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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 Elgrande.com Inc.
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Serial No. 75/554,945
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David H. Diets of Seed and Berry LLP for
Elgrande.com Inc.

Ronald L. Fairbanks, Trademark Examining Attorney, Law
Office 112 (Janice O'Lear, Managing Attorney)
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Before Simms, Walters and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Elgrande.com Inc. has filed an application to register

SHOPENGINE for "on-line retail store services featuring

books, computer software, pre-recorded music, pre-recorded

motion pictures and documentaries, and pre-recorded

multimedia products."[1]

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[1] Serial No. 75/554,945, filed September 17, 1998, based on an
allegation of a bona fide intention to use the mark in commerce.
The application as filed also included goods in Class 9 but
applicant filed simultaneously with the notice of appeal an
amendment to delete the Class 9 goods. Accordingly, the appeal
lies only with the Class 35 services.

Registration has been finally refused under Section 2(e)(1) of the Trademark Act on the ground that the mark would be merely descriptive, if used in connection with applicant's recited services. The refusal has been appealed and both applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

Applicant, in describing the nature of its on-line retail store services, states that the services "include an optional search function by which a user is able to search for products of interest. This function is performed using search engine software." (Brief p.5). Applicant contends, however, that SHOPENGINE is at most suggestive of its services. Applicant argues that ENGINE is not directly or indirectly descriptive of any other aspect of applicant's services, beyond this optional search function.

Moreover, applicant argues, any recognition of the asserted descriptive meaning of the mark as a whole involves a multi-step process, namely, a dissection of the mark into components, speculation that engine must refer to a "search engine" and then an assessment of how "engine" is being used with "shop" to reach the conclusion that the services include software which performs a search function as part of the shopping process. Applicant asserts that there is no recognized meaning for the term SHOPENGINE and

it is not used descriptively by others. In addition,

applicant argues that there is an incongruity in the

combination of the words SHOP and ENGINE in that SHOP would

most likely be viewed as a reference to "shopping" whereas

ENGINE would be perceived to refer to software which

performs a "primary and highly repetitive function."

Shopping, according to applicant, involves too much

purchaser discretion to be effectively performed by a

software engine.

The Examining Attorney maintains that SHOPENGINE is

merely descriptive of applicant's service in that these

services feature easy searching for specific goods because

the web site contains an ENGINE that allows a customer to

SHOP for specific products. To support this position, the

Examining Attorney has made of record dictionary

definitions of the separate words "shop" and "engine" which

include the following:

    Shop   1. To visit stores in search of merchandise
                    or bargains.
                2. To look for something with the intention
                    of acquiring it.[2]

    Engine   1. Software that performs a primary and
                    highly repetitive function such as a
                    database engine, graphics engine or
                    dictionary engine.

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[2] *The American Heritage Dictionary of the English Language* (3rd ed. 1992).

2. Slang for processor.[3]

Thus, according to the Examining Attorney, the individual words inform the prospective customer of a characteristic, function, attribute or property of applicant's services, namely, that the applicant provides a highly repetitive functioning processor (an ENGINE) that enables these customers to search for merchandise with an eye toward purchasing (SHOP). The composite mark or combination of these two descriptive words, he argues, remains merely descriptive, with no separate non-descriptive meaning being created.

While applicant argues that there is no recognized meaning for the term SHOPENGINE, the Examining Attorney counters this argument with the evidence of record of excerpts of articles obtained from the Nexis database in which the term "shopping engine" has been used in conjunction with the terms "computer" or "Internet."[4] The

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[3] A. Freedman, *The Computer Glossary: The Complete Illustrated Dictionary* (8th ed. 1998).

[4] We note that we have not considered those of the excerpts which are newswire stories. Newswire stories are of minimal evidentiary value because it is not clear that such stories have appeared in any publication of general circulation and thus have had any impact on purchaser perception. See In re Urbano, 51 USPQ2d 1776, 1778 (TTAB 1999) at n. 3; In re Men's International Professional Tennis Council, 1 USPQ2d 1917 (TTAB 1986).

following are examples of the representative sampling made

of record:

> The promotional world once turned on toasters and
> fishing rods ... . Then came frequent-flyer miles.
> Then came Wal-mart, a decade of declining
> unemployment, Priceline.com, countless other Internet
> shopping engines and more frequent-flyer miles.
> *Advertising Age* (April 17, 2000);

> It's because airlines have gotten increasingly adept
> at using computers to distinguish between different
> kinds of fliers, and charging different kinds of
> fliers different fares. On the Internet, shopping
> engines perform the same functions in reverse, while
> Priceline has taken the idea of differential pricing
> to its market-driven extreme.
> *Slate Magazine* (January 13, 2000);

> Today Inktomi offers search, a shopping engine and
> traffic-management services for Internet service
> providers.
> *USA TODAY* (May 12, 1999);

> These shopping engines represent a technical
> challenge, however: the sites pull in product, pricing
> and transaction data from a variety of sites and a
> multitude of formats, and then massage it into a
> consistent user format for visitors.
> *InternetWeek* (April 6, 1998);

> Within a few months C2B unveiled a "shopping engine"
> to help consumers comparison shop on the Internet.
> *The American Spectator* (April 1999).

The Examining Attorney argues that these excerpts show the

public's knowledge and awareness of Internet or

computerized "shopping engines" and that, by seeking to

register SHOPENGINE, applicant is merely changing the verb

"shopping" to the verb "shop." Such is, according to the

Examining Attorney, a "distinction without a difference."

Finally, for purposes of better understanding the
nature of applicant's services, the Examining Attorney
points to a report of a television interview with
applicant's chairman and CEO, James R. West,[5] in which
applicant's services are described as follows:

> The company reports it has developed an Internet
> search system called a "Shop Engine," which allows
> consumers who may be looking for particular items
> to purchase, a faster method to get what they want.
> "If someone uses a Search Engine," explained West,
> "to look for the latest book by Tom Clancy, they may
> type in 'Tom Clancy' or 'books by Tom Clancy' and
> receive thousands, maybe millions of choices, very few
> of which have anything to do with buying his books.
> By using the Shop Engine at http://www.ElGrande.com
> however, their choices would be limited to where they
> can actually buy the book itself.

Once again, the Examining Attorney maintains that the term
SHOPENGINE, taken as a whole, is neither incongruous nor
unusual, but rather merely describes applicant's on-line
services which feature an ENGINE used to enable customers
to SHOP for specific products.

A term is merely descriptive within the meaning of
Section 2(e)(1) if it immediately conveys information about
a characteristic or feature of the goods or services with
which it is being used, or is intended to be used. See In
re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir 1987); In

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[5] Although obtained from the newswire release of *PR Newswire*
dated August 6, 1999, we have considered this as evidence of the
nature of applicant's services, rather than any public awareness
of the interview.

re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215

(CCPA 1978). Whether or not a particular term is merely

descriptive is determined not in the abstract, but rather

in relation to the goods or services for which registration

is sought, the context in which the designation is being

used, and the significance the designation is likely to

have to the average purchaser as he or she encounters the

goods or services bearing the designation, because of the

manner in which it is used. See In re Bright-Crest, Ltd.,

204 USPQ 591 (TTAB 1979). It is not necessary that the

term describe all the characteristics or features of the

goods or services in order to be merely descriptive; it is

sufficient if the term describes one significant attribute

thereof. See In re Pennzoil Products Co., 20 USPQ2d 1753

(TTAB 1991).

Applicant has acknowledged that its on-line retail

store services include an optional search function by which

users or potential customers may search for products of

interest or, in other words, search for merchandise which

they seek to buy. From the description of the services

given by Mr. West it appears that this search function is

in fact a significant feature or attribute of applicant's

services.

As stated above, it is not necessary that the term SHOPENGINE describes applicant's on-line services in their entirety; it is sufficient if the term describes one significant feature or attribute of these services. From the dictionary definitions relied upon by the Examining Attorney it is clear that ENGINE aptly describes the highly repetitive functioning processor which applicant provides to users such that they may search for merchandise and that SHOP describes this latter activity. We agree with the Examining Attorney that the composite term SHOPENGINE retains the descriptive significance of the individual terms, the term SHOP merely pinpointing the specific function or use of this particular ENGINE. There is nothing incongruous in this combination of the two terms which might impart a non-descriptive connotation to the composite term.

Furthermore, from the excerpts obtained from the Nexis database, it is clear that there would be public awareness of "shopping engines" as provided on the Internet for purposes of comparison shopping and the like. Clearly the modification by applicant of the word "shopping" to "shop" fails to change the descriptive significance of the term. Thus, we are fully convinced that potential users of applicant's on-line retail store services would be

immediately informed of the availability of such a
"shopping engine" as part of applicant's services by the
use of the term SHOPENGINE. The term is no more than
merely descriptive of a significant feature of applicant's
services.

Accordingly, we find SHOPENGINE would be merely
descriptive if used as intended with applicant's on-line
retail store services.

Decision: The refusal to register under Section
2(e)(1) is affirmed.