

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MAY 18, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re International Business Machines Corporation

Serial No. 74/651,589

Alexander Tognino for International Business Machines
Corporation.

Howard Smiga, Trademark Examining Attorney, Law Office 102
(Thomas V. Shaw, Acting Managing Attorney).

Before Hanak, Wendel and Bucher, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

International Business Machines Corporation has filed
an application to register the mark SYSTEM OBJECT MODEL for
"computer software in the field of language neutral object
oriented programming technology for assembling and
interfacing software components in an operating program."¹

¹ Serial No. 74/651,589, filed March 27, 1995, based on an
allegation of a bona fide intent to use the mark in commerce.

Registration has been finally refused on the ground that the mark is merely descriptive under Section 2(e)(1) of the Trademark Act. Applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.²

The Examining Attorney maintains that OBJECT MODEL is a term of art which immediately describes the main function of applicant's software, namely, to provide object modeling technology in order to facilitate interaction between various computer programs. The addition of the term SYSTEM, the Examining Attorney argues, simply describes the computer system or computer program system in which the software operates and does not alter the descriptive significance of OBJECT MODEL. As evidentiary support, the Examining Attorney relies upon various dictionary definitions, statements made in applicant's Web page in describing its software, and excerpts from the Nexis database with respect to "object model" or "object modeling" in general. In addition, the Examining Attorney has referred to statements made by applicant in describing its software during the prosecution of this application.

² After the filing of applicant's brief, the case was remanded to the newly assigned Examining Attorney for supplementation of the record. Following the continuation of the final refusal, applicant was allowed time to file a supplemental brief, but no brief was filed.

Applicant contends that the phrase SYSTEM OBJECT MODEL, when viewed as a whole, is not descriptive, but creates a impression separate from its component parts. Applicant insists that the juxtaposition of the words makes the mark "incongruous and suggestive in nature." Applicant argues that the term "object model" by itself does not describe applicant's goods, since

SYSTEM OBJECT MODEL is not for using [sic] object-oriented programming and does not model an object in an operating system. To the contrary, IBM's SYSTEM OBJECT MODEL, because it is language and operating program neutral, is used to solve incompatibilities between languages and compilers. Objects can be implemented in one language, compiled, packaged, and shipped in binary form, and can be used and/or specialized using another language. (Brief p. 5).

Applicant maintains that its software is a new and complex product with many facets, information which the mark SYSTEM OBJECT MODEL does not immediately convey to consumers.

Applicant further argues that applicant is not just the first, but, to the best of its knowledge, the only source of software of this nature and that SYSTEM OBJECT MODEL is widely recognized in the marketplace as identifying applicant as the source of this software.³

³ The copies of excerpts retrieved from the Nexis database which applicant has attached to its brief to support its claim of the link made by customers between the mark SYSTEM OBJECT MODEL and applicant has been objected to by the Examining Attorney as untimely. Trademark Rule 2.142(d) provides that the record should be complete prior to the filing of an appeal.

Applicant also points to registrations which it has already obtained for the marks SOM⁴ and SOMOBJECTS⁵ for its software.

A term or phrase is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic, feature or function of the goods with which it is being used. 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 the characteristics or features of the goods in order for it to be considered merely descriptive; it is sufficient if the term describes one significant attribute of the goods. See *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

When first requested to describe the nature of its software, applicant stated that the goods could be defined as "a tool for object-oriented programming in the operating system." (Response of Feb. 26, 1996). The identification of goods as finally accepted by the Examining Attorney

Accordingly, we have given no consideration to this late-filed evidence. Furthermore, even if we had considered the evidence, it would not have changed our decision on the descriptiveness of applicant's mark.

⁴ Reg. No. 2,065,384, issued May 27, 1997, for the mark SOM for "computer software to allow language neutral oriented programming."

⁵ Reg. No. 1,950,175, issued January 23, 1996, for the mark SOMOBJECTS for "computer software to allow language neutral oriented programming" and for "manuals for use with computer software."

describes the software as being "in the field of language neutral object oriented programming technology." Thus, as pointed out by the Examining Attorney in the continuation of the final refusal, although applicant's software is language neutral, it is "very much in the realm of object technology."

In applicant's own Web page, which has been made of record by the Examining Attorney, we find statements such as the following:

In order to solve these problems, the developers Of SOM [SYSTEM OBJECT MODEL] designed an advanced object model and implemented the object-oriented runtime engine necessary to support this model.

SOM is packaging technology and runtime support for building language independent class libraries. It embodies an advanced object model with a complete runtime implementation.

SOM embodies features commonly associated with object oriented programming systems such as ... as well as advanced capabilities including metaclasses, user intercept and control of method dispatch and dynamic class construction. SOM provides these capabilities in a language independent way that solves the fragile base class problem.

On the basis of these statements alone, we find that "object model" has been demonstrated to be a term of art in the computer industry which is directly applicable to applicant's software. Despite other features or selling points of the software, particularly the fact that it is

language neutral, the term OBJECT MODEL, as used in applicant's mark, immediately conveys information as to the central function of applicant's goods. Applicant itself uses the term in a technical sense to describe its software.

As independent evidence of the applicability of the term to applicant's software, the Examining Attorney has introduced a definition of "object technology" as

[t]he use of objects as the building blocks for applications. Objects are independent programs modules written in object-oriented programming languages. Just as hardware components are routinely designed as modules to plug into and work with each other, objects are software components designed to work together at runtime without any prior linking.

Computer Glossary (8th Ed. 1998).

This is compared to applicant's description of its software as "as an object-oriented technology based program for building, packaging, and manipulating binary class libraries" or as providing a "language neutral environment for defining interfaces between applications built on different programming platforms such that interact between programs can be made efficiently and without language incompatibilities." (Applicant's response, August 14, 1997). We agree with the Examining Attorney that this fully supports the conclusion that applicant's software

embodies object technology in order to facilitate interaction between other programs. The use of the terms "object model" and "object modeling" in connection with specific types of object oriented technologies or methodologies is demonstrated in various Nexis excerpts made of record by the Examining Attorney.

Upon consideration of all of this evidence, we are convinced that OBJECT MODEL is a term of art which is being used by applicant in its recognized sense. The addition of the word SYSTEM to indicate that the OBJECT MODEL operates within the computer system does not alter this descriptiveness. Applicant's mark as a whole is merely descriptive of a major feature of its software. The fact that there are other significant attributes of the software does not alter the descriptiveness of the term SYSTEM OBJECT MODEL. Although applicant argues that the combination of terms is incongruous, applicant has failed to explain where the incongruity lies. Since applicant, in the same sentence, also argues that the mark is suggestive, it would appear that there is no incongruity.

Applicant's further arguments as to being the only source of software of this nature and as to the recognition by the purchasing public of the mark SYSTEM OBJECT MODEL as identifying applicant as being this source are irrelevant

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to the issue of descriptiveness. The fact that applicant may have been the first, or is the only source of software which is aptly described by the phrase SYSTEM OBJECT MODEL does not alter the descriptiveness of the phrase. See *In re Pharmaceutical Innovations, Inc.*, 217 USPQ 365 (TTAB 1983) and the cases cited therein. Public recognition of the phrase as an indication of source may have weight in a claim of acquired distinctiveness, but cannot refute the underlying descriptiveness of the phrase.

The fact that applicant has obtained registrations for different marks for similar software products is equally irrelevant to the descriptiveness of the present mark.

Accordingly, we find SYSTEM OBJECT MODEL merely descriptive of the software with which applicant intends to use the mark.

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

E. W. Hanak

H. R. Wendel

D. E. Bucher

Administrative Trademark Judges,
Trademark Trial and Appeal Board

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