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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Unisys Corporation

Serial Nos. 74/605,313; 74/610,287; 74/633,387

Thomas J. Scott for applicant.

Josette M. Beverly, Trademark Examining Attorney, Law Office 102 (Myra Kurzbard, Managing Attorney).

Before Quinn, Hohein and Walters, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Unisys Corporation has filed trademark applications to register the following marks:

> USOFT THE SERVER/CLIENT SOFTWARE COMPANY for "advertising, promoting and marketing of computer software of others, namely, a series of object-oriented software development tools used to build programs, run and manage networks by distributing advertising information via electronic, hard copy and trade shows presentations," in International Class 35; "installation of computer software, namely, a series of object-oriented software development tools used to build programs, run and manage networks," in International Class 37; and "computer software consultation and computer programming for others, namely, a series of

object-oriented software development tools used to build programs, run and manage networks," in International Class 42[1]; and

THE SERVER/CLIENT SOFTWARE COMPANY for "computer software – namely, a series of object-oriented software development programs used to build, run and manage applications," in International Class 9; "printed publications – namely, programmer, operator, installation and maintenance manuals for use with object-oriented software development tools used to build, run and manage applications," in International Class 16[2]; "advertising, promoting and marketing of computer software of others, namely, a series of object-oriented software development tools used to build programs, run and manage networks by distributing advertising information via electronic, hard copy and trade shows presentations," in International Class 35; "installation of computer software, namely, a series of object-oriented software development tools used to build programs, run and manage networks," in International Class 37; and "computer software consultation and computer programming for others, namely, a series of object-oriented software development tools used to build programs, run and manage networks," in International Class 42.[3]

With respect to the mark USOFT THE SERVER/CLIENT SOFTWARE COMPANY, the Trademark Examining Attorney required a disclaimer of the phrase THE SERVER/CLIENT SOFTWARE COMPANY and has finally refused registration under Section 6 of the Trademark Ace, 15 U.S.C. 1056, on the ground that

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[1] Serial No. 74/605,313, filed December 1, 1994, based on based on an allegation of a bona fide intention to use the mark in commerce in connection with the identified services.

[2] Serial No. 74/633,387, filed February 13, 1995, based on an allegation of a bona fide intention to use the mark in commerce in connection with the identified goods.

[3] Serial No. 74/610,287, filed December 12, 1994, based on based on an allegation of a bona fide intention to use the mark in commerce in connection with the identified services.

this portion of applicant's mark is a unitary phrase which is merely descriptive in connection with applicant's services and, thus, applicant may not claim exclusive rights in the phrase THE SERVER/CLIENT SOFTWARE COMPANY apart from the mark as a whole. Similarly, with respect to the mark THE SERVER/CLIENT SOFTWARE COMPANY, the Trademark Examining Attorney has finally refused registration under 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 of its goods and services.[4]

Applicant has appealed in each case. In the interest of judicial economy, as the issues in these three appeals are essentially the same and the facts are similar, we consider the appeals together and issue a single opinion. Both applicant and the Examining Attorney have filed briefs, but oral hearings were not requested. We affirm the refusal to register in each case.

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*

[4] We note that in each of the three applications herein, applicant entered a disclaimer of "THE" and "SOFTWARE COMPANY" apart from the mark as a whole. However, in its brief on appeal in each case, applicant withdrew the disclaimer. Therefore, we do not consider these disclaimers herein.

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).

We take judicial notice of the following excerpts from dictionary definitions of "server," "client," "client server," and "client/server architecture":

> *server*[5]: a functional unit that provides shared services to workstations over a network.
>
> *client*[6]: A functional unit that receives shared services from a server.
>
> *client/server architecture*[7]: An arrangement used on local area networks that makes use of 'distributed intelligence' to treat both the server and the individual workstations as intelligent, programmable devices, thus exploiting the full computing power of each.

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[5] *IBM* Dictionary of Computing, 1993.

[6] *id.*

[7] *Microsoft Press Computer Dictionary*, 1991. Although this definition was submitted in an untimely manner by applicant with its brief, we take judicial notice of this definition.

> *client server*[8]: A computer on a local area network that you can request information or applications from. The idea is that you - the user - are the client and . . . - the slave - is the server. That was the original meaning of the term. Over time, client server began to refer to a computing system that splits the workload between desktop PCs (called 'workstations') and one or more larger computers (called 'servers') joined on a local area network (LAN).

> *software*[9]: All or part of the programs, procedures, rules, and associated documentation of a data processing system.

Additionally, we note the following excerpts of articles from the LEXIS/NEXIS database, which were submitted by the Examining Attorney:

> "Server and client software comes on two disks, and you install Imagery HSM at a Microsoft Windows client." *LAN Times*, March 4, 1996.

> "Meridian Data's CD Net Plus is designed to solve this bottleneck. A combination of server and client software, the product approaches the situation from the viewpoint of the network administrator." *Computer Reseller News*, December 11, 1995.

> "The world's first free-of-charge secure server/client software is available from INTERWEB INC which incorporates the SSL protocol and is compatible with the Netscape Navigator . . ." *Telecomworldwire*, February 6, 1996.

> "The last thing an already harried network administrator needs is a CD-ROM server with client software that will generate help desk calls." *InfoWorld*, February 12, 1996.

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[8] *id.*

[9] *IBM Dictionary of Computing, supra*.

In view thereof, the Examining Attorney contends that the terms SERVER, CLIENT and SOFTWARE have well understood meanings in the computer industry; that the slash "/" between SERVER and CLIENT in applicant's mark means "and" or "or"; that the evidence demonstrates that the terms SERVER and CLIENT are "used in conjunction with one another to refer to a type of data processing architecture"; that the wording SOFTWARE COMPANY merely describes the nature of applicant's business entity; that SERVER/CLIENT merely describes the type of software company, as applicant characterizes its services as featuring server/client software products; and, thus, that the combined phrase THE SERVER/CLIENT SOFTWARE COMPANY merely describes "the type of business establishment from which [applicant's] services emanate."

Applicant readily acknowledges "the extensive, well-known use" in the computer industry of the terms "server," "client," "client/server software," "server software," "client software," and "server and client software" and that the phrase "client/server" is "ingrained and very familiar to members of the computer industry." However, while "client/server" may be a term of art in the computer industry, applicant contends that it's reversal of the two components of that term, *i.e.*, to form the phrase SERVER/CLIENT, creates a distinctive mark in connection with

its goods and services "wherein the server software is the focus of increased functionality in a client/server environment." In support of the contention that its particular juxtaposition of "server" and "client" is unique, in two of the three applications herein applicant submitted an article[10] by the ButlerBloor Organization[11] describing and evaluating applicant's goods and services, in pertinent part, as follows:

> USoft calls itself the server/client software company. This is well thought out. It makes the reader stop and think. Most particularly, it reflects the emphasis on the server. Unlike some so-called competitive products, which are really client development tools and actually do very little at the server level, USoft have *(sic)* not neglected client performance either.

In the present case, it is our view that, when applied to applicant's proposed goods and services, the phrase THE SERVER/CLIENT SOFTWARE COMPANY immediately describes, without conjecture or speculation, a significant feature or function of those goods and services. In particular, applicant is a software company which intends to offer client and server computer software products and related services which are "server-centric" in application. Nothing

[10] There is no indication as to whether this report is independently prepared or commissioned by applicant.

[11] The record in application Serial No. 74/605,313 does not contain the ButlerBloor report, although the report is referenced in the brief in that case. Thus, while the report cannot be considered in connection with the appeal in that case, we note that our decision in that case would be the same if the report was of record in that application.

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 and services to readily perceive the merely descriptive significance of the phrase THE SERVER/CLIENT SOFTWARE COMPANY as it pertains to those goods and services.

Applicant is correct that a combination of descriptive words may result in an arbitrary unitary designation which is registrable. However, this is true only if the juxtaposition of the words is inventive, evokes a unique commercial impression, or if the term has a bizarre or incongruous meaning as applied to the goods or services. *See, In re National Shooting Sports Foundation, Inc*., 219 USPQ 1018, 1020 (TTAB 1983) and cases cited therein. Such is not the case herein. Clearly, the combination of the words "server" and "client" into the term SERVER/CLIENT has a meaning which ordinary usage would ascribe to those words in combination and the fact that the term SERVER/CLIENT is not found in the dictionary is not controlling on the question of registrability. *See, In re Gould Paper Corp*., 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed Cir. 1987) and *In re Orleans Wines, Ltd*., 196 USPQ 516, 517 (TTAB 1977). Further, rather than evoking a unique commercial impression or creating an incongruous meaning, the phrase SERVER/CLIENT

describes precisely the fact, touted by applicant, that its software and services focus on the server.[12]

Finally, the fact that applicant may be the first entity to use the phrase SERVER/CLIENT in connection with its goods and services is not dispositive where, as here, such term unequivocally projects a merely descriptive connotation. *See, In re MBAssociates*, 180 USPQ 338, 339 (TTAB 1973).

In conclusion, we find the phrase THE SERVER/CLIENT SOFTWARE COMPANY to be merely descriptive in connection with the proposed goods and services identified in the applications herein.

Decision: The refusals in applications Serial Nos. 74/610,287 and 74/633,387 under Section 2(e)(1) of the Act are affirmed. Likewise, the requirement for a disclaimer in application Serial No. 74/605,313 under Section 6 of the Act is affirmed. With respect to application Serial No. 74/605,313, applicant is allowed until twenty days from the mailing date of this decision to submit a proper disclaimer

[12] Nor does the slash "/" between the words SERVER and CLIENT lend a distinctive quality to applicant's proposed mark.

of the phrase THE SERVER/CLIENT SOFTWARE COMPANY, failing which registration will be refused. *See*, Trademark Rule 2.142(g).

T. J. Quinn

G. D. Hohein

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