

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB MARCH 13, 00

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Cuba GmbH International Marketing Concept

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Serial No. 75/089,625

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Cecelia M. Perry of McGlew and Tuttle for Cuba GmbH  
International Marketing Concept

Cheryl S. Goodman, Trademark Examining Attorney, Law Office  
102 (Thomas Shaw, Managing Attorney)

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Before Seeherman, Walters and Bottorff, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Cuba GmbH International Marketing Concept has appealed the refusal of the Trademark Examining Attorney to register "Shape CD," shown in an upper and lower type format, for "a house mark for CD-Rom's with interactive multimedia programs or interactive media software," in Class 9, and for "booklets, pamphlets, and manuals for explaining or describing the CD-ROM's and compact discs as mentioned

above."<sup>1</sup> Exclusive rights to "CD" have been disclaimed apart from the mark. Registration has been refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its identified goods.

The appeal has been fully briefed. An oral hearing was not requested.

It is the Examining Attorney's position that SHAPE CD describes a feature of applicant's product, which is a regular compact disc (CD) that has been cut into a particular shape and size. Applicant has stated that it "will custom make a non-round CD to the specifications of its client." Response filed October 24, 1997.

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<sup>1</sup> Application Serial No. 75/089, 625, filed April 17, 1996, and claiming, in addition to an asserted bona fide intention to use the mark in commerce, a right of priority under Section 44(d) of the Trademark Act, based on an application filed in Germany on October 17, 1995. Applicant subsequently perfected its basis for registration under Section 44(e) by submitting a copy of the German registration. After reviewing the German registration the Examining Attorney stated that the mark shown in the drawing of the present application did not conform to the mark shown in the German registration because the U.S. application showed the mark as a typed drawing, in all capital letters, while the German registration showed the mark in a combination of upper and lower case letters, to wit: Shape CD. Applicant subsequently submitted an amended drawing, which the Examining Attorney accepted. However, the amended drawing does not appear to be in the file, and the Office's TRAM records continue to show the mark as a typed drawing. If applicant ultimately succeeds in this appeal, it will have to submit a copy of its amended drawing. Although the mark is Shape CD, in our opinion we will follow the conventional manner of depicting a trademark in all capital letters.

The Examining Attorney has submitted a number of excerpts taken from the NEXIS data base and from the Internet showing that the term "shaped CD" is used as a term for non-round compact discs:<sup>2</sup>

"So one shaped CD gives the consumer a unique souvenir with both perceptual and practical value..."

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The amount of data that a shaped CD can hold is contingent on how much space is left on the disc after the laser-shaping process is finished...

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The only other limitation of the shaped CD is that it is not recommended for use in vehicle CD systems...

"Billboard," January 16, 1999

Disney has also come out with a new holiday item, its first-ever shaped CD, titled "Holiday 1998." Shaped like Mickey Mouse, the \$3.99 title features new recordings...

"Billboard," November 21, 1998

For something that really stands out, it is hard to beat the shaped CD, whichat [sic] Sonopress can be

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<sup>2</sup> Applicant has objected to certain of the NEXIS submissions because two appear to be in foreign publications, and there is no indication as to whether they have been exposed to the consuming public in the United States. We agree with applicant, and those references have not been considered. Applicant has also questioned whether the publication "One to One" has a U.S. circulation because its copyright is held by a "PLC," which is a designation for a foreign corporation. If applicant believed this material should be excluded it should have provided the Board with a basis for excluding it, rather than mere speculation. Accordingly, we have considered the "One on One" submissions. We would add, though, that even if this material had not been considered it would not have affected our decision herein.

customised to virtually any specification.

"Music Week," October 24, 1998

...seven years that AZRA has been producing cut CDs, it has achieved a respectable marketing success: in 1990, a shaped CD was produced for Stardust Records using a latching process developed in-house.

"One to One," January 1998

This is a shaped-CD in the form of a candy heart with the words, "I Love You" on it.

Cable News Network Financial,  
December 23, 1997 6:20 p.m.

According to the magazine GEM (German Entertainment Market), the inventor of the shaped CD has, sadly, now filed for bankruptcy. Mario Koss, who came up with the idea of non-round CDs when he was ...

"One to One," June 1997

Sonopress is now producing its own trademarked version of the shaped CD—the CUT-CD—which can be used for all forms of audio replication. There are 500 "off-the-shelf" shapes...

"One to One," March 1997

Shaped CD's—they don't have to be round any more (headline)

The few shaped CD's on the market now are audio... You can also do a shaped CD with data, or data and CD audio tracks... And apparently many car audio CD players not only don't read shaped CD's but get jammed if you insert a shaped CD.

[Mmc@multimeidacross.com.au](mailto:Mmc@multimeidacross.com.au), From the Archive, week ending November 8, 1996

A shaped compact disc is a normal circular CD that has been cut into a particular shape and size.  
Website of Advanced Media Technologies LC., shapeshifters.net, © 1998

You're probably thinking, "OK, what exactly is a shaped CD? A shaped compact disc is a regular circular cd that has been cut into a particular shape and size. A German company once developed these now called "shaped discs" and they are quite visually engaging. There are no limits with shapes—from pictures of your favorite artists to the shape of a dragon's head, with its fangs and tongue sticking out in different directions!...

The most amazing aspect of the shaped CD is that it does not have to be round to play on our CD devices...

Shaped CD's are becoming a fast and growing phenomenon here in the United States and are starting to pop up in record stores nationwide.  
Noartificialflavor.com, © 1996

Articles about applicant's subsidiary, Shape CD Inc., contain the following statements:

The company, formed in April 1997, takes clients' artwork and, using computer-assisted design software and a computer-controlled routing device, sculpts the CD to fit the artwork. The result is CDs and CD-roms in the shape of backstage passes, corporate logos, and product themes, all of which take the configuration well beyond its original mission.

"The potential market for shaped CDs in retail, corporate, and entertainment

applications is amazing even to us," says company president Rod Lowenstein...

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But beyond the novelty of the shape are other benefits, adds Lowenstein... A recent promotion for Pepsi featured a CD in the shape of a backstage pass...

"So one shaped CD gives the consumer a unique souvenir with both perceptual and practical value...

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...Universal commissioned shaped CDs as promotional soundtrack pack-ins for the recent anniversary releases of the videos for "Animal House," "The Sting," and "American Graffiti."

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The amount of data that a shaped CD can hold is contingent on how much space is left on the disc...

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"The possibilities are almost as endless as the shapes themselves," [Lowenstein] says.

"Billboard, January 16, 1999

The two-year-old parent company, Creativity United By Artist GMBH [applicant], headquarters near Berlin, Germany, has thus far done both CD-Audio and CD-ROM shaped CDs for a variety of mostly corporate clients... Record labels have also been biting, and special promotional shaped discs have been issued in Europe, including one in the shape of rock star David Bowie's head. ...[The U.S. company has] a manufacturing plant in Kissimmee, FL, where seven employees can turn out up to 1.5 million shaped CDs per month. Dan Daley, "A New Shape for CDs," [www.kipnet.com](http://www.kipnet.com)

This evidence establishes that non-round compact discs or CD's are commonly referred to as "shaped CD's," and that

consumers for applicant's identified goods would readily understand the term "shaped CD" to refer to such a product. Applicant's argument that "most consumer's [sic] are not aware of non-round CD's," reply brief, p. 1, is not persuasive, since we must determine the question of mere descriptiveness from the standpoint of the purchasers of non-round CD's, which are applicant's goods, rather than purchasers of compact discs in general.<sup>3</sup> Nor are we persuaded by applicant's argument that SHAPE CD is an incongruous term because a disc, by definition, is round, and the "shape" of applicant's CD is not. The evidence of record clearly shows that the term "shaped CD's" is used to refer to non-round CD's, and that when the term "shaped" is used in this manner, consumers would readily understand it to mean a non-round disc.

Accordingly the question we must consider is whether, given the apt descriptiveness of "shaped CD" for non-round compact discs, consumers would view applicant's mark SHAPE CD as merely descriptive. Applicant argues that it is not correct to equate "shape" with "shaped"; that the words do

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<sup>3</sup> It is also not clear, given the statements in the NEXIS and Internet submissions about the use of shaped CD's for recordings of various popular artists, that those members of the general public who purchase CD's are not aware of shaped CD's.

not have identical meanings, and are not phonetic equivalents.

We disagree. It is well established that a mere misspelling of a word will not turn a descriptive word into a non-descriptive mark. See J. McCarthy, McCarthy on Trademarks, § 11.31 © 1999), and cases cited therein. The Examining Attorney has discussed a number of these cases in her brief, and we will not repeat what is set forth there. The terms SHAPE CD and "shaped CD" are so phonetically similar that one would have difficulty distinguishing one from another when they are used in sentences. See, for example, **American Druggists' Syndicate v. United States Industrial Alcohol Co.**, 2 F.2d 942 (DC Cir. 1924), in which AL-KOL was found to be the phonetic equivalent of "alcohol," and therefore was held to be merely descriptive of rubbing alcohol. SHAPE CD has an even closer phonetic similarity to "shaped CD" than AL-KOL has to "alcohol." See also, Restatement (Third) of unfair Competition, § 14, comment a (1995), "The mere misspelling or corruption of an otherwise descriptive word will not ordinarily alter the descriptive character of the designation. In many instances the contrivance will not overcome the ordinary meaning of the term, and prospective purchasers will thus

continue to understand the designation in a purely descriptive sense."

A term is merely descriptive under Section 2(e)(1) of the Trademark Act if it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of a product or service. **In re Venture Lending Associates**, 226 USPQ 285 (TTAB 1985). When consumers of shaped CDs view the mark SHAPE CD in connection applicant's CD's, they will immediately understand that SHAPE CD refers to the non-round shape of the goods. Accordingly, we find that applicant's mark SHAPE CD is, at the very least, merely descriptive of its CD-ROM's. Further, because these CD-ROM's are the subject matter of applicant's written materials in Class 16, it is merely descriptive of these goods as well.

In addition to the descriptiveness of SHAPE CD as a mere misspelling of the common descriptive term for the goods, the evidence of record also shows that the non-round shape of applicant's goods is a significant feature of them. Accordingly, SHAPE CD is merely descriptive of applicant's goods for this reason also.

Finally, applicant has argued repeatedly that "shape" is not merely descriptive because every object has a shape, and that the Office has issued a number of third-party

registrations for marks containing the word SHAPE and, by analogy, SOLID and PROFILE. The difference between those marks and the present situation, however, is that in this case we have clear evidence that the term commonly used to describe applicant's goods is "shaped CD." We do not hold applicant's mark to be merely descriptive simply because applicant's goods have a shape, but because consumers will understand, upon seeing SHAPE CD for applicant's goods, that they are shaped CD's and further, because the non-round shape of the CD is a significant feature of them.

Decision: The refusal of registration is affirmed.

E. J. Seeherman

C. E. Walters

C. M. Bottorff  
Administrative Trademark Judges  
Trademark Trial and Appeal Board