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JUMPING THE DISTINCTIVENESS HURDLE: REGISTRABILITY OF TRADEMARKS WITH HIGH TECHNOLOGY WORD COMPOSITIONS

I. INTRODUCTION

Imagine that you are about to expand your small flower boutique into the vast realm of the Internet. You register the domain name “petals.com” for your business and start to use the term as your trademark by selling flowers via the World Wide Web. Shortly after your e-business starts, you attempt to register the name E-PETALS with the United States Patent and Trademark Office (U.S.P.T.O.) for your on-line flower selling and shipping services, but the U.S.P.T.O. denies your application. The trademark examiner at the U.S.P.T.O. renders the mark descriptive of your services, reasoning that “e-” commonly means “electronic” and “petals” describes flowers. Therefore, the U.S.P.T.O. claims that E-PETALS fails to identify your flowers in the mind of the consuming public.

Since the Internet became mainstream, trademark applications have flooded the U.S.P.T.O. with marks comprising of high technology terms, such as “.com,” “e-,” “i-,” and “virtual.”¹ The U.S.P.T.O. has raised the standard for registrability of these marks as the U.S.P.T.O., courts, and general public have gained more knowledge about the Internet and its

¹ See U.S.P.T.O., Examination Guide No. 2-99: *Marks Composed, In Whole or In Part, of Domain Names*, September 29, 1999, available at <http://www.uspto.gov/web/offices/tac/notices/guide299.htm> (recognizing U.S.P.T.O.’s reception of trademark applications with marks composed of domain names); *In re Styleclick.com, Inc.*, 57 U.S.P.Q.2d 1445, 1448 (T.T.A.B. 2000) (revealing pervasiveness of Internet and its effects on new terminology). “Dot.com” is the top-level domain (TLD) portion of a domain name, which is the Internet address. See U.S.P.T.O., Examination Guide No. 2-99: *Marks Composed, In Whole or In Part, of Domain Names*, September 29, 1999, available at <http://www.uspto.gov/web/offices/tac/notices/guide299.htm>. The “e-” prefix means “electronic.” See *In re Styleclick.com, Inc.*, 57 U.S.P.Q.2d 1445, 1448 (T.T.A.B. 2000). The “i-” prefix may mean “information” or “Internet.” See *In re Int’l Data Group, Inc.*, No. 74/618,652, 1998 T.T.A.B. LEXIS 325, at *5 (T.T.A.B. Sept. 14, 1998) (determining that IWAY means “information superhighway”); *In re Zanova, Inc.*, Nos. 75/519,495 and 75/571,710, 2001 T.T.A.B. LEXIS 340, at *7, *14 (T.T.A.B. Apr. 30, 2001) (stating “I” stands for Internet in ITOOL). “Virtual” means “that someone at a computer is able to encounter certain things in a non-physical or ‘virtual’ manner.” *In re Styleclick.com, Inc.*, 58 U.S.P.Q.2d 1523, 1526 (T.T.A.B. 2001).

terminology.² Yet the law still is very much unsettled despite recent guidelines for “.com” cases and case precedent regarding the registrability of marks with high technology word compositions.³ Presently, the U.S.P.T.O. examines “.com” composition marks for registrability by removing the “.com” portion and examining the remaining portion for distinctiveness.⁴ For example, examiners determine that marks composed of a descriptive word with “.com” are descriptive and, therefore, unregistrable without proof of acquired distinctiveness.⁵ Unlike “.com” cases, no guidelines exist for determining the registrability of “e-” prefix, “i-” prefix, and “virtual” composition marks other than scant case law.⁶

This note begins with a background in trademark law explaining factors for determining a trademark’s registrability. Next, Part III examines trends by the U.S.P.T.O. in determining the registrability of marks with “e-” prefix, “i-” prefix, and “virtual” compositions. In an attempt to propose a rule for marks with these compositions, this section also discusses the Trademark Trial and Appeal Board’s (T.T.A.B.) reasoning for denying such marks registration. The conclusion examines the potential consequences of a descriptiveness refusal and the importance of creating examination guidelines for these marks.

² See *In re Styleclick.com, Inc.*, 57 U.S.P.Q.2d 1445, 1447-48 (T.T.A.B. 2000). At the early stages of the Internet, the U.S.P.T.O. granted registrations to marks that would be deemed descriptive or generic today because U.S.P.T.O. examiners and Trademark Trial and Appeal Board (T.T.A.B.) judges were unfamiliar with Internet terminology, and the law was uncharted. See *id.*

³ Compare U.S. Trademark Electronic Search System, available at <http://tess.uspto.gov/bin/gate.exe?f=tess&state=4tqgff.1.1> (on-line search database of federally filed trademarks), and U.S. Patent and Trademark Office, Examination Guide No. 2-99: *Marks Composed, In Whole or In Part, of Domain Names*, September 29, 1999, available at <http://www.uspto.gov/web/offices/tac/notices/guide299.htm> (providing guidelines for “.com” marks), with *In re Styleclick.com, Inc.*, 57 U.S.P.Q.2d 1445 (T.T.A.B. 2000) (holding E FASHION merely descriptive of computer software for shopping and electronic shopping services), and *In re Regal Disc. Sec., Inc.*, No. 75/329,304, 2000 T.T.A.B. LEXIS 756 (T.T.A.B. Nov. 14, 2000) (holding E-OPTION suggestive of stock brokerage services).

⁴ See U.S. Patent and Trademark Office, Examination Guide No. 2-99: *Marks Composed, In Whole or In Part, of Domain Names*, September 29, 1999, available at <http://www.uspto.gov/web/offices/tac/notices/guide299.htm> (proclaiming merely descriptive words combined with top-level domains merely descriptive).

⁵ See *id.*; discussion *infra* Part II C (explaining importance of acquired distinctiveness for descriptive marks). Acquired distinctiveness is equivalent to “consumer recognition and association.” *Grupo Gigante S.A. de C.V. v. Dallo & Co., Inc.*, 119 F. Supp.2d 1083, 1091 (C.D.Ca. 2000).

⁶ See discussion *infra* Part III.

II. BACKGROUND

A. Trademark purpose and protection

Trademark law seeks to ensure that the public identifies goods and services with their sources.⁷ A main purpose of trademark law is to prevent consumer confusion with other sources and, in particular, to protect consumers from misidentifying “palmed off” goods or services as the originals.⁸ The Lanham Act reveals that its intent is to prevent unfair competition, fraud, and deception, among others, in commerce.⁹

State law protected trademarks before federal trademark legislation existed.¹⁰ Prior to federal trademark legislation, in order for an infringement claim to be successful, the registrant had to show that the infringer had knowledge of the registered mark and used the infringing mark in the same commercial area as the registrant.¹¹ In 1905, Congress enacted one of the first trademark acts.¹² Then in 1946, Congress enacted the Lanham Act, which presently governs trademark law.¹³ Today, federal and state statutes-- as well as the common law-- protect trademarks.¹⁴ However, federal law supercedes state law when a conflict between the two arises.¹⁵

Federal trademark registration provides the registrant with distinguished benefits.¹⁶ For instance, a federal registrant is presumed to

⁷ *Breakers of Palm Beach, Inc. v. Int'l Beach Hotel Dev., Inc.*, 824 F. Supp. 1576, 1581 (S.D.Fla. 1993) (stating policies supporting trademark law). The Lanham Act, the statute governing trademark law, states that a trademark can be

any word, name, symbol, or device . . . (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

Lanham Act §45, 15 U.S.C. § 1127 (2000).

⁸ See *Breakers*, 824 F. Supp. at 1581; *Fuddrucker, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 845 (9th Cir. 1987) (explaining when likelihood of confusion occurs).

⁹ Lanham Act §45, 15 U.S.C. §1127 (2000).

¹⁰ See *Dawn Donut Co., Inc. v. Hart's Food Stores*, 267 F.2d 358, 363 (2d Cir. 1959) (explaining trademark protection under state law prior to Lanham Act).

¹¹ *Id.* at 362.

¹² *United We Stand America, Inc. v. United We Stand, America New York, Inc.*, 128 F.3d 86, 92 (2d Cir. 1997).

¹³ See *id.*

¹⁴ J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 22:1, 22-2 (4th ed. 2001).

¹⁵ *Id.* at § 22:2, 22-6.

¹⁶ ROBERT P. MERGES, ET AL, INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE 640 (Richard A. Epstein ed., Aspen Law & Business 2000).

own the mark identifying the goods or services.¹⁷ Specific potential benefits include national constructive use and notice, incontestable status after five years, and the ability to bring a federal claim.¹⁸

Among the requirements for federal trademark registration, an applicant must actually use the mark or have an intent to use the mark in commerce.¹⁹ Section One of the Lanham Act sets forth the requirements of mark owners in securing federal registration of marks “used in commerce” or when the owner has a “bona fide intention . . . to use a trademark in commerce.”²⁰ The Act defines “commerce” as “all commerce which may lawfully be regulated by Congress.”²¹ Precedent holds that commerce for trademark purposes extends to transactions that “substantially affect” interstate or foreign commerce.²²

B. The “sliding scale” of trademark distinctiveness

A trademark’s scope of protection and overall registrability rests on its level of distinctiveness.²³ The more distinctive the mark, the higher level of protection it will receive.²⁴ The U.S.P.T.O. only grants registration to distinctive marks or descriptive marks that have acquired distinctiveness.²⁵ The level of a mark’s distinctiveness classifies it as: generic, descriptive, suggestive, arbitrary, or fanciful.²⁶ This classification system, which categorizes the distinctiveness of marks, is commonly referred to as a “sliding scale.” Generic marks, at the bottom of the sliding scale, are afforded no protection and cannot be registered because they fail

¹⁷ MICHAEL L. RUSTAD & CYRUS DAFTARY, E-BUSINESS LEGAL HANDBOOK § 4.03[F][1] (Aspen Law & Business 2001).

¹⁸ ROBERT P. MERGES, ET AL, INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE 640 (Richard A. Epstein ed., Aspen Law & Business 2000).

¹⁹ See Lanham Act §1, 15 U.S.C. §1051 (2000).

²⁰ See *id.*

²¹ See Lanham Act §45, 15 U.S.C. §1127 (2000).

²² See *Larry Harmon Pictures Corp. v. Williams Rest. Corp.*, 929 F.2d 662, 665 (Fed. Cir. 1991) (quoting *In re Silenus Wines, Inc.*, 557 F.2d 806, 811-12 (C.C.P.A. 1977)); see also *Buti v. Perosa*, 139 F.3d 98, 102 (2d Cir. 1998) (discussing influence of Commerce Clause on trademark law).

²³ See *Breakers of Palm Beach, Inc. v. Int’l Beach Hotel Dev., Inc.*, 824 F. Supp. 1576, 1582 (S.D.Fla. 1993) (examining levels of trademark distinctiveness and importance of distinctiveness).

²⁴ See *id.*; TRADEMARK MANUAL OF EXAMINING PROCEDURE, 2d ed., Revision 1.1, 1209.01, available at <http://www.uspto.gov/web/offices/tac/tmep/>. This notion is consistent with the meaning of “trademark” under the Lanham Act, which states that a trademark is used “to identify and *distinguish* his or her goods . . . from those manufactured or sold by others . . .” Lanham Act § 45, 15 U.S.C. §1127 (2000) (emphasis added).

²⁵ See TRADEMARK MANUAL OF EXAMINING PROCEDURE, 2d ed., Revision 1.1, 1212, available at <http://www.uspto.gov/web/offices/tac/tmep/>; Lanham Act §2(f), 15 U.S.C. § 1052(f) (2000).

²⁶ *Breakers*, 824 F. Supp. at 1582.

to identify the applicant's own goods or services.²⁷ By their nature, generic marks only provide information about the *type* of goods or services but fail to serve as identifiers of the *source* of the goods or services.²⁸ Further, if generic marks were offered protection, they would preclude others from using the generic term to describe a similar product or service.²⁹ Next on the sliding scale are descriptive marks, which the U.S.P.T.O. may register provided the marks have achieved acquired distinctiveness.³⁰ Finally, suggestive, arbitrary, and fanciful marks have the highest level of protection and may be registered without proof of acquired distinctiveness.³¹ "Suggestive marks subtly connote something about the service or product" with the use of the consumer's imagination.³² Arbitrary marks, which offer even stronger protection, are marks that "bear no relationship to the product or service" of the mark.³³ Fanciful marks offer the most protection.³⁴ Fanciful marks are original and have no association with the product or service bearing the mark.³⁵

²⁷ *Id.*

²⁸ *Id.*: see also *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 308 (3d Cir. 1986) (holding CHOCOLATE FUDGE, as applied to soda, generic and not protectable).

²⁹ *A.J. Canfield*, 808 F.2d at 297. "Even complete 'success . . . in securing public identification . . . cannot deprive competing manufacturers of the product of the right to call an article by its name.'" *Id.* (quoting *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976)).

³⁰ See *Breakers*, 824 F. Supp. at 1582-83; *Grupo Gigante S.A. de C.V. v. Dallo & Co., Inc.*, 119 F. Supp.2d 1083, 1091 (C.D.Ca. 2000) (describing descriptiveness and acquired distinctiveness). A term is merely descriptive

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 and/or services . . . Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods and/or services . . . , the context in which it is being used . . . , and the possible significance that the term would have to the average purchaser . . .

In re Styleclick.com, Inc. 57 U.S.P.Q.2d 1445, 1447 (T.T.A.B. 2001).

³¹ *Grupo Gigante S.A. de C.V.*, 119 F. Supp.2d at 1091. "Marks that are arbitrary, fanciful, or suggestive are regarded as immediately capable of identifying particular goods and services . . . and are, in effect, 'irrebuttably presumed to have achieved customer recognition and association immediately upon adoption and use.'" *Id.* (citing 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 15:1 at 15-5).

³² *Breakers*, 824 F. Supp. at 1583 (holding THE BREAKERS for oceanfront hotel as suggestive mark).

³³ *Id.* (providing APPLE for computers and IVORY for soap as examples of arbitrary marks).

³⁴ *Id.*

³⁵ *Id.* (providing XEROX and KODAK as examples of fanciful marks).

C. Acquired distinctiveness

Acquired distinctiveness, also known as “secondary meaning,” is consumers’ recognition of a trademark and identification of it with its source.³⁶ A user with a non-registered descriptive mark is entitled to protection only in the areas in which the mark has gained secondary meaning.³⁷ This rule is consistent with the common law principle of use—that “the senior user of a mark cannot monopolize markets that neither his trade nor his reputation has reached.”³⁸

Furthermore, secondary meaning indicates the extent to which non-registered descriptive marks have protection and also is a requirement for federal registration of descriptive marks.³⁹ Section Two of the Lanham Act denies registration to descriptive or misdescriptive marks, geographically descriptive marks, and surnames used as marks, unless the mark “has become distinctive as used on or in connection with the applicant’s goods in commerce.”⁴⁰ The Lanham Act does not state the requirements for secondary meaning and instead leaves interpretation to the courts and the U.S.P.T.O.⁴¹ Specific evidence that the U.S.P.T.O. has considered in determining the existence of secondary meaning include: long use of the mark; advertising expenditures; affidavits or declarations asserting recognition of a mark as a source indicator; and surveys, market research, and consumer reaction studies.⁴²

III. TRENDS IN THE REGISTRABILITY OF “E-” PREFIX, “I-” PREFIX, AND “VIRTUAL” COMPOSITION MARKS

A. “E-” prefix marks

To date, the T.T.A.B. has decided a hand-full of appeals from applicants who were refused registration of their “e-” prefix marks by

³⁶ See *Grupo Gigante S.A. de C.V.*, 119 F. Supp.2d at 1091 (describing meaning and importance of secondary meaning); *Fuddrucker, Inc. v. Doc’s B.R. Others, Inc.* 826 F.2d 837, 843 (9th Cir. 1987) (noting secondary meaning depends on public’s association of trademark with source). “The phrase ‘has become distinctive’ in the Lanham Act is synonymous with the term ‘secondary meaning.’” J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, §15:60, 15-93 (4th ed. 2001).

³⁷ *Adray v. Adray-Mart, Inc.*, 76 F.3d 984, 987-88 (9th Cir. 1996).

³⁸ See J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, §26:2, 26-6 (4th ed. 2001).

³⁹ See generally *Adray*, 76 F.3d at 987-88; Lanham Act §2, 15 U.S.C. § 1052 (2000).

⁴⁰ See Lanham Act §2(f), 15 U.S.C. § 1052(f) (2000).

⁴¹ See J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, §15:66, 15-94.3 (4th ed. 2001).

⁴² See TRADEMARK MANUAL OF EXAMINING PROCEDURE, 2d ed., Revision 1.1, 1212.06, available at <http://www.uspto.gov/web/offices/tac/tmep/>.

trademark examiners on the basis of lack of distinctiveness.⁴³ The oldest case reported was decided October 19, 2000.⁴⁴ The Board held such a mark to be suggestive only once.⁴⁵ By only considering the T.T.A.B. appeals, one could be misled in thinking that the U.S.P.T.O. deems most "e-" prefix marks to be merely descriptive.⁴⁶ A federal registration search, however, indicates that the U.S.P.T.O. has registered many "e-" prefix composition marks prior to the year 2000.⁴⁷ A closer examination of the U.S.P.T.O.'s trends in registering "e-" prefix marks suggests that until 1999, the U.S.P.T.O. granted registrations to virtually all applicants with

⁴³ See *In re* U.S. Tsubaki, Inc. No. 75/684,389, 2001 T.T.A.B. LEXIS 737 (T.T.A.B. Sept. 28, 2001) (holding E-CHAIN merely descriptive of electronic catalog and software regarding industrial roller chain); *In re* Cairo, No. 75/596,169, 2001 T.T.A.B. LEXIS 675 (T.T.A.B. Sept. 17, 2001) (holding ECERTIFIED merely descriptive of certification of delivery of e-mail messages); *In re* E* Prescription, Inc., No. 75/589,909, 2001 T.T.A.B. LEXIS 596 (T.T.A.B. Aug. 9, 2001) (holding EPHYSICIAN descriptive of computer hardware and software for delivery of drug prescriptions); *In re* U.S. Tsubaki, Inc., No. 75/684,041, 2001 T.T.A.B. LEXIS 592 (T.T.A.B. Aug. 9, 2001) (holding E-SPROCKET merely descriptive of electronic catalog regarding industrial chain drive and idler sprockets); *In re* Consumer Ins. Group, No. 75/772,303, 2001 T.T.A.B. LEXIS 474 (T.T.A.B. June 19, 2001) (holding ETERM merely descriptive of insurance brokerage services); *In re* Brian S. Gladden, No. 75/711,666, 2001 T.T.A.B. LEXIS 435 (T.T.A.B. June 6, 2001) (holding EOUTDOORS merely descriptive of on-line services related to outdoor activities); *In re* Brian S. Gladden, No. 75/711,655, 2001 T.T.A.B. LEXIS 372 (T.T.A.B. May 11, 2001) (holding EOUTDOORS merely descriptive of on-line services related to outdoor activities); *In re* Mark S. Cooperman, No. 75/652,852, 2001 T.T.A.B. LEXIS 128 (T.T.A.B. Feb. 12, 2001) (holding EMAILER ID merely descriptive of e-mail software and presentation software); *In re* eCash Tech., Inc., No. 74/605,417, 2000 T.T.A.B. LEXIS 723 (T.T.A.B. Nov. 29 2000) (holding E-CASH merely descriptive of computers and related goods for the transfer of data); *In re* Styleclick.com, Inc., 57 U.S.P.Q.2d 1445 (T.T.A.B. 2000) (holding E FASHION merely descriptive of computer software for shopping and electronic shopping services); *In re* Regal Disc. Sec., Inc., No. 75/329,304, 2000 T.T.A.B. LEXIS 756 (T.T.A.B. Nov. 14, 2000) (holding E-OPTION suggestive of stock brokerage services); *In re* Seifert, No. 75/273,635, 2000 T.T.A.B. LEXIS 793 (T.T.A.B. Oct. 19, 2000) (holding E-CATALOG merely descriptive of computer software for use in creating a catalog). See also *Continental Airlines, Inc. v. United Air Lines, Inc.*, No. 98,459, 1999 T.T.A.B. LEXIS 717 (T.T.A.B. Dec. 29, 1999) (holding E-TICKET generic of electronic ticketing services). See generally <http://www.uspto.gov/web/offices/com/sol/foia/ttab/decsum/decsum.htm> (providing summaries of T.T.A.B. decisions from 1996 to 2002). However, only one of the cases, *In re Styleclick.com, Inc.*, is citable as precedent of the T.T.A.B.

⁴⁴ See *supra* note 43; *In re* Seifert, No. 75/273,635, 2000 T.T.A.B. LEXIS 793 (T.T.A.B. Oct. 19, 2000).

⁴⁵ See *supra* note 43 (listing *In re* Regal Disc. Sec., Inc., which held E-OPTION suggestive of stock brokerage services).

⁴⁶ See generally *supra* note 43.

⁴⁷ See U.S. Trademark Electronic Search System, available at <http://tess.uspto.gov/bin/gate.exe?f=tess&state=4tqgff.1.1> (on-line search database of federally filed trademarks); *In re* Styleclick.com, Inc., 57 U.S.P.Q.2d at 1447-48. Most of these marks were registered between 1997-1998. See *id.*

“e-” prefix marks.⁴⁸ Aside from reasoning that the U.S.P.T.O. has inconsistent practices regarding the examination of these marks and reasoning that each application is decided on its own facts, a strong explanation for the inconsistency is the growth and effects of the Internet.⁴⁹

A good example of the T.T.A.B.’s analysis is in *In re Styleclick.com, Inc.* (“*Styleclick.com I*”).⁵⁰ In that case, the applicant sought to register the mark E FASHION for “computer software for consumer use in shopping,” “computer software for providing fashion . . . advice,” and “electronic retailing services . . .”⁵¹ The applicant appealed the trademark examiner’s refusal arguing that the mark was suggestive.⁵² Disclosing that “e-” means “electronic,” the applicant argued that “electronic fashion” requires “thought and deliberation . . . to glean its significance in relation to the goods and services.”⁵³ The T.T.A.B., however, affirmed the trademark examiner’s decision.⁵⁴ The *Styleclick.com I* court did not provide a bright-line rule for determining the registrability of “e-” prefix marks, but it did provide some guidance for future applications.⁵⁵ The court found that the “e-” prefix generally has the meaning of “electronic” in terms of computers and the Internet.⁵⁶ Additionally, the court pronounced that a “non-source identifying prefix,” when used in conjunction with another descriptive term, renders the whole

⁴⁸ Compare *supra* note 43, with U.S. Trademark Electronic Search System, available at <http://tess.uspto.gov/bin/gate.exe?f=tess&state=4tqgff.1.1> (on-line search database of federally filed trademarks). See *In re Styleclick.com, Inc.*, 57 U.S.P.Q.2d at 1448 (discussing registration of “e-” prefix marks).

⁴⁹ See *In re Styleclick.com, Inc.*, 57 U.S.P.Q.2d at 1448. As the T.T.A.B. has stated,

While, by most standards, one to three years in the past would be viewed as ‘recent,’ a year or two is an eternity in ‘Internet time,’ given the rapid advancement of the Internet into every facet of daily life . . . Only ‘recently,’ the Internet meaning of the ‘e-’ prefix may have been known only by those few who were then accessing the Internet. We have no doubt that in the year 2000, the meaning of the ‘e-’ prefix is commonly recognized and understood by virtually everyone as a designation for the Internet.

Id. at 1448.

⁵⁰ 57 U.S.P.Q.2d 1445 (T.T.A.B. 2000). Since *Styleclick.com, Inc.* appealed the refusals of two different marks and both cases have the same name, this note will refer to them as “*Styleclick.com I*” and “*Styleclick.com II*.” See *In re Styleclick.com, Inc.*, 57 U.S.P.Q.2d 1445 (T.T.A.B. 2000) (deciding registrability of E FASHION); *In re Styleclick.com, Inc.*, 58 U.S.P.Q.2d 1523 (T.T.A.B. 2001) (deciding registrability of VIRTUAL FASHION).

⁵¹ *In re Styleclick.com, Inc.*, 57 U.S.P.Q.2d at 1446.

⁵² *Id.*

⁵³ *Id.*

⁵⁴ *Id.* at 1448.

⁵⁵ *Id.*

⁵⁶ *In re Styleclick.com, Inc.*, 57 U.S.P.Q.2d 1445, 1448 (T.T.A.B. 2000).

mark merely descriptive.⁵⁷ The T.T.A.B.'s policy reason for holding such marks merely descriptive is that terms such as "e-" must remain available for other Internet users.⁵⁸

B. "I-" prefix marks

As with "e-" prefix marks, the U.S.P.T.O. has been inconsistent in registering marks with the "i-" prefix composition.⁵⁹ The U.S.P.T.O. has registered marks with "i-" prefixes, but in all T.T.A.B. cases regarding registrability of marks with an "i-" prefix, the court has affirmed the refusal.⁶⁰ The absence of guidelines within the U.S.P.T.O. as to how to treat these marks makes the examination of them difficult.

The "i-" prefix commonly stands for either "Internet" or "information" in the high technology field.⁶¹ In *In re Zanova*, the T.T.A.B. affirmed the refusal to register ITOOL for computer services and software for use in creating web pages.⁶² After reviewing the evidence that "Internet tools" is a commonly used term to refer to computer programs relating to the Internet, the court determined that ITOOL does not make a

⁵⁷ *Id.* The *Styleclick.com* I court's proposed examination of "e-" prefix marks is similar to the examination of marks composed of ".com" and other TLD marks, which are analyzed by removing the ".com" portion and determining the distinctiveness of the remaining portion of the mark. Compare *supra* note 4 with *In re Styleclick.com, Inc.*, 57 U.S.P.Q.2d at 1448. The T.T.A.B. has determined that the combination of two generic or descriptive terms does not necessarily result in an arbitrary or suggestive whole. See *In re U.S. Tsubaki, Inc.*, No. 75/684,041, 2001 T.T.A.B. LEXIS 592, at *6-7 (T.T.A.B. Aug. 9, 2001). This is consistent with the U.S.P.T.O.'s guidelines on reviewing marks composed in whole or in part of a TLD that the TLD "does not add source identifying significance to the composite mark." See *supra* note 4.

⁵⁸ *In re Styleclick.com, Inc.*, 57 U.S.P.Q.2d at 1448.

⁵⁹ See *infra* note 60.

⁶⁰ See *In re Zanova, Inc.* Nos. 75/519,495 and 75/571,710, 2001 T.T.A.B. LEXIS 340 (T.T.A.B. Apr. 30, 2001) (holding ITOOL merely descriptive of computer services and software for web site design); *In re IntraGroup, Inc.*, No. 75/477,608, 2001 T.T.A.B. LEXIS 260 (T.T.A.B. Mar. 29, 2001) (holding ITJOBS merely descriptive and generic of on-line resumes and job placement information); *In re Int'l Data Group, Inc.*, No. 74/618,652, 1998 T.T.A.B. LEXIS 325 (T.T.A.B. Sept. 14, 1998) (holding IWAY merely descriptive of newsletters, journals, newspapers, and books regarding online communication topics). See generally <http://www.uspto.gov/web/offices/com/sol/foia/ttab/decsum/decsum.htm> (providing summaries of T.T.A.B. decisions from 1996 to 2002). Only *In re Zanova, Inc.* is citable as precedent of the T.T.A.B.

⁶¹ See generally *In re Int'l Data Group, Inc.*, No. 74/618,652, 1998 T.T.A.B. LEXIS 325, at *5 (T.T.A.B. Sept. 14, 1998) (determining "IT" means "information technology"); *In re Zanova, Inc.*, Nos. 75/519,495 and 75/571,710, 2001 T.T.A.B. LEXIS 340 (T.T.A.B. Apr. 30, 2001) (determining "I" stands for "Internet" in ITOOL).

⁶² *In re Zanova, Inc.*, Nos. 75/519,495 and 75/571,710, 2001 T.T.A.B. LEXIS 340, at *1, *20 (T.T.A.B. Apr. 30, 2001).

“registrable composite.”⁶³ Similarly, the court in *In re IntraGroup, Inc.* found that ITJOBS for a service providing online resumes and job placement information was generic and merely descriptive because “IT” means “information technology” and “information technology jobs” was the service that the mark sought to identify.⁶⁴ In determining the registrability of the marks in *In re Zanova* and *In re IntraGroup, Inc.*, the courts first examined the compositions of the marks for their meaning.⁶⁵ Then the courts made a final determination based on the mark as a whole when considering the goods or services that the marks identified.⁶⁶

C. “Virtual” type marks

As with “e-” prefix and “i-” prefix marks, the U.S.P.T.O. has treated marks with “virtual” compositions inconsistently.⁶⁷ Although the registrability of third party marks cannot determine the registrability of a different mark for different goods and/or services, third party registrations provide insight as to the U.S.P.T.O.’s trends in granting registration to similar marks.⁶⁸ The U.S.P.T.O. has granted registration to “virtual” type marks in the past but more recently has denied them registration.⁶⁹

⁶³ See *In re Zanova, Inc.*, Nos. 75/519,495 and 75/571,710, 2001 T.T.A.B. LEXIS 340, at *14-16 (T.T.A.B. Apr. 30, 2001).

⁶⁴ *In re IntraGroup, Inc.*, No. 75/477,608, 2001 T.T.A.B. LEXIS 260, at *5, *17 (T.T.A.B. Mar. 29, 2001).

⁶⁵ *In re Zanova, Inc.*, Nos. 75/519,495 and 75/571,710, 2001 T.T.A.B. LEXIS 340, at *14 (T.T.A.B. Apr. 30, 2001); *In re IntraGroup, Inc.*, No. 75/477,608, 2001 T.T.A.B. LEXIS 260, at *5 (T.T.A.B. Mar. 29, 2001).

⁶⁶ *In re Zanova, Inc.*, Nos. 75/519,495 and 75/571,710, 2001 T.T.A.B. LEXIS 340, at *17 (T.T.A.B. Apr. 30, 2001); *In re IntraGroup, Inc.*, No. 75/477,608, 2001 T.T.A.B. LEXIS 260, at *13 (T.T.A.B. Mar. 29, 2001).

⁶⁷ See *In re Styleclick.com, Inc.*, 58 U.S.P.Q.2d 1523, 1526-27 (T.T.A.B. 2001) (providing examples of where U.S.P.T.O. has not treated “virtual” type marks, like applicant’s, consistently).

⁶⁸ See *id.* at 1526.

⁶⁹ See generally *In re Prize Central Networks, Inc.*, No. 75/509,370, 2001 T.T.A.B. LEXIS 745 (T.T.A.B. Oct. 3, 2001) (holding VIRTUAL LAS VEGAS for on-line computer games distinctive and registrable); *In re Concurrent Tech. Corp.*, No. 75/538,498, 2001 T.T.A.B. LEXIS 332 (T.T.A.B. Apr. 26, 2001) (holding VIRTUALCAST merely descriptive of “computer software for simulating metal forming processes”); *In re SpecComm Int’l, Inc.*, No. 75/300,898, 2001 T.T.A.B. LEXIS 216 (T.T.A.B. Feb. 28, 2001) (holding VIRTUAL FIRE & RESCUE EXPO merely descriptive of online workshops in fire and rescue field); *In re Styleclick.com, Inc.*, 58 U.S.P.Q.2d 1523 (T.T.A.B. 2001) (holding VIRTUAL FASHION merely descriptive of computer software in relation to shopping, fashion, and beauty); *In re EIS Int’l, Inc.* No. 75/510, 2000 T.T.A.B. LEXIS 872 (T.T.A.B. Dec. 12, 2000) (holding VIRTUAL CENTER FORECASTER not merely descriptive of software and database for running global forecasts); *In re Am. Online*, No. 75/280,610, 1999 T.T.A.B. LEXIS 611 (T.T.A.B. Oct. 27, 1999) (holding VIRTUAL KEY not merely descriptive of computer services). Of all these cases, only *In re Styleclick.com, Inc.* (“*Styleclick.com II*”) is citable as precedent of the T.T.A.B. The *Styleclick.com II* court

The only citable T.T.A.B. decision regarding “virtual” marks, *In re Styleclick.com, Inc.*⁷⁰ (“*Styleclick.com II*”), points to this inconsistency within the U.S.P.T.O.⁷¹ In this case, the T.T.A.B. affirmed the examiner’s refusal of the mark VIRTUAL FASHION for computer software and retailing services in regard to fashion, shopping, and beauty.⁷² The court recognized that the U.S.P.T.O. has been inconsistent in determining the registrability of marks with “virtual” compositions.⁷³ Although the court did not provide a bright-line rule for examining such a trademark, the court did provide some guidance.⁷⁴ First, the court examined the meaning of the two words in the mark individually.⁷⁵ Then the court analyzed them as a whole in relation to the goods and services.⁷⁶ Since both words were merely descriptive of the goods and services, the mark was descriptive as a whole.⁷⁷ The court denied registration recognizing the need “to protect the competitive needs of others, that is, ‘descriptive words must be left free for public use.’”⁷⁸

D. Conclusion: The importance of articulating proper examination procedures for “e-” prefix, “i-” prefix, and “virtual” composition marks

In examining a mark with an “e-” prefix, “i-” prefix, or “virtual” composition, it is important to recognize that the use of the mark in relation to the goods or services it identifies is what determines the mark’s distinctiveness.⁷⁹ For example, consider the mark VIRTUAL BLACK for

reasoned that the inconsistency results from the growth of the Internet. *In re Styleclick.com, Inc.* 58 U.S.P.Q.2d 1523, 1527 (T.T.A.B. 2001). As the *Styleclick.com II* court stated,

Only “recently,” the computer or Internet meaning of “virtual” may have been known only by those few who were then using computers or accessing the Internet. We have no doubt that in the year 2001, the meaning of the term “virtual” is commonly recognized and understood by most people as meaning something that is merely conceptual rather than something that has physical reality, especially in connection with things encountered via computers and the Internet.

Id.

⁷⁰ 58 U.S.P.Q.2d 1523 (T.T.A.B. 2001).

⁷¹ See *In re Styleclick.com, Inc.*, 58 U.S.P.Q.2d at 1526-27.

⁷² *Id.* at 1524, 1528.

⁷³ *Id.* at 1526-27.

⁷⁴ See *id.* at 1527 (analyzing the registrability of VIRTUAL FASHION).

⁷⁵ *In re Styleclick.com, Inc.* 58 U.S.P.Q.2d 1523, 1526 (T.T.A.B. 2001).

⁷⁶ *Id.*

⁷⁷ *Id.*

⁷⁸ See *id.* at 1527 (citing *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 U.S.P.Q. 382, 383 (C.C.P.A. 1968)).

⁷⁹ See *In re IntraGroup, Inc.*, No. 75/477,608, 2001 T.T.A.B. LEXIS 260, at *13 (T.T.A.B. Mar. 29, 2001). “[D]escriptiveness of a mark is not considered in the abstract,

watch repair services. If the services are not “virtual” within the meaning of the Internet or any other meaning, and the word “black” has no affiliation with the services, the mark may be distinctive. Alternatively, if the mark immediately describes the goods and/or services, the mark is merely descriptive, or possibly even generic, and cannot be granted registration on the Principal Register.

Having a trademark examiner deem a mark merely descriptive may have grave consequences. Often the financial effects of a descriptiveness refusal may be significant. A company that already has advertised, manufactured, and placed its goods in the marketplace could be greatly affected by a refusal. Since the benefits of federal registration are so desirable, a trademark refusal could prompt a company to pull all of its products off the shelves and re-start the manufacturing and advertising process with a new trademark. Alternatively, the company could appeal to the T.T.A.B. and then appeal again to a federal court, but, of course, litigation also is expensive. Overall, it is important for the applicant to have a strong mark to better identify the goods and services and to prevent the costly effects of a trademark registration denial.

To better inform trademark applicants and their attorneys of the possible detrimental consequences of using a mark with a high technology word composition, the U.S.P.T.O. should implement explicit regulations regarding the examination of marks composed in part of high technology terms, such as “e-,” “i-,” and “virtual.” Presently, only a few cases regarding the registrability of marks with “e-” prefixes, “i-” prefixes, and “virtual” compositions are citable as precedent of the T.T.A.B. Trademark applicants with marks of such compositions who file for registration without the assistance of attorneys most likely have little way of knowing that the mark’s prefix does not make an otherwise descriptive mark distinctive. The Internet age arrived, and the U.S.P.T.O. should implement guidelines regarding the examination of trademarks with compositions that reflect society’s developments.

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