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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Thomson Multimedia Inc., by change of name from
Thomson Consumer Electronics, Inc.¹

Serial No. 75/584,718

Scott J. Stevens and James M. Durlacher of Woodard,
Emhardt, Moriarty, McNett & Henry LLP for Thomson Consumer
Electronics, Inc.

Brendan Regan, Trademark Examining Attorney, Law Office 113
(Odette Bonnet, Managing Attorney).

Before Simms, Seeherman and Holtzman, Administrative
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Thomson Multimedia Inc. (applicant), a Delaware
corporation, by change of name from Thomson Consumer
Electronics, Inc., has appealed from the final refusal of
the Trademark Examining Attorney to register the mark E-
MAIL.TV for the following amended description of goods and

¹ On January 29, 2001, the change of name was recorded in this Office
at Reel 2222 Frame 0402.

Serial No. 75/584,718

services: television receivers incorporating circuitry to receive data services in the fields of information, education and entertainment, in Class 9; computerized on-line ordering services in the fields of electronic products, apparel, automobile parts, food, furniture, jewelry, sporting goods, and appliances, in Class 35; on-line bill payment services; on-line banking transaction services, in Class 36; electronic mail services; providing multiple user access to a global computer information network, in Class 38; and on-line security services, namely, monitoring and controlling home security systems, in Class 42.² The Examining Attorney has refused registration under Section 2(e)(1) of the Act, 15 USC §1052(e)(1), arguing that the mark is merely descriptive of applicant's goods and services. Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

We affirm the refusal as to the class of goods (9) and as to one of the classes of services (38) but reverse as to the other classes.

This case has had a relatively long procedural history. In the first refusal, the original Examining

²Application Serial No. 75/584,718, filed November 9, 1998, based upon applicant's allegation of a bona fide intention to use the mark in commerce.

Serial No. 75/584,718

Attorney found that applicant's mark was merely descriptive because the mark identified the subject matter of applicant's goods (televisions) and the purpose of applicant's services (some involving e-mail). Then, in the next Office action, the Examining Attorney made this refusal final, arguing that each part of applicant's mark was descriptive of a feature or characteristic of applicant's goods and services in that applicant's mark consisted of the highly descriptive term "E-MAIL" with the descriptive term "TV". The term as a whole describes that consumers access e-mail through their televisions, the Examining Attorney contended. The Examining Attorney placed in the record excerpts from an electronic database (with the search request of articles discussing both e-mail and television). The Examining Attorney retrieved articles discussing "e-mail on TV screens," "send[ing] emails through their television sets," "email television sets," "a new TV-based email service" and "interactive TV for email."

Applicant responded that, while it intends to use its goods to help provide e-mail (or electronic mail) services, e-mail is only one of a number of services that applicant intends to provide. Applicant envisions that its television receivers will provide one aspect of an overall

Serial No. 75/584,718

system that allows consumers to perform a variety of functions including allowing access to the Internet.

Applicant then filed its initial appeal brief arguing that its mark has "incongruity" because of the presence of the "dot" in its mark.

[T]he pervasive presence of the internet in virtually all of today's advertising has inundated the public's vernacular so that a high level of sensitivity has emerged to words and expressions that include the internet "dot."...

As described above, the mark EMAIL.TV [sic, should be E-MAIL.TV] is suggestive of an internet domain name. The "dot tv" is the top level domain name for the country of Tuvalu, but the mark is not intended to describe a domain name for Tuvalu. The mark therefore has a double meaning; one that suggests a country specific domain name, and one that suggests some relationship between the terms "email" and "tv."

Appeal brief, 4-5.

After the filing of this appeal brief, a new Examining Attorney requested remand in order to supplement the record with additional evidence. The Board granted that request and the Examining Attorney issued a new refusal. In that refusal, the Examining Attorney held that applicant's mark was merely descriptive because it consisted of the descriptive term "E-MAIL," which is assertedly descriptive of applicant's goods and services, and the top level domain (TLD) ".TV". The Examining Attorney referred to

Serial No. 75/584,718

Examination Guide 2-99, in effect at that time, which instructed Examining Attorneys to refuse registration if the mark is composed of a merely descriptive term combined with a TLD. The Exam Guide noted that a TLD is perceived as part of an Internet address and does not add any source-identifying significance to the mark. The Examining Attorney also submitted the following information from Tech Encyclopedia, obtained from the Internet:

(dotTV Corporation, Pasadena, CA, www.tv)
The registrar for Internet addresses that end in .tv. The .tv top level domain is the country code for the Pacific island of Tuvalu, which has approximately 10,000 inhabitants. For granting exclusive registration rights to dotTV, Tuvalu receives part of the proceeds from registration fees. dotTV provides an auction for bidding on names, and the winning bid becomes the registration fee for two years, which is increased in subsequent years.

The Examining Attorney also submitted a copy of the Web page site where one may register .tv domain names (indicating that e-mail.tv was not available), as well as an article from the Internet (retrieved in January 2001) explaining how the TLD .tv came to be.

COUNTRY FOR SALE

...The money came as a result of a contract with a California company called Dot TV, which had a different sort of dream from that of the people of Tuvalu. The idea was to sell to the public what they consider to

be prime real estate on the World Wide Web: Web addresses that end in ".tv".

But to do that required making a deal with Hon. Ionatana and his country, for they were the ones who were lucky enough to be assigned ".tv" when domain names were assigned to countries back in 1991. They agreed to license the name in exchange for an equity stake in the company and roughly \$50 million over the next decade...

...Though he won't give specific numbers about the number of domain names registered to date, Kerner said he's been amazed at how quickly the company has grown since launching last April, how global the reach has been, and how vast an array of businesses have registered names.

"Real estate, retailers, and banks have been among our top registrants," he said. The notion is that as broadband opens up a new world for streaming media on the Web, more companies will want to have the Dot TV domain as their online presence.

The Examining Attorney also attached a copy of Exam Guide 2-99 indicating that, with respect to country code TLDs, each country determines who may use its code, and that, while some countries require that users of their code be citizens or have some association with the country, other countries do not.

The Examining Attorney eventually issued a final refusal under Section 2(e)(1).

In his brief, the Examining Attorney continues to argue that "E-MAIL" merely describes a feature of applicant's goods and services and, relying upon *In re CyberFinancial.Net, Inc.*, 65 USPQ2d 1789 (TTAB

Serial No. 75/584,718

2002)(holding BONDS.COM to be generic for certain services available over the Internet), that the TLD ".TV" does not serve a source-indicating function but merely indicates an address on the World Wide Web. It is the Examining Attorney's position that it is not necessary that a mark describe all of applicant's goods and services in order to be found merely descriptive.

Applicant, on the other hand, while agreeing that "E-MAIL" has the meaning of "electronic mail" and that the mere addition of a TLD such as ".com" to a term may not by itself convey any added significance, argues that the ".TV" portion of its mark does not fall within this category of well-known Internet domain names. It is applicant's position that the TLD ".TV" in its mark may suggest some connection to the Internet, but that it does not provide more than a mere suggestion of what that connection could be. This TLD, according to the applicant, is not a "typical" TLD and should not be treated as such in determining the registrability of a trademark. Applicant contends that consumers do not have a "well-founded understanding" of the significance of ".tv" as a TLD, that the TLD ".tv" has a "relative unknown quality" and is "not immediately recognizable by consumers as a TLD in the same manner that they would associate '.com' or '.net'" with the

Serial No. 75/584,718

Internet. In another Response, filed April 24, 2002, applicant indicates that it is its intention to acquire the domain name "e-mail.tv" in order to "enhance its ability to market its goods and services" under the mark. While applicant admits that it will offer e-mail services, applicant contends that most of its services do not involve e-mail. In addition to arguments made in applicant's initial appeal brief, applicant argues that its mark is only suggestive because the presence of the "dot" in its mark creates a mental pause in the minds of consumers and that imagination is needed to determine the attributes of applicant's goods and services. Applicant argues that here the TLD ".TV" enhances or conveys additional meaning, one not anticipated by consumers. In this regard, applicant contends that its mark conveys such meanings as a suggestion that there is some association with the Internet³ as well as some association with television. According to applicant, the mark may suggest such multiple meanings as a television that incorporates e-mail capabilities or services that allow viewers to interact with TV personalities, and that, in any event, the ".TV" in its mark enhances the mark and makes it more distinctive.

³ Applicant does not argue that consumers will know that ".tv" is the country code domain name of Tuvalu.

Serial No. 75/584,718

Applicant also mentions in its reply brief, for the first time, such third-party registrations as ALUMINIUM.COM for brokerage of aluminum and commodity trading services, and CAFÉ.COM for restaurant services. Applicant argues, therefore, that the Office does permit registration of words with TLDs.⁴ Finally, applicant asks us to resolve any doubt on the question of mere descriptiveness in its favor, in accordance with precedent.

A term is considered to be merely descriptive of goods or services within the meaning of Section 2(e)(1) if it forthwith conveys information about a significant quality, characteristic, feature, function, purpose or use of the goods or services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009-10 (Fed. Cir. 1987) and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). In this regard, it is not necessary that a term describe all of the characteristics or functions of the goods or services in order for it to be considered merely descriptive thereof. Rather, it is sufficient if the term describes a significant attribute or quality about the goods or services. Moreover, whether a term is merely descriptive is determined, not in the abstract, but in

⁴Aside from the fact that applicant did not submit copies of these registrations, new evidence attempted to be made of record for the first time in an appeal brief is untimely. See Trademark Rule 2.142(d).

Serial No. 75/584,718

relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with the goods or services and the possible significance that the term may have to the average purchaser of the goods or services because of the manner of its use. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Therefore, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

On the other hand, a mark is suggestive if, when the mark is used on or in connection with the goods or services, a multi-stage reasoning process, or imagination, thought or perception is required in order to determine the attributes or characteristics of the goods or services offered under the mark. *In re Abcor Development Corp.*, *supra* at 218, and *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1349 (TTAB 1984). We have often stated that there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently involving subjective judgment. See *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992) and *In re TMS Corp. of the Americas*, 200 USPQ 57, 58 (TTAB 1978).

In evaluating the registrability of applicant's mark, we note what Section 1209.03(m) of Trademark Manual of Examining Procedure (3rd ed. Rev June 2003) states concerning the registrability of descriptive or generic terms with domain names:

Internet domain names raise some unique trademark issues. A mark comprised of an Internet domain name is registrable as a trademark or service mark only if it functions as an identifier of the source of goods or services. Portions of the uniform resource locator (URL) including the beginning, ("http://www.") and the top level Internet domain name (TLD) (e.g., ".com," ".org," ".edu,") function to indicate an address on the World Wide Web, and therefore generally serve no source-indicating function. See TMEP §§1215 et seq. regarding marks comprising domain names. TLDs may also signify abbreviations for the type of entity for whom use of the cyberspace has been reserved. For example, the TLD ".com" signifies to the public that the user of the domain name constitutes a commercial entity. In re Martin Container, Inc., 65 USPQ2d 1058, 1060-1061 (TTAB 2002) ("[T]o the average customer seeking to buy or rent containers, "CONTAINER.COM" would immediately indicate a commercial web site on the Internet which provides containers.")...

If a proposed mark includes a TLD such as ".com", ".biz", ".info", the examining attorney should present evidence that the term is a TLD, and, if available, evidence of the significance of the TLD as an abbreviation (e.g. ".edu" signifies an educational institution, ".biz" signifies a business).

Because TLDs generally serve no source-indicating function, their addition to an

otherwise unregistrable mark typically cannot render it registrable. In re CyberFinancial.Net, Inc., 65 USPQ2d 1789, 1792 (TTAB 2002) ("Applicant seeks to register the generic term 'bonds,' which has no source-identifying significance in connection with applicant's services, in combination with the top level domain indicator ".com," which also has no source-identifying significance. And combining the two terms does not create a term capable of identifying and distinguishing applicant's services."); In re Martin Container, 65 USPQ2d at 1061 ("[N]either the generic term nor the domain indicator has the capability of functioning as an indication of source, and combining the two does not result in a compound term that has somehow acquired this capability.")... For example, if a proposed mark is composed of merely descriptive term(s) combined with a TLD, the examining attorney must refuse registration on the Principal Register under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), on the ground that the mark is merely descriptive. See TMEP §1215.04.

Similarly, if a proposed mark is composed of generic term(s) for the applicant's goods or services and a TLD, the examining attorney must refuse registration on the ground that the mark is generic. See TMEP §§1209.01(c)(i) and 1215.05.

Section 1215.04, referred to in this section, provides:

If a proposed mark is composed of a merely descriptive term(s) combined with a TLD, the examining attorney should refuse registration under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), on the ground that the mark is merely descriptive. This applies to trademarks, service marks, collective marks and certification marks.

Example: The mark is SOFT.COM for facial tissues. The examining attorney must refuse registration under §2(e)(1).

Example: The mark is NATIONAL BOOK OUTLET.COM for retail book store services. The examining attorney must refuse registration under §2(e)(1).

The TLD will be perceived as part of an Internet address, and does not add source identifying significance to the composite mark. In re CyberFinancial.Net, Inc., 65 USPQ2d 1789, 1792 (TTAB 2002) ("The public would not understand BONDS.COM to have any meaning apart from the meaning of the individual terms combined"); In re Martin Container, Inc., 65 USPQ2d 1058, 1060 (TTAB 2002) ("[T]o the average customer seeking to buy or rent containers, "CONTAINER.COM" would immediately indicate a commercial web site on the Internet which provides containers.")...

Upon careful consideration of this record and the arguments of the attorneys, we agree with the Examining Attorney that applicant's mark used in connection with television receivers incorporating circuitry to receive data services as well as electronic mail services is merely descriptive of those goods and services available at a ".tv" Web site. First, the word "E-MAIL" has obvious descriptive significance in connection with both television sets that may be equipped to send and receive e-mail as well as electronic mail services. This term, coupled with the TLD ".TV", which is nothing more than a recently available Web address (through an arrangement with the

Serial No. 75/584,718

country of Tuvalu) maintains its descriptive significance for applicant's television receivers which may send and receive e-mail and its electronic mail services available on the Internet at the ".tv" Web address.

While applicant has argued that its asserted mark may have a variety of connotations, as noted above we must analyze applicant's mark as used or intended to be used with its specified goods and services. When so viewed, we conclude that applicant's mark merely describes a significant feature or characteristic of its goods and its electronic mail services and that the TLD ".TV", indicative of an Internet address, does not detract from that descriptive significance. See *In re CyberFinancial.Net, Inc.*, *supra*, and *In re Martin Container, Inc.*, *supra*.

Applicant argues in a Response (filed July 30, 2001, 3) that it is possible to register a descriptive word with an Internet TLD which "add[s] a new or unanticipated meaning." Applicant posits, for example, the hypothetical mark FISHING.NET for "a sporting goods store that outfits fishermen." First, assuming that FISHING.COM were merely descriptive of a service offered over the Internet of promoting or selling goods for the sport of fishing, it is not at all certain to us that the hypothetical mark FISHING.NET would not be descriptive merely because of the

Serial No. 75/584,718

use of the TLD ".net" in the mark rather than the TLD ".com". But, even assuming that FISHING.NET were not merely descriptive, that hypothetical example, which is a play on words (that is, "fishing net" and the hypothetical Web address FISHING.NET), is distinguishable from this case. Either as an Internet address offering television receivers, which may have the capability to send and receive e-mail, as well as electronic mail services (which is the manner in which we believe consumers of applicant's goods and services will perceive the mark) or simply as E-MAIL[.]TV, the ".TV" portion of applicant's mark is not a play on words but will be seen as the well-accepted shorthand reference to "television," which is a component of applicant's goods (television receivers) or a significant feature of its e-mail services, which may be sent or received on television sets. There will be no potential non-descriptive significance imparted by this mark, even if not seen as an Internet address, as there might be in the hypothetical example FISHING.NET.

However, as to applicant's on-line ordering services of various goods, its bill paying and banking services as well as its on-line security services, the Examining Attorney has simply provided no evidence that the asserted mark E-MAIL.TV is merely descriptive of those services. Of

Serial No. 75/584,718

course, because this is an intent-to-use application where applicant has not begun use, such evidence may not be available to applicant. Nevertheless, there is simply nothing in this record to indicate that e-mail is in any way involved in the rendering of on-line ordering, on-line bill paying, on-line banking and on-line security services, services which are most likely to be rendered over the Internet and not by way of e-mail. We hasten to point out, however, that if and when applicant submits its statement of use with evidence of use of the mark E-MAIL.TV, the Examining Attorney is at that time free to again refuse registration under Section 2(e)(1) as to these services should it become apparent that the mark is merely descriptive of an aspect or feature of those services.

Decision: The refusal of registration is affirmed with respect to applicant's goods and its electronic mail services in Class 38; the refusal is reversed as to all other classes.

Serial No. 75/584,718

Seeherman, Administrative Trademark Judge, concurring in part and dissenting in part:

I concur with the majority's reversal of the refusal with respect to applicant's services in Classes 35, 36 and 42, but I respectfully dissent from the majority view that E-MAIL.TV is merely descriptive of applicant's goods and services in Classes 9 and 38.

I agree with the majority that the word "e-mail" in applicant's mark is merely descriptive of its goods and its electronic mail services. However, applicant's mark is not E-MAIL; rather, it is E-MAIL.TV, and I believe that the addition of ".TV" suggests an additional meaning, such that the mark should not be considered merely descriptive.

As the majority notes, the present Examining Attorney takes the position that the mark is merely descriptive because the word "E-MAIL" is merely descriptive, and the addition of ".TV", which is a top level domain name signifying the country of Tuvalu, does not obviate the descriptive nature of this word. In doing so, the Examining Attorney has followed the instructions provided in the Trademark Manual of Examining Procedure, which is quoted at length in the majority opinion, and which, in particular, states:

Serial No. 75/584,718

If a proposed mark is composed of a merely descriptive term(s) combined with a TLD, the examining attorney should refuse registration under Trademark Act §2(e)(1), 15 U.S.C. §1052(e)(1), on the ground that the mark is merely descriptive.

Section 1215.04.

However, as explained in TMEP Section 1215.04, the principle behind the policy that the addition of a top level domain to a descriptive term will not avoid a finding of mere descriptiveness is that this element does not have source-identifying significance to the public. Therefore, the question that I think should be addressed is whether the top level domain will be viewed only as part of an internet address, or whether it has another significance to the public. I agree that top level domains such as ".com," ".edu" and ".gov" are in such common use that the public will view these suffixes, when used as part of a mark, merely as addresses, and will not accord them source-indicating significance. In this sense, the top level domain is similar to company terms such as "Inc." or "Ltd." However, I do not believe that we should apply this policy so formulaically that a top level domain should never be considered in gauging consumer reaction to the mark. There are top level domains that, in addition to their meaning as Internet addresses, have meanings because they are common

Serial No. 75/584,718

English words or abbreviations. For example, the domain name for India is ".in"; Italy is ".it" and Turkmenistan is ".tm." If the top level domain name ".in" were combined with the term "dive" to form the mark DIVE.IN for dive shop services, I suggest that the mark as a whole would not be merely descriptive, despite the descriptiveness of the word "dive." Rather, this is a situation in which a descriptive term is combined with a top level domain in a manner that conveys a meaning separate from that of the domain name, and therefore the top level domain would have source-indicating significance.

In the present case, the top level domain ".TV" has a separate and readily recognized meaning that is different from the top level domain signifying the country of Tuvalu, i.e., the meaning of "television." Thus, I believe that ".TV" in the mark E-MAIL.TV has source-indicating significance, and that the consideration of whether the term is descriptive should not be made on the basis of the word E-MAIL alone.

The majority makes the comment that ".TV" is "a recently available Web address (through an arrangement with the country of Tuvalu)." It should be noted that ".TV" has been and remains the top level domain for the country of Tuvalu. An article which is of record indicates that

Serial No. 75/584,718

Tuvalu has recently entered into an arrangement with a private company to register domain names with this TLD. Although this private company may be registering ".TV" domain names, this TLD is not a new top level domain name, such as the recently created TLDs ".info" and ".biz"; to be clear, this is not a new domain name that has been designated for businesses involved with television or the television industry.

Because the ".TV" portion of applicant's mark will not be viewed as merely a top level domain without source-identifying significance, the question is whether the mark E-MAIL.TV in its entirety is merely descriptive of the goods and services in Classes 9 and 38. As the majority points out, there is often a thin line of demarcation between a suggestive mark and a merely descriptive one, and the determination of the category into which a mark falls frequently involves subjective judgment. In my judgment, E-MAIL.TV falls on the suggestive side of the line. When the suffix ".TV" is combined with the word "E-MAIL," and the resulting mark E-MAIL.TV is used in connection with "television receivers incorporating circuitry to receive data services in the fields of information, education and entertainment," it suggests television receivers that involve computers and the Internet and e-mail. However,

Serial No. 75/584,718

the combination is suggestive because some thought process is necessary; E-MAIL.TV does not immediately and directly convey information about applicant's goods. See *In re Nalco Chemical Co.*, 228 USPQ 972 (TTAB 1986)(VERI-CLEAN suggestive of chemical anti-fouling additives). The fact that the mark is used in the format of an Internet address conveys a meaning that is something more than that of the descriptive word "E-MAIL," while the ".TV" portion of the mark, because it has a meaning as "television" as well as being a top level domain, causes this element to have a source-identifying significance in the mark, as opposed to the examples and case law set forth in the TMEP section quoted in the majority opinion. For similar reasons, E-MAIL.TV is suggestive of applicant's "electronic mail services."

Finally, it is a well-established principle that if there is doubt on the issue of descriptiveness, that doubt should be resolved in favor of publishing the mark. I believe that, at the very least, there is doubt as to whether E-MAIL.TV is merely descriptive, and I would therefore reverse the refusal of registration with respect to Classes 9 and 38 as well as Classes 35, 36 and 42.