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Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re LightSurf Technologies, Inc.

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Serial Nos. 75/807,307; 75/807,308;
75/807,309; and 75/807,310

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Martin R. Greenstein of TechMark for LightSurf Technologies, Inc.

Irene D. Williams, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

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Before Seeherman, Hohein and Chapman, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

On September 24, 1999 LightSurf Technologies, Inc. applied to register the marks PHONEPICTURE,[1] PHONEPICS,[2] PHONEPHOTO[3] and PHONEPIX[4], based on an asserted bona fide

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[1] Application Serial No. 75/807,307.
[2] Application Serial No. 75/807,308.
[3] Application Serial NO. 75/807,309
[4] Application Serial No. 75/807,310.

intention to use the mark. The goods and services in each application are identified, as amended, as:

> Computers, computer network servers, computer software, digital cameras; video cameras; digital and electronic cameras for uploading to and downloading from computers, computer printers and scanners; wired or wireless communications terminals, handheld portable terminals and organizers, and Internet and network web browsers, all for connecting to and exchanging information over the Internet and local area, wide area and enterprise networks; computer e-commerce software to allow users to perform electronic business transactions via the Internet or other computer networks; computer software used for the creation, enhancement, modification, transmission, reception, exchange, storage, and synchronization of information, messages, audio and video data and files, multimedia files, ephotos, photographic and graphic files and images, and wired or wireless e-mail with or without attached files, ephotos and images, and instruction manuals sold as a unit therewith (Class 9); and
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> Web site hosting services for others; creating and maintaining a web site and Internet access site which provides users with wired and wireless access to and the ability to create, enhance, modify, transmit, receive, exchange, store and synchronize information, audio and video data and files, multimedia files, ephotos, photographic and graphic files and images, and e-mail with or without attached files, ephotos and images; computer services, namely providing a web site where users can send and receive greeting cards,

> memos, faxes, messages and announcements containing ephotos and/or digital images and other attached files or data, photographic and digital photography services, electronic photo and imaging services (Class 42).

Registration has been finally refused with respect to all four applications pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's marks are merely descriptive of the identified goods and services.

The appeals have been fully briefed.[5] An oral hearing was not requested.

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[5] With her appeal brief the Examining Attorney submitted dictionary definitions for "wireless telephone," "radio telephone" and "wired." Applicant has objected to the first two definitions as not being properly in the record. Applicant is correct that the definitions were not made of record prior to the filing of the appeal, as required by Trademark Rule 2.142(d). However, the Board may take judicial notice of dictionary definitions, see **University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.**, 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). Although the Examining Attorney did not explicitly request the Board to take judicial notice of such definitions, that was clearly her import in referring to and submitting the definitions, and we therefore do judicially notice them. As for applicant's comment that the submission does not properly identify the dictionary from which they come, the submission adequately identifies the dictionary as The American Heritage Dictionary of the English Language 3d ed. © 1992.

The Examining Attorney also submitted with her brief copies of the LEXIS/NEXIS excerpts that she had previously made of record. It is not necessary to include as exhibits to briefs complete copies of all the materials that were previously made of record, since this makes the file unduly bulky. If certain articles or materials are believed to be particularly apposite, only they should be included as exhibits to the brief.

After the appeals in these applications were filed, applicant's attorney indicated that he would be making a request to consolidate them. Although such a request was never filed, because the appeals involve common questions of fact and law, we hereby consolidate the appeals, and have decided them in a single opinion.

The Examining Attorney asserts that applicant's mark is merely descriptive of its identified goods and services because applicant's goods include wired or wireless communications terminals and handheld portable terminals and organizers, and such items include telephones. Moreover, according to the Examining Attorney, applicant's identified goods include software which creates, transmits, receives, exchanges, etc., audio and video data and files, ephotos, photographic files and images, digital cameras, video cameras, etc. In other words, according to the Examining Attorney, the identified wired or wireless communications terminals encompass telephones and the terminals' ability to exchange information over the Internet encompasses the exchange of pictures.

As for the services, the Examining Attorney asserts that a feature or function of applicant's Internet access site is to allow pictures to be received or transmitted by wired or wireless communication devices, i.e., telephones.

That is, applicant's services would allow phone access to such things as ephotos and photographic files and images.

Thus, the Examining Attorney argues that each mark is a combination of two ordinary descriptive terms which conveys an immediate idea to potential purchasers that a significant feature of applicant's goods and services is that a picture may be sent or displayed over some kind of phone connection.

In support of her position the Examining Attorney has submitted dictionary definitions[6] which are applicable to the elements of the particular marks involved, to wit:

> Phone: a telephone
>
> Picture: a visual representation or image painted, drawn, photographed, or otherwise rendered on a flat surface
>
> Pic: *Slang.* A photograph
>
> Photo: A photograph

The Examining Attorney has also made of record excerpts of articles retrieved from the LEXIS/NEXIS database. Many of these excerpts are taken from foreign publications or wire services, so there is no indication that the articles had any public exposure in the United States. However, because these articles do not use the

[6] The American Heritage Dictionary of the English Language, 3d ed. © 1992.

specific terms sought to be registered, it appears that the Examining Attorney was using them, not to show that the respective marks are being used descriptively by the writers of the articles, but to show that telephones and particularly mobile phones now have the capability to transmit and receive pictures or video.

A mark is merely descriptive, and therefore prohibited from registration by Section 2(e)(1) of the Act, if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods or services with which it is used or is intended to be used. On the other hand, suggestive marks--for which imagination, thought or perception is required to reach a conclusion on the nature of the goods or services--are registrable. See **In re Gyulay**, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a term is merely descriptive must be decided, not in the abstract, but in relation to the goods or services for which registration is sought and the context in which it is or will be used. See **In re Abcor Development Corporation**, 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

As noted, the Examining Attorney has asserted that the term “wired or wireless communications terminals” in the identification of goods encompasses telephones, and has further asserted that the exchange of information over the

Internet that may be accomplished by the wireless communications terminals includes the exchange of pictures. However, the specific portion of the identification relating to wired and wireless communications terminals is "wired or wireless communications terminals, handheld portable terminals and organizers, and Internet and network web browsers, all for connecting to and exchanging information over the Internet and local area, wide area and enterprise networks." We do not read this identification as encompassing telephones, since it is not clear from this record that telephones (as opposed to telephone lines) are normally used for connecting and exchanging information over the Internet or local area, wide area or enterprise networks, or that consumers would refer to or consider wired or wireless communications terminals which have such capabilities as telephones.

The Examining Attorney also argues that a feature or funcion of applicant's Internet access site is to allow "phone pictures" to be received or transmitted by wired or wireless communication devices, i.e., telephones. Again, however, it is not clear from the identification of services that a web site or Internet access site which provides users with wired and wireless access and the

ability to transmit and receive photographic files and images would be perceived to be a telephone.

The Office has the burden of demonstrating that a term is merely descriptive of the identified goods and services. We cannot say, on the basis of the records herein, that the Office has met its burden in these cases.[7] Thus, we must fall back on the well-established principle that, when there is doubt on the issue of mere descriptiveness, such doubt must be resolved in favor of publication. **In re The Stroh Brewery Co.**, 34 USPQ2d 1796 (TTAB 1994). We hasten to add, however, that we might well reach a different conclusion on a more complete record, such as might be adduced in an opposition proceeding. Moreover, upon second examination once specimens are submitted with the

[7] The Board has stated in previous decisions how helpful it is to the Board (as well as in the examination of an application) when Examining Attorneys make use of Trademark Rule 2.61(b), which provides that "the examiner may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application." Such information would have been particularly helpful in these applications, which involve high-tech products and services, and would have enabled us to better assess the question of whether or not these marks are merely descriptive. Although we recognize that the applications are not based on use, applicant could still have been asked to furnish literature about its proposed products and services if those products and services are currently being sold by applicant under another mark, or if the goods and services are being sold by competitors. Even if no one yet offers the products or services, applicant could still have provided information about them.

statements of use, the Examining Attorney is certainly free to revisit the issue of mere descriptiveness.

Decision: The refusal of registration is reversed with respect to all four applications.