

PATENTS.COM Not Registrable as a Trademark, Court Rules

By Brian E. Banner *

In *In Re Oppedahl & Larson LLP*, the US Court of Appeals for the Federal Circuit has upheld a decision to refuse registration of the mark PATENTS.COM on the grounds that it was merely descriptive and thus not entitled to registration.

Oppedahl & Larson LLP, a law firm offering patent, copyright, trademark, trade secret and other IP services, submitted an intent-to-use application to the US Patent and Trademark Office (USPTO) to register the mark PATENTS.COM for "computer software for managing a database of records and for tracking the status of the records by means of the Internet". The registrar rejected the application. Oppedahl & Larson filed an amendment to allege use supported by a specimen that read in part:

"Welcome to the PATENTS.COM software download links page. From this page you can reach download locations for Oppedahl & Larson LLP's most popular software: Partridge - software for tracking the status of US patent applications and issued patents."

On appeal, the Trademark Trial and Appeal Board (TTAB) upheld the decision on the grounds that the mark was merely descriptive of Oppedahl & Larson's goods (ie, software for tracking patent applications and issued patents) under 15 USC §1052(e). The TTAB noted that a mark may be merely descriptive even if it does not describe the "full scope and extent" of the applicant's goods or services. However, it may also qualify for registration on the Principal Register under 15 USC §1052(f) if evidence is offered that it has acquired secondary meaning (ie,

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distinctiveness through long and relatively exclusive use in commerce). Oppedahl & Larson had not alleged acquired distinctiveness and, thus, its application was refused. Oppedahl & Larson appealed to the US Court of Appeals for the Federal Circuit, arguing that:

- the USPTO erred in considering the two parts of its PATENTS.COM mark separately rather than considering the consumer's impression of the mark as a whole;
- the USPTO applied a *per se* rule that '.com' never possesses source-identifying significance;
- the addition of '.com' will generally, if not always, add source-identifying significance (eg, a purchaser may conjure up images of a river when seeing the name 'Amazon', but would think of an online retailer when seeing 'Amazon.com'); and
- domain names are inherently distinctive because they can only be associated with one entity or source at a time.

The court upheld the TTAB ruling. It held that when the USPTO examines marks that are also domain names, it must evaluate the commercial impression of the mark as a whole, including the top-level domain (TLD) indicator (eg, '.com'). However, the addition of a TLD to an otherwise unregistrable mark will typically not add any source-identifying significance, similar to the analysis of 'corp' and 'inc'. The court found that this is not a bright-line or *per se* rule, as, in exceptional circumstances, a TLD may render an otherwise descriptive term sufficiently distinctive for trademark registration (eg, Tennis.net for a store that sells tennis nets).

The court concluded as to the first three arguments that the USPTO did not dissect the mark, or apply a bright-line or *per se* rule that the addition of a TLD to an otherwise descriptive term will never under any circumstances affect the registration of a mark. Rather, it held that '.com' possessed no source-identifying characteristics. Further, substantial evidence supported the conclusion that:

- 'patents' was descriptive of a feature of Oppedahl & Larson's goods;
- '.com' indicated a commercial entity in relation to the Internet; and
- the combination of the terms did not render the mark as a whole distinctive and registrable.

In fact, the addition of '.com' to the term 'patents' only strengthened the descriptiveness of the mark in light of the goods in the application.

As to the fourth argument, the court held that the fact that a domain name can only be owned by one entity does not of itself mean that it is a source identifier. There is no *per se* rule that extends trademark protection to all domain names regardless of their use.