

## ALERT

### SYNOPSIS OF RECENT TRADEMARK-RELATED DECISION

Posted: January 6, 2017

#### **CAFC FINDS DOTBLOG MARK NOT DESCRIPTIVE OF INFORMATION SERVICES ABOUT BLOGS PROVIDED VIA THE INTERNET**

In a recent decision, the Court of Appeals for the Federal Circuit found DOTBLOG to be suggestive and not descriptive of information services about blogs provided through the Internet.” *In re: Driven Innovations, Inc.*, 2016-1094 (CAFC Jan. 4, 2017) In doing so, the Court found that the fact the term DOTBLOG has some relation to online blogs does not mean it is descriptive because there is no instantaneous mental leap between the word and the services at issue Although the decision was designated “nonprecedential”, the Court’s analysis and finding of suggestiveness under these circumstances could influence and inform future decisions of the Trademark Trial and Appeal Board and the United States Patent and Trademark Office.

Applicant sought to register DOTBLOG for “providing specific information as requested by customers via the internet.” The specimen of use described DOTBLOG as “a service in which we use proprietary search techniques to find relevant and current blog posts relating to any given search query and provide ... a summary report of what those posts are saying”

Both “dot” (as in .com) and “blog” have well understood meanings. Applicant’s services are provided on the Internet and relate to blogs. That was enough for the USPTO to refuse registration on the ground DOTBLOG is merely descriptive. It was enough for the TTAB as well which affirmed the refusal. See *In re Driven Innovations, Inc.*, 115 U.S.P.Q.2d 1261 (T.T.A.B. 2015)

It was not enough for the CAFC.

The CAFC reviewed the factual findings of the Board for substantial evidence and reviewed the Board’s legal conclusions *de novo* treating the Board’s finding that DOTBLOG is merely descriptive as a factual finding that is reviewed for support by substantial evidence.

As the CAFC noted, a term is descriptive if it “immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” A mark is suggestive if it “requires imagination, thought and perception to reach a conclusion as to the nature of the goods.” The line between descriptive and suggestive can be difficult to draw. (Supporting citations omitted) However, “[i]f the mental leap between the word and the product’s attribute *is not almost instantaneous*, this strongly indicates suggestiveness, not direct descriptiveness.” Citing *Nautilus Grp., Inc. v. ICON Health & Fitness, Inc.*, 372 F.3d 1330, 1340 (Fed. Cir. 2004) (Italics Added)

In considering the component words “dot” and “blog”, the CAFC disagreed with the Board and found that neither word immediately describes the nature of Applicant’s services. Instead, “dot” is suggestive because it requires some operation of the imagination to connect the word “dot” to the online nature of Applicant’s services. In short, it requires some thought to connect the dots. Similarly, although the word “blog” may establish some general relation between the services rendered and blogs, it does not describe how the services relate to blogs. As a result, the use of “blog” also is not descriptive because it does not immediately convey knowledge of a feature of the services.

More importantly, in considering DOTBLOG as a whole mark, the CAFC found the definitions of “dot” and “blog” (and the proposed existence of the new .*blog* generic top-level domains) only shows, at most, that

the “mark DOTBLOG likely would have some relation to online blogs.” However, “mere relation” does not mean a mark is descriptive where, as is the case with DOTBLOG, there is no instantaneous mental leap between the word and the services at issue – i.e. using proprietary search techniques to find and provide a summary report of relevant and current blog posts. As the CAFC found, “the lack of this instantaneous mental leap ‘strongly indicates suggestiveness, not direct descriptiveness.’” Citing *Nautilus*, 372 F.3d at 1340.

In addition, the CAFC disagreed with the fundamental reasoning of the Board because it would logically result in the refusal to register any mark that uses the word “blog” for anything that relates to blogs. As the CAFC noted, the USPTO has not employed this type of analysis in past cases, as demonstrated by the various “blog” marks the USPTO has previously allowed.

For these reasons, the CAFC found the refusal to register the DOTBLOG mark on descriptiveness grounds was not supported by substantial evidence. The CAFC concluded the mark is suggestive and reversed the decision of the Board.

The “instantaneous” mental leap test for descriptiveness is not new. However, the application of this test under the circumstances and facts in the DOTBLOG application *may* suggest that it will be somewhat more liberally applied in the future.

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