

THIS DECISION IS NOT CITABLE AS
PRECEDENT OF THE TTAB

April 17, 1997

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Penton Publishing, Inc.

Serial No. 74/535,662

Charles R. Rust and Kenneth L. Mitchell of Woodling, Krost &
Rust for applicant.

Lynn A. Luthey, Trademark Examining Attorney, Law Office 106
(Mary I. Sparrow, Managing Attorney).

Before Quinn, Hohein and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Penton Publishing, Inc. has filed a trademark
application to register the mark MECHATRONICS DESIGN for a
"trade magazine directed to engineers and engineering
managers who develop products."¹

The Trademark Examining Attorney has finally refused
registration under Section 2(e)(1) of the Trademark Act, 15

¹ Serial No. 74/535,662, in International Class 16, filed June 10, 1994,
based on a bona fide intention to use the mark in commerce.

U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its goods.

Applicant has appealed. Both the applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

The Examining Attorney contends that MECHATRONICS DESIGN is a term widely used to describe a feature of an engineering specialty, namely the combination of mechanical and electrical engineering design knowledge simultaneously to develop products; and that, since the applicant's goods are magazines directed to engineers and engineering managers who develop products, the mark is merely descriptive of the subject matter of applicant's publication. In support of this contention, the Examining Attorney submitted excerpts from the LEXIS/NEXIS database of articles using the term MECHATRONICS and articles using both of the terms MECHATRONICS and DESIGN. Following are several examples:

. . . coalition has developed multi- or interdisciplinary courses . . . including . . . "Mechatronics," which examines the complex design process that goes into most consumer products . . . [Chemical Engineering, July, 1995].

It's a challenging problem that requires a high degree of mechatronic design . . . [Machine Design, October 10, 1994].

Mechatronics is the integration of mechanical, electronic, and software engineering in product design and manufacturing . . . [Computer Graphics World, February, 1993].

. . . for the design of intelligent systems that make decisions for themselves, where electronics, computers and mechanical engineering have to be integrated for efficient design. Mechatronics embraces these disciplines so they are not separated by traditional boundaries in product development. [*Financial Times*, September 21, 1990].

Additionally, the Board takes judicial notice of the dictionary definition, submitted with the Examining Attorney's brief, of MECHATRONICS as follows:

A technology (originally from Japan) which combines mechanical engineering with electronics, mainly so as to increase automation in manufacturing industries.

Formed by putting together the first two syllables of *mechanics* and the last two of *electronics*.

The word first started to appear in English-language sources in the early eighties in descriptions of Japan's pioneering work in the field. Often *mechatronics* involves developing robots to carry out very precise manufacturing tasks, and this is probably what most people in English-speaking countries think of as mechatronics, especially in relation to car assembly; however, the word can be applied to many different aspects of the manufacturing process...²

Applicant contends that the mark is, at most, suggestive in connection with the recited goods; that MECHATRONICS is not merely descriptive of the recited goods; and that DESIGN has no "particular meaning in relationship to the subject matter or relevant trade or trades [rather] it is believed that the word design is used in a generally

² *The Oxford Dictionary of New Words*, Oxford University Press, 1991.

broad sense without any particular specific meaning.”³
Applicant submitted no additional explanation or evidence.

The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of a product or service. *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

The evidence clearly establishes that MECHATRONICS is a widely used term describing a field of engineering and that it is specifically related to the development, or design, of products and devices pertaining to manufacturing processes. The term DESIGN is repeatedly used in the excerpts of

³ Applicant's response of July 7, 1995, p. 3.

record, in a descriptive manner, in relation to the engineering aspects of product development. There is no evidence in the record which suggests that the combination of these two terms results in a composite mark that has a significance other than the merely descriptive meanings of the two individual terms. Thus, we agree with the Examining Attorney's conclusion that MECHATRONICS DESIGN merely describes the subject matter of a magazine directed to engineers who develop products.

In conclusion, it is our view that, when applied to applicant's goods, the term MECHATRONICS DESIGN immediately describes, without conjecture or speculation, a significant feature or function of applicant's goods, namely, the subject matter of applicant's magazines. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's goods to readily perceive the merely descriptive significance of the term MECHATRONICS DESIGN as it pertains to trade magazines directed to engineers and engineering managers who develop products.

Decision: The refusal under Section 2(e)(1) of the Act is affirmed.

T. J. Quinn

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G. D. Hohein

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board