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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 Nevin Wayne Fouts

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Serial Nos. 75/559,419 and 75/559,420

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Steven John Hultquist and Marianne Fuierer of Intellectual Property/Technology Law for applicant.

John C. Tingley, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

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Before Cissel, Quinn and Chapman, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Applications have been filed by Nevin Wayne Fouts to register the marks E-NOTE and ENOTE for "portable wireless modem-equipped digital processing and display apparatus linkable to a local area network, and corresponding local area network equipment, namely such portable apparatus."[1]

[1] Application Serial Nos. 75/559,419 and 75/559,420, respectively, filed September 24, 1998, each based on an allegation of a bona fide intention to use the mark in commerce. In a response filed October 4, 1999 in connection with application Serial No. 75/559,419, applicant amended the identification of goods to that shown above. In a response filed

The Trademark Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark, if applied to applicant's goods, would be merely descriptive thereof.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested. Because of the essentially identical issues involved in these appeals, the Board shall decide them in one opinion.

Applicant argues, in urging that the refusals be reversed, that the Examining Attorney has improperly dissected the marks into their component parts.[2] Applicant

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October 27, 1999 in connection with the other application, Serial No. 75/559,420, applicant amended the identification to read "portable wireless modem-equipped digital processing and display apparatus linkable to a local area network." Although the terminology "and corresponding local area network equipment, namely such portable apparatus" was not included in the amendment filed in application Serial No. 75/559,420, both applicant and the Examining Attorney have treated the identification of goods as if such terminology were included. In fact, the Examining Attorney, in his brief at page 1, footnote 1, made the observation that the co-pending applications involved identical identifications of goods. Given that applicant agrees, we assume that the omission in application Serial No. 75/559,420 was an oversight. In deciding the present appeal, we have considered mere descriptiveness based on the identification set forth in the first paragraph of this decision.

[2] During prosecution, applicant submitted a voluntary disclaimer of the letter "E" apart from its marks. See: *TMEP* § 1213.01(c). Given that the involved marks are compound terms and, thus, are considered unitary, Office policy would not require a disclaimer. *TMEP* § 1213.04. Although *TMEP* § 1213.01(c) indicates that in such a situation the Examining Attorney should offer the applicant the opportunity to withdraw the disclaimer, the Examining Attorney merely noted but did not enter the disclaimer.

also contends that there are a multiplicity of possible meanings of the letter "e" and the term "note," such that the combined terms are not merely descriptive.[3] Applicant states that imagination is needed to perceive the merely descriptive significance of the marks, and that there is no need for competitors to use E-NOTE or ENOTE in connection with their goods. Applicant has furnished a copy of its provisional patent application covering the goods identified herein, and excerpts of web pages retrieved from the Internet.

The Examining Attorney maintains that the letter "e" is a commonly understood abbreviation of the word "electronic," and that, when combined with the term "note," the marks sought to be registered are merely descriptive of applicant's goods. The Examining Attorney points out that applicant's contentions would suggest that mere descriptiveness is determined in a vacuum, whereas the proper test involves a consideration of the marks as applied to the goods. In this connection, the Examining Attorney asserts that the marks are merely descriptive of applicant's goods, namely that "the apparatus can take

[3] Applicant did not submit the dictionary pages in support of the definitions set forth in its brief. Nonetheless, such evidence is proper subject matter for judicial notice and, accordingly, we have considered the dictionary definitions in reaching our decision.

notes on a pad of paper, which inputs the notes into its memory and that the 'note' can also be transmitted via a wireless modem." (brief, p. 4). The Examining Attorney has submitted dictionary definitions of the prefix "e-" and the word "note."[4]

It is well settled that a term is considered to be merely descriptive of goods, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods for which registration is sought. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

In order to better understand the nature of applicant's goods, we refer to the provisional patent

[4] The Board takes judicial notice of the dictionary definition of "note" which accompanied the Examining Attorney's brief.

application covering the goods which indicates that the "present invention relates to a unitary, hand-held information accessory, wirelessly linkable to a digital information network" and that the "invention also relates to a network system comprising at least one such information accessory, and preferably a plurality of such information accessories, wirelessly linked for communication with the network and to one another." The patent application recognizes that computer and information communication systems have proliferated in educational environments and that the advances in technology "point up the need for an information appliance having utility in educational and academic applications, that will effectively provide the computational abilities of a personal computer or personal digital assistant, in integration with means for note taking and assimilation of presentational material from lectures, reading, seminars, workshops, laboratory work, etc." The patent application goes on, in pertinent part, as follows:

> The network system of the present invention has particular utility in educational usage. In the educational setting, the information accessory device network system can be used for distributing notes, lectures, outlines, sharing notes between students, taking tests and electronically grading tests, and conducting competitive activities

> as described hereinafter. Such network system can also improve classroom interaction by enabling instructors to view the notes taken and problems being solved by students...
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> *****
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> [T]here may be provided a pen-based input element operationally coupled with the CPU or the computational module of the device. Such pen may for example be configured to enable the user to take notes on the pad of paper retained on one of the half-sections of the device, while simultaneously inputting those notes into the memory of the information accessory device. The notes may for example be further concurrently transmitted via wireless modem to a storage component, database, server, etc., of the local network.

The prefix "e-" is defined as follows: "(Electronic-) The 'e-dash' prefix may be attached to anything that has moved from paper to its electronic alternative, such as e-mail, e-cash, etc." The Computer Glossary (9th ed. 1999). Another definition of "e-" submitted by the Examining Attorney shows the following: "combining form, e-, for electronic, has been used to form words relating to the publication or exchange of information in an electronic format." The Oxford Dictionary of New Words (1997). The word "note" is defined, in pertinent part, as "memorandum; a condensed or informal record; a brief comment or explanation." Merriam Webster's Collegiate Dictionary.

Applicant's patent application along with the dictionary definitions of the individual components clearly indicate that, if applied to applicant's goods, the terms E-NOTE and ENOTE would immediately describe, without conjecture or speculation, a significant feature or function of applicant's goods, namely that the goods enable the user to exchange or share notes (as, for example, a student's notes from a lecture) by electronic means. Essentially the paper notes become "e-notes." As explained in the patent application, a pen-based input element may be used to take notes which are simultaneously inputted into memory, and the notes can then be transmitted via a wireless modem. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers and prospective purchasers for applicant's goods to readily perceive the merely descriptive significance of the terms E-NOTE and ENOTE as they pertain to applicant's goods.

To the extent that applicant points to other meanings of "e" and "note," it should be remembered that such meanings are not relevant as we must consider the mark in relation to the goods. When the compound term is considered as applied to applicant's specific goods, which involve the electronic transmission of notes, the term is

merely descriptive. In re Styleclick.com Inc., 57 USPQ2d 1445 (TTAB 2000). Further, the fact that others have not used the term in a descriptive manner is not persuasive of a different result. In re National Shooting Sports Foundation, Inc., 219 USPQ 1018 (TTAB 1983).

Decision: The refusal to register is affirmed in each application.