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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Platinum Technology, Inc.**

Serial No. 75/137,097

Martin R. Greenstein of **TechMark** for Platinum Technology,
Inc.

Kathleen M. Vanston, Trademark Examining Attorney, Law
Office **103** (**Michael Szoke**, Managing Attorney).

Before **Hanak**, Bottorff and Rogers, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Platinum Technology, Inc. (applicant) seeks to
register REALTIMEEXTRACT for "computer software for use in
database access, navigation, implementation,
administration, conversion, migration and management;
computer software for database query and reporting;

computer software for client/server and remote computing applications; computer software utilities; computer software containing database system tools; computer software providing access to global computer networks and wide area networks; computer software for system management; and instructional manuals sold as a unit." The intent-to-use application was filed on July 22, 1996.

The Examining Attorney refused registration pursuant to Section 2(e)(1) of the Trademark Act on the basis that applicant's mark is merely descriptive of applicant's goods. In addition, citing Trademark Rule 2.61(b), the Examining Attorney also refused registration on the basis that "applicant has not submitted product literature relevant to [applicant's] software product." (Examining Attorney's brief page 6).

When the refusal was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

We turn first to a consideration of whether REALTIMEEXTRACT is merely descriptive of applicant's

computer software. At the outset, we note that the issue before us is not whether the phrase "real time extract" is merely descriptive of applicant's computer software. Rather, the issue is whether the applied for mark REALTIMEEXTRACT is merely descriptive of applicant's computer software.

The Examining Attorney has made of record excerpts of stories taken from the NEXIS database in which the word "extract" appears in close proximity to the phrase "real time." At page 4 of her brief, the Examining Attorney sets forth those five extracts which she deemed most pertinent in demonstrating that applicant's mark is merely descriptive of its computer software. These five extracts are reproduced below exactly as they appear at page 4 of the Examining Attorney's brief.

Cache operations happen too quickly to extract a real time high level language trace...(Story 3 of 14).

NOMS is a client/server application in which Window NT-based agents extract information in real time from legacy mail-transportation systems (Story 6 of 14).

...requirements is extremely important to the success of the system to extract real time data for inclusion into a centralized database for satisfying the information management requirements...(Story 7 of 14).

...it shows greatest benefit as an audio front-end to a database from which it can extract real time information...(Story 10 of 14).

An IMS-based application...extracts this information from the real time application (Story 13 of 14).

It is the position of the Examining Attorney that these excerpts demonstrate that applicant's mark is merely descriptive because "it is likely that the ability to extract information in real time is an important function of applicant's software." (Examining Attorney's brief page 4).

At the outset, we note that the Examining Attorney has failed to make of record any evidence showing the use of the phrase "real time extract" with those three words in that order. Moreover, the evidence made of record by the Examining Attorney demonstrates the use of the word "extract" as a verb, and not as a noun, as it would be in the phrase "real time extract." Of course, as might be expected, none of the evidence made of record by the Examining Attorney demonstrates use of REALTIMEEXTRACT.

Applicant correctly points out, and the Examining Attorney does not contend to the contrary, that its mark REALTIMEEXTRACT is a coined word. In this regard, reference is made to the case of Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co., 189 USPQ 348 (CCPA 1976). In

that case, the Court affirmed the decision of this Board finding that Goodyear's mark BIASTEEL was not merely descriptive when applied to tires despite the fact that the words "bias" and "steel" were common dictionary words widely used in the tire industry. In so doing, the Court had the following comments: "The proposed mark [BIASTEEL] is a coined word, not to be found in a dictionary. ... As the board noted, the record is devoid of evidence that appellant [Firestone] or anyone else has used the words 'bias' and 'steel' together to describe tires." 189 USPQ at 350. See also, Minnesota Mining & Mfg. Co. v. Johnson & Johnson, 454 F.2d 1179, 172 USPQ 491 (CCPA 1972).

We find that the same reasoning applicable in Firestone Tire and Minnesota Mining is equally applicable here, and accordingly find that applicant's mark REALTIMEXTRACT is not merely descriptive of applicant's goods. Of course, to the extent that there may be any doubts on the issue of whether applicant's mark is merely descriptive, it is the long standing practice of this Board to resolve said doubts in applicant's favor. In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972).

Turning to the second basis for refusal, namely, that purportedly "applicant has not submitted product literature

relevant to [applicant's] software product," we find that this refusal is without merit.

In the first office action, the Examining Attorney stated that "the nature of [applicant's] goods is not clear"; that "applicant must submit samples of advertisements or promotional materials for goods of the same type"; and that "if such materials are not available, the applicant must submit a photograph of similar goods and must describe the nature, purpose and channels of trade of the goods on which the applicant has asserted a bona fide intent to use the mark."

Applicant responded by submitting a description of applicant's current product line.

In the second and final office action, the Examining Attorney responded to applicant's submissions with the following statements: "The requirement that applicant submit product information is CONTINUED and made FINAL. The Examiner is not interested in general information about applicant's many products. The Examiner was interested in specific information about the product called REALTIMEEXTRACT. Please submit relevant information."

In response, applicant submitted both a Notice of Appeal and a Request for Reconsideration. Attached to the

latter were additional and more detailed pieces of literature describing applicant's current product line. In the Request for Reconsideration, applicant made the following statements: "With respect to the Examiner's request for literature for this or similar products, applicant previously submitted literature generally describing its products, explaining that the product on which the mark will be used is similar to the database products and utility products sold by applicant. Applicant submits herewith additional materials, namely data sheets on three of its representative database products..."

In response to this Request for Reconsideration, the Examining Attorney made the following comments: "The final requirement that applicant submit product information which pertains to this product is MAINTAINED. Literature on other products of applicant is not probative of the use of the term REALTIMEEXTRACT in relation to this particular product. The Examiner needs specific information about this particular product in order to fully assess the mark."

At page 6 of her brief, the Examining Attorney stated as follows: "In this case the Examining Attorney has repeatedly requested information about applicant's software product entitled REALTIMEEXTRACT. Applicant has repeatedly

provided information concerning other software products which applicant has designed. Information pertaining to these products is not relevant to a determination of the descriptiveness of the mark in this application."

In its reply brief, applicant pointed out that its application is an intent-to-use application and "that it would be impossible to comply with [the Examiner's] requirement since there was no such literature in existence. ... Applicant had fully complied [with the Examiner's request] to the extent possible. In fact, the applicant provided literature for similar products in an attempt to enlighten the Examiner regarding the nature of [applicant's proposed] products."

To cut to the quick, we are not certain what the Examining Attorney was requesting of the applicant. In the first office action, the Examining Attorney requested advertisements, promotional materials or photographs of "similar goods." Applicant complied with this requirement to the extent that it submitted detailed product literature describing its current product line and explaining that said product line was similar to the computer programs on which it intended to use the mark REALTIMEEXTRACT.

However, in the second office action and in all subsequent papers, the Examining Attorney requested product literature pertaining specifically to non-existent products to be sold in the future under the mark REALTIMEEXTRACT. Obviously, as pointed out by applicant, this requirement by the Examining Attorney was impossible to comply with, and thus was inappropriate.

If the Examining Attorney's true desire was to receive from applicant product literature put out by applicant's competitors describing products very similar to the products on which applicant would in the future use its REALTIMEEXTRACT mark, the Examining Attorney should have explicitly made such a request. Applicant would then have been able to either supply such product literature from its competitors, or explain that at the then present time, no such product literature from competitors was available because the computer programs on which applicant intended to use the mark REALTIMEEXTRACT were truly innovative. However, at no time did the Examining Attorney request product literature put out by applicant's competitors, or for that matter, by any third parties or others.

Decision: The refusal to register is reversed both on the basis that applicant's mark is not merely descriptive

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and on the basis that applicant did, to the fullest extent possible, comply with the Examining Attorney's request for information concerning applicant's future products to be marketed under the mark REALTIMEEXTRACT.

E. W. Hanak

C. M. Bottorff

G. F. Rogers
Administrative Trademark
Judges, Trademark Trial and
Appeal Board