

This Opinion is not a
Precedent of the TTAB

Mailed: April 27, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Diamond Offshore Drilling, Inc.
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Serial No. 87766205
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Brit Nelson of Jackson Walker LLP,
for Diamond Offshore Drilling, Inc.

David A. Hoffman, Trademark Examining Attorney, Law Office 107,
Leslie Bishop, Managing Attorney.

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Before Cataldo, Ritchie, and Goodman,
Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Diamond Offshore Drilling, Inc. (“Applicant”) seeks registration on the Principal Register of the mark BLOCKCHAIN DRILLING, in standard characters, for, as amended, “Drilling of offshore oil or gas wells utilizing blockchain technology and solutions to enhance efficiencies and reduce costs,” in International Class 37, and “Implementation of blockchain technology and solutions, namely, providing a non-downloadable cloud-based computer software platform to enhance efficiencies and

reduce costs in drilling offshore oil and gas wells,” in International Class 42.¹ In response to a requirement by the Trademark Examining Attorney in the May 17, 2018 Office Action, Applicant disclaimed the exclusive right to use “DRILLING” apart from the mark as shown.

The Examining Attorney refused registration on the ground that the applied-for mark is merely descriptive of the services pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). When the refusal was made final, Applicant filed this appeal and filed a request for reconsideration, which was denied. The appeal was resumed and both Applicant and the Examining Attorney filed briefs. For the reasons discussed herein, the refusal is affirmed.

I. Evidentiary Issue

As a preliminary matter, the Examining Attorney objects to evidence that Applicant submitted for the first time as exhibits to its brief. The exhibits include three trademark registrations, a web page, and Wikipedia definitions of the terms “blockchain” and “well drilling.” In accordance with Board rules, “The record in the application should be complete prior to the filing of an appeal.” Rule 2.142(d); 37 C.F.R. § 2.142(d).

Nevertheless, “if the applicant or the examining attorney submits excerpts from articles during examination, the nonoffering party may submit the complete article, even if such submission is made after the appeal is filed.” Trademark Trial and

¹ Serial No. 87766205 was filed on January 23, 2018, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use the mark in commerce in both classes.

Appeal Board Manual of Procedure (“TBMP”) § 1207.01 (2019), citing *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 820 (Fed. Cir. 1986) (holding that if only a portion of an article is submitted, that portion is not thereby insulated from the context from which it came.). The Examining Attorney submitted Wikipedia definitions of the terms “blockchain” and “well drilling” with the January 8, 2019 Final Office Action. The Wikipedia entries from the Examining Attorney are dated 12/12/2018. Although there is no indication that these entries are incomplete, we find it appropriate in this case to consider the updated entries submitted by Applicant, which are dated 9/27/2019.² In accordance with 37 C.F.R. § 2.142(d), we give no consideration to the other evidence submitted by Applicant for the first time with its brief.

II. Mere Descriptiveness

A term is deemed to be 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. *See In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987)); *see also In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is

² 7 TTABVUE 12, 29. Although the Wikipedia evidence submitted by Applicant, as discussed below, is supportive of our findings, we would reach the same conclusion without it.

being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

Moreover, it is settled that “[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them.” *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). *See also In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985). On the other hand, if a mark requires imagination, thought and perception to ascertain the nature of the goods or services, then the mark is suggestive. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd*, 695 F.3d 1247, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (citing *In re Abcor Dev. Corp.*, 200 USPQ 215). A composite of descriptive terms is registrable only if it has a separate, non-descriptive meaning. *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382, 385 (CCPA 1968) (holding SUGAR & SPICE not merely descriptive of bakery products).

The Examining Attorney argues that the applied-for mark “BLOCKCHAIN DRILLING” is merely descriptive of the identified services because “the wording

‘Blockchain’ refers to specific technology used to enhance the drilling process.”³ The Examining Attorney also points out that the term “Drilling” has been disclaimed pursuant to a requirement in the May 17, 2018 Office Action.⁴ In this regard, the Examining Attorney argues that the terms are used in a descriptive or generic manner in the identification of services itself, as well as in Applicant’s own advertising.⁵

Applicant, by contrast, argues that its applied-for mark is instead incongruous, and therefore at worst suggestive of the identified services:

The mark BLOCKCHAIN DRILLING is suggestive in that blockchain is traditionally used in ledgers, accountant’s records, and in other secure data storage systems. Oil and gas well drilling, on the other hand, is a rough and tumble, messy and dangerous endeavor – rendering well drilling incongruous with back office accounting in a safe environment.⁶

Applicant submitted several definitions of the term “blockchain,” from Google.com, Oxford Dictionary, Collins Dictionary, Cambridge English Dictionary, and Wiktionary. Applicant notes that all of these definitions refer to “blockchain” in the context of “bitcoin” or “cryptocurrency.”⁷ While it is true that all of the definitions submitted by Applicant refer to “blockchain” as a financial concept, we take judicial

³ May 17, 2018 Office Action.

⁴ 9 TTABVUE 8.

⁵ 9 TTABVUE 6-7.

⁶ 7 TTABVUE 5.

⁷ Attached to November 19, 2018 Response to Office Action, at 8-23.

notice that other dictionary definitions are not so limited. For example, Merriam-Webster offers the following definition:⁸

Blockchain: *noun* a digital database containing information (such as records of financial transactions) that can be simultaneously used and shared within a large, decentralized, publicly accessible network; *also*: the technology used to create such a database.

The Examining Attorney further submitted a Wikipedia entry for “blockchain,” which reiterates that blockchain technology, while often used in reference to cryptocurrency exchanges, may be implemented in other systems, including supply chain monitoring.

The following excerpts are illustrative:⁹

Blockchain: A blockchain, originally block chain, is a growing list of records, called *blocks*, which are linked using cryptography. Each block contains a cryptographic hash of the previous block, a timestamp, and transaction data (generally representing a merkle tree root hash). By design, a blockchain is resistant to modification of the data. It is “an open, distributed ledger that can record transactions between two parties efficiently and in a verifiable and permanent way.”

Other uses: Blockchain technology can be used to create a permanent, public, transparent ledger system for compiling data on sales, tracking digital use and payments to content creators, such as wireless users or musicians. . . . Walmart and IBM are running a trial to use a blockchain-backed system for supply chain monitoring.

As noted above, Applicant submitted an updated Wikipedia entry for “blockchain.”

While containing the same general information, the excerpt submitted by Applicant

⁸ *www.merriam-webster.com/dictionary/blockchain*. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

⁹ Attached to January 8, 2019 Final Office Action at 9, 13.

further elaborated on “Supply chain” uses of “blockchain” technology, explaining, “There are a number of efforts and industry organizations working to employ blockchains in supply chain logistics and supply chain management.”¹⁰

In its identification of services, in both Class 37 and 42, Applicant specifically refers to “blockchain technology” as used in its “drilling” activities:

International Class 37: **Drilling** of offshore oil or gas wells utilizing **blockchain** technology and solutions to enhance efficiencies and reduce costs.

International Class 42: Implementation of **blockchain** technology and solutions, namely, providing a non-downloadable cloud-based computer software platform to enhance efficiencies and reduce costs in **drilling** offshore oil and gas wells.

The Examining Attorney also submitted evidence from Applicant’s website, wherein Applicant touts its “*Blockchain Drilling* platform” as providing “transparency, provenance and immutability across the entire supply chain.”¹¹

Overall, we find that the applied-for mark “BLOCKCHAIN DRILLING,” when viewed in relation to Applicant’s identified services, immediately conveys that Applicant contemplates implementing “blockchain” technology as a feature of its “drilling” activities. Although Applicant argues that its use of “BLOCKCHAIN DRILLING” is incongruous, based upon the evidence discussed above and Applicant’s services as identified, we fail to see the incongruity. We further note that the fact that an applicant may be the first and only user of a term or phrase does not justify

¹⁰ 7 TTABVUE 12, 18.

¹¹ Attached to January 8, 2019 Final Office Action at 7-8.

registration as a mark if it is nevertheless merely descriptive of the applied-for goods or services. *See KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 72 USPQ2d 1833, 1838 (2004) (holding that trademark protection does not provide for “a complete monopoly on use of a descriptive term simply by grabbing it first.” (citation omitted)); *see also In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987); *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1514 (TTAB 2016); TMEP § 1209.03(c) (Oct. 2018). Thus, while doubt is resolved for Applicant, we have no doubt that consumers require no imagination, thought or perception to arrive at this conclusion. *See DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 103 USPQ2d at 1755. Therefore, we find that the proposed mark is merely descriptive of the identified services.

Decision: The refusal to register on the ground that the term is merely descriptive of Applicant’s services under Section 2(e)(1), 15 U.S.C. § 1052(e)(1), is affirmed.