

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE
TTAB

9/28/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re DJS Associates, Inc.

Serial Nos. 74/265,139;
74/802,305; and 75/975,964

Charles N. Quinn of Dann, Dorfman, Herrell and Skillman,
P.C. for applicant.

Steven Fine, Trademark Examining Attorney, Law Office 107
(Thomas Lamone, Managing Attorney).

Before Cissel, Hairston and Wendel, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

DJS Associates, Inc. has filed applications to
register the mark FORENSIC ENGINEERING SERVICES for
"accident investigations; and expert witnesses respecting
highway, traffic and transportation safety" (Serial No.
74/265,139), for "highway safety testing and consultation;

traffic and transportation engineering services" (Serial No. 74/802,305) and for "providing seminars and lectures in the field of highway, traffic and transportation safety" (Serial No. 75/975,964).¹

Registration has been finally refused on the grounds that the matter sought to registered is generic and thus incapable of registration under Section 2(f), 15 U.S.C. § 1052(f), of the Trademark Act.²

¹ All of the services were initially set forth in S.N. 74/265,139 and the final refusal was issued with respect to all. After filing an appeal, applicant requested first one and then a second division, resulting in the two "child" applications, S.N. 74/802,305 and S.N. 75/975,964. Applicant also submitted two declarations under Section 2(f), which together covered all the services, and a disclaimer of the term "Services" with respect to the services specified in S.N. 75/975,964. In each instance, the application was remanded to the Examining Attorney for reconsideration, but the refusal was continued. Inasmuch as the applications involve common issues of law and fact, the cases have been consolidated and we consider the appeal, which in fact is directed to all three applications, in this one opinion.

² While the Examining Attorney has set forth the refusal in his brief in terms of Sections 1, 2, and 45 of the Trademark Act, in the final refusal, and the continuations thereof, he followed the alternative approach to genericness, namely, that FORENSIC ENGINEERING SERVICES is the ultimate in descriptiveness, as the name of the services, under Section 2(e)(1), 15 U.S.C. § 1052(e)(1), and thus incapable of acquiring distinctiveness under Section 2(f), 15 U.S.C. § 1052(f). We have chosen to take the latter approach, although the factual analysis is the same for either. See *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

Applicant and the Examining Attorney have filed briefs,³ but no oral hearing was requested.⁴

The Examining Attorney initially supported his refusal to register applicant's mark on the basis of genericness with a sampling of twenty-five of the seventy articles found on the Nexis database referring to "forensic engineering." The articles illustrate specific services encompassed by "forensic engineering," such as the investigation of building collapses, water line ruptures, automobile defects, and bridge collapses, as well as describe "forensic engineering" in more general terms, such as "failure analysis in automobile accidents, fires and explosions, structural evaluations and blasting-related problems." (The Kansas City Star, Aug. 25, 1992). In the

³ In view of their untimely submission, no consideration has been given to the third-party registrations and application introduced by the Examining Attorney in his appeal brief. Trademark Rule 2.142(d).

⁴ In view of the remands to the Examining Attorney, as well as confusion as to the date for filing the brief, applicant has filed three briefs, all of which have been taken under consideration. While the Board agrees with applicant that the last action issued by the Examining Attorney should have indicated that the services under consideration were at that point the subject of S. N. 75/975,964 and not 74/802,305, we see no basis for the argument that this action should have issued as a first action in the newly created divisional application. Both divisional applications were created, at applicant's request, after the issuance of a final refusal of the parent application, and thus registration of applicant's mark for all of the services, regardless of their later division to separate applications, had been finally refused.

first continuation of the final refusal, the Examining Attorney supplemented his evidence with additional excerpts from the Nexis database, one of which specifically describes the use of analysis by forensic engineers as the basis for recommendations to "enhance safety on highways." (Canadian Occupational Health & Safety News, May 29, 1995). Another article speaks of the appearance of forensic engineers as "expert witnesses in court trials to explain technical issues and offer explanations, based on sound scientific investigation... ." (Evansville Business Journal, July 1994). In the second continuation of the final refusal, the Examining Attorney added the definition for "forensic engineering" found in the McGraw-Hill Dictionary of Scientific and Technical Terms (3rd Ed. 1983), i.e., "the application of accepted engineering practices and principles for discussion, debate, argumentative or legal purposes."

In addition to this extrinsic evidence, the Examining Attorney has based his arguments upon the specimen of record in the parent application, which consists of a brochure promoting the FORENSIC ENGINEERING SERVICES division of applicant, whose services are listed as "Engineering Analysis in: Accident Reconstruction, Highway Safety, and Traffic & Transportation" along with

"Investigations," "Expert Testimony" and "Seminars & Lectures."

The Examining Attorney maintains that the evidence establishes that the term "forensic engineering" is a generic or common descriptive term for a class of services and that applicant's services fall within the class. While noting that the most well-known aspect of "forensic engineering" is accident investigation, the Examining Attorney points to the dictionary definition to show that the full range of "forensic engineering," includes any service "that logically bridges the engineering and legal argument/policy debate fields." (Examiner's Brief, p.3). Thus, he argues that applicant's performance of engineering analysis in preparation for public discussion, as well as for legal purposes, lies within the realm of "forensic engineering." Insofar as applicant's seminars and lectures are concerned, the Examining Attorney takes the position that "Forensic Engineering Services" is generic for the subject matter of these seminars and, thus, generic for the service of providing the seminars.

Applicant has raised two major arguments with respect to the refusal in general. In the first place, applicant contends that the Examining Attorney has failed to produce any evidence whatsoever of the use of FORENSIC ENGINEERING

SERVICES in any form, much less as a generic term. Second, applicant argues that there has been no showing that the term is being used in a generic context when used in connection with applicant's services. With respect to the seminars and lectures in particular, applicant argues that the service of providing seminars does not fall within the scope of "forensic engineering" and furthermore, that there is no indication in applicant's identification of these services that the subject matter of these seminars is "forensic engineering," as described in the dictionary definition made of record by the Examining Attorney.

As set forth by our primary reviewing court in *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986), a generic term is the common descriptive name of a class of goods or services. The critical issue in determining whether a term is generic is whether the members of the relevant public primarily use or understand the term sought to be registered to refer to the genus of goods or services in question. The Court set out the following two-step inquiry to be used in determining whether a term is generic:

- (1) What is the genus of goods or services at issue, and

- 2) Is the term sought to be registered primarily understood by the relevant public to refer to that genus of goods or services.

Here the engineering services involved are directed to not only accident investigations, highway safety testing and consultation, and expert witnesses respecting highway, traffic and transportation safety, but also to traffic and transportation engineering services. We believe that all these services may be construed as engineering services and analysis as applied to the field of highway or traffic safety for purposes of consultation or providing expert witnesses.

The term sought to be registered is FORENSIC ENGINEERING SERVICES. While applicant places great emphasis on the presence of the word SERVICES in the term, and the absence of the word in the evidence relied upon by the Examining Attorney, we find no merit to this argument. The word "Services" is unequivocally generic for any service, and has no source-indicating significance whatsoever. Cf. *In re Failure Analysis Associates*, 1 USPQ2d 1144 (TTAB 1986) [while "Failure Analysis" is no more than name of services offered, word "Associates" is sufficient to render FAILURE ANALYSIS ASSOCIATES capable of distinguishing applicant's services from those of others, since no evidence that consumers would use term

"Associates" to refer to category of services rendered]. Thus, our inquiry is restricted to whether the relevant public would primarily consider the services being offered by applicant to fall within the genus defined by the term "Forensic Engineering."

We find this to be the case. It is patently evident from applicant's brochure that the engineering analyses which are performed by applicant are investigations in the areas of highway and traffic safety for "discussion, debate, argumentative or legal purposes" and accordingly, fall within the broad definition of "forensic engineering." Furthermore, from the Nexis database evidence made of record, we find that "forensic engineering" would be readily recognized by the public as an area of engineering directed to failure analysis, whether in connection with a bridge collapse or an automobile accident, for either legal or public policy purposes. Applicant's use of FORENSIC ENGINEERING SERVICES in connection with its engineering services and analyses in the area of highway or traffic safety would simply convey the information that applicant's services are in this general area of engineering, so the term is not capable of acting as an indication of source for applicant alone. See *In re Gould Paper Corp*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987).

Turning to the seminars and lectures being offered by applicant, we find no reason to believe that these seminars are intended for any other purpose than to educate persons with respect to the application of engineering analysis to highway and traffic safety. Thus, the subject matter would fall within the general realm of "forensic engineering." Accordingly, use of FORENSIC ENGINEERING SERVICES in connection with these seminars would simply indicate the topic to be discussed, rather than the source of the seminars. See *In re Harcourt Brace Jovanovich, Inc.*, 222 USPQ 820 (TTAB 1984).

In summary, we find that FORENSIC ENGINEERING SERVICES is generic for the services listed in each of the applications and incapable of distinguishing applicant's identified services from like services of others. Furthermore, even if the term were not considered generic, we agree with the Examining Attorney that the evidence produced by applicant is insufficient to establish acquired distinctiveness. The declarations of use of the term for a period of ten years are inadequate to prove that the term has acquired secondary meaning as an indicator of source to the relevant public.

Ser No. 265139

Decision: The refusal to register is affirmed.

R. F. Cissel

P. T. Hairston

H. R. Wendel
Trademark Administrative Judges,
Trademark Trial and Appeal Board