

This Opinion is Not a
Precedent of the TTAB

Mailed: February 9, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bitvoyant

Serial No. 86693221

Bitvoyant, pro se.

Heather Sales,¹ Trademark Examining Attorney, Law Office 122,
John Lincoski, Managing Attorney.

Before Lykos, Masiello and Heasley,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On July 15, 2015, Bitvoyant (“Applicant”) filed an application to register the mark **HONEYFILE** in standard character format on the Principal Register for goods and services ultimately identified as

“Computer software platforms for use in the field of computer network security that assist in the tracking of data exfiltration and network intelligence” in International Class 9; and

¹ The prosecution of this application was originally assigned to Elissa Garber Kon. Subsequent to the filing of Applicant’s notice of appeal, the Office reassigned the application on October 14, 2016 to the undersigned Trademark Examining Attorney.

“Computer security consultancy; Computer security service, namely, restricting access to and by computer networks to and of undesired web sites, media and individuals and facilities; Computer security services, namely, enforcing, restricting and controlling access privileges of users of computing resources for cloud, mobile or network resources based on assigned credentials; Computer virus protection services; Design and development of electronic data security systems; Platform as a service (PAAS) featuring computer software platforms for use in the field of computer network security that assist in the tracking of data exfiltration and network intelligence” in International Class 42.²

The Trademark Examining Attorney has refused registration of the mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the mark is merely descriptive of Applicant’s identified goods and services, and under Trademark Act Sections 1 and 45, 15 U.S.C. §§ 1051 and 1127, on the ground that Applicant’s original and substitute specimens fail to show the applied-for mark used in direct connection with the identified goods in International Class 9.

Applicant appealed and filed a request for reconsideration, which was denied. Both Applicant and the Examining Attorney have filed briefs.³ For the reasons explained below, we affirm both refusals to register.

I. Descriptiveness Refusal – International Classes 9 and 42

At the outset, we consider the descriptiveness refusal as to the goods and services in International Classes 9 and 42. Section 2(e)(1) of the Lanham Act precludes registration of a mark that, when used in connection with the goods or services of the applicant, is merely descriptive of them. 15 U.S.C. § 1052(e)(1). The test as set forth

² Application Serial No. 86693221, filed under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging March 16, 2015 as the date of first use anywhere and in commerce.

³ We note that Applicant did not address the specimen refusal pertaining to the goods identified in International Class 9 in its appeal brief.

by our primary reviewing court, the Court of Appeals for the Federal Circuit, is articulated as follows: “A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *In re Chamber of Commerce of the U.S.A.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). It is not necessary that a term describe all of the purposes, functions, characteristics, or features of a product to be considered merely descriptive; it is enough if the term describes one significant function, attribute, or property. *In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (“A mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services”) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)). Evidence that a term is merely descriptive to the relevant purchasing public “may be obtained from any competent source, such as dictionaries, newspapers, or surveys.” *In re Bayer*, 82 USPQ2d at 1831 (quoting *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986)).

The evidence of record shows that Applicant’s mark immediately conveys to prospective consumers a “quality, feature, function or characteristic” of Applicant’s goods and services. In the cybersecurity industry, honeyfiles are “an intrusion detection mechanism based on deception. Specifically, a honeyfile is a bait file that is intended for hackers to open, and when the file is opened, an alarm is set off.” *See*

Jim Yuill, et al., *Honeyfiles: Deceptive Files for Intrusion Detection*, Proceedings of the 2004 IEEE Workshop on Information Assurance, <http://www.dtic.mil/dtic/tr/fulltext/u2/a484922.pdf>. September 24, 2015 Office Action, p. 9. As the Examining Attorney's evidence shows, it is not uncommon for the term "honeyfile" to denote bait or decoy files designed to alert users when unauthorized access has occurred:

The security industry has also employed the use of decoy files, or "honeyfiles," sprinkled across its servers containing bogus credentials.⁴

The honeyfile system monitors all file access on the server and alerts users when honeyfiles have been accessed.⁵

Applicant's own specimen confirms our finding, stating that HONEYFILE "is introduced into a user's environment, and designed to evoke responses that are far more characteristic of malicious users than normal users"; and applicant states that "We design HONEYFILES to attract adversaries with feasible mock assets (at the file level)." July 15, 2015 specimen, p. 1. Thus, as applied to Applicant's International Class 9 computer software platforms and International Class 42 computer security services and computer software platform services, Applicant's proposed mark

⁴ See George Lawton, Simulated Passwords Could Help Overcome a Plague of Password Problems, *Service Virtualization Today*. <http://servicevirtualizationtoday.com/simulated-passwords-could-help-overcome-a-plague-of-password-problems/>. September 24, 2015 Office Action, p. 29.

⁵ See B.M. Bowen, et al., *Security and Privacy in Communication Networks*, 5th International ICST..., at 54. <https://books/google.com/books>. September 24, 2015 Office Action, p. 28.

immediately informs prospective purchasers of a “quality, feature, function or characteristic” of the goods and services.

Applicant contends that its mark is suggestive because consumers would have to engage in multistage reasoning to determine the characteristics of Applicant’s identified goods and services. In support thereof, Applicant cites to a myriad of cases where the Board found various marks to be incongruous and not merely descriptive. *See, e.g., In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382, 385 (CCPA 1968) (SUGAR & SPICE double entendre for bakery products). Applicant also argues that **HONEYFILE** engenders an incongruity by “juxtaposing discordant elements or ideas,” i.e., the term “honey,” which “is usually used with cooking” and “file,” which is associated with computers. Brief, p. 13; 7 TTABVUE 14. Applicant takes the position that the combination of the two words results in “a new non-descriptive commercial impression, namely sticky files that are traceable.” Brief, p. 14; 7 TTABVUE 14.

Applicant’s arguments are unpersuasive. It is well settled that determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *See In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Bayer*, 82 USPQ2d at 1831; *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). For example, in the case of *In re Polo Int’l Inc.*, 51 USPQ2d 1061, 1063 (TTAB 1999), the Board found the term DOC in the mark DOC-CONTROL would be understood to refer to the “documents” managed by applicant’s software, not “doctor,” as shown in a dictionary definition. Likewise, in *In re Digital*

Research Inc., 4 USPQ2d 1242, 1244 (TTAB 1987), the Board found the mark CONCURRENT PC-DOS merely descriptive of “computer programs recorded on disk” where the evidence showed that the computer industry used the denomination “concurrent” as a descriptor of a particular type of operating system. In other words, the issue is whether someone who knows what the goods and services are will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); *In re Patent & Trademark Serv. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998). 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 the mark would have to the purchasers of the goods or services in the marketplace. *In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Bayer*, 82 USPQ2d at 1831; *In re Omaha Nat’l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987). We fail to see any incongruous meaning in the juxtaposition of the two terms “honey” and “file” in Applicant’s mark when considered in relation to the goods and services. As the record shows, Applicant’s use of **HONEYFILE** in connection with cybersecurity software and services is not unique; rather this word has become a term of art to identify a type of computer software and feature of computer services designed to detect unauthorized intruders. In light of the use of the term by third parties in the cybersecurity industry, it would be perceived by consumers as identifying or describing the same or similar features of the Applicant’s software platform and computer services.

Applicant also urges the Board to draw a negative inference based on evidence showing no search results when the term “honeyfile” is searched in various sources. See January 14, 2016 Response, pp. 13-17 (search results from Webopedia and Technology Definitions and Cheat Sheets from Whatis.com – The Tech Dictionary and IT Encyclopedia). Vocabulary in the computer field evolves rapidly. *In re Styleclick.com Inc.*, 57 USPQ2d 1445, 1448 (TTAB 2000) (noting “a year or two is an eternity in ‘Internet time,’ given the rapid advancement of the Internet into every facet of daily life”). As illustrated by the evidence discussed above, it appears that an entire industry has emerged based on the principle of bait or decoy server files known as honeyfiles.

As to competitor need to use Applicant’s proposed mark, Applicant advances the argument that competitors are free to use other terms in the field to describe the involved goods and services such as “sugar data, sweet facts, entice stats.” Brief, p. 12; 7 TTABVUE 13. The logic of Applicant’s argument fails because unlike the above coined terms, the record shows that “honeyfile” has a specific meaning in the cybersecurity industry. Competitors in this field should be able to use this descriptive term when advertising to the public their own computer software and computer security services. As explained in the seminal case of *In re Abcor Dev. Corp.*, 200 USPQ at 217:

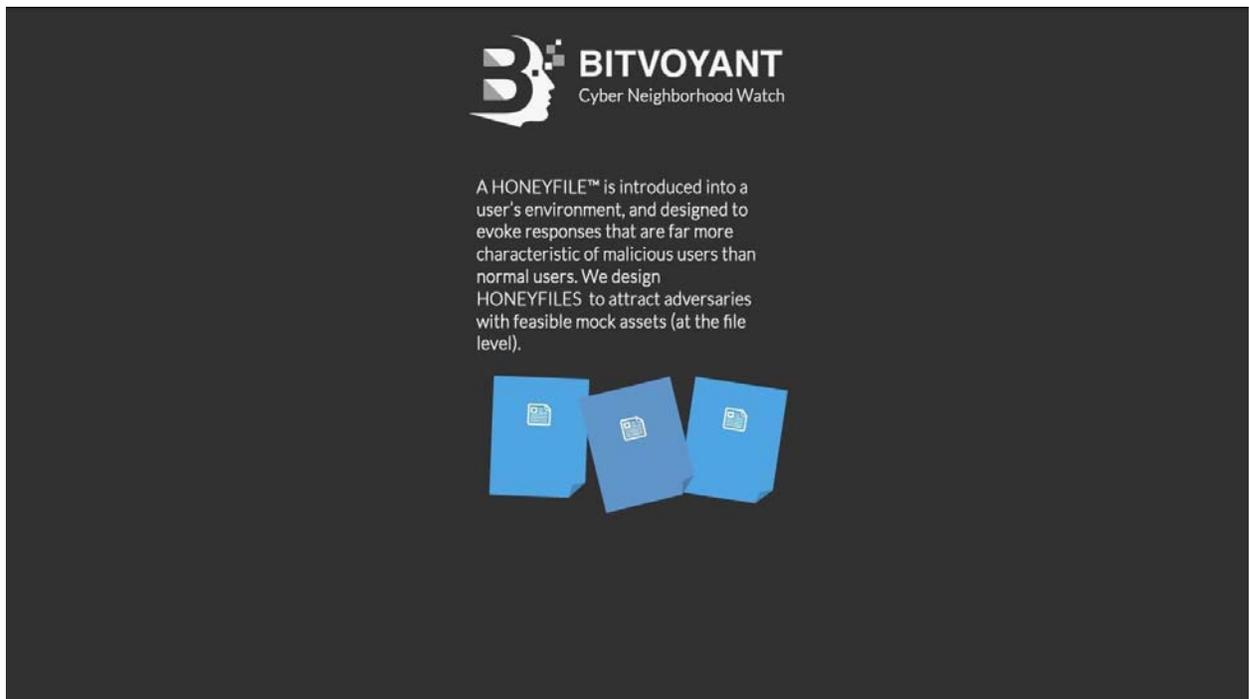
The major reasons for not protecting such marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.

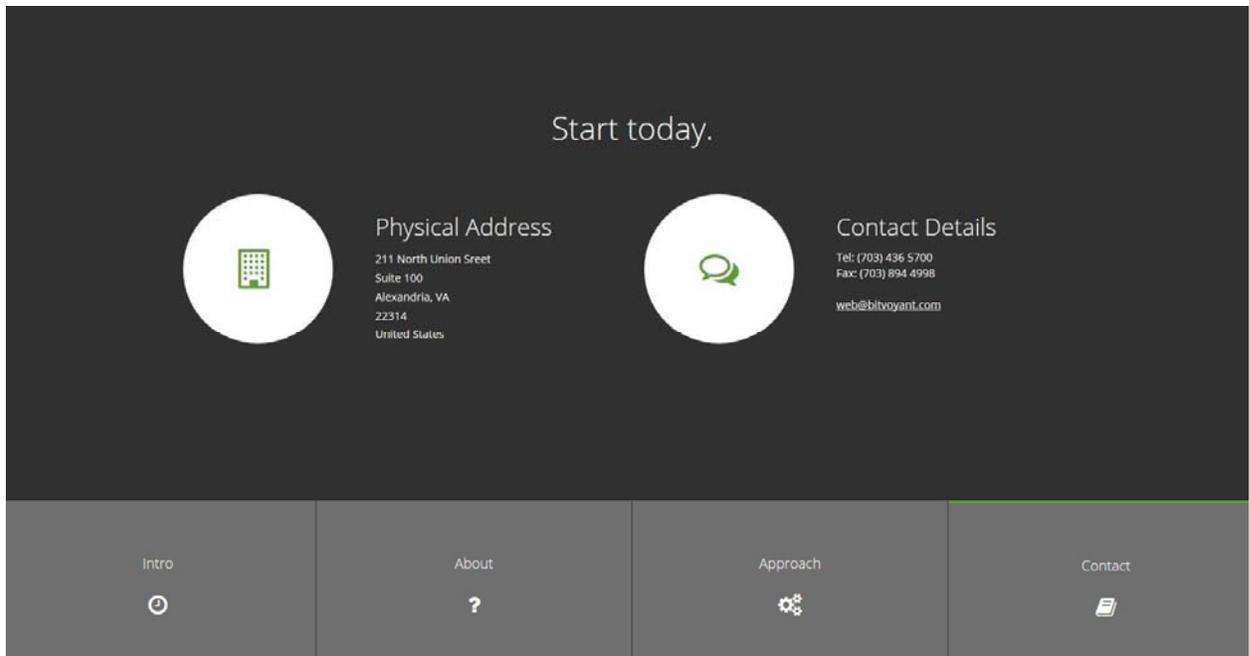
In sum, we find that that Applicant's proposed mark **HONEYFILE**, when used in connection with the identified goods and services is merely descriptive.

II. Specimen Refusal for International Class 9 Goods

We turn now to the specimen refusal for Applicant's International Class 9 goods identified as "[c]omputer software platforms for use in the field of computer network security that assist in the tracking of data exfiltration and network intelligence."

Applicant filed with its application the specimen depicted below described as a screenshot of Applicant's website:

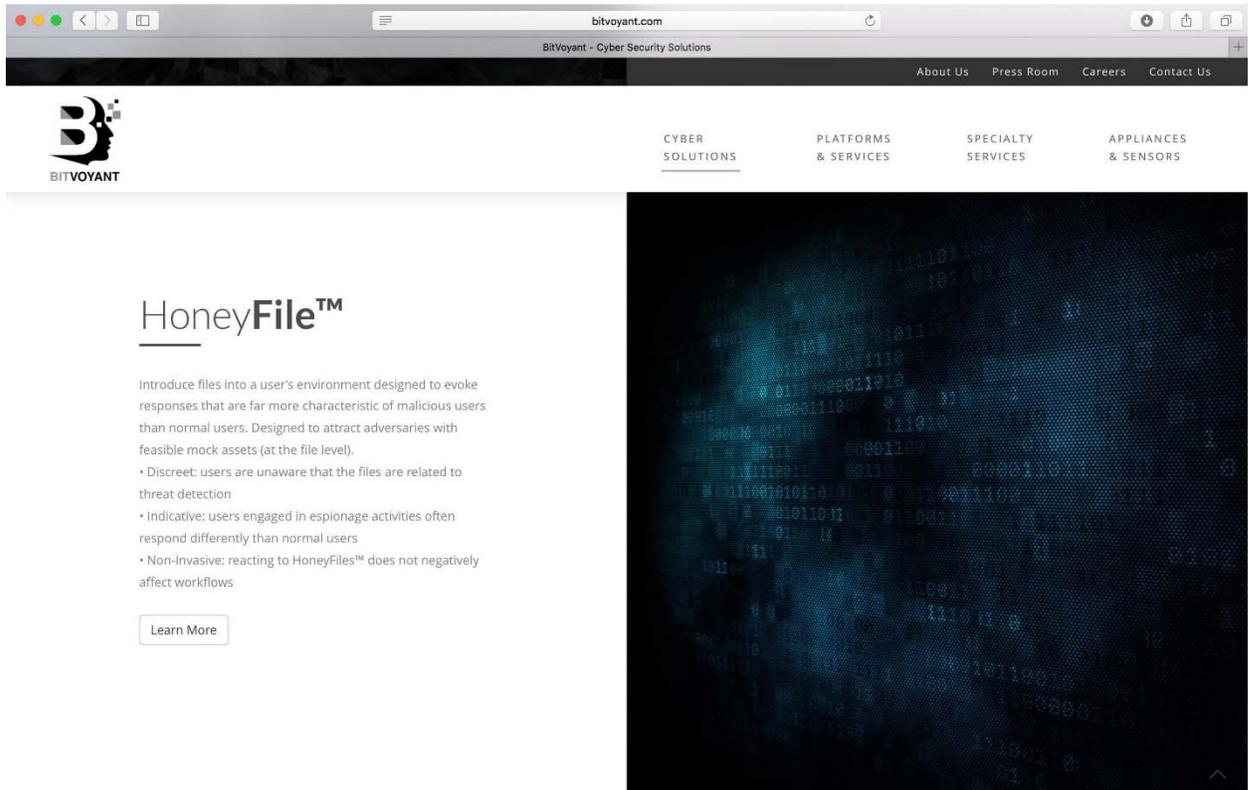




The Examining Attorney refused registration of the mark for the International Class 9 goods because the specimen consists of advertising material and does not show the applied-for mark in use in commerce for the identified goods.⁶ September 24, 2015 Office Action.

In an attempt to overcome the refusal, on July 21, 2016, Applicant submitted a substitute specimen pictured below

⁶ The Examining Attorney also refused registration as to International Class 42 because the original specimen did not show the applied-for mark in use in commerce. Upon submission of the substitute specimen displayed below, the Examining Attorney withdrew the refusal as to this class.



The substitute specimen also appears to be an excerpt from Applicant’s website. The Examining Attorney maintained the refusal, stating that the newly submitted specimen again appears to be advertising material. The Examining Attorney also found that the specimen did not constitute a display associated with the goods, reasoning that the “learn more” button on the web page does not consist of a means for ordering the goods.

For a trademark application under Section 1(a) of the Trademark Act, the Applicant must include one specimen for each class, showing use of the mark in commerce on or in connection with the goods. 15 U.S.C. § 1051(a)(1); 37 C.F.R. §§

2.34(a)(1)(iv), 2.56(a). A trademark specimen should be a label, tag, or container for the goods, or a display associated with the goods. 37 C.F.R. § 2.56(b)(1). Special considerations may be relevant with regard to specimens for computer software. As explained in the Trademark Manual of Examining Procedure (“TMEP”) (Jan. 2017) § 904.03(e):

The computer program, video, and movie industries have adopted the practice of applying trademarks that are visible only when the goods, that is, programs or movies, are displayed on a screen (e.g., on the first several frames of a movie).

An acceptable specimen might be a photograph or printout of a display screen projecting the identifying trademark for a computer program, or a photograph of a frame(s) of a movie or video bearing the mark. It is not necessary that purchasers see the mark prior to purchasing the goods, as long as the mark is applied to the goods or their containers, or to a display associated with the goods, and the goods are sold or transported in commerce. *In re Brown Jordan Co.*, 219 USPQ 375 (TTAB 1983) (holding that stamping the mark after purchase of the goods, on a tag attached to the goods that are later transported in commerce, is sufficient use).

For downloadable computer software, an applicant may submit a specimen that shows use of the mark on an Internet website. Such a specimen is acceptable only if it creates an association between the mark and software and provides sufficient information to enable the user to download or purchase the software from the website. *See In re Azteca Sys., Inc.*, 102 USPQ2d 1955 (TTAB 2012). If the website simply advertises the software without providing a way to download, purchase, or order it, the specimen is unacceptable. *See In re Dell Inc.*, 71 USPQ2d 1725, 1727 (TTAB 2004); *see also In re Osterberg*, 83 USPQ2d 1220, 1224 (TTAB 2007). ...

We agree with the Examining Attorney’s assessment that neither the original nor the substitute specimen constitutes a display associated with Applicant’s International Class 9 goods. This is a question of fact. *Land’s End Inc. v. Manbeck*, 797 F.Supp. 311, 24 USPQ2d 1314, 1316 (E.D. Va. 1992); *In re Hydron Technologies*

Inc., 51 USPQ2d 1531, 1533 (TTAB 1999); *In re Shipley Co. Inc.*, 230 USPQ 691, 694 (TTAB 1986).

“A website page which displays a product, and provides a means of ordering the product, can constitute a ‘display associated with the goods,’ as long as the mark appears on the webpage in a manner in which the mark is associated with the goods.” *In re Dell, Inc.*, 71 USPQ2d at 1727. None of Applicant’s proffered specimens includes a “download” or similar link to put the consumer on notice that the identified goods are indeed available for download or the equivalent thereof. As such, the specimens cannot qualify as a display associated with the goods on this basis.

“Another factor in the analysis of whether a specimen is an acceptable display used in association with the goods is whether the mark is displayed in such a way that the customer can easily associate the mark with the goods.” *In re Osterberg*, 83 USPQ2d at 1223 (internal citations omitted). As noted above, a display of a mark on a screen that appears when computer software is in use is a suitable display associated with the goods. Here, there is no evidence to indicate that that is the nature of the specimens. The specimens merely provide a description of Applicant’s products, in the nature of mere advertising. This, however, is not enough. “That the webpage contains a description of the goods does not mandate acceptance of the specimen; an association must be made between the mark and the goods.” *In re Azteca*, 102 USPQ2d at 1958 (rejecting webpage specimen for applicant’s computer software). For these reasons, Applicant’s specimens fail to show use of the mark

HONEYFILE in commerce in connection with Applicant's International Class 9 goods.

Decision: The descriptiveness refusal under Section 2(e)(1) of the Trademark Act is affirmed as to both International Classes 9 and 42; the specimen refusal as to International Class 9 is affirmed.