

**This Opinion is Not a
Precedent of the TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tesher

Serial No. 85405171

Sean K. Enos of Schmeiser, Olsen & Watts LLP,
for Peter Tesher.

Maureen Dall Lott, Trademark Examining Attorney, Law Office 117,
J. Brett Golden, Managing Attorney.

Before Quinn, Kuhlke and Bergsman,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Peter Tesher (“Applicant”) seeks registration on the Principal Register of the mark COLLEGE BIDS (in standard characters) for the following services, as amended:

On-line trading services in which a seller posts items to be sold at a set price; online trading services in which a seller posts items to be sold in an auction-style format where bidding is done electronically; and providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods, buyers' and sellers' performance, and delivery and overall trading

experience in connection with the foregoing, all for commercial purposes, in International Class 35.¹

Applicant disclaimed the exclusive right to use the word “Bids” in connection with “on-line trading services in which a seller posts items to be sold at a set price; online trading services in which a seller posts items to be sold in an auction-style format where bidding is done electronically.”

The Trademark Examining Attorney has refused registration of Applicant’s mark under Section 2(e)(1) of the Trademark Act of 1946, 15 U.S.C. § 1051(e)(1), on the ground that the mark COLLEGE BIDS is merely descriptive of “on-line trading services in which a seller posts items to be sold at a set price; online trading services in which a seller posts items to be sold in an auction-style format where bidding is done electronically.”

In addition, the Trademark Examining Attorney issued a final requirement that Applicant disclaim the exclusive right to use the word “College” in connection with “providing evaluative feedback and ratings of sellers’ goods and services, the value and prices of sellers’ goods, buyers’ and sellers’ performance, and delivery and overall trading experience in connection with the foregoing, all for commercial purposes.”

After the Trademark Examining Attorney made the refusal and requirement final, Applicant appealed to this Board. We reverse the refusal to register under

¹ Application Serial No. 85405171 was filed on August 23, 2011, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Section 2(e)(1), and we reverse the requirement that Applicant disclaim the word “College.”

I. Whether COLLEGE BIDS is merely descriptive?

The basis for the refusal on the ground that COLLEGE BIDS is merely descriptive for “on-line trading services in which a seller posts items to be sold at a set price; online trading services in which a seller posts items to be sold in an auction-style format where bidding is done electronically” is set forth below:

In this case, applicant's mark is “COLLEGE BIDS.” “COLLEGE” refers to an institution of higher learning,² and “BID” refers to an offer such as the price one will pay or charge.³ “COLLEGE BIDS,” therefore, refers to college-related bids or offers.

... The services are broadly identified. It is, therefore, presumed that applicant's services are offered to all persons and entities including colleges and that the items offered for sale include those for or on the subject of colleges.

In applicant's February 4, 2013 response, applicant confirmed that the consumers of its services could include colleges.⁴ A mark that describes an intended user or group of users of a product or service is merely descriptive. [Internal citations omitted]. Accordingly, “COLLEGE” in

² “College” is defined, *inter alia*, as “[a]n institution of higher learning that grants the bachelor's degree in liberal arts or sciences or both.” Yahoo! Education website (Yahoo.com) attached to the December 9, 2011 Office Action.

³ “Bid” is defined, *inter alia*, as “to offer (a certain sum) as the price one will pay or charge.” infoplease website (dictionary.infoplease.com) attached to the December 9, 2011 Office Action.

⁴ In the Trademark Examining Attorney's August 5, 2012 Office Action, she required Applicant to answer the following questions: 1) Will Applicant's services be available to colleges and institutions of higher learning?; and 2) Will Applicant's services include those where sellers may post items from or in connection with a college and where others may bid on them? In response, Applicant wrote that its services will be available to all sellers and that, therefore, the answers are “yes.” February 4, 2013 Response to an Office Action.

the mark is merely descriptive of at least one group of the intended users of the services.

Moreover, the excerpt from applicant's website attached to the February 26, 2013 final Office action says, in part:

What is CollegeBids? - It is a social media site oriented **to students**. We have information on sporting events, apartment listings, travel and food discounts, jobs, **spring break** activities and the best nightlife party **events at your school** or in your community. We even have **educational information** as well. What makes us different is our auction style trading system where you can sell, buy and trade new and used valuables and **school items**. But most importantly, it is a great place to meet new friends.

This excerpt refers to students, school events, spring break activities, jobs, educational information, and trading services for school items, which presumably include college students, college events, spring break activities for college students, college jobs or jobs for college students, college-related educational information, and trading services for college-related items.

Even more significant is that the excerpt from applicant's website shows that consumers must identify their "college" in order to sign up for applicant's services.⁵ Thus, it appears that 1) applicant's services are being targeted, at least in part, to colleges and college communities and 2) applicant's trading services feature college-related items. In light of the foregoing, "COLLEGE" in the mark merely describes features of the services, namely, some of the intended users and a relevant field or subject matter of the services.

* * *

The foregoing establishes that each word in the mark merely describes a feature of the services. Moreover, each of the individual components in the composite mark

⁵ The excerpt is a login page with three entries: 1) email; 2) name; and 3) college. Email and name are identified as required fields. See the excerpt in Section II below.

retains its descriptive meaning in connection with the services, and the composite mark does not appear to have any unique, incongruous, or otherwise non-descriptive meaning in connection with the relevant services. Accordingly, applicant's mark "COLLEGE BIDS" is merely descriptive of applicant's "on-line trading services in which a seller posts items to be sold at a set price" and "online trading services in which a seller posts items to be sold in an auction-style format where bidding is done electronically."⁶

A term is 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. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). See also, *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a mark or a component of a mark is merely descriptive is determined in relation to the goods or services for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). A term need not immediately convey an idea of each and every specific feature of the goods or services in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of them. See *In re Gyulay*, 3 USPQ2d at 1010; *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). This requires consideration of the context in which the mark is used or intended to be used in connection with those goods or services, and the possible significance that

⁶ 7 TTABVUE 6-8.

the mark would have to the average purchaser of the goods or services in the marketplace. *See In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re Abcor Dev. Corp.*, 200 USPQ at 218; *In re Venture Lending Assocs.*, 226 USPQ 285 (TTAB 1985). The question is not whether someone presented only with the mark could guess the products or activities listed in the description of goods or services. Rather, the question is whether someone who knows what the products or services are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002)). *See also In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (quoting *Estate of P.D. Beckwith, Inc. v. Commissioner*, 252 U.S. 538, 543 (1920). *See also In re Tower Tech, Inc.*, 64 USPQ2d at 1318 (SMARTTOWER merely descriptive of commercial and industrial cooling towers);

In re Sun Microsystems Inc., 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer programs for use in developing and deploying application programs); *In re Putman Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE merely descriptive of news and information services in the food processing industry). However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, non-descriptive meaning, or if the composite has a unique or incongruous meaning as applied to the goods or services. See *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE for “bakery products”); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE for “a snow removal hand tool having a handle with a snow-removing head at one end, the head being of solid uninterrupted construction without prongs”). Thus, we must consider the issue of descriptiveness by looking at the mark in its entirety.

“On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive.” *In re Tennis in the Round, Inc.*, 199 USPQ 496, 498 (TTAB 1978). See also, *In re Shutts*, 217 USPQ at 364-65; *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980). In this regard, “incongruity is one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive from the descriptive mark.” *In re Shutts*, 217 USPQ at 365. See also *In re Tennis in the Round, Inc.*, 199 USPQ at 498 (the association of applicant’s mark TENNIS IN THE ROUND with the

phrase “theater-in-the-round” creates an incongruity because applicant’s services do not involve a tennis court in the middle of an auditorium). On the spectrum of distinctiveness, the dividing line between merely descriptive and suggestive is a fine one. *In re Gyulay*, 3 USPQ2d at 1010. See also *In re Recovery, Inc.*, 196 USPQ 830, 831 (TTAB 1977).

We start with “on-line trading services in which a seller posts items to be sold at a set price; online trading services in which a seller posts items to be sold in an auction-style format where bidding is done electronically” and determine what information consumers will understand the mark COLLEGE BIDS to convey about those services. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 103 USPQ2d at 1757. When viewed in its entirety, COLLEGE BIDS does not immediately convey any information regarding “on-line trading services.” The mark may suggest that the on-line trading services emanate from colleges or involve college students. Even assuming that the services are offered to colleges and that the items offered for sale include those for or on the subject of colleges, the nexus between the mark and the services requires a multi-step reasoning process. For example, as noted above, the Trademark Examining Attorney contends that the mark COLLEGE BIDS “refers to college-related bids or offers” without any evidence that “college-related bids or offers” have a generally understood meaning.

The Trademark Examining Attorney also contends that “COLLEGE” in the mark is merely descriptive of at least one group of the intended users of the

services.” However, the mark is COLLEGE BIDS, not “COLLEGE,” and COLLEGE BIDS does not identify a user group.

In view of the foregoing, the mark COLLEGE BIDS, when used in connection with “on-line trading services in which a seller posts items to be sold at a set price; online trading services in which a seller posts items to be sold in an auction-style format where bidding is done electronically,” is not merely descriptive.

II. Whether the exclusive right to use the word “College” should be disclaimed when the mark COLLEGE BIDS is used in connection with “providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods, buyers' and sellers' performance, and delivery and overall trading experience in connection with the foregoing, all for commercial purposes”?

The Trademark Examining Attorney issued a final requirement that Applicant disclaim the exclusive right to use the word “College” in the mark COLLEGE BIDS when that mark is used in connection with “providing evaluative feedback and ratings of sellers' goods and services, the value and prices of sellers' goods, buyers' and sellers' performance, and delivery and overall trading experience in connection with the foregoing, all for commercial purposes.”

Section 6(a) of the Trademark Act of 1946, 15 U.S.C. § 1056(a), provides in part that an applicant may disclaim the exclusive right to use an unregistrable component of an otherwise registrable mark. The purpose of the disclaimer is to make it clear, if it might otherwise be misunderstood, that the applicant is not claiming the exclusive right to use the unregistrable component of the mark. *In re Kraft, Inc.*, 218 USPQ 571, 572-573 (TTAB 1983). The USPTO may refuse registration of the entire mark if the applicant fails to comply with a proper

disclaimer requirement. *See In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859, 1861 (Fed. Cir. 1987); *In re Grass GmbH*, 79 USPQ2d 1600, 1602 (TTAB 2006).

The Trademark Examining Attorney contends that the word “College” in Applicant’s mark COLLEGE BIDS describes the subject matter of the services (e.g., college, college events, and college items).⁷ However, as we noted above, the mark is COLLEGE BIDS, not “COLLEGE.”

When the composite mark is unitary in nature, no disclaimer is required. *In re Kraft, Inc.*, 218 USPQ at 572-573. A unitary mark is a mark with multiple elements that create a single and distinct commercial impression separate and apart from the meaning of its constituent elements. *Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991). *See also In re Kraft, Inc.*, 218 USPQ at 573 (the elements of a unitary mark are so integrated or merged that they cannot be regarded as separate elements, and it is obvious that no claim is made other than to the entire mark). In *Kraft*, the Board explained that a unitary mark could be created “where the words which have been put together function as a unit, with each relating to the other rather than directly to the goods.” 218 USPQ at 573. *See also In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981).

To determine whether a composite mark is unitary, the Board must determine “how the average purchaser would encounter the mark under normal marketing of such goods and also . . . what the reaction of the average purchaser would be to this

⁷ 7 TTABVUE 12-13.

display of the mark." *Id.* quoting *In re Magic Muffler Service*, 184 USPQ 125, 126 (TTAB 1974). This can best be accomplished by looking at the specimen filed with the application because it shows how the mark is used in connection with the goods or services. *In re Magic Muffler Service*, 184 USPQ at 126. Since this application was filed based on Applicant's bona fide intent to use the mark, there is no specimen. However, we have the benefit of Applicant's login page submitted by the Trademark Examining Attorney in the February 26, 2013 Office Action. Applicant has used the mark as set forth below.



We find that the mark COLLEGE BIDS is a unitary mark because the words have been joined together to function as a unit. Neither term stands out by itself pointing to the services. Consumers will not break the mark COLLEGE BIDS into its component parts but will regard it as a unitary mark. See *In re J.R. Carlson Laboratories, Inc.*, 183 USPQ 509, 511 (TTAB 1974) (consumers will call for

applicant's product as E GEM notwithstanding the fact that they would recognize the descriptive significance of the letter "E"). *See* Applicant's webpage above where Applicant uses "CollegeBids" as a single unitary phrase, not separable elements.

We find that purchasers will not go through the mental process of parsing the mark COLLEGE BIDS into its component parts, but will regard it as a unitary mark. Under the circumstances presented by the record before us, the registration of the mark COLLEGE BIDS does not create or recognize any rights in the individual elements of the mark apart from the mark as a whole. Therefore, we conclude that the requirement for a disclaimer of the term "College" is not necessary.

Decision: The refusal to register Applicant's mark COLLEGE BIDS is reversed and the requirement that the word "College" be disclaimed is reversed.