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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bell & Howell Document Management Products Company

Serial No. 74/166,555

Howard B. Rockman of Welsh & Katz, Ltd. for applicant.

Mary Crawford, Trademark Examining Attorney, Law Office 102
(Mickey Kurzbard, Managing Attorney)

Before Simms, Hanak and Hairston, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Bell & Howell Document Management Products Company
(applicant) seeks registration of IMAGE SEARCH in typed
capital letters for "microfilm computer-assisted document
management and retrieval system, comprising microfilm
camera, microfilm reader/printer, computer record server,
computers, computer monitors, computer printers and system
software, all for the storage, retrieval and management of
documents and information." The application was filed on

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May 13, 1991 with a claimed first use date anywhere and in commerce of March 31, 1987.

The Examining Attorney has refused registration on the basis that the term IMAGE SEARCH is generic. In addition, the Examining Attorney contends that "the evidence submitted [by applicant] to support a showing of [acquired] distinctiveness is ... insufficient even if the term 'image search' is capable of registration." (Examining Attorney's brief page 2).

When the refusal was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs and were present at a hearing before this Board on April 8, 1997.

Applicant and the Examining Attorney agree that there are two issues before this Board. First, is the term IMAGE SEARCH generic for the goods set forth in applicant's application? Second, if the term IMAGE SEARCH is not generic but merely descriptive for said goods, has this term acquired distinctiveness such that it now functions as a trademark to identify applicant's goods and distinguish these goods from the goods of others? (Applicant's brief page 3; Examining Attorney's brief page 2).

It has been repeatedly stated that "determining whether a mark is generic ... involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is

the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?" H. Marvin Ginn v.

International Association of Fire Chiefs, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Of course, in a proceeding such as this, the genus of goods at issue are the goods set forth in the description of goods in the application itself. Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) ("Thus, a proper genericness inquiry focuses on the description of [goods or] services set forth in [the application or] certificate of registration."). The fact that the term IMAGE SEARCH may be generic for goods which are similar to or even closely related to the goods as described in the application does not establish that IMAGE SEARCH is also generic for the latter goods. By way of example, the fact that the term TOUCHLESS was generic for automobile washing equipment did not establish that said term was likewise generic for automobile washing services. Magic Wand, 19 USPQ2d at 1553. Cf. In re The Stroh Brewery Co., 34 USPQ2d 1796, 1797 (TTAB 1995) ("In addition, the fact that a term may be descriptive of certain types of goods does not establish that it is likewise descriptive of other types of goods, even if the goods are closely related.").

Thus, the burden rests with the Examining Attorney to establish that the mark sought to be registered is generic

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for the goods as described in the application. In re Merrill Lynch, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1997). Moreover, it is incumbent upon the Examining Attorney to make a "substantial showing ... that the matter is in fact generic." Merrill Lynch, 4 USPQ2d at 1143. Indeed, this substantial showing "must be based on clear evidence of generic use." Merrill Lynch, 4 USPQ2d at 1143. Thus, it is beyond dispute that "a strong showing is required when the Office seeks to establish that a term is generic." In re K-T Zoe Furniture Inc., 16 F.3d 390, 29 USPQ2d 1787, 1788 (Fed. Cir. 1994). Moreover, any doubt whatsoever on the issue of genericness must be resolved in favor of the applicant. In re Waverly Inc., 27 USPQ2d 1620, 1624 (TTAB 1993).

The record in this case dates to 1991 and is, to say the least, quite massive. In support of her contention that IMAGE SEARCH is generic, the Examining Attorney has made of record a large number of excerpts of articles and a few full text articles taken from the Nexis database. The time period for these excerpts and articles spans from 1983 to 1994. However, most of these excerpts and articles are from the 1990's. There is a small minority of excerpts and articles from the 1980's. This distinction is of importance because with regard to the excerpts and articles from the 1990's, the vast majority of them use the term "image

search" in a descriptive manner to describe a category of systems which, as will be discussed in greater length in a moment, are quite different from applicant's IMAGE SEARCH document management and retrieval system. On the other hand, some of the excerpts and articles from the 1980's use the term "image search" in a descriptive manner to describe systems which apparently are somewhat similar to applicant's system. We use the term "apparently" because even the Examining Attorney, in discussing these 1980's excerpts and articles, has stated that said excerpts and articles concern "systems [which] appear to be of the same genus as the applicant's system." (Examining Attorney's brief page 12, emphasis added). We will begin our analysis with the vast majority of excerpts and articles from the 1990's which use the term "image search" to describe systems which are quite different from applicant's system, and then conclude our analysis by considering the limited number of excerpts and articles from the 1980's which use the term "image search" to describe systems which appear to be somewhat similar to applicant's system.

In reviewing the 1990's evidence, it is clear that "image search" is a descriptive term for a certain type of product. However, the type of product for which the term "image search" is descriptive is not the product described in the application. At a minimum, the Examining Attorney's

1990's evidence simply does not constitute the "substantial showing" (Merill Lynch) or the "strong showing" (K-T Zoe) required to prove that applicant's mark IMAGE SEARCH is a generic term for applicant's goods as described in the application.

As previously noted, applicant's description of goods is as follows: "microfilm computer-assisted document management and retrieval system, comprising microfilm camera, microfilm reader/printer, computer record server, computers, computer monitors, computer printer and system software, all for the storage, retrieval and management of documents and information." Stripping away the recitation of the components and the somewhat redundant final verbiage, applicant's goods are a "microfilm computer-assisted document management and retrieval system."

Applicant has been quite forthright in submitting for the Examining Attorney's inspection large amounts of literature describing applicant's IMAGE SEARCH microfilm computer-assisted document management and retrieval system.¹

¹ The dissent disparagingly accuses the majority of giving "lip service to the principle that the issue of descriptiveness/genericness should be evaluated in terms of the identification [of goods] in the application." Suffice it to say that the identification of goods is a full and accurate description of applicant's actual goods. The identification was carefully considered by the Examining Attorney in Office Action Nos. 1, 2 and 3. In actions 2 and 3, the Examining Attorney had the benefit of being able to review the aforementioned large amounts of product literature forthrightly provided by applicant. Unlike the dissent, the Examining Attorney in her brief never even suggested that the issue of genericness would be decided

Put in simple terms, such a document management and retrieval system works in the following fashion. Documents (i.e. letters, invoices, patient records etc.) are microfilmed. The microfilmed versions of the documents are then indexed according to the guidelines established by applicant's customers, usually with the assistance of applicant. For example, one of applicant's customers may wish to index letters by author, recipient, subject matter and date. This indexing is done with a computer, and the indexed, microfilm version of the document is entered into a computer system. When the microfilm version of the document needs to be retrieved, an image of the document appears on a computer screen. The computer screen could be located in the same building as the main computer containing all of the indexed documents, or it could be located thousands of miles away from the main computer. Moreover, more than one employee of applicant's customer can retrieve or access the same indexed, microfilm document at the same time. Thus, an

differently based upon whether the focus was on applicant's actual goods or on applicant's identification of goods. Indeed, quite to the contrary, the Examining Attorney stated that the relevant "genus of goods includes the 'applicant's goods specifically' as stated in the identification of goods." (Examining Attorney's brief page 8).

In view of the above, it appears that the dissent refuses to adhere to the Board's practice of resolving questions of genericness in applicant's favor. That is to say, given the full and accurate identification of goods, it is hard to fathom how the dissent can be so certain that IMAGE SEARCH is generic with respect to the identification of goods when the dissent concedes

employee in New York could retrieve or access the identical document which is simultaneously being retrieved or accessed by an employee in San Francisco. The vast majority of documents entered into applicant's IMAGE SEARCH system consist of text and not pictures, although some documents do consist of text and simple pictorial representations. However, the key to applicant's IMAGE SEARCH system is the initial indexing. For example, if a letter has been indexed only by author, recipient, subject matter and date, it cannot be later retrieved by searching for copy recipients. Applicant's IMAGE SEARCH document management and retrieval system cannot retrieve all documents mentioning, for example, Mr. Jones somewhere in the bodies of the documents. Rather, said system can only retrieve those documents which were initially indexed under the name Mr. Jones. Likewise, applicant's system is unable to search for all documents containing the pictorial representations of a certain item.

In reviewing the numerous 1990's excerpts and articles from the Nexis database made of record by the Examining Attorney, it appears that the descriptive term "image search" is used to describe various related systems which are simply not the document management and retrieval system described in the application. Because many of the excerpts made of record by the Examining Attorney are very truncated,

that, at a minimum, IMAGE SEARCH "may not be generic with respect

it is difficult to state with certainty the precise nature of the systems for which the term "image search" is descriptive. However, it appears that the descriptive term "image search" is used to describe large photographic libraries which are placed on computers and which can be accessed by multiple customers of the owner of the library. For example, in the December 13, 1993 issue of InfoWorld there appears an article entitled "Kodak Picture Exchange offers browsing of stock photo CDs." The very truncated excerpt of that article reads, in part, as follows: "For \$399, customers receive Kodak's access software and are charged \$1.42 per minute for conducting image searches." An article in the October 1992 issue of Information Today speaks of a company founded by Bill Gates whose "technology makes image searches easier and quicker for the user." Continuing, the article notes that "these developments make possible the creation of vast libraries of visual information. People will be able to access an image on a display screen as easily as they pull a book from a library shelf." The article states that the beneficiaries of such technology would include museums, schools, publishers, businesses and individuals. The article then notes that "individuals may access image databases in their homes as visually oriented tools for learning, discovery and

to applicant's actual [goods]."

entertainment. For example, people could select images of historical or current events to have delivered to them electronically."

Another article discusses a more sophisticated product "still in its infancy that will allow users to search for an image stored in a database, such as a film library, based on the image content," as opposed to searching for images by words or file names. See Network World of April 27, 1992. This more sophisticated system would allow subscribers to the library to search for all pictures containing, for example, the representation of an elephant, as opposed to being limited to word searches where some pictures containing the representation of an elephant were indexed under the word "elephant," and others were not.

The foregoing products described in the 1990's excerpts and articles submitted by the Examining Attorney wherein the words "image search" are used in a descriptive fashion are quite different from applicant's IMAGE SEARCH microfilm computer-assisted document management and retrieval system. There are a number of differences, but two differences stand out. First, the products described in the 1990's excerpts and articles submitted by the Examining Attorneys are libraries available, usually for a fee, to a virtually unlimited number of customers. These libraries described in the Examining Attorney's evidence have pictorial images

which are of interest to a significant number of subscribers. Moreover, there is nothing "confidential" about the images in these libraries. In contrast, applicant's IMAGE SEARCH computer-assisted document management and retrieval system is designed to contain proprietary documents which can only be accessed by employees of the owner of said documents.

Second, the products described in the 1990's excerpts and articles made of record by the Examining Attorney contain pictures, such as famous works of arts, clip art etc. Subscribers to these libraries are truly searching for particular images or pictures. In contrast, the material in applicant's IMAGE SEARCH system consists primarily of documents containing exclusively text. While there is no doubt that documents containing diagrams or other pictures could be placed into applicant's IMAGE SEARCH document management and retrieval system, this does not mean that applicant's system serves as a pictorial library.

We now turn to consider the small minority of excerpts and articles submitted by the Examining Attorney from the 1980's. As previously noted, some of these excerpts and articles use the term "image search" to describe products which appear to be similar to applicant's IMAGE SEARCH document management and retrieval system. One such article is from the February 1985 issue of Modern Office Technology.

The title of the article is "A Marriage Made in Charleston; Electronic filing at Union Carbide," and the article reads, in part, as follows: "Electronic filing ... is at the heart of the new accounts payable information management system at Union Carbide's sprawling South Charleston, West Virginia, complex. Computer terminals throughout the facility and in locations as far away as Louisiana and New Jersey are now used as remote request terminals for finding and retrieving documents stored on microfilm. The system lets Union Carbide capitalize on microfilm's ability to store virtually unlimited quantities of information ... while tapping an IBM 370 computer's power to index, sort, and search. ... The relatively new filing system replaces a less sophisticated microfilm system. The old system required those who wanted paper copies of stored data to fill out forms, or go to retrieval centers for document image searches." Obviously, the product described in this February 1985 article, as well as a few other products described in some of the other articles from the 1980's, appear to be similar to applicant's IMAGE SEARCH document management and retrieval system. However, in none of these excerpts or articles from the 1980's is the term "image search" used as a generic term for the name of any product. Rather, the term "image search" is used simply to describe one aspect of these products. Indeed, in reviewing this February 1985 article,

it appears that if there is any generic term for the product discussed, said generic term is "electronic filing."

Thus, while some of the excerpts and articles from the 1980's (which represent a small minority of the Examining Attorney's evidence) discuss products which appear to be similar to applicant's system, the important point to remember is that when the term "image search" is used, it is used not as the generic name for a product. Rather, it is used simply to describe an aspect of the products.

Moreover, the issue before this Board "is whether [IMAGE SEARCH] is now the common descriptive or generic name for applicant's" document management and retrieval system. In re Montrachet, 878 F.2d 375, 11 USPQ2d 1393, 1394 (Fed. Cir. 1989) (emphasis added). Even if some of these 1980's excerpts and articles had used the term "image search" as the generic name for a product similar to applicant's system (which they did not), the 1980's excerpts and articles would not be sufficient to prove that applicant's mark IMAGE SEARCH is currently the generic name for applicant's system, especially in light of the fact that the vast majority of the excerpts and articles submitted by the Examining Attorney (i.e. those from the 1990's) now use the term "image search" to describe a function of products which are totally different from applicant's IMAGE SEARCH document management and retrieval system.

Having determined that the Examining Attorney has simply not made the "substantial showing" or "strong showing" required to prove that IMAGE SEARCH is now the generic term for the goods identified in applicant's application, or indeed is the generic term for any goods, we will now consider whether or not applicant has established that the descriptive term IMAGE SEARCH has become distinctive of its goods pursuant to Section 2(f) of the Lanham Trademark Act. In support of its claim of acquired distinctiveness, applicant relies upon the fact that not only has it made continuous use since March 1987 of its mark IMAGE SEARCH on computer-assisted document management and retrieval systems, but in addition upon the fact that it has used this same mark since 1981 on microfilm reader/printers. Moreover, applicant submitted the October 9, 1992 declaration of Larry Turner, its product manager for its IMAGE SEARCH products. Mr. Turner declared that not only had applicant sold as of June 30, 1992 over \$9.2 million worth of IMAGE SEARCH document management and retrieval systems, but in addition, applicant had sold since 1981 over \$8.3 million worth of IMAGE SEARCH microfilm reader/printers. Furthermore, Mr. Turner declared that applicant's IMAGE SEARCH products are not products which are sold to ordinary consumers, but rather are products which are sold to a relatively limited number of institutions

which have the need to manage large amounts of documents. These institutions would include the U.S. Department of Defense, local police departments, banks and hospitals. Thus, applicant argues that its sales figures are quite substantial given the limited customer base for its IMAGE SEARCH products.

In addition, applicant also relies upon the numerous brochures, owner manuals and advertisements for its IMAGE SEARCH products which were discussed earlier in this opinion as further proof that IMAGE SEARCH has acquired distinctiveness among this rather narrow customer base. Moreover, applicant has made of record a number of articles from technical and professional journals which discuss applicant's IMAGE SEARCH computer-assisted document management and retrieval system.

Finally, applicant has submitted three additional declarations. One of these declarations is from an employee of a large hospital which utilizes applicant's IMAGE SEARCH document management and retrieval system. The other two declarations are from managers of two different companies which distribute document management systems. All three individuals state that they, and to the best of their knowledge, the individuals that they deal with, recognize IMAGE SEARCH as a trademark of applicant. Furthermore, the declaration of one of the two distributors (Gene Erfeldt)

further confirms applicant's assertion that the customer base for applicant's IMAGE SEARCH document management and retrieval system is quite limited. Mr. Erfeldt states, in part, as follows: "[Applicant's] IMAGE SEARCH systems are considered to be high end price range products and are sold to a limited community of consumers. When I meet with customers it has been my experience that among this class of consumers who are in the market for computer-assisted document management systems, the trademark IMAGE SEARCH is recognized as designating a computer-assisted document management system originating with one source - [applicant]."

In view of the foregoing, we find that applicant has demonstrated that its mark IMAGE SEARCH has acquired distinctiveness pursuant to Section 2(f) as indicating computer-assisted document management and retrieval systems originating from one source, namely, applicant.

Decision: The refusal to register is reversed.

E. W. Hanak

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

Simms, Administrative Trademark Judge, dissenting:

I dissent from the decision of the majority finding that the term IMAGE SEARCH is registrable on the Principal Register. Essentially, while I agree with the majority that the term sought to be registered may not be generic with respect to applicant's actual document management and retrieval systems, these words are generic because they identify a genus or type of document management and retrieval system covered by the identification of goods in the application.

The record shows that applicant makes and sells two systems--IMAGE SEARCH 2000 and IMAGE SEARCH PLUS 2000, the latter system being an optical computer-assisted document management and retrieval system. When using this system, documents are scanned and the images are stored on an optical disk.

The Image Search Plus system can scan 8-½" x 11" documents in less than three seconds and store the image on optical disk as you create a computerized document index. Any document image and index can be displayed in seconds on the high resolution monitor. (Exhibit L)

As documents arrive you'll be able to scan, digitize, distribute and store them by a hard copy, floppy disk, streaming tape, optical disk or by cable to remote displays.

Entire files, single documents or high quality data can then be easily located with multiple cross references, retrieved in seconds and displayed on your system's monitor in the highest resolution available.

Image Search Plus completely automates this primary data base, integrating document handling into your existing office scheme. It's a user-friendly system consisting of the industry's top-rated software, PC-AT's and digital scanners that let you store and retrieve an actual image of a document. When you need to see it, simply punch it up and read it in your monitor... (Exhibit E)

However, unlike other systems discussed below, applicant's system uses various edit codes, field descriptors and other search/retrieval options for data entry and retrieval. That is, documents are entered and retrieved by entering information about them and then searching or retrieving that information, which will then result in the retrieval of the document from a particular location in the system. Applicant's systems include microfilm or scanning equipment for converting the documents to be stored to machine-readable bit-mapped code. This code is then stored on computer or optical disks. The documents can then be retrieved, sorted or otherwise manipulated. Applicant's brief, filed August 23, 1994, 7. Applicant's goods are sold to schools, hospitals, police departments and municipalities.

As noted above, while I agree with the majority that the term IMAGE SEARCH may not be generic for applicant's actual goods (because applicant's goods appear not to be able to conduct "image searches" per se), I believe that the majority has failed to analyze the issue of

descriptiveness/genericness with respect to the goods as identified in the application--"microfilm computer-assisted document management and retrieval system, comprising microfilm camera, microfilm reader/printer, computer record server, computers, computer monitors, computer printers and system software, all for the storage, retrieval and management of documents and information." See, for example, *Magic Wand, Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) (In a cancellation proceeding, "a proper genericness inquiry focuses on the description of services set forth in the certificate of registration"); *In re Vehicle Information Network Inc.*, 32 USPQ2d 1542, 1544 (TTAB 1994) (" In any event, the question of registrability must be determined, in proceedings before the Board, on the basis of the goods or services as set forth in the application, rather than in reference to the precise nature of the goods or services on or in connection with which the mark is actually used or intended to be used"); and *In re Cryomedical Sciences Inc.*, 32 USPQ2d 1377, 1379 (TTAB 1994) ("Although we appreciate the exact nature of the disposable probes has yet to be determined, the identification of goods, as listed in the application, is broad enough to include all types of disposable cryosurgical probes, including those containing electronic devices or microprocessors"). When analyzed in this light, I believe

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this record is clear that the term "image search" is generic for a type or category of document management and retrieval system encompassed by the identification of goods. While there is some discussion in the briefs as to the appropriate "genus" of goods, even applicant's counsel states that he believes that the relevant genus is "document management systems" or "computer-assisted document management systems." See applicant's brief, filed August 23, 1994, 7, and Response, filed January 12, 1995.

The majority has given lip service to the principle that the issue of descriptiveness/genericness should be evaluated in terms of the identification in the application. However, while professing to so analyze the issue, the majority has deviated from this principle and instead focused on applicant's actual products. See, for example, the discussion on pages 7, 8 and 10, as to why there are differences between some of the systems discussed in the articles of record and applicant's actual goods, not the more broadly identified microfilm document management and retrieval systems set forth in the application.

The majority seems not even to find this term merely descriptive of the goods listed in the application ("...the type of product for which the term 'image search' is descriptive is not the product described in the application", "...it appears that the descriptive term 'image

search' is used to describe various related systems which are simply not the document management and retrieval system described in the application" and "...the vast majority of the excerpts and articles...now use the term 'image search' to describe a function of products which are totally different from applicant's IMAGE SEARCH document management and retrieval system"), a fact which applicant conceded at the oral hearing, and admitted by virtue of its claim of acquired distinctiveness (and no alternative argument that its mark is inherently distinctive), as well as perhaps by applicant's alternative amendment (not mentioned by the majority) that its mark should be considered for registration on the Supplemental Register if the Board finds it to be unregistrable under Section 2(f) of the Act.

Turning then to the evidence of record, the following excerpts made of record by the Examining Attorney are noteworthy:

Through the end of this month, PNI is offering the Seymour client software for \$175, which includes three hours of on-line time. The next seven hours are \$1.25 per minute; after that, it is \$1.50 per minute. PNI said an average image search costs about \$20. Until Oct. 31 downloading images is free...

MacWeek, October 3, 1994

More than a stock image disc, Questock contains 4,500 images; Kodak's Browser Software; and Questock, a unique image search system.

Thousands of high-resolution photographs, computer graphics and illustrations are presented in categories such as agriculture, backgrounds, children, icons, illustrations, maps, people, textures and more.

T H E Journal (Technological Horizons In Education), August 1994

Also on display was Eastman Kodak's online location image search network, which provides film and commercial production companies with quick access to thousands of still images and pertinent information about those locations.

SHOOT, June 24, 1994

"Database size is about to go up by three orders of magnitude as users add complex data such as images," said Michael Stonebraker, cofounder and chief technology officer of Montage Software, Inc. in Oakland, Calif., which sells a combined object-relational database server and tools.

Montage, a product with image search capabilities similar to Visualizer, is priced starting at \$995. It currently runs on Unix...

InfoWorld, May 30, 1994

...the Automated Patent System (APS) consists of two major components: the Search and Retrieval system and the Patent Application Management System. The Search and Retrieval component of the Automated Patent System enables examiners to review text from data bases containing U.S. patent documents using "word" searches and enables examiners to retrieve digital images of domestic and foreign patent documents by technological classification. The implementation of the text and image search systems has greatly improved the quality of the patents we issue. This is due to the fact that the

text and image search systems obviate the problem of file integrity by ensuring that all references all available to the patent examiners when they are conducting their searches.

Congressional Testimony of Bruce A. Lehman, Assistant Secretary of Commerce, Federal Document Clearing House, March 9, 1994

On a sobering note, Gordon Kerr, senior vice president of MIS at Hyatt Hotels Corp., said massively parallel systems from Pyramid and other vendors could benefit users with intensive data and image search demands, such as insurance companies, retailers, or credit reporting agencies.

Computerworld, November 15, 1993

Users that intend to implement the Novell software should be aware they need more than just back-end imaging services to get an imaging system up and running. They will also need the front-end applications that provide the user interface, image search and retrieval facilities, and a range of other features.

Network World, November 15, 1993

Core Software Technology and Digital will provide an on-line satellite images search and visual preview service, called Image Net..

Digital News & Review, August 9, 1993

Image search

Searching for images in Cumulus is easy and very fast. The Find dialog contains pop-up menus from which you choose items that determine the nature of your search. One menu lists a range of classifications, such as keyword, file type, image resolution and

even words you have placed in the Notes field...

MacWeek, July 6, 1993

The Mac may have text retrieval programs aplenty, but what if you are trying to find a particular set of pixels in a database of images? General Image has the answer - Full Pixel Search, an image searching program that allows users to search for similar regions within a database of 8-bit TIFF or PICT images on Apple Computer's Macintosh.

Newsbytes News Network, April 26, 1993

Applications using technologies such as unstructured data (document image), EDM, voice, text-image search by content, and knowledge bases will dramatically benefit from the processing power of the Alpha AXP architecture. For instance, the paper mountains of insurance companies can be scanned into EDM servers to reduce search times from days to seconds.

Digital News & Review, March 15, 1993

...The Picture Network system uses technology developed by Systems Research and Applications Corp., which also has invested in Picture Network; Tribune has licensed Systems Research's image search-and-retrieval technology to manage its editorial photo library and to develop and market similar systems for the newspaper industry.

Chicago Tribune, March 2, 1993

Letraset also plans a CD-ROM containing 72-dpi versions of all the Phototone images, image search and browsing software, and screen fonts. No price has been set for the disc, which is slated for release in March.

MacWeek, February 22, 1993

The control program provides point and click access to the following functions:

- image search (based upon demographic parameters of genus, species, sex, age, geographical location, etc.)...
T H E Journal (Technological Horizons In Education), February 1993

Software used to search Kodak Picture Exchange mirrors the look and feel of Kodak Shoebox image search and retrieval software. In other words, it will share a common interface with other Photo CD image databases.
CD-ROM World, January 1993

Caere has inked technology alliances with Alcom Corp., Delrina Technology Inc. and Bit Software Inc. to grow the network fax market, officials said. It also sells OCR conversion software, document image search and retrieval software, and scanning software.
PC Week, December 7, 1992

Digital communication networks make it possible to quickly share these vast amounts of visual information. Unlike physical files, which place images in rigid categories and locations, digital files can be stored, grouped, and viewed according to multiple criteria. The flexibility provided by this technology makes image searches easier and quicker for the user...
Information Today, October 1992

The ConnX for Windows offers Microsoft Windows users direct access information in workgroups that cross various platforms

using the XSoft Document Services, while DSR can conduct text and image searches in GlobalView and non-GlobalView files. OPEN OSI Product & Equipment News, September 24, 1992

Cotton Inc., a leading advocate and re-search firm for the cotton industry, has picked Retrieval Technologies, Inc.'s re:Search Full Text and Image Retrieval software to manage its textile information, both in the United States and Europe.

Based in Cambridge, Retrieval Technologies, dubbed reTech, specializes in information management systems. Its product, re:Search, is a PC-based full text and image search and retrieval program for use with CD-ROM and magnetic media applications. Re:Search lets users build his or her own personalized library from scannable materials such as reports, manuals, memos, letters, transcriptions, and books, or from on-line information downloaded from word processing programs of information services. MASS HIGH TECH, February 11, 1991

With Open/image, Wang's goal is to provide universal access to its imaging services and help customers automate business processes across workgroups, departments, and the entire enterprise.

Enhancements to Wang's Open/image-Windows 3.0 include support for Windows 3.0, the ability to query by keyword during image searches, image caching to speed up image retrieval and display, and integration with a wide selection of higher-speed document scanners, according to the company. LAN Times, February 4, 1991

Company officials said Topic represents the next generation in document retrieval systems, offering end users the most comprehensive text and image search and retrieval capabilities

available today. Topic is based on concept retrieval technology, an easy-to-use method that uses a knowledge base of topics.

Government Computer News, May 14, 1990

Current top image management system vendors include IBM; Kodak of Rochester, N.Y.; Laserdata of Lowell, Mass.; Plexus of San Jose, Calif.; and FileNet of Costa Mesa, Calif.

Image management adherents point to the obvious advantages of combining text and image searches in one system. The technology could be useful, for example, in calling up photographs in a personnel system search, X-ray records with a medical history, or photos of an auto accident with an insurance claim, they say.

Digital Review, January 9, 1989

Versions of the product to be released later this year will be capable of storing and retrieving graphic images as well as text, said James Geer, president of Executive Technologies. "With costs declining not only for disk storage but also for input devices such as optical scanners, ther [sic] will be increasing demand for full-text and image search/retrieval products like ours," he said.

InfoWorld, April 20, 1987

The system features two Kodak IMT-150 micro-image terminals linked to the mainframe computer. The relatively new filing system replaces a less sophisticated microfilm system. The old system required those who wanted paper copies of stored data to fill out forms, or go to retrieval centers for document image searches... The new system eliminates that, as well as the need to sort incoming documents by purchase order sequence or other category before microfilming.

Eliminating time-consuming sorting and retrieval request procedures was a top priority of the first phase of Union Carbide's transition program. But savings don't stop there. Streamlined operations boosted productivity in the divisional offices...

Modern Office Technology, February 1985

It is applicant's position that many articles relied upon by the Examining Attorney use the term IMAGE SEARCH to refer to a function of different types of computer systems. These articles, according to applicant, may show only that these words are descriptive of one function of a computer-assisted product, but they do not prove that this term is generic for applicant's goods

The Examiner's evidence shows that "image search" is sometimes used to describe an internal function of a computer or to describe certain functions of some computer software. When a user wishes to retrieve a document, the computer carries out what could be called an "image search" to locate the document. However, the Examining attorney has offered no evidence to show that "image search" is ever used by consumers of document management systems, or people in the relevant industry, to generically refer to document management systems...

At most, "image search" is a technical term which may refer to an internal function of a computer. Data can be said to be stored as images, and during retrieval of the data the computer searches for the proper image. It appears that the performance of a [sic] "image search" is useful in many different contexts and for many different purposes. However conducting a [sic] "image search" is merely incidental to the operation of the computer's function.

The Examiner has not offered sufficient evidence to show that consumers primarily refer to computers generally, or to Applicant's goods specially as "image searchers". IMAGE SEARCH is not a term

commonly used by the consumers or users of Applicant's goods. In fact, it is arguable whether most users of Applicant's product would even know that the computer could be considered to be conducting an "image search."

Applicant's brief, filed August 23, 1994, 7-8, 11.

If a designation is understood by the relevant public to refer to a genus or a class or category of goods, the term is considered generic. *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). In this regard, evidence of the public's understanding may be obtained from such competent sources as newspapers, magazines, trade journals, etc. I agree with the Examining Attorney that this record, by a clear preponderance of the evidence, demonstrates that the term "image search" has been used in relevant sources as a generic term for a type of document management and retrieval system used for obtaining stored data in a database. I conclude, therefore, that the relevant public has come to identify the term sought to be registered with a particular type of product--a computer-operated document and retrieval system.

Suffice it to say that I do not discern the distinction the majority strains to make between the type of systems discussed in the articles from the 1980s and the '90s. Aside from the fact that applicant does not assert this alleged difference, I simply do not believe it to be the

case. Rather, as most of the excerpts above demonstrate (mostly from the '90s, which the majority says reveal products more dissimilar to applicant's than the articles from the '80s), there were document management and retrieval systems discussed in both decades which conducted image searches, although it is undoubtedly true that, as technology advanced, image searching became more sophisticated. Nevertheless, the term "image search" appears in both decades used in the context of document management and retrieval systems similar to applicant's. If there is any difference in the systems discussed in the record, it is probably because this technology can be used in more than one environment. A document management and retrieval system may include a private database set up as an internal network for a business for the storage and retrieval of documents, and it appears that it may also include what the majority characterizes as "libraries", a commercial database open to others, and to which one normally subscribes, but by which one may access "documents" or "images" placed on the system by another. However, in both cases the term is used in a similar manner in the materials of record--to identify a type of system that conducts image searches. Indeed, some of the references even refer to "image search and retrieval" systems. It is clearly a term that should be freely available to

competitors to describe generically their systems, a freedom which, in my opinion, is jeopardized by the majority's allowance of registration to applicant.

In view of the highly descriptive, and I believe generic, nature of the term sought to be registered, I do not believe that applicant has demonstrated that the term sought to be registered is now associated exclusively with its goods. In my view, the primary significance of the term in the minds of the consuming public is a type or category of product and not applicant's trademark. Of course, the more descriptive an asserted mark, the heavier the burden on the applicant to demonstrate acquired distinctiveness. In *re Seaman & Associates, Inc.*, 1 USPQ2d 1657 (TABB 1986).

With respect to some of the evidence recited in applicant's claim of acquired distinctiveness, sales of a product, as we have recognized in the past, may be an indication of the popularity of the goods and not necessarily a recognition by the public of the trademark status of the alleged mark under which the goods are sold. Applicant and the majority have relied on applicant's sales and promotion of its mark. However, applicant's own product literature uses the term in an ambiguous manner (see below), it not being clear whether the term is being used descriptively (or generically) or as a trademark.

I do not believe, therefore, that great weight should be placed on this evidence. Finally, the widespread use by competitors and others in the industry heavily detracts from applicant's claim that the asserted mark identifies its

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goods and its goods alone. *Genesco, Inc. v. Levi Strauss & Co.*, 742 F.2d 1401, 222 USPQ 939, 940-41 (Fed. Cir. 1984) ("When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.").

A final point--registration to applicant herein, I believe, substantially interferes with the right of competitors and others to use this term in the generic manner in which it is now understood in the trade. For example, if a competitor were to use, say, KODAK IMAGE SEARCH, in connection with a document management and retrieval system using image search technology, and if that competitor were to seek registration of its mark, with "IMAGE SEARCH" disclaimed, there is a real probability that the Examining Attorney will refuse registration on the basis of a registration which may issue to applicant herein.

R. L. Simms
Administrative Trademark Judge
Trademark Trial and Appeal Board