet” would be suggestive, at most, of the involved products. While arguably the term “Pharmacist” alone may be merely descriptive for applicant’s PDA-related goods and services, there is no evidence in the record before us that the phrases “iPharmacist” describes a feature of applicant’s goods or services.

In support of his position, the Trademark Examining Attorney has cited to the case of *In re Zamova, Inc.*, 59 USPQ2d 1300, 1304 (TTAB 2000) [ITool merely descriptive of computer software for use in creating web pages and custom designing websites for others]. However, this Board pointed out that the record in that case was “clear that ‘Internet tool[s]’ is a *commonly used term* and can refer to a wide variety of computer programs or computer-based services relating to the Internet.” (*emphasis supplied*) The Board found that “it is abundantly clear that the term ‘Internet tools’ not only describes a wide array of software and related services, but also *aptly describes applicant’s goods and services.*” (*emphasis supplied*) By contrast, in this case, while acknowledging that the term “Internet Pharmacist” is a term of art, we have explicitly found that it does not describe applicant’s goods and services.

When making a refusal under Section 2(e)(1) of the Act, the Examining Attorney has the burden of establishing that the mark is merely descriptive. In the instant case, we find that burden has not been met. *In re Remacle*, 66 USPQ2d 1222 (TTAB 2002) [BIO-CD is not merely descriptive of, *inter alia*, modified compact discs used to test biological matter and related equipment and services]. It is not at all apparent that the Trademark Examining Attorney’s interpretation of the mark will immediately come to mind when prospective purchasers encounter the term **IPHARMACIST** used in association with applicant’s goods and services. *In re The Rank Organization Limited*, *supra* at 326. In view of the foregoing, we cannot conclude that the term **IPHARMACIST** possesses a merely descriptive significance in connection with the identified goods and services.

Finally, the Board has noted many times that any doubt we may have in reaching a conclusion about the “merely descriptive” character of a mark must be resolved in favor of the applicant — that is to say, in such cases we are required to reverse the refusal to register and allow publication of the mark for opposition so that any affected third party may file an opposition and develop a more comprehensive record. See *In re Atavio*, 25 USPQ2d 1361, 1363 (TTAB 1992); *In re The Rank Organization Ltd.*, *supra* at 326, and cases cited therein; and *In re Morton-Norwich Products, Inc.*, 209 USPQ 791, 791 (TTAB 1981).

***8 Decision:** The refusal to register under Section 2(e)(1) of the Lanham Act is hereby reversed.

FN1. Application Serial No. 76-449597 was filed on September 9, 2002 based upon applicant’s allegation of a *bona fide* intention to use the mark in commerce.

FN2. Application Serial No. 78-429952 was filed on June 4, 2004 based upon applicant’s allegation of a *bona fide* intention to use the mark in commerce (Section 1(b) of the Act) and under Section 44(e) of the Act, based upon Canadian Registration No. TMA-604,501, which issued on March 9, 2004. This later-filed application now contains exactly the same identification of goods and recitation of services as the earlier filed application except that it adds “multimedia software recorded on CD-ROM featuring pharmaceutical information for use by pharmacists and pharmacy technicians in the practice of pharmacy” to the ending of the identification of goods in International Class 9.

FN3. <http://www.ipharmacist.ca/public/technology.xml>

FN4. <http://www.ipharmacist.ca/public/support.xml>

FN5. <http://www.acronymfinder.com>. Applicant has not questioned the reliability of this website.

FN6. THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (3rd Ed. 1992).

FN7. Of course, as applicant also points out, the forty-two meanings other than “Internet” suggested by the “Acronym

Finder” for the letter “T” included terms having absolutely no readily-seen connections to applicant’s goods or services, such as “indoor.”

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2003 WL 22719383 (Trademark Tr. & App. Bd.)

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board
Patent and Trademark Office (P.T.O.)

IN RE BRAINLAB AG

Serial No. 78083252

November 14, 2003

Don W. Bulson of Renner, Otto, Boisselle & Sklar, LLP for BrainLAB AG

Susan C. Hayash, Trademark Examining Attorney
Law Office 110
(Chris A.F. Pedersen, Managing Attorney)

Before Simms, Walters and Chapman
Administrative Trademark Judges
Opinion by Chapman
Administrative Trademark Judge:

BrainLAB AG (a German corporation) has filed an application to register on the Principal Register the mark shown below

iPlan

for goods and services amended to read as follows:

“computers; planning software and programs for neurosurgical, orthopedic, radiotherapeutic or radiosurgical purposes; planning software and programs for application in robot-assisted medical applications; planning software and programs for application in ear, nose and throat (ENT) surgery; planning software and programs for application to three-dimensional registration or referencing patient data by producing light markings; data carriers including planning software and programs for neurosurgical, orthopedic, radiotherapeutic or radiosurgical purposes; data carriers including planning software and programs for application in ear, nose, and throat surgery purposes; data carriers including planning software and programs for application to three-dimensional registration and or referencing patient data by producing light markings; light pointers, laser light pointers and infrared light pointers for medical applications” in International Class 9;

“electronic apparatus and image presentation apparatus for medical purposes; image-guided localization systems for surgical purposes; neurosurgical instruments and apparatus; medical and surgical robots and accessories, namely control boxes, instrument adaptors, tool holders, adaptors for endoscopes and microscopes, and connection cables; radiotherapeutic and radiosurgical apparatus; devices to acquire and adjust radiation points for

medical purposes; systems and components to precisely position patients for radiotherapeutic, radiosurgical or neurosurgical purposes, namely collimators, infrared and video cameras and accessories, patient markers, displays, isocenter phantoms, calibration phantoms, patient trays and accessories, head holders and adaptors, vacuum pumps, vacuum cushions, referencing stars, ultrasound phantoms, ultrasound adaptors, and x-ray registration kits; nuclear spin tomographs; magnetic resonance tomographs; intra-operative, image-guided localization systems and components for neurosurgical, orthopedic, stereotactic, radiotherapeutic or radiosurgical purposes, and for application in ear, nose and throat surgery, including cameras, displays, image presentation apparatus, computers, reference clamps, pointers, surgical instruments, registration markers and marker spheres, body markers, canullae, laptops, docking stations, panels, panel parts, headsets, headrings, remote controls, probes, sensors, instrument adaptors, virtual keyboards, dental referencing devices, laser pointers, phantom pointers, systems and components for software-controlled precision treatment in neurosurgery, orthopedics, radiotherapy or radiosurgery and in ear, nose, and throat surgery, including localizers, torque wrench sets, stereotactic or neurosurgical arcs, biopsy kits, fixation adaptors, instrument calibration matrixes and fixation rings, planning stations, computers, couchmounts, collimators, target positioners, film holders, mask systems, couch stabilizers, couch adaptors, radiation devices, linear accelerators, gantries, microscope adaptors, fixation pins, head and neck immobilization devices; instruments and apparatus for three-dimensional registration or referencing of patients; light pointers for medical use” in International Class 10; and “computer programming services, namely, developing programs for others for neurosurgical, orthopedic, radiotherapeutic or radiosurgical purposes, for application in ear, nose, and throat surgery, for robot-assisted applications, and for three-dimensional registration or referencing of patients; customer service for the operation of medical navigation, localization and registration devices; customer service via telephone, internet and or other telecommunication means; customer service via telephone, internet and or other telecommunication means (including online customer service) for the operation of medical navigation, localization or registration devices and for radio-therapeutic or radiosurgical purposes” in International Class 42.^[FN1]

*2 The Examining Attorney who first examined this application ultimately made final his refusal to register the mark for the International Class 9 goods on the basis that under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), when used on applicant's International Class 9 goods, the mark is merely descriptive of them. The Examining Attorney also made final the requirements for a more definite recitation of goods in International Classes 9 and 10, and for a more definite recitation of services in International Class 42, along with his requirement that, because the “customer services...” portion of applicant's services identified in International Class 42 is properly classified in International Class 35, applicant must take the necessary steps to delete such services from International Class 42 and add International Class 35 to the application.

Applicant appealed as to the refusals in each of the three classes. Both applicant and the Examining Attorney have filed briefs.^[FN2] Applicant did not request an oral hearing.

In the Examining Attorney's brief on appeal, she withdrew the requirements for a more definite identification of goods in International Classes 9 and 10. Thus, the only issues on appeal are whether the mark is merely descriptive of the goods listed in International Class 9; and whether the requirements for a more definite identification of services in International Class 42 and the transfer of the specified services to International Class 35 are proper.

Turning first to the question of the recitation of services in International Class 42, the Examining Attorney did not accept either the original identification of services or the amended identification of services (as set forth above) in International Class 42. The Examining Attorney had suggested in his Final Office action the following, if appropriate:

“customer services in the field of _____ [indicate field] for the operation of medical, navigation, localization and registration devices via telephone and the Internet” in International Class 35; and
 “computer programming services for others, namely, computer software development in the fields of neurosurgery, orthopedics, radiotherapy and radio surgery; computer programming services for others, namely, computer software development for robot-assisted applications, three-dimensional registration and referencing of patients; technical support services, namely, troubleshooting of computer hardware and software problems relating to the

operation of navigation, localization and registration hardware drives" in International Class 42.

Applicant contends that its identification of services as amended is not indefinite; that a "similar" identification of services was accepted in another of applicant's applications (Serial No. 78067471, now Registration No. 2752867); and that the recited services in International Class 42 are properly classified therein.

*3 Both applicant and the Examining Attorney argued the issue of a proper identification of services based on the amended identification of services. Thus, our decision relates to the question of the acceptability of the amended identification.

As explained above, all three involved classes of goods and services in this application are based on both applicant's assertion of a bona fide intention to use the mark in commerce and Sections 44 (d) and (e) of the Trademark Act. Section 1(b)(2) of the Trademark Act, 15 U.S.C. §1051(b)(2), requires that the written application specify the goods or services on or in connection with which applicant intends to use the mark. See also, Sections 44(d)(2) and (f), 15 U.S.C. §44(d)(2) and (f). Trademark Rule 2.32(a)(6) requires, in relevant part, that a trademark application must set forth "the particular goods or services" with which the mark is used or is intended to be used.

Further, the identification of goods or services must be specific and definite. See TMEP §§805 and 1402.01-1402.03(a) (3d ed. 2002). It is within the discretion of the United States Patent and Trademark Office (USPTO) to require that the goods or services be specified with particularity. See *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296, 1298 (TTAB 1986), and cases cited therein, rev'd on other grounds, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1998). As stated in TMEP §1402.01 (Third Edition 2002): "To 'specify' means to name in an explicit manner. ... The identification of goods or services must be specific, definite, clear, accurate and concise. ..."

The USPTO's *Trademark Acceptable Identification of Goods and Services Manual* clearly indicates, as pointed out by the Examining Attorney, that "customer services in the field of ___" are properly classified in International Class 35. USPTO classification is based on the Nice Agreement Concerning the International Classification of Goods and Services, to which the United States is a party. Each of the countries party to the Nice Agreement is obliged to apply the Nice Classification in connection with the registration of marks. Thus, applicant has clearly misclassified its services, "customer services..." within International Class 42. Such services are properly classified in International Class 35.

Additionally, the specified portions of applicant's amended identification of services in International Class 42, "customer service for the operation of..." and "customer service via telephone..." are so vague as to be unacceptable. These portions as written encompass customer services such as an answer line, which is a business service in International Class 35, and the service of troubleshooting computer hardware and software problems, which is properly in International Class 42. Applicant has not clarified the "customer service..." portions of its identification of services.

*4 Upon review by this Board, the Examining Attorney's requirements for a more definite identification and proper classification of services are proper. That is, we have carefully reviewed the identification of services in this application and we find the Examining Attorney's requirement for a more definite identification and classification of services to be well taken because the language proposed by applicant does not clearly, and with the necessary specificity, identify applicant's services. See *In re Citibank, N.A.*, 225 USPQ 612 (TTAB 1985).

Turning to the issue of mere descriptiveness in relation to the goods in International Class 9, it is the Examining Attorney's position that the mark "iPlan" (in stylized lettering) "merely describes a function, feature, or purpose of the computer software, in that it offers planning software that enables users to plan its [sic-their] operating and other procedures, and is available via the internet, or allows access to the internet." She specifically argues that "i" means "internet" as shown in "acronymfinder.com" and in several excerpted stories retrieved from the Nexis database; that

the word "plan" is defined in The American Heritage Dictionary (Third Edition 1992) as "1. A scheme, program or method worked out beforehand for the accomplishment of an objective: a plan of attack";^[FN3] that the word "planning" as it is used in the phrase "planning software and programs..." in applicant's International Class 9 identification of goods, is merely the adjectival form of the word "plan"; that the term "'IPLAN' means 'internet plan' with no separate, nondescriptive meaning" (brief, p. 6); that no mental gymnastics are required to determine information about these goods; and that applicant's deletion of wording relating to the Internet which was in the original identification of the International Class 9 goods, does not preclude the possibility that applicant's computer software is available on the Internet.

Applicant urges reversal arguing that its mark "iPlan" (in stylized lettering) is suggestive and does not describe a function, feature or purpose of the involved goods; that even assuming the letter "i" suggests some relationship to the Internet (and there are several other meanings for "i" in the "acronym finder," e.g., international, interstate, iodine, Italy), the goods do not include the Internet or components of the Internet; that while the term "plan" may suggest something to do with a plan or planning, there is no evidence that "Internet Plan" is used in relation to planning software and programs for any medical purpose, and thus, this phrase has no definite meaning in the relevant trade; that when the letter "i" and the term "plan" are combined, they evoke a new and unique commercial impression; and that the Examining Attorney has not established a prima facie case that the mark is merely descriptive of the involved goods.

*5 It is well settled that "a term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]." (Emphasis added). In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). Moreover, the immediate idea must be conveyed with a "degree of particularity." In re TMS Corporation of the Americas, 200 USPQ 57, 59 (TTAB 1978). See also, See In re Neit Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); and In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd, unpub'd, Fed. Cir. February 13, 1991.

Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the term (or phrase) is being used or is intended to be used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); Abcor, 200 USPQ at 218; and In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991).

It has long been acknowledged that there is often a very narrow line between terms which are merely descriptive and those which are suggestive, and the borderline between the two is hardly a clear one. See In re Atavio Inc., 25 USPQ2d 1361 (TTAB 1992).

We find that the evidence submitted by the Examining Attorneys does not establish a prima facie case that the mark "iPlan" (in stylized lettering as shown above) is merely descriptive of applicant's identified goods in International Class 9, including "planning software and programs" for various specific medical uses and purposes. We agree with the Examining Attorney that the "acronym finder" printout and the excerpted stories retrieved from the Nexis database establish that, in relation to the identified goods, the "i" portion of applicant's mark is likely to be perceived as meaning "Internet." However, the dictionary definitions of "plan" and "planning" are insufficient to establish the term "plan" as it appears in the mark is merely descriptive of a significant feature of applicant's goods.

Further, when considered in connection with applicant's planning software and programs for various medical uses (e.g., for neurosurgical, orthopedic, radiotherapeutic or radiosurgical purposes; for application in robot-assisted medical applications; for application in ear, nose and throat (ENT) surgery; and for application to three-dimensional registration or referencing patient data by producing light markings) the mark "iPlan" does not readily and immediately evoke an impression and an understanding of the specific nature of or a feature of applicant's identified International Class 9 goods. See Concurrent Technologies Inc. v. Concurrent Technologies Corp., 12 USPQ2d 1054

(TTAB 1989); *In re Intelligent Medical Systems Inc.*, 5 USPQ2d 1674 (TTAB 1987); and *In re TMS Corporation of the Americas*, supra.

*6 The facts in the case of *In re Zanova Inc.*, 59 USPQ2d 1300 (TTAB 2001), cited by the Examining Attorney, are distinguishable from the situation now before the Board. In the *Zanova* case (59 USPQ2d at 1304), involving applications for the mark ITOOL, the Board pointed out that the record was "clear that 'Internet tool(s)' is a commonly used term and can refer to a wide variety of computer programs or computer-based services relating to the Internet"; that "it is abundantly clear that the term 'Internet tools' not only describes a wide array of software and related services, but also aptly describes applicant's goods and services"; and that "the evidence demonstrates that the term 'tool' itself is, contrary to applicant's argument, also descriptive of applicant's goods and services."

It appears from the identification of goods that the term "planning software" may describe a type of software, but there is no evidence in the record before us that the term "plan" in relation to applicant's software for use in various specific medical applications merely describes a significant feature of applicant's goods; or that the phrases "iPlan" or "Internet plan" describe a feature of applicant's specific software.

The Board has noted many times that if there is doubt about the "merely descriptive" character of a mark, that doubt is resolved in applicant's favor, allowing publication of the mark so that any third party may file an opposition to develop a more comprehensive record. See *In re Atavio*, supra.

Decision: The refusal based on the requirements for a more definite identification of services in International Class 42, and for the classification of "customer services in the field of _____" in International Class 35 is affirmed; and the refusal to register the mark for the International Class 9 goods under Section 2(e)(1) of the Trademark Act is reversed.

Accordingly, at the appropriate time, this application will be forwarded for publication of the mark for opposition in International Classes 9 and 10 only. International Class 42 is hereby deleted from the application.

FN1. Application Serial No. 78083252 was filed September 9, 2001, for goods and services in International Classes 9, 10 and 42. The application was filed based in each class on both (i) applicant's assertion of a bona fide intention to use the mark in commerce and (ii) Sections 44(d) and (e) of the Trademark Act, 15 U.S.C. §1126(d), applicant's German application No. 301 16 947.0 10 filed March 14, 2001, issued as German Registration No. 301 16 947 on April 8, 2002 for International Classes 9, 10, and 42.

The acceptability of the classification and of the recitation of services in International Class 42 are issues in this appeal and will be fully addressed later in this decision.

FN2. A different Examining Attorney submitted the brief on appeal.

FN3. The Examining Attorney requested in her brief on appeal (p. 6) that the Board take judicial notice of an additional dictionary definition of the word "plan." The request is granted. See TBMP §704.12(a) (2d ed. June 2003).

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THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board
Patent and Trademark Office (P.T.O.)

IN RE ILINE, LLC

Serial No. 75 621,298

June 7, 2002

Samuel Fifer for iLine, LLC

Kelly A. Choe, Trademark Examining Attorney
Law Office 113
(Odette Bonnet, Managing Attorney)

Before Hanak, Wendel and Bucher
Administrative Trademark Judges
Opinion by Hanak
Administrative Trademark Judge

iLine, LLP (applicant) seeks to register ILINE in typed drawing form for "telecommunications services, namely, the international electronic transmission of voice and facsimile data over data lines using the global computer network." The intent-to-use application was filed on January 13, 1999.

Citing Section 2(e)(1) of the Trademark Act, the Examining Attorney has refused registration on the basis that applicant's mark ILINE is merely descriptive of applicant's services.

As has been stated repeatedly, "a term is merely descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]." In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)(emphasis added). Moreover, the immediate idea must be conveyed forthwith with a "degree of particularity." In re TMS Corp. of the Americas, 200 USPQ 57, 59 (TTAB 1978); In re Entenmann's Inc., 15 USPQ 750, 751 (TTAB 1990), aff'd 90-1495 (Fed. Cir. February 13, 1991). Finally, the mere descriptiveness of a mark is determined by considering the mark in its entirety, and not considering just the component parts of the mark. Abcor Development, 200 USPQ at 218. See also In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999).

It is the position of the Examining Attorney that "I LINE [is] understood to mean INTERNET LINE." and that the term INTERNET LINE is clearly descriptive of "telecommunications services, namely, the international electronic transmission of voice and facsimile data over data lines using the global computer network." (Examining Attorney's brief page 8).

In an effort to show that the letter I is synonymous with the word INTERNET, the Examining Attorney has made of record only two pieces of evidence. First, the Examining Attorney has submitted a photocopy of a page from the Illustrated Computer Dictionary for Dummies (4th ed. 2000) where the letter "i" is defined as follows: "The prefix for all things Internet, as in iMac. A second cousin to e, which is more prominently used, though i is more accurate because everything e happens on the i. Internet. See also e." Second, the Examining Attorney has submitted a press release dated April 14, 1998 from States News Service which contains the following sentence: "'I lines will not only carry voice, but also cable, and video,' said Sarah Hofstetter, Vice President of Corporate Communications at IDT Corp."

*2 We will deal with the Examining Attorney's second piece of evidence first. This piece of evidence is not a news story, but rather is simply a press release put out by States News Service on behalf of IDT Corp. Because the Examining Attorney has not established that this press release was ever carried by any publication and thus was exposed to the public, it is entitled to no evidentiary value. Indeed, given the vast expanse of the Nexis data base, we presume that had this press release been carried by a publication, that publication using the term "I lines" would have been picked up in the Examining Attorney's search.

With regard to the dictionary definition made of record by the Examining Attorney, applicant notes that it could not find one other dictionary which listed the letter I (in either lower or upper case) or listed the term "I lines" (whether depicted as one or two words).

This Board has conducted its own independent search of all available computer dictionaries in the trademark library of the USPTO. Simply by way of example, some of the dictionaries consulted include the following: Webster's New World Dictionary of Computer Terms (8th ed. 2000); Barron's Dictionary of Computer & Internet Terms (7th ed. 2000); The Computer Glossary (2001); Dictionary of Computer Science Engineering and Technology (2001); The Computer Dictionary (1998); Microsoft Press Computer Dictionary (1997); and the Dictionary of Personal Computing and the Internet (1997).

In addition, we have also consulted the Acronyms, Initialisms & Abbreviations Dictionary (29th ed. 2001). This is a massive work comprising seven volumes with over 20,000 pages. The comprehensive nature of this work is demonstrated by the fact that the letter I is listed as having over 280 definitions. However, not one of these 280 definitions means "Internet," or anything like Internet. To be precise, the term "i-line" appears in this work. However, this work defines this term as a photo-journalism expression meaning "identification line."

Obviously, applicant is not seeking to register INTERNET LINE. Rather, applicant is seeking to register ILINE. Thus, as the Examining Attorney agrees, the issue before us is whether the letter I (whether depicted in lower or upper case) is so generally understood as representing the term INTERNET so as to be substantially synonymous therewith. This test for determining whether a letter or series of letters is merely descriptive was established by the predecessor to our primary reviewing Court in Modern Optics, Inc. v. Univis Lens Co., 234 F.2d 504, 110 USPQ 293 (CCPA 1956). This test is as follows:

It does not follow, however, that all initials or combinations of descriptive words are ipso facto unregistrable. While each case must be decided on the basis of the particular facts involved, it would seem that, as a general rule, initials cannot be considered descriptive unless they have become so generally understood as representing descriptive words as to be accepted as substantially synonymous therewith. 110 USPQ at 295 (emphasis added).

*3 The Modern Optics rule for determining whether initials are merely descriptive has been favorably received by other Courts of Appeal. See Anheuser-Busch, Inc. v. Stroh Brewery Co., 750 F.2d 631, 224 USPQ 657, 659 (8 Cir. 1984) ("We find the reasoning of Modern Optics persuasive."); G. Heileman Brewing Co. v. Anheuser-Busch Inc., 873 F.2d 985, 10 USPQ2d 1801, 1808 (7 Cir. 1989). Of course, this Board would be bound to follow the rule of Modern Optics regardless of its favorable reception by other circuits.

Based upon this record, we find that the Examining Attorney has simply failed to establish that the letter I is substantially synonymous with the term INTERNET. The one dictionary definition relied upon by the Examining Attorney is simply outweighed by the plethora of other dictionaries consulted by this Board which do not list any definition for the letter I. Indeed, even the massive 20,000 page Acronyms, Initialisms & Abbreviations Dictionary (29th ed. 2001) does not define the letter I as meaning INTERNET, although this work provides over 280 other definitions for the letter I. In short, the Examining Attorney has simply failed to prove her contention that the evidence "clearly shows that the wording ILINE [is] understood to mean INTERNET LINE." (Examining Attorney's brief page 8). Accordingly, we find that applicant's mark in its entirety (ILINE) is simply not descriptive of "telecommunications services, namely, the international electronic transmission of voice and facsimile data over data lines using the global computer network," and hence reverse the refusal to register.

One final comment is in order. At page 6 of her brief the Examining Attorney contends that "the Board has recognized that the letter I is generally understood to mean Internet." In support of this proposition she cites In re Zanova Inc., 59 USPQ2d 1300 (TTAB 2001) wherein the Board held that the mark ITOOL was merely descriptive for "computer services, namely, providing custom services for web sites and design of web sites for others" and for "computer software for use in creating web pages." However, the evidentiary record in Zanova was dramatically different from the current evidentiary record. Not only did the record in Zanova include numerous articles wherein the term "Itool" was used descriptively, but more importantly, the Board noted that "applicant concedes that 'I' or 'i' can mean 'Internet.'" 59 USPQ2d at 1304. In stark contrast, the current applicant has in no way conceded that the letter I (whether depicted in upper or lower case) means Internet.

*4 Decision: The refusal to register is reversed.

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