

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 9/18/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Platinum Technology, Inc.

Serial No. 74/529,796

Martin R. Greenstein of TechMark for applicant.

Cynthia H. Mancini, Trademark Examining Attorney, Law
Office 109 (Deborah S. Cohen, Managing Attorney).

Before Hanak, Quinn and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Platinum Technology, Inc. has filed an application to register the mark PLATINUM INTEGRATOR for "computer software for use in database design, implementation, administration and management; database query and reporting, and for programming and application development, and instruction manuals sold as a unit therewith."¹

¹ Ser. No. 74/529,796, filed May 26, 1994, based on a bona fide intent-to-use. An amendment to allege use was filed July 25, 1994, alleging dates of first use of June 30, 1994.

Registration has been finally refused on the ground that the term INTEGRATOR is merely descriptive, under Section 2(e)(1) of the Trademark Act, of a purpose, function, feature or characteristic of applicant's computer software and therefore must be disclaimed pursuant to Section 6(a) of the Trademark Act.

Applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

The Examining Attorney takes the position that applicant's software combines several distinct functions, namely the functions listed in the identification of goods, into one program. Thus, in the Examining Attorney's view, the software "integrates" or serves as an "integrator" of these functions. The Examining Attorney refers to applicant's advertisement, which was submitted during prosecution, as evidence of the functioning of the software to "integrate" independent elements of a computer system. In particular, the Examining Attorney relies upon the statements that

PLATINUM Integrator can access data regardless of the data's residence: IMS, CICS, DB2®, or any other application on single or multiple subsystems. PLATINUM Integrator processes through legacy applications so there's no need to re-engineer them.

The Examining Attorney also refers to a news release obtained from the Nexis database with respect to applicant's product which describes the software as

"... a new development tool that lets PC-based programs access mainframe applications using the Structured Query Language..." and "...uses SQL to tie desktop and mainframe applications together."
(*CommunicationsWeek*, August 29, 1994).

In further support of her position, the Examining Attorney has submitted both general dictionary definitions of "integrate" and "integrator", as well as computer dictionary definitions of "integrator" and "integrated software". In addition, the Examining Attorney has made of record Nexis database articles which describe other software products utilizing the term "Integrator", namely, the Database Integrator of Digital Equipment Corporation, a "multi-database management product" (*Networks Update*, August 1994) and the DB Integrator of DEC which "enables users to access data on a variety of different systems using Structured Query Language commands." (*Computergram International*, February 15, 1994). Other articles were introduced showing varied uses of the term "integrator", including references to persons and companies who serve as "integrators" or "systems integrators" for computer software products and to software products which act as "data integrators".

Applicant argues that none of the dictionary definitions introduced by the Examining Attorney are related to the functions of applicant's software product. Applicant further argues that there is nothing in its literature or the identification of goods which suggests that INTEGRATOR describes any of the features of its software.² Applicant contends that to go through the steps of changing "systems integrator" - a person who sets up computer systems - to "integrator" for software which can convert or interchange data with other computer programs necessarily makes applicant's use of INTEGRATOR suggestive, rather than merely descriptive.

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic, use, function, or feature of the goods with which it is being used. See *In re Abcor Development*

² Applicant has noted in its brief several third-party registrations for marks containing the term INTEGRATOR for computer software products, without disclaimer of the term. The Examining Attorney, in her objection to the evidence, pointed out that copies of these registrations were not made of record by applicant during the prosecution of the case. This is true, except for the one registration which was made of record by the Examining Attorney in connection with the 2(d) refusal which was later withdrawn. Nonetheless, we agree with the Examining Attorney that each case must be considered on its own merits, and not on the basis of third-party registrations. This is particularly true when it is a question of descriptiveness, since this is uniquely tied to the particular goods or services at issue. Thus, even if all of the third-party registrations were considered, they are not persuasive in reaching a different result in this case.

Corp. 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); In re Bright-Crest Ltd., 204 USPQ 591 (TTAB 1979). Moreover, the immediate idea must be conveyed with a "degree of particularity." In re TMS Corp. of the Americas, 200 USPQ 57, 59 (TTAB 1987); In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd 90-1495 (Fed. Cir. Feb. 13, 1991).

We find that, on the record before us, the Examining Attorney has failed to establish that INTEGRATOR is merely descriptive of applicant's computer software. The computer dictionary definitions of "integrator" in terms of an electronic circuit or electronic device, as well as the definitions for software which is "integrated", are not applicable. The promotional literature supplied by applicant, as well as the news release about its software, in no way refers to applicant's product as an "integrator" nor describes its functions in term of integration. The Examining Attorney has provided no basis for equating the services of a person or company that acts as a "systems integrator" with the functions of applicant's computer software product. Finally, although we recognize that certain of the articles introduced by the Examining Attorney show use by others of the term "Integrator" in connection with software products which appear to be similar to applicant's software in function, we have no

basis for concluding that these other parties are not also using the term as part of a trademark, in a suggestive manner. There is no evidence that "integrator" is used as a term of art in the computer software field for products of this nature. Cf. In re Intelligent Instrumentation Inc., 40 USPQ2d 1792 (TTAB 1996)[Use of term "visual design tools" in the relevant trade is evidence that VISUAL DESIGNER aptly describes program for designing new or custom applications via these tools.]

While the Examining Attorney has likened this case to In re Time Solutions, Inc., 33 USPQ2d 1157 (TTAB 1994), we cannot agree. In that case, the Board found the mark YOUR HEALTH INSURANCE MANAGER merely descriptive of the applicant's software for personal record keeping of medical and health insurance information on the basis of the "everyday" meaning of the term "Manager", whether or not the computer definition was directly applicable, and on the description by applicant in the advertising of its goods as " ... software to manage your medical records and health insurance." Although the Examining Attorney argues that a similar correlation may be made between the ordinary dictionary definitions of the terms "integrate" and "integrator" and applicant's goods, we find no comparable use of the term "integrate" or "integrator" in any of

applicant's advertising such that potential purchasers would associate the term with the functions of applicant's software product. Thus, we find that the record falls short in establishing that the term INTEGRATOR in applicant's mark immediately, and with a degree of particularity, conveys information as to applicant's computer software, so as to be merely descriptive thereof.

We recognize that there is evidence that the term "integrator" has at least some meaning in the computer field. To the extent that this evidence casts doubt on whether the term is merely descriptive of applicant's goods, we find it appropriate to resolve this doubt in the favor of applicant, since any person who believes he would be damaged by the registration of the mark will have the opportunity to file an opposition thereto. See *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

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Decision: The refusal of registration without a disclaimer of the term INTEGRATOR is reversed.

E. W. Hanak

T. J. Quinn

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

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