

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JULY 21, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Virginia Tech Intellectual Properties, Inc.

Serial No. 75/158,235

James W. Hiney, Esq. for Virginia Tech Intellectual
Properties, Inc.

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

Before Simms, Chapman and Wendel, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

On August 27, 1996 Virginia Tech Intellectual
Properties, Inc. filed an intent-to-use application to
register on the Principal Register the mark SITEPLANNER for
"interactive software package allowing user to assess the
coverage regions of transmitters for wireless
communications systems in indoor environments to create a
building floor plan in real time" in International Class 9.

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark, if used on applicant's identified goods, would be merely descriptive of them.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing. We affirm.

The Examining Attorney contends that the applied-for mark immediately describes a characteristic, use or purpose of applicant's stated goods in that it merely describes both (1) the software which "functions as a site planner because it plans for the site of wireless communication system installations" (brief, p. 3); and (2) the intended users of the goods, namely, a professional person involved in site planning.

In support of her refusal to register, the Examining Attorney submitted (i) the Webster's New World Dictionary definitions of "site" as "2. the place where something is, was or is to be located," and "plan" as "2a. a scheme or program for making, doing, or arranging something; project, design, schedule, etc."; and (ii) copies of excerpts of published stories retrieved from the Nexis database to show that site planners are those who arrange for the location of things, and they would be intended users of applicant's

software product to locate the optimum place for the wireless communication system within a structure.

Applicant argues that (1) the goods on which applicant intends to use the mark SITEPLANNER are software packages which are "used to select a site not plan it" (brief, p. 6); and (2) the PTO has allowed seven other similar marks for computer software.

The test for descriptiveness is well settled. A term is considered merely descriptive within the meaning of Section 2(e)(1), if, when considered in conjunction with the goods with which it is intended to be used, it immediately and forthwith conveys information about the nature of the goods, or about a quality, characteristic, feature, purpose or function thereof. See *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984). It is not necessary that the term describe all of the properties or functions of the goods or services in order for the term to be considered merely descriptive thereof; rather it is sufficient if the term describes a significant attribute or idea about them. And, of course, 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 and the possible significance that the term may have to the average purchaser of the goods or services because of the manner of

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its use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (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). The question is not whether someone presented with only the mark could guess what the goods are. Rather, the question is whether someone who knows what the goods are will understand the mark to convey information about them. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990).

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], held that 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".

The distinction made by applicant is that its software product will not plan anything, but it will peruse data and select a site, while planning the site is done subsequent to the selection thereof. This is a distinction consumers will not likely make given the ordinary meaning of the component words "site" and "planner." Moreover, the

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applied-for mark does not involve any incongruous word combinations, and there is no imagination needed to understand the meaning of SITEPLANNER either in the context of the function of the goods or in referring to intended users of the goods.

Thus, when the Nexis evidence referring to "site planners" is viewed together with the dictionary definitions in the record of the terms "site" and "plan," we are of the opinion the applied-for mark, the term SITEPLANNER, is merely descriptive of the goods on which applicant intends to use the mark, i.e., software used to assess optimum locations for wireless communications systems within a building. That is, the term immediately and without conjecture or speculation describes a significant feature, function or the intended users of applicant's goods. See *In re Cryomedical Sciences Inc.*, 32 USPQ2d 1377 (TTAB 1994) (SMARTPROBE merely descriptive of disposable cryosurgical probes); *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) (SCREEN FAX PHONE merely descriptive of facsimile terminals employing electrophoretic displays); *In re Eden Foods Inc.*, 24 USPQ2d 1757 (TTAB 1992) (DOUBLE CERTIFIED ORGANIC held merely descriptive of pasta); *Domino's Pizza Inc. v. Little*

Caesar Enterprises Inc. 7 USPQ2d 1359 (TTAB 1988) (SINGLE, DOUBLE and TRIPLE merely descriptive of applicant's pizza); and In re IBP, Inc., 228 USPQ 304 (TTAB 1985) (requirement for a disclaimer of the merely descriptive terms "select trim" for pork affirmed).

Applicant's argument based on the PTO's supposed allowance of seven other similar marks for computer goods is of no avail. First, mere listings of third-party registrations is not probative evidence. See In re Duofold Inc., 184 USPQ 638 (TTAB 1974); In re Hub Distributing, Inc., 218 USPQ 285 (TTAB 1983); and In re Hungry Pelican, Inc., 219 USPQ 1202 (TTAB 1983). See also, Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992). Second, three of the listings are applications, not registrations.¹ Third, the Board does not have the records of those files before us, and each case must be decided on its own record. See In re Scolastic Testing Service, Inc., 196 USPQ 517 (TTAB 1977).

¹ We note for the record that the list sets forth only the registration (or application) numbers and the purported marks. There is no information as to the goods or services involved, or as to the ownership (many may be owned by the same entity), or as to disclaimers, Section 2(f) claims or any other such matters.

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

R. L. Simms

B. A. Chapman

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