

## When Is A Domain Name Merely Descriptive Under U.S. Law?

By Brian E. Banner \*

The CAFC addressed this question recently in an appeal from the Trademark Trial and Appeal Board's holding that "patents.com" was merely descriptive under U.S. law. IN RE OPPEDAHL & LARSON LLP, (CAFC, June 25, 2004). In the case before the USPTO the Applicant filed an intent-to-use application to register the mark "patents.com" and eventually identified the goods as "Computer software for managing a database of records and for tracking the status of the records by means of the Internet." Its amendment to allege use specimen read:

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:

- Feathers – software for tracking the status of US trademark applications and registered trademarks
- Partridge – software for tracking the status of US patent applications and issued patents
- Raptor - software for tracking the status of Express Mail shipments to the US Patent & Trademark Office.

The Examining Attorney and the TTAB refused to register the mark "patents.com" based on a finding that the mark is merely descriptive of applicant's goods, i.e., software for tracking patent applications and issued patents. In particular, the PTO found that the term "patents" merely describes a feature of the goods, and the term ".com" is a top level domain indicator (TLD) without any trademark significance.

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