

# Federal Circuit: Reiteration of High Threshold for Descriptiveness Refusals

*In re Driven Innovations, Inc.*, Ser. No. 77073701 (Fed. Cir. Jan. 4, 2017) (not precedential)

The U.S. Court of

Appeals for the Federal Circuit recently reversed a Trademark Trial and Appeal

Board (“TTAB”) decision in which the Board upheld a Section 2(e)(1)

descriptiveness refusal for the DOTBLOG mark. [More](#)

*In re Driven Innovations, Inc.*, Ser. No. 77073701 (Fed. Cir. Jan. 4, 2017) (not precedential)

The U.S. Court of Appeals for the Federal Circuit recently reversed a Trademark Trial and Appeal Board (“TTAB”) decision in which the Board upheld a Section 2(e)(1) descriptiveness refusal for the DOTBLOG mark. In doing so, the Federal Circuit reiterated that the high standard for a merely descriptive refusal requires that the descriptive nature of the mark be “immediately” and “instantaneously” apparent to consumers. The decision is somewhat of a departure from the TTAB’s trend in favor of a seemingly less stringent standard for descriptiveness refusals.

In *In re Driven Innovations*, Ser. No. 77073701 (Fed. Cir. Jan. 4, 2017) (not precedential), Driven Innovations, Inc. (“Driven Innovations”) filed a 2006 trademark application for DOTBLOG covering “providing specific information as requested by customers via the Internet.” Slip Op. at 2. In 2012, Driven Innovations filed a Statement of Use with a specimen showing that its services included providing a summary of blog posts to users. *Id.* The Examining Attorney refused registration on the basis that the mark was merely descriptive. *Id.* at 3. As evidence, the Examining Attorney included definitions of DOT and BLOG and concluded that the compound mark merely described the services. Specifically, he noted that DOT is the functional equivalent of a period and that punctuation is rarely distinctive. He also stated that the BLOG element describes the subject matter of the services. See Office Action (Oct. 5, 2012). In his Final Office Action, the Examining Attorney also

argued that the mark is merely descriptive because the identification “is broad enough to include the providing of information about websites and blogs within the gTLD .BLOG and providing of information online at websites within the gTLD .BLOG.” See Final Office Action (November 15, 2013). Driven Innovations appealed to the TTAB.

The TTAB upheld the refusal to register the mark. *In re Driven Innovations, Inc.*, 115 U.S.P.Q. 2d 1261 (T.T.A.B. 2015). The TTAB agreed with the Examining Attorney that the mark is merely descriptive because DOT describes the online nature of the services and BLOG describes the subject matter, and also because consumers will perceive the mark “as related to information gleaned from the ‘.blog’ domain,” which ICANN recently delegated. *Id.* at 1267-68.

The Federal Circuit reviewed the TTAB’s decision *de novo* and concluded that the limited evidence in the record did not meet the substantial evidence standard necessary to support a refusal. *In re Driven Innovations, Inc.*, Ser. No. 77073701 (Fed. Cir. Jan. 4, 2017). Specifically, the Court held that some imagination is necessary to connect the term “DOT” to the provision of services on the Internet.[1] *Id.* at 7. The Court went further and concluded that BLOG was also not descriptive because it did not sufficiently describe “how the services rendered relate to blogs.” *Id.* The Court reasoned that BLOG did not “immediately” convey knowledge of a feature of the services. *Id.*

The Court also rejected the TTAB’s logic regarding the public’s association between the mark and the .Blog new generic top-level domain. *Id.* at 7-8. It held that the DOTBLOG mark would merely tell consumers that the services “have some relation to online blogs.” “Mere relation,” the Court reasoned, “does not mean that the mark is descriptive.” *Id.* Again, the court cited the need for an “instantaneous” association between the mark and feature of the service in the minds of consumers. *Id.* at 8.

The Court’s decision, although not precedential, is significant because it reminds us that there is a high threshold for a mark to be held merely descriptive. “Mere relation” between the term and the nature, function, or feature of the goods or services is not enough to justify a descriptiveness refusal. Instead, the descriptive association between the mark and the goods or services must be “instantaneous” and “immediate.” If the consumer has to pause to think, even for a short moment, about what the mark means in relation to the services, the mark is suggestive, not descriptive.

The reasoning in the DOTBLOG case represents a stricter standard than has been applied in some recent TTAB decisions and by some USPTO examining attorneys. For example, this decision can be

contrasted with a 2011 TTAB decision holding that .MUSIC is merely descriptive. *In re theDotCommunications Network LLC*, 101 U.S.P.Q. 2d 1062 (T.T.A.B. 2011). In that case, the applicant applied for the mark in connection with various Internet related services, such as social networking, registration of domain names, online publications, etc. *Id.* at 1062-63. As in the DOTBLOG case, the applicant had no relationship with the registry that had applied for the .musicnew gTLD string. *Id.* at 1066. As an initial matter, the Board in the .MUSIC case noted that consumers would most likely assume that .MUSIC refers to a new gTLD. *Id.* at 1063-67. It then considered the various services that were listed in the applications and noted that owners of gTLD registries provide the types of services listed in the applications. *Id.* at 1067. Accordingly, the Board concluded that consumers would view the .MUSIC mark as descriptive, and not as a source identifier, for the applicant's services. *Id.* at 1067-69.

The relevant facts of the .MUSIC case are nearly identical to those of the DOTBLOG case, and the different outcomes can be explained by the different approaches taken by the TTAB and Federal Circuit. While the TTAB in .MUSIC held that consumers' perceived relationship between the services and the .Music gTLD was sufficient to render the mark merely descriptive, the Federal Circuit explicitly rejected this type of analysis, holding that a mere relationship between the descriptive meaning and the services is not enough to show that consumers would immediately and instantaneously consider the term descriptive. Unfortunately for applicants, the Federal Circuit's decision may not significantly change the way that the TTAB or USPTO analyze potentially descriptive marks. First, the case has been marked as non-precedential, meaning that it has limited authority as applied to future cases. In addition, each mark must be reviewed on its own merits, and the analysis of whether a mark is merely descriptive is often highly fact-specific. That said, the case may lead examining attorneys to gather more evidentiary support for a descriptiveness refusal in the future. In this case, the evidence of record consisted of dictionary definitions for DOT and BLOG and some very limited evidence regarding the existence of a .Blog new gTLD. The TTAB has long held that this type of evidence is sufficient to support a *prima facie* descriptiveness refusal, but it is clear from the Federal Circuit's opinion that the evidence was deficient. It remains to be seen whether the case has a meaningful impact on examination practice or TTAB decisions.

---

[1] It is unclear whether the Court intended to make a pun.

