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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re OMG Electronics, LLC

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Serial No. 85703706

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Richard A. Ryan,
for OMG Electronics, LLC.

Christine Martin, Trademark Examining Attorney, Law Office 104,
Zachary Cromer, Managing Attorney.

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Before Kuhlke, Adlin and Hudis,
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

OMG Electronics, LLC ("Applicant") seeks registration on the Principal Register of the proposed mark IWATCH (in standard characters) for the following goods (as amended): "mobile phones; devices for hands-free use of mobile phones; portable and handheld digital electronic devices, namely, mobile phones and cell phones, for

recording, organizing, transmitting, manipulating, and reviewing text, data, audio and video files" in International Class 9.[1]

After Applicant's IWATCH Application was published for opposition, multiple oppositions were filed against the Application and Applicant filed its own opposition against a third-party IWATCH application. These oppositions were resolved in Applicant's favor without any findings on the merits.[2] The U.S. Patent and Trademark Office ("USPTO") then issued a Notice of Allowance for Applicant's IWATCH Application on December 20, 2016.

After Applicant requested and was granted multiple extensions of time to prove use of its mark, on June 13, 2019 Applicant filed its Statement of Use with supporting specimens of use – alleging first use of the mark anywhere since at least as early as December 1, 2016, and first use of the mark in commerce since at least as early as December 1, 2018 under Trademark Act Section 1(d), 15 U.S.C. § 1051(d). The Trademark Examining Attorney subsequently refused registration of Applicant's mark under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1) on the ground that the mark is merely descriptive of a feature of the goods.

After the Examining Attorney made the refusal final, Applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. We affirm the refusal to register.

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[1] Application Serial No. 85703706 was filed on August 14, 2012, based upon Applicant's allegation of a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b); Statement of Use filed.

[2] *See* Opposition Nos. 91209583, 91210722 and 91213343.

I. Applicable Law on Mere Descriptiveness

A mark may not be registered on the Principal Register if, "when used on or in connection with the goods of the applicant[,]" the mark is "merely descriptive ... of them…." Trademark Act Section 2(e)(1). A mark is merely descriptive if it "'consists merely of words descriptive of the qualities, ingredients or characteristics of the goods … related to the mark.'" *DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173 (Fed.Cir.2004) (quoting *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920))).

The determination of whether a proposed mark is merely descriptive is made in relation to an applicant's goods, not in the abstract. *DuoProSS*, 103 USPQ2d at 1757. "The question is not whether someone presented with only the mark could guess what the goods … are. Rather, the question is whether someone who knows what the goods … are will understand the mark to convey information about them." *Id.* (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)).

"The line between a mark that is merely descriptive and may not be registered absent secondary meaning,[3] and one that is suggestive and may be registered, is that a suggestive mark 'requires imagination, thought and perception to reach a conclusion as to the nature of the goods,' while a merely descriptive mark 'forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the

[3] Applicant did not request, in the alternative, to register its proposed mark on the Supplemental Register or on the Principal Register with a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f).

goods.'" *DuoProSS*, 103 USPQ2d at 1755 (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) (quoting *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 765 (2d Cir. 1976))).

Any competent source suffices to show the relevant purchasing public's understanding of a contested term, including dictionary definitions, trade journals, newspapers and other publications, and consumer surveys. *In re Chamber of Commerce of U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Bayer A.G.*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); *In re Stereotaxis, Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005) (citing *In re Bed & Breakfast Registry,* 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986)), as well as "advertising material directed to the goods." *In re Abcor*, 200 USPQ at 218. The public's understanding of the term also may be obtained from websites and publications, and an applicant's own specimens of use and any explanatory text included therein. *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017); *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

"When determining whether a mark is merely descriptive, the Board must consider the commercial impression of a mark as a whole. … Because a mark must be considered as a whole, the Board may not 'dissect' the mark into isolated elements." *DuoProSS*, 103 USPQ2d at 1756 (internal citation omitted). On the other hand, we may consider the significance of each element separately in the course of evaluating the proposed mark as a whole. *Id.* at 1757 (noting that "[t]he Board to be

sure, can ascertain the meaning and weight of each of the components that makes up the mark."). Thus, "[w]hen two or more merely descriptive terms are combined, ... [i]f each component retains its merely descriptive significance in relation to the goods …, the combination results in a composite that is itself merely descriptive." *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012). Only where the combination of descriptive terms creates a mark with a unique, incongruous, or otherwise non-descriptive meaning in relation to the goods is the combined mark registrable. *See In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382, 384 (CCPA 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013).

II. Examination of the Record on the Question of Mere Descriptiveness

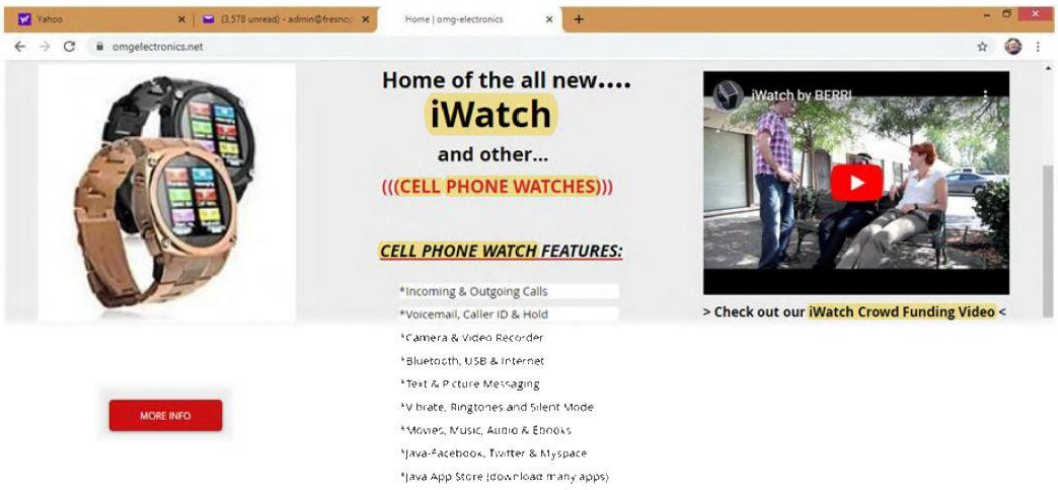
In view of the above principles, we now review the record to determine the relevant purchasing public's understanding of the terms "i" or "I" and "WATCH," as well as the proposed IWATCH mark as a whole.

A. The Relevant Purchasing Public

"Whether a mark is merely descriptive or not is 'determined from the viewpoint of the relevant purchasing public.'" *In re Stereotaxis,* 77 USPQ2d at 1090 (quoting *In re Bed & Breakfast*, 229 USPQ at 819). In its Application (as amended), Applicant describes its goods bearing the IWATCH mark as "mobile phones; devices for hands-free use of mobile phones; portable and handheld digital electronic devices, namely, mobile phones and cell phones, for recording, organizing, transmitting, manipulating, and reviewing text, data, audio and video files." While this description is sufficiently broad to include Applicant's actual goods it does not fully tell us what Applicant's goods really are.

Shown below is one of the specimens of use submitted with Applicant's Statement of Use (described as a "digital photograph[] of the goods having the trademark thereon and [a] package[] having the trademark thereon for the goods"):[4]

On its website, Applicant describes its goods bearing the proposed IWATCH mark as "cell phone watches:"[5]



[4] Statement of Use of June 13, 2019 at TSDR 6. Page references herein to the application record refer to the online database of the USPTO's Trademark Status & Document Retrieval ("TSDR") system. All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer. *See, e.g., In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1402 n.4 (TTAB 2018). References to the briefs on appeal refer to the Board's TTABVUE docket system. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable.

[5] Website page provided with Office Action Response of January 7, 2020 at TSDR 14.

In its Brief, Applicant more particularly describes its goods as "a smart phone that is configured to be worn on the user's wrist."[6] These descriptions are consistent with Applicant's goods as shown in its specimen of use and on its website, and with with Applicant's identification of goods.

More fully, Applicant states "the goods being sold under the IWATCH name are in fact mobile phones (i.e., cellular phones) that have all of the features of most modern smart phones, including those listed in description of the goods set forth in Applicant's trademark application, that are worn on the user's wrist."[7] Purchasers are enabled with "the ability to have a smart phone being readily available on the user's wrist … **without the need to be tethered to a smart phone** (specifically, the IWATCH can replace the smart phone that is normally carried, when not in use, in the user's pocket, purse, clothing or the like)." (emphasis Applicant's).[8] We therefore find the relevant purchasing public to be those persons who desire to have the functionality of a smart phone, and Applicant's identification of goods encompasses miniaturized smart phones of the type worn on the wrist (as pictured in Applicant's specimens of use).

B. Definitions

The Examining Attorney made of record the following definitions:

- **Internet-related prefixes** such as **e-**, **i-**, **cyber-**, **info-**, **techno-** and **net-** are added to a wide range of existing words to describe new, Internet- or computer-

[6] Applicant's Brief, 4 TTABVUE 9.

[7] *Id*. at 10.

[8] *Id.* at 12.

related flavors of existing concepts, often electronic products and services that already have a non-electronic counterpart. (WIKIPEDIA).[9]

- A **smartwatch i**s a wearable computer in the form of a wristwatch; modern smartwatches provide a local touchscreen interface for dally use.… [S]martwatches have more general functionality closer to smartphones, including mobile apps, a mobile operating system and WiFi/Bluetooth connectivity. … Some models, called "watch phones" (or vice versa), have mobile cellular functionality like making calls. … For many purposes, a "watch computer" serves as a front end for a remote system such as a smartphone, communicating with the smartphone using various wireless technologies. (WIKIPEDIA).[10]
- **Smartwatch** – A computer-based wristwatch that provides an extension to a smartphone via Bluetooth. (FREE DICTIONARY).[11]

C. Applicant's Online Advertising

As noted, Applicant on its website describes its device bearing the proposed IWATCH mark as a "cell phone watch."[12] On its INDIEGOGO crowd-funding page, Applicant touts the product as "the ultimate mobile device that has the benefits of a wrist watch."[13] In its YOUTUBE promotional video, the item pictured clearly is a watch worn on one's wrist that Applicant asserts provides the following functionality: "make and receive telephone calls, send and receive text and picture messages, Micro SD and SIM card (data and subscriber information storage), 32 gigabytes of (internal) storage, micro USB (charging), Bluetooth connectivity (smart phone tethering), LCD

[9] WIKIPEDIA definition of "e-, i-, cyber-, info-, techno- and net-" provided with Office Action of July 24, 2019 at TSDR 4.

[10] WIKIPEDIA definition of "smartwatch" provided with Office Action of January 30, 2020 at TSDR 5.

[11] FREE DICTIONERY definition of "smartwatch" *Id.* at 13.

[12] Website page provided with Office Action Response of January 7, 2020 at TSDR 14.

[13] INDIEGOGO crowd-funding page provided with Office Action of July 24, 2019 at TSDR 12.

touch screen, HD camera."[14] In its Brief, Applicant provides a list of these features and more provided by the IWATCH device.[15]

D. Third-Party Uses

The Examining Attorney further introduced evidence that competitors, such as 3G (phone watch), Apple (Apple Watch), Samsung (Galaxy Watch Smartwatch, Galaxy Watch Active), Fitbit (Ionic Smartwatch), Amazon (Amazfit Bip Smartwatch) and Fossil (Gen4 and Gen5 Smartwatches), commonly use the wording "WATCH" to identify smart watches with Internet connectivity capabilities (directly or tethered to a smartphone) designed to be worn on a user's wrist.[16]

III. Discussion and Analysis on the Question of Mere Descriptiveness

Having reviewed the record in its entirety, for the reasons that follow, we find that, as a whole, IWATCH is merely descriptive of Applicant's goods.

Viewing the definitions made of record in the context of Applicant's identified goods, "i-" is a typical Internet-related prefix added to a wide range of existing words to describe Internet- or computer-related electronic products that already have a non-electronic counterpart. A SMARTWATCH is a wearable computer or mobile phone in the form of a wristwatch. It is in this "defined sense" in which Applicant uses "i" and "watch" in connection with its goods and the advertising therefor.

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[14] Screen shots of Applicant's YOUTUBE video, provided with Office Action Response of January 7, 2020 at TSDR 18-22.

[15] Applicant's Brief, 4 TTABVUE 11.

[16] *See* Office Action of July 24, 2019 at TSDR 10-11; Office Action of January 30, 2020 at TSDR 21-33, 35-47, 54-71.

Applicant argues that "the use of 'I' with[in] the [proposed IWATCH] [m]ark fails to be merely descriptive of … Applicant's good[s] in the manner in which … many other uses of 'i' in that the goods are not merely an intelligent watch or a watch that connects to the [I]nternet (as for most 'I' trademark uses)."[17] We disagree. As Applicant itself made clear during prosecution, in its Brief, and in its promotional materials, a considerable number of functions provided by Applicant's goods (sending/receiving e-mails, images and video files, and accessing websites) are only available via Internet connectivity.

Moreover, the Board has held that the prefix "i" or "I" is understood by purchasers to signify the Internet, when used in relation to Internet-related products or services. *See In re Zanova, Inc.*, 59 USPQ2d 1300, 1305 (TTAB 2000) (ITOOL merely descriptive of computer software for use in creating web pages, and custom design of websites for others); *RxD Media, LLC v. IP Application Dev. LLC*, 125 USPQ2d 1801, 1813 (TTAB 2018) (holding IPAD merely descriptive of web-based software application for mobile-access databases management whereby users can store and access their personal information).

Applicant argues "[t]he fact that Applicant's goods can display time, a rather minor and relatively insignificant feature of the goods (which feature may or may not be utilized by every consumer and, even if utilized, the feature will not be utilized to the same extent by every consumer), does not mean that the mark is 'merely

[17] Applicant's Brief, 4 TTABVUE 12.

descriptive' of the goods."[18] This is beside the point. The record makes clear that smartwatches perform many of the same functions as, and sometimes work in conjunction with, smartphones, and Applicant's identification of goods encompasses smartwatches. The term WATCH in Applicant's mark describes this type of watch, a smartwatch which performs these types of mobile phone functions, several of which require Internet access.

Even if displaying the time is only one of a number of features provided by Applicant's goods, clearly the product provides this feature which is encompassed within the "reviewing text, data" portion of Applicant's identification of goods, in addition to other functionality that is within the scope of Applicant's identification. "A mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods …." *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)). "[I]t need only describe a single feature or attribute." *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012).

Finally, Applicant says its "use of IWATCH in association with the subject mobile phones or smart phones diminishes the descriptiveness of the words 'i' and 'watch' as they would be used individually and creates a mark having a different commercial impression."[19] We disagree. Rather, when "i" and "watch" are combined in Applicant's

[18] *Id.* at 9.

[19] *Id.* at 10.

proposed IWATCH mark, each component retains its merely descriptive significance in relation to Applicant's goods – a smartphone designed to be worn as a watch having capabilities enabled via Internet connectivity – such that the combination results in a composite that is itself merely descriptive. *In re Phoseon Tech.*, 103 USPQ2d at 1823. As a whole, the combination of the descriptive terms "i" and "watch" does not create a unique, incongruous, or otherwise non-descriptive meaning in relation to Applicant's goods. *Cf. In re Colonial Stores,* 157 USPQ at 384; *In re Positec*, 108 USPQ2d at 1162-63. It is telling in this regard that Applicant does not identify any specific "different commercial impression" created by its proposed mark.

Decision: The refusal to register Applicant's proposed IWATCH mark on the ground of mere descriptiveness under Trademark Act Section 2(e)(1) is affirmed.