Paper No. 12
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re QUALCOMM Incorporated

Serial No. 75/183,251

Russell B. Miller, Brian S. Edmonston and Thomas R. Rouse for QUALCOMM Incorporated.

Anil V. George, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Hohein, Bucher and Rogers, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

QUALCOMM Incorporated, a Delaware corporation, has filed an application for registration of the mark "PUREVOICE" for a "computer hardware signal compression and decompression vocoders, namely, voice coders and decoders sold as components of telephones; computer software for signal compression and decompression." in International Class 9.[1]

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that,

[1] Serial No. 75/183,251, filed on October 17, 1996, claiming use since September 1994 and first use in interstate commerce on September 15, 1996.

when used in connection with applicant's goods, the mark "PUREVOICE" is merely descriptive of them.

Applicant has appealed the final refusal to register. Briefs have been filed, but applicant did not request an oral hearing. We reverse the refusal to register.

It is well settled that a term or phrase is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *See In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). Whether a term is merely descriptive is determined not in the abstract but in relation to the goods for which registration is sought, the context in which it is being used on those goods and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use. *See In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

However, a mark is suggestive if, when the goods are encountered under the mark, a multi-stage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. *See*, *In re Abcor Development*

Corp., *supra* at 218, and *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1349 (TTAB 1984). There is often a thin line between a suggestive mark and a merely descriptive designation. In real life, it is sometimes difficult to divine the exact metes and bounds separating the highly suggestive mark from the merely descriptive term, forcing tribunals in this subjective area to rely heavily upon their collective intuitions. *See*, *In re Atavio*, 25 USPQ2d 1361, 1362-1363 (TTAB 1992); *In re TMS Corp. of the Americas*, 200 USPQ 57, 58 (TTAB 1978); and *In re George Weston Ltd.*, 228 USPQ 57, 58 (TTAB 1985).

In support of his position, the Trademark Examining Attorney has submitted excerpts from a dozen LEXIS/NEXIS® articles where "PureVoice" or "pure voice" appear. We note that three of these "PureVoice" references are to PCS[2] handsets incorporating applicant's "PureVoice" codec.[3] The other nine stories do indeed use the terms "pure" followed immediately by the word "voice." However, as applicant points out, in each of these articles, the writer is distinguishing "voice-only" transmissions from combinations of voice-data-text-video, etc., or from voice-over-frame transmissions, or to refer to the development of real-time Internet Protocol (IP) telephony. Accordingly, we find that this part of the record does nothing

[2] "PCS" is short for "Personal Communications System," the term in this country for a "Personal Communications Network," or "PCN."

[3] The word "Codec" appearing in the LEXIS/NEXIS® articles, is a shorthand expression for a coder/decoder algorithm like applicant's.

to support the refusal for descriptiveness made by the Trademark Examining Attorney.

The Trademark Examining Attorney has also made of record and relies upon definitions of the following terms:

> (a) the word "pure" which *The American Heritage® Dictionary of the English Language, Third Edition,* defines in relevant part as an *adjective meaning:* "**1.** Having a homogeneous or uniform composition; not mixed: *pure oxygen.* **2.** Free from adulterants or impurities: *pure chocolate.* **3.** Free of dirt, defilement, or pollution; **4.** Free of foreign elements. **5.** Containing nothing inappropriate or extraneous: *a pure literary style.* … **11.** *Music*. Free from discordant qualities: *pure tones.* **12.** *Linguistics*. Articulated with a single unchanging speech sound; monophthongal: *a pure vowel…*"
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> (b) the word "voice" which *The American Heritage® Dictionary of the English Language, Third Edition,* defines in relevant part as a noun meaning: "**1. a.** The sound produced by the vocal organs of a vertebrate, especially a human being. **b.** The ability to produce such sounds. **2.** A specified quality, condition, or pitch of vocal sound: *a hoarse voice; the child's piping voice.* **3.** *Linguistics*. Expiration of air through vibrating vocal cords, used in the production of vowels and voiced consonants. **4.** A sound resembling or reminiscent of vocal utterance: *the murmuring voice of the forest.* **5.** *Music*. **a.** Musical sound produced by vibration of the human vocal cords and resonated within the throat and head cavities. **b.** The quality or condition of a person's singing: *a baritone in excellent voice.* **c.** A singer: *a choir of excellent voices.* **d.** One of the individual parts or strands in a composition: *a fugue for four voices; string voices carrying the melody.* Also called *voice part…*"; and,
>
> (c) the word "vocoder" which *Newton's Telecom Dictionary* defines in relevant part as "…(Voice coders) use a speech analyzer to convert analog waveforms into narrowband digital signals. They are used in digital cellular phones … to transmit digitally encrypted speech signals over normal narrowband voice communications channels. These devices are used to reduce the bandwidth requirements for transmitting digitized speech signals…"

Based upon this evidence, the Trademark Examining Attorney contends that the term "PUREVOICE" is merely descriptive because:

> As the Applicant's goods are used, exclusively, to carry voice traffic over telephone networks and global computer information networks, the wording "PUREVOICE" merely describes a characteristic of the relevant goods… (Trademark Examining Attorney's appeal brief, p. 3).
>
> The combined wording "PUREVOICE" is a laudatory phrase that is descriptive of the Applicant's voice transmission hardware and software. In the context of the relevant goods, the telecommunications and dictionary evidence of record indicate that "PUREVOICE" is synonymous with wording such as "clear," "distortion-free," "noiseless," "clean," "perfect," "unadulterated," and "noiseless," (sic) which wording the Applicant concedes is descriptive of the relevant goods. (Trademark Examining Attorney's appeal brief, pp. 4 - 5).

On the other hand, applicant maintains that "PUREVOICE" is, at worst, suggestive of applicant's goods:

> Applicant's PUREVOICE mark suggests the clarity and quality of voice transmissions … The term "pure" is typically associated with materials, compounds, and other tangible products, and not with the signal processing arts. Thought and imagination are therefore required to determine the nature and function of applicant's goods. (Applicant's brief, p. 5).

Further, applicant argues that at no time during the course of prosecuting this application has the Trademark Examining Attorney provided any substantial evidence that the mark is descriptive. On this point, we agree that the Office has failed to make a *prima facie* case for descriptiveness.

The goods as set forth in the identification of goods involve both integrated circuits (hardware embedded with complex compression and decompression software) that are critical

components of wireless telephone handsets, as well as similar compression and decompression software, but which is apparently not restricted to use in wireless telephone handsets. This listing could clearly include, for example, PureVoice™ encoder technology that efficiently compresses and decompresses voice data for computer users on the Internet.

Keeping the above distinctions in mind, it also appears that the Trademark Examining Attorney has put forth two somewhat different theories for mere descriptiveness. The first paragraph from the Trademark Examining Attorney's brief as cited above (from page 3 of his brief), seems to be grounded on the "voice-only" usages reflected in the LEXIS/NEXIS® excerpts. By contrast, the second above-cited paragraph (from pages 4 and 5 of his brief) refers to several dictionary entries in arguing that the combination of words, "Pure Voice," is the equivalent of an admitted descriptor like "distortion-free." We find neither of these arguments compelling as applied to the two types of goods on which applicant is using its mark.

In an attempt to understand better the underlying technology as it is applied to PCS telephone handsets, we return to the definition quoted above for the word "vocoder." This definition submitted by the Trademark Examining Attorney is entirely consistent with applicant's identification of goods, and the specimens of record.

As seen in the definition of record, if the human voice is to be transmitted via wireless telecommunication devices, the initial step is to translate voice signals into a digital approximation through Analog-to-Digital Conversion (ADC).

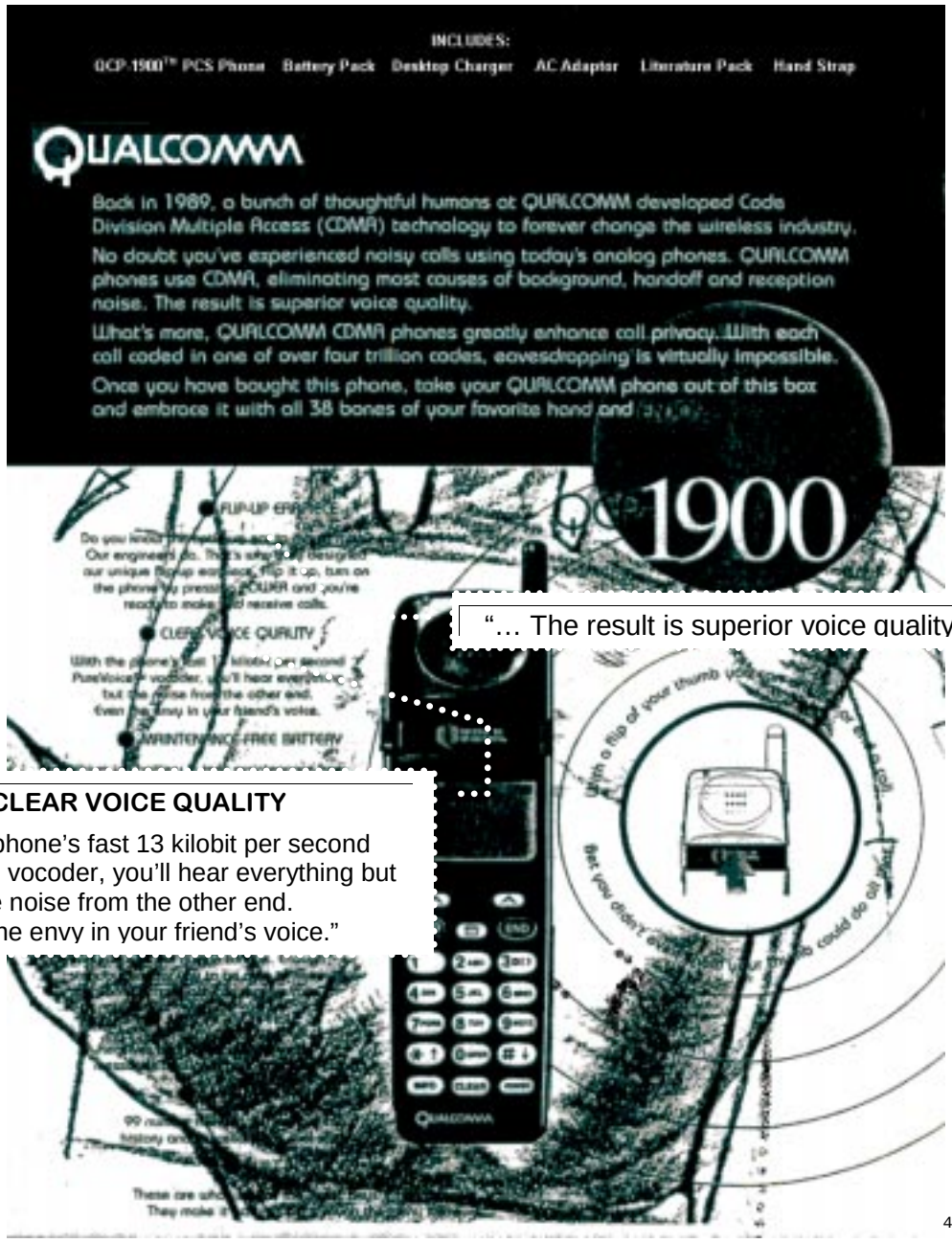
The recited definition further suggests that digital signal processing (both ADC and the further encryption, compression, etc., of these signals) involves complex technology relying upon super-fast, number-crunching processors.

Finally, this definition helps to explain the instant technology within a real-world business environment. The "bottom line" in any business is to make a profit. Telecommunication companies compete for finite bands of the radio spectrum at auctions conducted by the Federal Communications Commission. To increase capacity, wireless service providers compress the human voice using speech coding. Speech coding is the process of digitally encoding voice signals for the purposes of storage or transmission. By digitizing speech and using powerful compression algorithms (also known as speech coders, voice coders or vocoders), the bit rate required for speech storage or transmission can be greatly reduced. Thus the performance of the speech coder directly determines system capacity and the amount of revenue that can be generated. In a mobile environment, the primary goal of speech coding is to

provide acceptable voice quality at the lowest bit rate possible and at the lowest cost.

We also learn about one particular handset and the way applicant uses its mark in commerce from the file copy of the actual packaging for the QUALCOMM® telephon

"... QUALCOMM developed Code Division Multiple Access (CDMA) technology ..."



Applicant argues that its high-rate vocoder achieves optimal compression. Applicant touts its own technology, incorporated into its Qualcomm® brand handsets (s*ee, e.g.*,

[4] The specimens of record are from applicant's model QCP-1900 telephone handset. This appears to be a shortened form of QCELP [Qualcomm Code(book) Excited Linear Prediction] vocoder for a 1900MHz PCS. As the specimens also explain, in 1989, applicant pioneered CDMA

reprint of specimens of record above), and into many of the digital integrated circuits of an ever-increasing number of wireless telephone handsets (having other brand names) in this country, as achieving superior sound quality along with remarkable power-efficiencies.

As to whether the term “pure voice,” in the sense of “voice-only,” is merely descriptive of voice coders and decoders sold as components of wireless telephones, we find that the Trademark Examining Attorney has established only that “pure voice” is sometimes used to mean “voice-only” in computer network settings. However, he has not established that the combined term is descriptive in the general field of digital signal processing or as applied to applicant’s specific goods. The fact that the words “pure voice” may be understood and used to refer to a “voice-only” network does not establish that it is likewise descriptive of speech coding technology (e.g., voice coders and decoders) embedded in digital wireless communications products,[5] even if there exists some relationship between these

(Code-Division Multiple Access) technology -- now the dominant technology for digital telephones in the United States.

[5] Furthermore, to the extent that applicant intends for this mark to imbue its products with positive attributes, it could well be seen as a negative feature if potential consumers of applicant’s PCS handsets were inclined to pick up the connotation of “voice-only” from the designation “PureVoice.” This is true because an ever-increasing percent of mobile telephones are designed to receive data. Accordingly, over the next number of years, one can anticipate that mobile electronic devices will continue to evolve, permitting easier bundling of new mobile data devices and services with voice services.

goods. *See In re The Stroh Brewery Co.*, 34 USPQ2d 1796, 1797 (TTAB 1994) [showing that the word "virgin" is descriptive of cocktails did not prove that it was likewise descriptive of non-alcoholic malt beverages].

With respect to whether the term "pure voice" is equivalent in meaning to such terms as "distortion-free" or "noiseless" and hence is merely descriptive of voice coders and decoders sold as components of wireless telephones, the Trademark Examining Attorney never cites specifically to any of the dictionary entries of "pure" or "voice" listed above, as making his case. On this point, we also agree with applicant: "Applicant can discern nothing of relevance in these dictionary definitions." (Applicant's brief, p. 6).

While, of course, laudatory terms which attribute quality or excellence to goods may be merely descriptive of the goods on which they are used, a term is merely descriptive if it *immediately* describes an ingredient, quality, characteristic or feature of the goods or services, or if it *directly* conveys information regarding the nature, function, purpose or use of the goods or services. *See In re Abcor, supra* at 217–18. For example, applying this test to other hypothetical marks for the

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Carriers will migrate from voice-only services to mobile information, and then ultimately, mobile e-commerce.

present goods, we have no question but that "distortion-free" or "noiseless" would be merely descriptive thereof.

By contrast, we believe that applicant's mark "PUREVOICE" does not directly describe applicant's goods, but only suggests the voice quality associated with the use of its compression and decompression technology. We agree that it requires a multi-stage reasoning process or imagination in order for customers or prospective purchasers of applicant's voice coders and decoders to be able to ascribe any particular significance to the phrase "PUREVOICE" when used in connection with these goods.

This conclusion is buttressed by the fact that this term does not appear to be needed by applicant's competitors in order to describe their products as it has not been shown that any third party in the intensely competitive field of wireless communications has used it in this manner. *See* *Minnesota Mining and Mfg. Co. v. Johnson & Johnson*, 454 F.2d 1179, 172 USPQ 491 (CCPA 1972) ["SKINVISIBLE" for transparent medical adhesive tape is not needed by competitors]; *Sperry Rand Corp. V. Sunbeam Corp*., 442 F.2d 979, 170 USPQ 37 (CCPA 1971) ["LEKTRONIC" for electric shavers not needed by competitors]; *Aluminum Fabricating Co. of Pittsburgh v. Season-All Window Corp*., 259 F.2d 314, 119 USPQ 61, 63 (2d Cir. 1958) [mark "SEASON-ALL," unlike the term "ALL-SEASON," is not merely descriptive of aluminum storm windows and doors]; *In re Reynolds Metals Co*.,

480 F.2d 902, 178 USPQ 296 (CCPA 1973) [registration of "BROWN-IN-BAG" for transparent plastic bags is suggestive as it will not prevent competitors from informing buyers that goods may be browned in their bags]; *Dewalt, Inc. v. Magna Power Tool Corporation/Yuba Consolidated Industries, Inc.*, 289 F.2d 656, 129 USPQ 275 (CCPA 1961) [opposer had used the words "POWER SHOP" descriptively in connection with the sale of multiple-purpose woodworking saws].

Here, as the specimens of record emphasize, applicant's own CDMA technology amplifies certain frequencies and suppresses others, encrypts information, and filters out interference, fading, cross-talk and background noise for PCS users. In this respect, while applicant concedes that the mark "PUREVOICE" suggests that applicant's goods ensure crystal-clear voice quality, it persuasively contends that such mark does not forthwith convey, with sufficient particularity, the purpose, function or use of applicant's goods or describe any significant aspect, feature or quality thereof.

The instant record is most unclear as to whether the term "pure voice," in the sense of "voice-only," is merely descriptive of computer software for signal compression and decompression, although this may indeed be the closest question with which we are faced herein. For example, in an effort to encourage Internet computer users to purchase applicant's

proprietary compression and decompression software and unique computer file formats, applicant might well tout its product as superior in recording, transmitting and/or reproducing the human voice ("pure voice" or "voice-only") most accurately.[6] In this event, one could argue that this points to a claimed benefit of using applicant's software in a manner that is violative of Section 2(e)(1) of the Lanham Act. However, we should hasten to add that while it appears as if the Trademark Examining Attorney entertained this argument,[7] there is no evidence to support such a theory within the record of this proceeding.

Finally, with respect to whether the term "pure voice" is equivalent to "distortion-free" or "noiseless" and hence is merely descriptive of computer software for signal compression and decompression for networked computers, we find nothing in the record, as was the case above with applicant's voice coders and decoders sold as components of wireless telephones, to support such an interpretation.

However, to the extent that we retain any doubt as to whether applicant's mark is merely descriptive or suggestive of its goods, we resolve such doubt, in accordance with the Board's

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[6] By contrast, other computer software for signal compression and decompression may fare better than does applicant's with non-speech sounds like music or special sound effects.

[7] "… As some of the applicant's goods may be used in connection with network services, it would appear that the proposed mark describes a feature of the applicant's goods…" (Office Action of December 15, 1997, p. 1).

practice, in favor of the publication of applicant's mark for opposition. *See*, *In re Morton-Norwich Products, Inc*., 209 USPQ 791 (TTAB 1981); *In re Gourmet Bakers, Inc*., 173 USPQ 565 (TTAB 1972); *In re Atavio Inc*., 25 USPQ2d 1361, 1363 (TTAB 1992); and *In re Rank Organization Ltd*., 222 USPQ 324, 326 (TTAB 1984).

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

G. D. Hohein

D. E. Bucher

G. F. Rogers

Administrative Trademark Judges, Trademark Trial and Appeal Board