

This Opinion is Not a
Precedent of the TTAB

Mailed: June 16, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Urban Tower LLC
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Serial No. 90464116
—

Michael Steinmetz and Andrea T. Timpone of Garson, Ségal, Steinmetz, Fladgate
LLP, for Urban Tower, LLC.

Shaunia Carlyle, Trademark Examining Attorney, Law Office 110,
Chris Pedersen, Managing Attorney.

—

Before Cataldo, Lykos and Dunn,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Urban Tower LLC, seeks registration on the Principal Register of the
mark URBAN TOWER (in standard characters), identifying the following services:

Antenna installation and repair in International Class 37;

Internet service provider (ISP); Internet service provider services;
Wireless broadband communication services; Wireless telephone
telecommunications services, namely, wireless mobile telephone calling
plans; Communication services, namely, transmission of voice, audio,
visual images and data by telecommunications networks, wireless
communication networks, the Internet, information services networks
and data networks; Leasing commercial fixed wireless spectrums;

Providing multiple user wireless access to the Internet; Telecommunication services, namely, wireless telephone services; Telecommunications services, namely, wireless telephony and wireless broadband communications services for the transmission of voice and data in International Class 38; and

Design and development of wireless communication systems for transmission and reception of voice, data and video in International Class 42.¹

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that URBAN TOWER merely describes a function or purpose of all three classes of the identified services. Applicant and the Examining Attorney filed briefs.²

I. Propriety of Refusal of Registration

Applicant objects to the Examining Attorney's issuance of the mere descriptiveness refusal of registration after previously approving its application for publication. Applicant argues:³

The underlying record reveals a backwards application of USPTO procedure for evaluating trademark applications. Here, the trademark examiner prolonged and impeded the Applicant's opportunity to prosecute Applicant's trademark application by withholding details and materials supporting their basis for refusal. Indeed, the exchange between Applicant and the Examining Attorney shows that Applicant

¹ Application Serial No. 90464116 was filed on January 13, 2021, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant's allegation of a bona fide intent to use the mark in commerce in connection with all classes of services.

² All citations to documents contained in the Trademark Status and Document Retrieval (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.

³ 10 TTABVUE 6-10 (Applicant's brief; emphasis supplied by Applicant).

had very little to respond to up until most recently. Applicant respectfully requests the Board to consider this appeal in view of the Examining Attorney's incomplete examination of Applicant's Mark during each turn of an office action as detailed below. ...

On July 27, 2021, the Examining Attorney issued the first Office Action (the "First Office Action"). Notably the First Office Action does not raise a refusal based on mere descriptiveness. Instead, the First Office Action is a narrow request for more information.

Critically, "[t]he initial examination of an application by the examining attorney must be a *complete* examination." TMEP § 704.01. Indeed, "[t]he examining attorney's first Office action must be complete, so the applicant will be advised of all requirements for amendment and grounds for refusal." *Id.* Importantly, "**[e]very effort should be made to avoid piecemeal prosecution**, because it prolongs the time needed to dispose of an application." *Id.*

Again, "[i]t is the policy of the USPTO to conduct a complete examination upon initial review of an application by an examining attorney and to issue **all possible refusals** and requirements in the first Office action." TMEP § 706.01.

Applicant essentially argues that the Examining Attorney failed to raise the mere descriptiveness refusal in her initial Office Action; failed to adequately address Applicant's arguments against the refusal of registration in its responses to the subsequent Office Actions; and failed to provide evidence in support of the refusal of registration until late in the prosecution of the involved application, hindering Applicant's ability to respond.

With regard to the Trademark Examining Operation's (TMEO) prosecution of the involved application, we note that trademark rights are not static, and that registrability must be determined on the basis of the facts and evidence in the record at the time registration is sought. *See, e.g., In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010). While the examination of this

application may not be a model of expediency, we see no significant deviation from acceptable standard practice and procedure on the Examining Attorney's part. *See generally* Trademark Manual of Examining Procedure (TMEP) § 1209.01 (July 2022) and authorities cited therein. Simply put, the Examining Attorney is required to issue all refusals and requirements pertaining to an application, including any not raised in the initial Office Action. In addition, Applicant was afforded opportunities to respond to the refusal of registration as set forth in the Examining Attorney's Office Actions.

We recognize Applicant's frustration, and construe its remarks regarding examination irregularities as amplifications of its arguments as to why it views the refusal to register as erroneous; thus, we have considered these remarks to that extent.

I. Mere Descriptiveness

In the absence of acquired distinctiveness,⁴ Section 2(e)(1) of the Trademark Act prohibits registration on the Principal Register of "a mark which, (1) when used on or in connection with the goods [or services] of the applicant is merely descriptive . . . of them." 15 U.S.C. § 1052(e)(1). A term is "merely descriptive" within the meaning of Section 2(e)(1) 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.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012)

⁴ Applicant has not made a claim of acquired distinctiveness. Accordingly, the question of whether Applicant's URBAN TOWER mark has acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), is not before us.

(quoting *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); see also *In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). “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 Gyulay*, 3 USPQ2d at 1009.

A term need only describe a single feature or attribute of the identified services to be descriptive. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001). Whether a mark is merely descriptive cannot be determined in the abstract or on the basis of guesswork. Descriptiveness must be evaluated “in relation to the particular [services] for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the [services] because of the manner of its use or intended use.” *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219 (quoting *In re Bayer AG*, 82 USPQ2d at 1831).

The question is not whether a purchaser could guess the nature of the services from the mark alone. Rather, we evaluate whether someone who knows what the 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); *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). To be merely descriptive, a term must forthwith convey an immediate idea of a quality,

feature, function, or characteristic of the relevant services with a “degree of particularity.” *The Goodyear Tire & Rubber Co. v. Cont’l Gen. Tire, Inc.*, 70 USPQ2d 1067, 1069 (TTAB 2008) (citing *In re TMS Corp. of the Americas*, 200 USPQ 57, 59 (TTAB 1978) and *In re Entenmann’s Inc.*, 15 USPQ2d 1750, 1751 (TTAB 1990)).

In her brief,⁵ the Examining Attorney argues:

Applicant’s applied-for mark, URBAN TOWER, is descriptive of the services under §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1) because it describes a feature and function of the applicant’s services, namely, that the services are located in URBAN areas and the services function as TOWERS.

In support of this contention, the Examining Attorney introduced into the record with her February 8, 2022 non-final Office Action⁶ and September 28, 2022 Denial of Applicant’s second Request for Reconsideration⁷ definitions, including the following, of terms comprising and related to the mark:

URBAN – “of, relating to, or located in a city, characteristic of the city or city life;”

TELECOMMUNICATION TOWER – “all types of towers including but not limited to: a monopole; tripole; lattice tower; guyed tower; self-supported tower; pole; mast; or other structure, which are used to support one or more telecommunication antennae for the purpose of radio telecommunications and which may be located at ground level or on the roof of a building and may include an equipment shelter

⁵ 12 TTABVUE 4 (Examining Attorney’s brief).

⁶ At 4, 9-11.

⁷ At 11.

containing electronic equipment and which is not staffed on a permanent basis and only requires periodic maintenance;”

WIRELESS COMMUNICATION TOWER – “any structure built for the sole or primary purpose of supporting one or more FCC licensed or authorized antennas and their associated facilities, including structures that are constructed for wireless communications services.”

Applicant introduced into the record with its June 14, 2022 Request for Reconsideration⁸ the following definitions of terms comprising the mark:

URBAN – “of, relating to, characteristic of, or constituting a city.”

TOWER – “a building or structure typically higher than its diameter and relative to its surroundings that may stand apart or be attached to a larger structure and that may be fully walled in or of skeleton framework (such as an observation or transmission tower).”

In further support of her contentions, the Examining Attorney introduced into the record with February 8, 2022 non-final Office Action,⁹ July 13, 2022 Denial of Applicant’s first Request for Reconsideration¹⁰ and September 28, 2022 Denial of Applicant’s second Request for Reconsideration,¹¹ screenshots, excerpted below, from informational and commercial websites from utilizing the terms “URBAN” and “TOWER” in the context of various aspects of telecommunications:

⁸ At 64-69, 85.

⁹ At 6-8.

¹⁰ At 23-49.

¹¹ At 11.

"urban cell tower" × 

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Guest Opinion: 5G cell towers are coming to your neighborhood

www.paloaltoonline.com › [news](#) › 2020/05/15

May 15, 2020 · A small urban cell tower is supposed to be < 100W ERP, which is actually < 10W input. No reason the amp should need a fan or noisy power ...

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BACKUP FOR URBAN AND REMOTE CELL TOWERS



Cell tower space is becoming crowded with so many other industries vying for the rented space. You need backup telecom generators that can deliver the need kW's, while fitting into a smaller footprint. Generac Industrial Power provides



rugged diesel and natural gas generators to provide the standby power for telecomm needed. They work well with critical power components such as UPS systems, rectifiers, and HVAC systems that ensures power will be continuous as the generator starts and runs up to speed.

Cell tower locations vary: they are either in the middle of cities or in the middle of nowhere. Generac manufactures sound-attenuated enclosures that reduce the noise level for city or urban cell tower locations. We also produce extreme weather-resistant enclosures, should your tower be located on a mountain, near the ocean, or in the Midwest and subject to a variety of weather events.

Generac also provides a range of controllers for remote monitoring that shows all the vital operating parameters of the generator set.

Tower One concentrates on Colombia tower deployments

Bamericas

Published: Monday, March 15, 2021

Technology H...

Mobile Netwo...

Client Base

Tower, Duct



Colombia has been the main focus of telecoms infrastructure firm [Tower One Wireless](#)' cell phone tower deployments this year.

Of the 18 new regional towers delivered during February, 13 are in Colombia, according to the company's latest construction report. Another five sites were activated in Mexico.

The group reports having another 67 towers under construction in its regional markets Colombia, Mexico and Argentina.

With the exception of an **urban tower** in Surtigas, Cartagena, all new Colombian towers were set up in rural areas: Riosucio (Chocó department), Rio Viejo (Bolívar), El Retorno (Guaviare), Calamar

(Guaviare), Orito, (two towers, Putumayo), San Miguel (Putumayo), Valle del Guamuez (four towers, Putumayo) and Belén de Los Andaquíes (Caquetá).

Challenges and Opportunities of Future Rural Wireless Communications

Yaguang Zhang, David J. Love, James V. Krogmeier, Christopher R. Anderson, Robert W. Heath, and Dennis R. Buckmaster

Abstract—Broadband access is key to ensuring robust economic development and improving quality of life. Unfortunately, the communication infrastructure deployed in rural areas throughout the world lags behind its urban counterparts due to low population density and economics. This article examines the motivations and challenges of providing broadband access over vast rural regions, with an emphasis on the wireless aspect in view of its irreplaceable role in closing the digital divide. Applications and opportunities for future rural wireless communications are discussed for a variety of areas, including residential welfare, digital agriculture, and transportation. This article also comprehensively investigates current and emerging wireless technologies that could facilitate rural deployment. Although there is no simple solution, there is an urgent need for researchers to work on coverage, cost, and reliability of rural wireless access.

I. INTRODUCTION

FOR the vast majority of broadband users living in urban environments, it can be difficult to understand the imbalance in communication resources between urban and rural regions throughout the world. Network operators prioritize urban tower density over ubiquitous geographic coverage. Considering the network of a U.S. cellular carrier as an example (Fig. 1), large cities have high cell tower counts per 1000 km², typically over 30. Users in suburban Chicago enjoy 80 to 165 towers per 1000 km². In sharp contrast, 70.5 percent of Indiana's land has less than ten towers per 1000 km², while 44.5 percent has less than five.

These disparities are unnoticed by most urban and suburban users. Fig. 1(a) shows that cell towers cluster not only in cities and towns but also along highways. Therefore, even when traveling, most users lack an accurate understanding of the broadband inequality. The National Association of Counties tested the Internet speeds of 3069 U.S. counties and found that over 65 percent were experiencing Internet speeds below the Federal Communications Commission (FCC) broadband definition (25 Mbps download, 3 Mbps upload) [2].

The 1G and 2G cellular eras had the simple objective of providing voice connectivity. Consequently, infrastructure construction based on population density (with large macrocells in rural areas) was an efficient, cost-effective approach. In the U.S., rural regions account for 97 percent of the land area but only 19.3 percent of the population [3]. Achieving broadband connectivity over such a large geographic area requires a high initial investment, as more towers are needed for broadband vs. voice service. For instance, the average cost for constructing one conventional cellular site is estimated to be US\$200,000–250,000, which is difficult to recover from a low density of potential rural users [4]. This fundamental revenue problem is arguably the

primary culprit for the digital divide.

In 5G and future standard deployments, there will be an increasing demand for the connection of physical objects [5]. Cisco predicts that by 2023, the number of devices connected to IP networks will be over three times the global population [6]. With the shift from connecting people to connecting things, new applications will require rural broadband to sustain the economy. According to the U.S. Department of Agriculture (USDA), digital agriculture could drive an annual additional gross benefit of US\$47–65 billion, corresponding to nearly 18 percent of annual agricultural production in 2017, and rural broadband connectivity could contribute over one-third of this [7]. The digital divide prevents such visions from being realized. Furthermore, broadband access has become a necessity instead of a luxury, especially during and after the COVID-19 pandemic. The digital divide is causing inequality in multiple dimensions, which could economically and socially cripple rural communities without intervention [8].

Promoting rural broadband and closing the digital divide have been top priorities of the USDA [7], the FCC [9], and the National Institute of Standards and Technology (NIST) [10]. However, the telecom industry still focuses on better serving areas with higher population densities. The digital gap has also been widened by 5G technologies such as millimeter-waves (mmWaves) requiring dense infrastructure deployment. The growing vision of connecting everything will only make ubiquitous coverage increasingly important. It is therefore crucial for the communications research community to achieve higher data rates in rural areas and develop innovative technical solutions to drive down the cost of rural networks.

This article examines the motivations and challenges of providing broadband access over vast rural regions, with an emphasis on wireless communication. An application-centric attitude was applied to reveal various benefits of bridging the digital divide. Key research goals were clarified based on the application requirements and unique features of rural environments. Moreover, this article introduces a comprehensive list of promising rural wireless technologies. In the foreseeable future, rural wireless research will involve developing, improving, and choosing technologies to balance primary trade-offs for each application use case.

II. MOTIVATIONS AND APPLICATIONS

This section showcases selected wireless applications to demonstrate the benefits of improving rural connectivity.

A. Overview

Wireless technologies are expected to support multiple future applications in key rural economic sectors (Fig. 2). On the *access network*, the objects of interest in many *outdoor* situations are mobile and/or scattered over a large area. It is normally easier to connect these objects wirelessly.

Crown Castle's Cellular Towers are the Most Urban

Crown Castle has the highest percentage of suburban and urban cellular towers, relative to peers American Tower and SBA Communications. Specifically, 62% of Crown Castle's towers are located in the top 100 cities in the United States, as compared to American Tower at 45% of the top 100 cities and SBA Communications at 43% of the top 100 cities. For example, these top 100 cities include New York City, Los Angeles, Chicago, and Houston.

Overall, Crown Castle's cellular towers are located in more urban and suburban environments, which is particularly important for 5G. Whereas American Tower and SBA Communications are more skewed towards rural environments. Therefore, initial C-Band deployments, for mid-band 5G, may also disproportionately favor Crown Castle's more urban tower portfolio.

"In general, CCI is seeing a significant increase in activity levels as carriers upgrade their networks to 5G, which bodes well for all of the US Towers," he wrote. "There is a sense of urgency from the carriers to deploy 5G, which has driven an increase to mgmt.'s guidance for network services and higher labor costs to process elevated leasing applications. Mgmt. said they had good visibility into rising activity levels when they gave initial 2021 guidance in October of 2020; however, we suspect that there may be upside to organic leasing revenue growth as the year progresses."

Crown Castle's somewhat more urban tower tilt puts it in a good position to capture the work that the U.S. carriers are doing because the carriers will initially target more densely populated areas, wrote MoffettNathanson's Nick Del Deo in an April 21 report.

Can the **cell tower** industry be the next market going "green" in 2017? With over 300,000 cell sites in the United States, and some experts estimating almost 1,000,000 worldwide, the benefits of switching to green technology may be worth it for major cell tower companies, such as American Tower, Crown Castle and SBA Communications.

United States mandates clean energy solutions



The United States may be the country to mandate certain clean energy solutions, but until that time comes, private companies see big opportunity in making the switch to green technology to power cell towers. Presently, India requires 50% of rural tower sites and 20% of **urban tower** sites to be powered by renewable energy systems, and they have years of experience with these solutions.

Global Tower Partners expands its national footprint through purchase of AT&T urban towers

September 17, 2007 - Global Tower Partners of Boca Raton, Florida, has announced the acquisition of 549 communications towers from AT&T Inc.

"The acquisition of these AT&T towers marks another major milestone in the growth of our company," said Marc C. Ganzl, chief executive officer, Global Tower Partners. "We are very excited about the prospects of this unique set of urban tower assets, as well as increasing our relationship with the wireless division of AT&T."



The towers are located in 27 states throughout the U.S. Financial terms of the transaction were not disclosed. RBC Daniels, L.P. acted as exclusive financial advisor to AT&T in the transaction.

AT&T Towers, formerly Cingular Sites is a group within the new AT&T dedicated to managing a tower portfolio of over 9,500 towers and is a competitor of GTP and other tower owners.

As a carrier operated tower company, AT&T Towers is the third largest national tower portfolio providing co-location opportunities. Last week the company loaded 8484 AT&T tower sites into their new [co-location database](#).

With the new AT&T towers, GTP will own approximately 3,100 towers. GTP was acquired by Macquarie, Australia's largest investment bank, for \$1.43 billion dollars from Blackstone Group. Macquarie is looking to further expand GTP's portfolio by offering to buy T-Mobile's 5,500 towers that are being sold by the carrier.

Macquarie is in the planning stages of contracting for due diligence inspections for their [T-Mobile proposal](#).

The Examining Attorney also introduced with her July 13, 2022 Denial of Applicant's first Request for Reconsideration¹² and September 28, 2022 Denial of Applicant's second Request for Reconsideration¹³ copies of eight third-party registrations identifying a wide variety of goods and services in which the term URBAN or TOWER is disclaimed.

Applicant essentially argues that its URBAN TOWER mark only suggests a function, feature or characteristic of its services. As discussed above, in her July 27,

¹² At 5-22, 50-52.

¹³ At 68-73.

2021 first Office Action¹⁴ the Examining Attorney requested the following information:

(1) Explain whether the wording “TOWER” in the mark has any meaning or significance in the trade or industry in which applicant’s goods are manufactured or provided, any meaning or significance as applied to applicant’s goods, or if such wording is a term of art within applicant’s industry.

(2) Respond to the following questions:

Do the applicant’s services involve communications TOWERS?

In its December 6, 2021 response,¹⁵ Applicant submitted the following:

In response to the 2 questions posed in the aforementioned Action Letter, Xchange Telecom LLC (“Xchange”) responds:

1. The goods and services that are being provided under this mark are for virtual collocation spaces on rooftops. In other words, Xchange leases rooftops from landlords, and subleases the rooftops to cellular providers. This is done in dense urban environments, where regular, traditional cellular towers are not available and prohibitively expensive to build. Hence, the mark “Urban Tower” is a unique mark which describes the business plan of creating a virtual communication tower environment in an urban setting. The working “Tower” is significant in the cellular telecommunications services as a place for cellular companies to install antennae to provide services to their customers. Xchange makes no claim as to the uniqueness of the individual words Urban and Tower when used separately, rather, Xchange is claiming that the mark “Urban Tower”, as taken as a whole, is unique to the services that Xchange is offering.
2. The applicant’s services involve communications equipment, but not communications towers, per se. The services provide virtual tower-like infrastructure for cellular companies.

In further support of its position, Applicant introduced into the record with its June 14, 2022 first Request for Reconsideration¹⁶ and August 30, 2022 second

¹⁴ At 1.

¹⁵ At 4.

¹⁶ At 20-56; 78-83, 100-122.

Request for Reconsideration¹⁷ copies of twelve third-party registrations for URBAN and TOWER formative marks issued to different entities and identifying a variety of goods and services, and screenshots from third-party websites showing uses of URBAN TOWER unrelated to its services.

We further note that the Examining Attorney introduced multiple copies of evidence. The Board has long discouraged this practice. *Virtual Independent Paralegals*, 2019 USPQ2d 111512, at *1. Submitting evidence more than once does not increase its probative value and, instead, undermines the effective presentation of the issues involved in the case, hinders the Board’s review of the record, and ultimately delays issuance of a final decision. *Id.* (“[M]ultiple submissions of the same evidence can cause confusion in reviewing the record and unnecessary delay in issuing a final decision. If evidence that purportedly is the same is presented more than once, the Board must compare all versions of the evidence to confirm that it is, in fact, identical. This is not an appropriate use of the Board’s limited resources.”).

The Examining Attorney’s evidence, excerpted above, includes only six third-party uses of the term URBAN TOWER, one use of “urban cell tower” and one use of “backup for urban and remote cell towers” in informational and commercial websites discussing cellular towers located in cities versus rural areas. These website excerpts suggest that URBAN TOWER has some significance in the context of cellular communications towers located in urban areas. However, the evidence of record, consisting of dictionary definitions of the terms comprising the mark and pages from

¹⁷ At 13-15.

the above internet websites, falls short of demonstrating that URBAN TOWER merely describes a function, feature or characteristic of Applicant's various telecommunications services, antenna installation and repair, and design and development of wireless communications systems with the required degree of particularity.

We acknowledge that the evidence shows six instances of various aspects of cellular communications towers located in cities referred to generally as URBAN TOWER(S). However, we agree with Applicant that the Examining Attorney's evidence is insufficient to show that URBAN TOWER merely describes a particular function or feature of Applicant's services. At least one, if not two of the online articles are technical in nature and there is no indication regarding the extent of their circulation or readership, even among telecommunications professionals who might be the purchasers or end users of the identified services. Further, it is impossible from the evidentiary record to determine whether use of URBAN TOWER simply represents use of the term in context, or indicates use of the term to describe some particular aspect of Applicant's services. On this record, URBAN TOWER is, at worst, a suggestive term in all of the articles in which it appears although, as noted above, the term may be descriptive of cellular communications towers located in cities and urban centers. As a result, the Examining Attorney's slim record evidence fails to demonstrate that URBAN TOWER describes a significant feature, aspect or characteristic of the recited services or their purpose such that the mark as a whole may be merely descriptive of thereof. To the extent that Applicant's services may be

used, inter alia, to create and maintain a substitute for a cellular communication tower in an urban setting, imagination or additional thought is required upon viewing URBAN TOWER to reach that conclusion. *See, e.g., In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985) (SPEEDI BAKE for frozen dough found to fall within the category of suggestive marks because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread)

With regard to the third-party registrations introduced into the record by Applicant and the Examining Attorney, as is often noted by the Board and the courts, each case must be decided on its own merits. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *see also In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001); *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001). This evidence nonetheless suggests that, based upon the evidentiary records presented in the underlying applications, the marks and services identified thereby were allowed to register without resort to disclaimer of the terms URBAN or TOWER, or resort to a showing of acquired distinctiveness under Trademark Act Section 2(f) in some cases, and not in others when identifying a variety of goods and services. However, these registrations are not dispositive on the issue under appeal herein.

Finally, to the extent that any “doubts exist as to whether [the] term is descriptive as applied to the . . . [services] for which registration is sought, it is the practice of this Board to resolve doubts in favor of the applicant and pass the mark to publication with the knowledge that a competitor of applicant can come forth and initiate an

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opposition proceeding in which a more complete record can be established.” *In re Stroh Brewery Co.*, 34 USPQ2d 1796, 1797 (TTAB 1994); *see also In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.3d 1567, 4 USPQ2d 1141, 1144 (Fed. Cir. 1987) (citing *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972)).”

Decision: The refusal to register Applicant’s mark under Section 2(e)(1) on the basis that the mark URBAN TOWER is merely descriptive of the identified services is reversed.