

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB AUGUST 13, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Indexing Technologies, Inc.

Serial No. 74/695,746

Philip Furgang of Furgang & Adwar, LLP for Indexing
Technologies, Inc.

Wanda Kay Price, Trademark Examining Attorney, Law Office
103 (Michael Szoke, Managing Attorney)

Before Quinn, Chapman and Bucher, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Indexing Technologies, Inc. has filed an application
to register the mark INDEXING TECHNOLOGIES for "wholesale
sales services of material handling equipment, indexing
devices, indexing components and parts therefor."¹

Registration has been finally refused on the basis

¹ Application Serial No. 74/695,746, filed June 29, 1995. The
claimed dates of first use and first use in commerce are January
1, 1995, and May 9, 1995, respectively. The acceptability of the
recitation of services is an issue in this appeal and will be
fully addressed later in this decision.

that under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), when used on applicant's services, the mark is merely descriptive of them. The Examining Attorney also made final the requirement for a more definite recitation of services.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs.² Applicant requested an oral hearing, but subsequently waived its right thereto.

Turning first to the question of the recitation of services, the Examining Attorney did not accept the original identification of services, and suggested, if appropriate: "wholesale distributorships featuring material handling equipment, namely,... (specify)..., indexing devices, namely,... (specify)..., indexing components, namely,... (specify)..., and parts therefor." In response, applicant offered the following amendment to the identification of services: "wholesale distribution featuring material handling equipment, indexing devices, indexing components and parts therefor." Applicant's

² In its brief, applicant referred to an "attached brochure" about applicant's services, explaining that applicant believed the brochure had been submitted as part of the application or in responses to Office actions. (Brief, p. 4). There was no brochure attached to applicant's brief. However, in light of applicant's assertion that it was submitted as part of the application (or other responses), we assume that the "brochure" was the same as the specimens submitted with the application. The specimens were available for the Board's consideration.

proposed amendment to the identification of services has also been rejected by the Examining Attorney as indefinite.

Both applicant and the Examining Attorney argued the issue of a proper identification of services based on the proposed amended identification of services.³ Thus, our decision relates to the question of the acceptability of the proposed amended identification.

Section 1(a)(1)(A) of the **Trademark Act**, 15 U.S.C. §1051(a)(1)(A), requires that the written application specify the goods or services on or in connection with which applicant uses the mark. Trademark Rule 2.33(a)(1)(v) requires, in relevant part, that a trademark application must set forth "the particular goods or services" with which the mark is used. Further, the identification of goods or services must be specific and definite. See TMEP §§804.01, and 1301.05. It is within

³ The only exception is that on page 4 of its brief, applicant states that "...the definition of goods *as originally filed* appropriately and accurately describe (sic) the goods." (Emphasis in original.) (We presume that applicant did not mean this as a reference to an identification of goods, but rather, was referring to the goods featured in its "wholesale distribution" services.) However, in the conclusion of applicant's brief, it requests that the Board accept the proposed amended identification of services (p. 8). To whatever extent, if any, applicant seeks to have the original identification of services deemed acceptable by the Board, such request is denied. The activity of "sales services" is generally unacceptable as constituting a "service" because the activity may refer to an applicant's merely selling its own goods, which is not a service.

the discretion of the Patent and Trademark Office to require that the goods or services be specified with particularity. See *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296, 1298 (TTAB 1986), and cases cited therein, rev'd on other grounds, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1998).

First, the Examining Attorney's requirement that applicant specify the items within the fields applicant has already identified is unnecessary. That is, applicant already indicated that its services feature "material handling equipment, indexing devices, indexing components and parts therefor." Because this is a service mark identification, there is no need to further list the items included under the categories of material handling equipment, indexing devices, and indexing components.

The problem with applicant's proposed identification lies with the term "distribution." As used in an identification of services, the Office has interpreted the term broadly to include a variety of functions related to the delivery of goods. (See, e.g., in the *PTO Acceptable Identification of Goods and Services Manual* under services, entries such as "Distribution of motion pictures," "Distribution (Handbill)," "Distribution (Mutual Fund)," and "Distribution (News analysis and features)." By

contrast, the term "distributorship(s)"⁴ is used more narrowly to mean "standing between," or being the middle link in the distribution chain. That is, in the context of identification and classification of services in this Office, "wholesale distribution" is deemed to be much broader than applicant's specific activity, namely that "[a]pplicant distributes its goods from a warehouse to retailers." (brief, p. 2). Under Office identification and classification requirements, this phrase is unacceptable for distributorship services. To the extent applicant has not identified its services as "wholesale distributorship featuring material handling equipment, indexing devices, indexing components and parts therefor," the Examining Attorney's requirement for a more definite identification of services is proper.

We turn now to the refusal to register on the ground of mere descriptiveness. It is well settled that a term is merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it immediately conveys information concerning an ingredient, quality, characteristic or

⁴ Applicant's concern that it does not establish wholesale distributorships is noted. The Examining Attorney's general requirement that applicant use the term 'distributorship' rather than 'distribution' is correct. However, according to our understanding of Office practice, it should have been acceptable if applicant had proposed the term in the singular.

feature thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a term or phrase describe all of the properties or functions of the goods or services in order for it to be considered merely descriptive thereof; rather, it is sufficient if the term or phrase describes a significant attribute of the goods or services. Moreover, whether a term or phrase 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 or phrase 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 (TTAB 1979). See also, *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991). Consequently, "[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).

The Examining Attorney contends that inasmuch as the term "indexing" clearly describes a feature of applicant's

services, and in view of the dictionary definition of "technology" or "technologies," it is clear that when considered as a whole, in connection with applicant's services, the applied-for mark is merely descriptive. Specifically, the Examining Attorney stated that "INDEXING TECHNOLOGIES" refers to "materials technology, namely, indexing devices and indexing components used to achieve the commercial or industrial objective of indexing." (brief, p. 4).

The Examining Attorney provided the following definition of "technology" or "technologies" from Webster's II New Riverside University Dictionary (1994):

"1.a. The application of science esp. to industrial or commercial objectives. b. The whole body of methods and materials used to achieve such objectives. 2. The body of knowledge available to a civilization that is of use in fashioning implements, practicing manual arts and skills, and extracting or collecting materials."

Applicant urges reversal of the refusal on the basis that the mark INDEXING TECHNOLOGIES, when viewed in its entirety, is suggestive, not merely descriptive, of applicant's services; that common words, when used as a composite mark, may become a valid trademark; that the Examining Attorney's definition of "technologies" is "so obscure as to have no meaning whatsoever" (brief, p. 5);

that the terms "technology" or "technologies" have been "held to be only suggestive of goods" (brief, p. 5); that "[I]f competitors do not need the mark INDEXING TECHNOLOGIES to describe their goods, then the mark is suggestive and deserves trademark protection" (Reply brief, p. 7); and that doubt is resolved in applicant's favor.

As stated by our primary reviewing court in the case of *In re Gould Paper Corporation*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (*SCREENWIPE* held generic for wipes that clean computer and television screens), the Patent and Trademark Office may satisfy its evidentiary burden by means of dictionary definitions showing that the "separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to those words as a compound". See also, *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988); *aff'd in op. not for pub.*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989). Here the Examining Attorney has met the burden of establishing a *prima facie* case of mere descriptiveness.

Although the term "indexing" is not specifically defined in the record before us, it appears to refer to a type of technology used with machine tools and tooling. The word "indexing" appears within the original and proposed amended identification of services, and applicant

also clearly uses the word descriptively on its specimens of record, as shown by the examples which follow: (1) "Your single source for O.E.M.⁵ quality indexing components and associated tooling"; (2) "Heavy-duty indexing and rotary tables for machine tool applications"; (3) "Indexing tool turrets and tooling for CNC lathes"; and (4) "Precision cam manufacturing and a comprehensive range of O.E.M. quality mechanical cam-driven indexing and positioning devices."

In this context, the term clearly refers to the use of highly calibrated accessories or specific precision systems in conjunction with machine tools.

By applicant's own words, the service applicant offers involves marketing indexing devices and indexing components. (See e.g., applicant's brief, p. 5, "Applicant distributes goods including, but not limited to, indexing devices and indexing components."; and in applicant's Response filed September 20, 1996, p. 1, applicant stated that the term INDEXING TECHNOLOGIES "may suggest the type of goods distributed" by applicant, and on p. 2, that some of the goods distributed by applicant "undeniably perform an indexing function.")

⁵ Original equipment manufacturers.

The dictionary definition of the term "technology" submitted by the Examining Attorney includes the plural "technologies" and one definition refers to "The application of science esp. to industrial or commercial objectives. b. The whole body of methods and materials used to achieve such objectives." This definition, as applied to services in the field of industrial engineering, is distinguishable from its application to specifically listed goods. In the broader context of services, the dictionary definition of "technology" shows that the term is well-suited for applicant's distributorship of precision devices -- the latest machine tool technology.

Applicant's specimens of record include the following bulleted statements: "*State-of-the-art*' tool turrets and tolling for CNC lathes," and "*Ultra precision* rotary tables for inspection machines and CMM applications." (Emphasis added.) Thus, applicant touts its services by emphasizing the technologically advanced aspects of the goods offered through its distributorship service.

The term INDEXNG TECHNOLOGIES, when used in connection with applicant's services ("wholesale distribution/distributorship featuring material handling equipment, indexing devices, indexing components and parts therefor"), directly describes those services to the

relevant purchasers, e.g., those knowledgeable about the technology of machine tools.

Accordingly, we find applicant's mark is merely descriptive. Specifically, we agree with the Examining Attorney that the words INDEXING TECHNOLOGIES, as applied to applicant's services, immediately convey to consumers that the services involve the latest technology in material handling and indexing equipment. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Putnam Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996); *In re Energy Products of Idaho*, 13 USPQ2d 2049 (TTAB 1989); and *In re Truckwriters Inc.*, 219 USPQ 1227 (TTAB 1983), aff'd unpubl'd Appeal No. 84-689 (Fed. Cir., November 1, 1984).

The cases of *In re Hutchinson Technology Inc.*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988); and *Concurrent Technologies Inc. v. Concurrent Technologies Corp.*, 12 USPQ2d 1054 (TTAB 1989), cited by applicant, do not require a different result herein.⁶ In the Hutchinson case, supra, the Court majority's discussion of the term "technology"

⁶ Applicant also cited the case of *Equine Technologies Inc. v. Equitech Inc.*, 68 F.3d 542, 36 USPQ2d 1659 (1st Cir. 1995). However, we find that case is not helpful in resolving an ex parte refusal to register at the PTO because there the appellate court was reviewing the propriety of the district court's granting of a preliminary injunction in a trademark infringement lawsuit over goods (hoof pads for horses). The Board's jurisdiction is limited by Section 17 of the Trademark Act.

was within the context of whether the mark HUTCHINSON TECHNOLOGY was primarily merely a surname, and the Court remanded the case for a disclaimer of the term "technology." In the case now before the Board applicant provides services, not goods, and the refusal to register is based on mere descriptiveness, not a surname.

In the Concurrent case, supra, the Board found the mark CONCURRENT TECHNOLOGIES CORPORATION was not merely descriptive for printed electronic circuit boards based on the absence of evidence of any descriptive uses of the terms "concurrent" or "concurrent technologies." The involvement of goods, not services, and the lack of evidence of any descriptive use in that case, are to be distinguished from the case now before the Board. In the instant case, there is dictionary evidence of the meaning of the term "technologies" as specifically referring to the application of science to industrial objectives, and applicant itself has repeatedly used "indexing" in a merely descriptive manner.

When the mark INDEXING TECHNOLOGIES is viewed as a whole, in the context of applicant's services, we find that the purchasing public would, without imagination or conjecture, readily understand the words to mean what applicant's services entail.

Finally, applicant's argument regarding the lack of evidence that applicant's competitors use the term to describe their services is not persuasive. The fact that a term may currently be in use by only the applicant cannot support the registration sought if the mark as used projects only a merely descriptive significance. See *In re Tekdyne Inc.*, 33 USPQ2d 1949, 1953 (TTAB 1994).

Decision: The requirement for a more specific identification of services is affirmed (as to the use of the term "distributorship").

The refusal to register under Section 2(e)(1) is affirmed.

T. J. Quinn

B. A. Chapman

D. E. Bucher
Administrative Trademark
Judges, Trademark Trial and
Appeal Board