

Hearing:
January 27, 1999

Paper No. 17
ejs

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

9/28/99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Buckeye Cablevision, Inc.

Serial No. 75/051,769

Donald R. Fraser of MacMillan, Sobanski & Todd for Buckeye
Cablevision, Inc.

Cheryl S. Goodman, Trademark Examining Attorney, Law Office
102 (Thomas Shaw, Managing Attorney)

Before Seeherman, Hairston and Bucher, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

On February 1, 1996 Buckeye Cablevision, Inc. applied
to register, pursuant to the provisions of Section 2(f) of
the Trademark Act, CABLESYSTEM CONTROLLER for "programmable
remote transmitter and receiver for operating a television
receiver."¹ Registration has been refused pursuant to

¹ Application Serial No. 75/051,769, filed February 1, 1996,
asserting first use and first use in commerce on April 1, 1987.

Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive and that its evidence is insufficient to demonstrate that the mark has acquired distinctiveness. In fact, the Examining Attorney has taken the position that the applied-for term is generic for applicant's goods.²

Applicant has appealed. Briefs were filed by applicant and the Examining Attorney, and a reply brief was submitted by applicant. Both applicant and the Examining Attorney appeared at an oral hearing before the Board.

As a preliminary matter, we note that in its brief applicant has argued not only that its mark has acquired distinctiveness, but that it is inherently distinctive. At the oral hearing applicant confirmed that it would like to maintain the position that its mark is inherently distinctive, although it recognized that its prior registration for the same mark for the same goods on the Supplemental Register, (see footnote 2), and the fact that

² Applicant has made of record its ownership of a Supplemental Registration for the same mark for the same goods as identified in the present application. Because an assertion of genericness of this mark for such goods would constitute an attack on applicant's Supplemental Registration, we regard the Examining Attorney's statements in this case as merely indicating her position that the mark is highly descriptive, and therefore requires a significant amount of evidence in order to establish acquired distinctiveness. See **Yamaha International Corp. v. Hoshino Gakki Co. Ltd.**, infra.

the current application was filed claiming registrability on the basis of acquired distinctiveness, were antithetical to a claim of inherent distinctiveness.

Applicant's registration on the Supplemental Register of CABLESYSTEM CONTROLLER for the goods identified herein is a concession that the term is merely descriptive. Similarly, the fact that the present application is made pursuant to Section 2(f) is also an acknowledgment that the term is merely descriptive. See **Yamaha International Corp. v. Hoshino Gakki Co. Ltd.**, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). Accordingly, the issue of whether the mark is merely descriptive or inherently distinctive is not before us in this appeal. In any event, as discussed below, the evidence establishes that applicant's mark is not inherently distinctive.

Applicant has explained that it is the largest provider of cable television service in the northwest Ohio area, and its service area extends into a township in Michigan. Applicant uses its mark CABLEVISION CONTROLLER on hand-held remote units, or remotes, which are used to signal converter units attached to television receivers.

In support of her position that CABLESYSTEM CONTROLLER is merely descriptive of "programmable remote transmitter

Ser. No. 75/051,769

and receiver for operating a television receiver," the Examining Attorney has made of record excerpts taken from the NEXIS data base which show that the term "cable system" is used to refer to cable programming services, guides for such programming, remotes, and receivers. See, for example, the following:

(Check your local cable system guide.)
"The San Diego Union Tribune,"
April 17, 1993

...the Los Angeles Times has aggressively cut deals with cable systems. A cable subscriber, instead of getting the particular cable system's guide, now may find his system-specific listings...
"Chicago Tribune," Sept. 29, 1991

Eliminated ban on changing IR codes for cable system remotes, heeding cable arguments...
"Consumer Electronics," April 15, 1996

Le Groupe Videotron (LGV) will supply its Videoway cable system box and interactive expertise...
"Brandweek," Oct. 18, 1993

In addition, the Examining Attorney has submitted excerpts from articles showing the use of "remote controller as a generic term":

The I-Stat System which includes a portable device about the size of a television remote controller...
"The New York Times," Jan. 28, 1996

Pan Pacific executives still can't figure out why about 100 television remote controllers have been stolen,

since the units don't work with other television sets.

It could be that customers are looking for higher guidance in determining whether taking towels, TV controllers and other items is really...

"The Houston Chronicle," April 10, 1994

With these cable boxes, users will operate their televisions using a remote controller called an "air mouse," ...

"Chicago Tribune," Feb. 13, 1994

Interactive television: TV views "talk back" by manipulating their remote controllers.

"Des Moines Register," Jan. 2, 1994

The evidence clearly demonstrates not only that CABLESYSTEM CONTROLLER is merely descriptive of a "programmable remote transmitter and receiver for operating a television receiver," but that it is highly descriptive. See **Remington Products Inc. v. North American Philips Corp.**, 892 F.2d 1576, 13 USPQ2d 1444 (Fed. Cir. 1990) (TRAVEL CARE merely descriptive or generic of travel personal care products); **DeWalt, Inc. V. Magna Power Tool Corp.**, 289 F.2d 656, 129 USPQ 275 (CCPA 1961) (POWER SHOP merely descriptive of woodworking saws, "power shop" being simply a short form of "power workshop").

As a mark's descriptiveness increases, the amount of proof required to demonstrate acquired distinctiveness likewise increases. **Yamaha International Corp. v. Hoshino**

Ser. No. 75/051,769

Gakki Co., Ltd., supra. Therefore, the burden on applicant to demonstrate that CABLESYSTEM CONTROLLER has acquired distinctiveness for its goods is a heavy one.

The evidence applicant has submitted to support its claim of acquired distinctiveness consists of two declarations, with exhibits, of Thomas K. Dawson, assistant to the president of applicant. He states that applicant is the largest provider of cable television services in the Northwest Ohio region. Applicant renders these services under the marks THE CABLESYSTEM and BUCKEYE CABLESYSTEM. Applicant distributes converter boxes and programmable remote units for customers to use to switch programs and to issue electronic "buy" instructions when ordering pay-per-view. Each remote unit which is distributed in conjunction with a converter box bears the mark CABLESYSTEM CONTROLLER.

Applicant has used the asserted mark CABLESYSTEM CONTROLLER on its remote units since April 1, 1987. Approximately 90,000 customers use such remotes. Mr. Dawson also estimates that 40% of applicant's total advertising expenditures during this period, or more than \$3.4 million, relates to promotion of pay-per-view sales and use of the CABLESYSTEM CONTROLLER remote units.

Mr. Dawson states that applicant has placed advertisements in newspapers, on television, and in

applicant's customer newsletter. However, of the four advertisements applicant has submitted, two, in "TV HOST" and in The CableSystem entertainment guide, do not include the term CABLESYSTEM CONTROLLER at all. The advertisement in the May 6, 1995 Toledo, Ohio "Blade" features the mark The CableSystem for cable program services, and is specifically for a pay-per-view program on IMPULSE. This advertisement states that the program is on "Channel 21A with CableSystem Converter." All references to "CableSystem Controller are in small type, e.g., "Press 'ALT' then 'BUY' on your CableSystem Controller. Order between 8:30pm and 12:00 Midnight," and, at the very bottom of the ad, "You must have a CableSystem Converter to enjoy this event." Applicant's mailer, which is for its Impulse home entertainment services, includes "CableSystem Controller" as part of a list for "what you need to enjoy Impulse Entertainment." The list also includes "CableSystem Converter," CableSystem Impulser (Subscription Dialer)," and "Telephone Connection to Impulser." Finally, Mr. Dawson states that, as part of its listing of program schedules, instructions on the use of the "CABLESYSTEM CONTROLLER remote unit" are given nine times per hour. There is no evidence as to the amount of time any customer would watch such a "station" and thereby be exposed to the

Ser. No. 75/051,769

use of the term. More importantly, applicant has not shown the manner in which the term CABLESYSTEM CONTROLLER is used in connection with instructions on how to use the remote. Thus, we cannot determine whether the term has been promoted in a trademark manner for the remote unit, or has been used merely as part of informational material on how to obtain applicant's cable television pay-per-view services. All in all, based on all the evidence of record, we do not find that the manner in which the words CABLESYSTEM CONTROLLER appear in applicant's advertising materials is sufficient to make a commercial impression upon consumers that CABLESYSTEM CONTROLLER is a trademark identifying the source of the remote controller.

With respect to the use of the asserted mark, Mr. Dawson speculates that if each customer changes channels twice per hour during an average of seven hours of use per day, each customer would have handled the remote control unit 46,000 times over nine years. Leaving aside that there is no support for these assumptions, the fact that a consumer may handle a remote unit bearing the term CABLESYSTEM CONTROLLER is not a sufficient basis to conclude that the consumer would notice the words appearing on the remote, or regard these highly descriptive words as a trademark.

Nor does the cost to applicant to purchase the remotes, or to have its asserted mark silk-screened on them, reflect purchaser perception of the CABLESYSTEM CONTROLLER as an indicator of source of the remotes.

The only evidence applicant has submitted of actual purchaser reaction is a single declaration by Mark I. Jacobs, a subscriber to applicant's cable programming services. This single declaration is insufficient to show that purchasers as a whole regard CABLESYSTEM CONTROLLER as a trademark for the remote units.

Having reviewed all of the evidence, we find that applicant has failed to establish that the highly descriptive term CABLESYSTEM CONTROLLER has acquired distinctiveness as a trademark for its programmable remote transmitter and receiver for operating a television receiver.

Decision: The refusal of registration is affirmed.

E. J. Seeherman

P. T. Hairston

D. E. Bucher
Administrative Trademark Judges
Trademark Trial and Appeal Board