

Hearing:

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RFC

THIS DISPOSITION IS NOT

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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Aiwa Co., Ltd.

Serial No. 75/162,058

Lisa A. Dunner of Pillsbury Madison & Sutro for Aiwa Co., Ltd.

Rita Odin, Trademark Examining Attorney, Law Office 109
(Ronald Sussman, Managing Attorney).

Before Cissel, Hairston and Bucher, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On September 6, 1996, applicant, a Japanese company, applied to register the mark "EXPANDED STEREO IMAGING SYSTEM" on the Principal Register for "audio apparatus, namely, combined radio receiver, cassette deck, compact disc player, amplifier, turntable and speaker system; radios, record players, mini disc recorders, mini disc players; car stereo equipment; namely, car radios, car

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stereo receivers, car audio cassette players, and car compact disc players; combined radio and clock; stereo tuners; microphones; stereo amplifiers; headphones; antennas; earphones; loudspeakers; video tape recorders; video tape players; video cameras; video disc players; television receiving sets and video tape recorders; computers, modems and computer hardware; namely, microcomputers, computer data backup apparatus and computer data storage apparatus; blank video tapes; compact discs featuring musical entertainment; and computer software for use in the field of data storage subsystems, accounting and telecommunications," in Class 9. The basis for the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce on the specified goods.

The Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's proposed mark merely describes a desirable feature of the goods with which applicant intends to use the mark. In support of the refusal, she attached a number of excerpts from published articles retrieved from the Nexis® automated database. Typical examples of these excerpts include the following: "... a passive speaker design which can be used with a traditional amplifier to produce

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an expanded stereo image..."; "...3-D stereo allows me to showcase soloists in their own audio space with enhanced clarity and presence as well as an expanded stereo image,' explains Grammy award-winning production mixer Ed Greene, who first utilized Spatializer technology..."; "With this technology, I'm able to use expanded stereo imaging to position the individual instruments realistically and bring Bonnie's vocal presence forward in the audio spotlight..."; "The Digital Spatializer® is a real time two-channel processor that provides precise control of expanded stereo imaging and realistic stereo synthesis from mono sources..."; and "In both professional and consumer audio equipment, B.A.S.E. provides a stunning effect--the stereo image is expanded in front of and behind the loudspeakers, and the audio appears from positions outside each speaker location."

Applicant responded to the refusal to register by disclaiming exclusive rights in the words "STEREO" and "SYSTEM" apart from the mark shown, by amending the identification-of-goods clause to read "headphone stereos," and by presenting arguments that the mark it seeks to register is not merely descriptive of headphone stereos.

Attached to the applicant's response were copies of two third-party registrations of trademarks for audio loud-

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speakers. One, Registration No. 1,483,157, which issued on April 5, 1988, but was subsequently canceled under Section 8 of the Act, included the slogan "a stereo image you don't have to imagine." The other, Registration No. 1,938,939, which issued on November 28, 1995, is for the trademark "WIDE IMAGING STEREO." Only the term "STEREO" was disclaimed apart from the mark in that registration.

The Examining Attorney was not persuaded by the arguments or evidence submitted by applicant, and the refusal to register was made final with the second Office Action. The Examining Attorney maintained that the mark applicant intends to use would be understood to be merely descriptive of headphone stereos because "expanded stereo imaging is used to position the individual instruments realistically and bring vocal presence forward in the audio spotlight. With this technology, stereo material can be both expanded and localized[,] making music sound as if it is coming from all around the listener." She attached to the final refusal excerpts from two audiophile magazines wherein the terms "stereo imaging" and "imaging system" are used in connection with various stereo speakers.

Additional evidence retrieved from the Nexis® and DIALOG® databases and from the Internet was also attached. Examples include the following: "...passive speaker design

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which can be used with any traditional amplifier to produce an expanded stereo image"; and references to "expanded stereo sound," "expanded stereo sound field," and "expanded stereo experience."

Applicant appealed the final refusal to register. The case was fully briefed, and both applicant and the Examining Attorney argued at the oral hearing before the Board.

Based on careful consideration of the record and arguments before us in this case, we hold that the refusal to register is well taken.

The test for determining whether a trademark is unregistrable under Section 2(e)(1) of the Act because it is descriptive of the products with which it is used, or is intended to be used, is well settled. Refusal to register under this section of the Act is proper if the term describes or immediately conveys information about a characteristic, function, feature or purpose of goods. In *re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); In *re Bight-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).

In the case at hand, the record before us clearly establishes that if it were used in connection with headphone stereos, the term "EXPANDED STEREO IMAGING SYSTEM" would immediately convey significant information to

prospective purchasers of such products, namely that they incorporate the technology to provide expanded stereo imaging. Although applicant argues to the contrary, the materials made of record by the Examining Attorney plainly show that the term sought to be registered has a readily understood meaning in the audio industry. Although the evidence does not show the phrase sought to be registered used to describe headphone stereos specifically, the evidence does show use of this phrase to describe speakers and other technology used to reproduce sound. In view of the fact that a headphone stereo necessarily incorporates some sort of miniature speaker system which reproduces sound in the same sense that a bookshelf speaker system does, we find that the evidence of record which shows descriptive significance for the term in connection with "speakers" or "loudspeakers" demonstrates the descriptive significance the term would have with respect to headphone stereos as well.

Applicant contends that the proposed mark is an incongruous combination of words, but the record does not support this argument. Although some of the articles and excerpts submitted by the Examining Attorney are not relevant to our analysis, there are examples provided wherein the precise wording sought to be registered is used

in connection with speakers or audio technology. In view of the relatively recent development of this technology and the fact that the ordinary meanings of these individually descriptive words do not lose their descriptive significance when the words are combined, applicant's arguments are not persuasive. Contrary to the contentions of applicant, the term sought to be registered does not "create a separate, nondescriptive meaning as a result of an incongruous juxtaposition of terminology..." (brief, unnumbered p. 3), nor does the record support the contention of applicant that, at most, applicant's proposed mark might be considered to be suggestive of headphone stereos because imagination, thought and perception would be required to reach a conclusion based on the term sought to be registered as to the nature of the goods. Applicant has not established that a consumer would need to use significant thought processes to conclude, from consideration of the proposed mark in connection with the goods specified in the application, that the products were systems designed to provide expanded stereo imaging.

Further, applicant's arguments with respect to the two third-party registrations are also unavailing. As noted above, the first registration has been canceled. The second registration argued by applicant involves a

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different mark for goods which are different from the goods specified in the instant application, but the mark therein does appear to be similar in some ways to the mark at issue in this case. It is well settled, however, that the Trademark Trial and Appeal Board is not bound to adopt the position apparently taken by an Examining Attorney with respect to an earlier-filed application. In re John Harvey & Sons Ltd., 32 USPQ2d 1451 (TTAB 1994). Our decision must be based on the particular record before us in each case, and, as discussed above, the record in the case at hand supports the conclusion that the term sought to be registered, if used in connection with headphone stereos, would immediately convey to prospective purchasers that the goods incorporate technology that results in expanded stereo imaging.

Accordingly, for the reasons set forth above, the refusal to register under Section 2(e)(1) of the Act is affirmed.

R. F. Cissel

P.T. Hairston

D. E. Bucher

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Administrative Trademark Judges,
Trademark Trial and Appeal Board

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