

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB JUNE 30,99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re **Metrologic Instruments, Inc.**

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Serial No. 74/**612,384**

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**Thomas J. Perkowski, Joan M. McGillycuddy, Bradley N. Ruben and  
Claudia A Smith** of Hopgood, Calimafde, Kalil & Judlowe, L.L.P.  
for **Metrologic Instruments, Inc.**

**Angela Lykos**, Trademark Examining Attorney, Law Office 102  
(**Thomas V. Shaw**, Managing Attorney).

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Before **Hanak, Hohein and Chapman**, Administrative Trademark  
Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

**Metrologic Instruments, Inc.** has filed an application  
to register the term "SCANKEY" for "bar code scanners and  
readers".<sup>1</sup>

Registration has been finally refused under Section  
2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis  
that, when used in connection with applicant's goods, the term  
"SCANKEY" is merely descriptive of them.

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<sup>1</sup> Ser. No. 74/612,384, filed on December 19, 1994, which alleges dates  
of first use of November 22, 1994.

Applicant has appealed. Briefs have been filed,<sup>2</sup> but an oral hearing was not held.<sup>3</sup> We reverse the refusal to register.

As explained by applicant in response to the Examining Attorney's initial Office Action, its "SCANKEY product is a handheld device which uses lasers to read bar code symbols for a variety of applications such as inventory control and retail store check out stations." In particular, according to applicant's initial brief:

This product is used primarily: in shipping and receiving to track a package or packages; for item tracking/inventory; to monitor work in progress for an item; for package sorting; and for order picking. The product is designed to allow ... person[s] to have hands free scanning capabilities so that they can track their information in a quicker, more efficient manner. Although the scanner does has [sic] a *numerical* keypad, the scanner and keyboard do not work together; rather, they work in the alternative with respect to imputting [sic] bar code information. Under normal operation, the scanner is used to scan in the bar code information. However, when the scanner can not read the bar code, then the operator would use the numerical keypad. The keypad can also be used to input quantity, price or other programmable fields.

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<sup>2</sup> Applicant, with its initial brief, has filed a piece of advertising literature for its goods. The Examining Attorney, in her brief, has objected to consideration thereof, correctly pointing out that the submission of such literature at this stage is untimely under Trademark Rule 2.142(d). Applicant, in its reply brief, has confirmed that the literature it has furnished "is not new evidence" in the sense that it was not previously available. Accordingly, the Examining Attorney's objection is sustained and applicant's literature has not been given further consideration. We hasten to add, however, that even if such advertising had been properly made of record, it would have made no difference in the disposition of this appeal.

<sup>3</sup> Although an oral hearing was requested by applicant and scheduled by the Board, applicant subsequently submitted a withdrawal of the oral hearing.

However, use of the numerical keypad for reading [in] the bar code is not the preferred mode of operation since its use slows the operator's performance.

In light thereof, applicant argues that, as used in connection with its bar code scanners and readers, "[t]he mark SCANKEY ... does not describe any aspect of the goods." There is nothing about the goods, applicant insists, "which is used to scan keys, nor can the keys scan anything." Moreover, while conceding that the several excerpts made of record by the Examining Attorney from her search of the "NEXIS" data base show that "there are products in which scan keys are a feature of the product[s] and[,] in those circumstances, it could be argued that ... the use of the words scan keys could be descriptive," applicant maintains that its goods do not contain any kind of scan keys which enable the user to scan or search for particular information or to retrieve such. Applicant contends, therefore, that the term "SCANKEY," while perhaps suggestive of its goods, is not merely descriptive of any characteristic, feature, function, use or purpose of its products.

The Examining Attorney, on the other hand, asserts that the term "SCANKEY immediately conveys to prospective consumers a feature of the applicant's bar code symbol scanners and readers," namely, "that they contain a key or keybutton which perform[s] or activate[s] a scanning function." In support of her position, the Examining Attorney relies, among other things, upon the following definitions, which she made of record from the Microsoft Press Computer Dictionary (1991) and which applicant furnished from Webster's New Collegiate Dictionary (1981):

(a) the word "scan," which the former at 306 in relevant part defines, "[i]n facsimile and other optical technologies" as meaning "to move a light-sensitive device across an image bearing surface such as a page of text, converting the light and dark areas on the surface into binary digits that can be interpreted by a computer" and the latter at 1022 in pertinent part lists both as a verb meaning "3 a : to examine successive small portions of (as an object) with a sensing device (as a photometer or a beam of radiation)" and as a noun signifying "1 : the act or process of scanning"; and

(b) the word "key," which the former at 201 in relevant portion defines as meaning, "[o]n a keyboard, the combination of a plastic key cap (which typically has a character printed on its face), a tension mechanism that suspends the key cap but allows it to be pressed down, and an electronic mechanism that records the key press and key release" and the latter at 627 sets forth, among other things, as connoting a "KEYBUTTON," which in turn is defined at 627 as signifying "any of the small buttons or knobs depressed by the fingers in operating a keyboard machine".

In addition, the Examining Attorney maintains that, as shown by excerpts from several articles retrieved from her search of the "NEXIS" database, "the term 'scan key' is used in the industry to identify a particular type of key which could be found on bar code symbol scanners and readers." The most probative of such excerpts, we note, is from a new product review in the September 7, 1996 issue of the L.A. Times which states that "[t]he [Texas Instruments personal] organizers have one-touch *scan keys* and reminder alarms" (emphasis added). The argument by applicant that, in fact, none of the excerpts (which also mention dictation systems and computer anti-virus programs) refers specifically to goods such as bar code scanners and

readers is "unconvincing," according to the Examining Attorney, because:

Given that scan keys are incorporated in a wide array of products and in light of the [dictionary] evidence presented by the applicant at the time the examining attorney issued the final refusal, it was reasonable for the examining attorney to assume that scan keys could be incorporated on bar code symbol scanners and readers. For this reason, the record evidence compels a finding that applicant's mark is merely descriptive.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is

from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

However, a mark is suggestive if, when the goods or services are encountered under the mark, a multistage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See, e.g., In re Abcor Development Corp., supra at 218, and In re Mayer-Beaton Corp., 223 USPQ 1347, 1349 (TTAB 1984). As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See, e.g., In re Atavio, 25 USPQ2d 1361 (TTAB 1992) and In re TMS Corp. of the Americas, 200 USPQ 57, 58 (TTAB 1978). The distinction, furthermore, is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. See In re George Weston Ltd., 228 USPQ 57, 58 (TTAB 1985).

In the present case, we are constrained to agree with applicant that, as emphasized in its reply brief, the Examining Attorney's position rests on "**assumptions which have no basis in fact** regarding the applicant's products." Not only has applicant "repeatedly stated for the record that its product does not include scan keys, i.e. keys that can scan," but the evidence is simply insufficient to show that bar code scanners and readers have any characteristic, feature or function which would operate as a scan key. As applicant further stresses in its reply, a

mere descriptiveness refusal "can not be based on some *possible* future part or function that *could be* incorporated in applicant's product." Thus, while bar code scanners and readers could perhaps, for example, feature a programmable key or keys designed to scan or read only certain bar-coded information, there is nothing on this record to suggest that such is or would typically be the case.

The Examining Attorney's position, in short, amounts to nothing more than speculation concerning possible attributes of applicant's goods which are suggested by the term "SCANKEY". On this record, a multi-stage reasoning process or imagination would be necessary in order for customers or prospective purchasers of bar code scanners and readers to conclude, as urged by the Examining Attorney, that such goods contain a key or keybutton which performs or activates some sort of scanning function. The term "SCANKEY," when used in connection with bar code scanners and readers, has not been shown to immediately or directly describe any significant aspect of either applicant's particular goods or such type of goods in general. However, to the extent that there may be any doubt as to whether applicant's mark is merely descriptive or suggestive of its goods, we resolve such doubt, in accordance with the Board's practice, in favor of the publication of applicant's mark for opposition. See, e.g., *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981) and *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

**Ser. No.** 74/612,384

**Decision:** The refusal under Section 2(e)(1) is reversed.

E. W. Hanak

G. D. Hohein

B. A. Chapman  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board