

THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re International Business Machines Corporation

Serial No. 75/183,983

Alexander Tognino for IBM Corporation.

Paula B. Mays, Trademark Examining Attorney, Law Office 114
(Margaret Le, Managing Attorney).

Before Chapman, Wendel and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

International Business Machines Corporation, a New York corporation, has filed an application for registration of the mark "SURFACE LAMINAR CIRCUIT" for "computer hardware, namely printed circuit boards and cards, utilizing a dielectric for circuit design and interconnection." ¹

The Trademark Examining Attorney issued a final refusal to register based upon Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that if applicant's proposed

¹ Serial No. 75/183,983, filed October 18, 1996, alleging a *bona fide* intention to use the mark in commerce.

mark were used in connection with these goods it would be merely descriptive thereof.

Applicant has appealed the refusal to register based upon the alleged merely descriptive nature of the mark. Briefs have been filed, but applicant did not request an oral hearing. We affirm the refusal to register.

A mark is unregistrable under Section 2(e)(1) of the Trademark Act as merely descriptive of the goods with which it is used if it immediately and forthwith conveys information about the characteristics, features or functions of those goods. See In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

The Trademark Examining Attorney has submitted dictionary entries of each of the words in the mark and has placed in the file newspaper articles and excerpts from patent documents where these words appear.² From this literature and from the patents we learn that printed circuit (wiring) boards are an integral part of electronic equipment. Applicant has been in the forefront of continuing efforts to increase the interconnection density and electrical efficiency of printed circuit boards, thereby decreasing their size and cost. Applicant's boards are

² These entries include excerpts from patent documentation extracted from the Dialog® database, as well as articles taken from printed publications found in the LEXIS® database.

multi-layer printed circuit boards having a plurality of interleaved parallel planar copper and glass epoxy layers. With the constant drive for further miniaturization in the size of computerized components, one result in recent years has been chip sized packaging which satisfies a variety of requirements including a high density of electrical circuitry, high performance, reliability and low cost.

Taking all of this evidence together, the Trademark Examining Attorney contends that the wording "... SURFACE LAMINAR CIRCUIT merely identifies a feature and characteristic of the applicant's goods; specifically that the applicant offers circuit boards featuring surface laminar layer technology." (Trademark Examining Attorney's appeal brief, p. 4).

By contrast, applicant argues that when taken as a whole, this mark is not merely descriptive:

... The combination "Laminar Circuit" may mean a complete path of an electrical current which path is contained in layers, although the nature of the layers is not clear. It is also not clear what "Surface" means in relation to "Laminar Circuit"; "Surface" tends to mean the surface but "Laminar" tends to mean the layers themselves. SURFACE LAMINAR CIRCUIT could mean that the circuit is formed entirely on the surfaces of the different layers of the board or card. However, SURFACE LAMINAR CIRCUIT could also mean that the entire circuit is formed within the outermost layer of the board or card. SURFACE LAMINAR CIRCUIT could also mean something apart from the actual layers of the board or card - an integrated circuit which is formed as a diffused surface layer of a flat silicon substrate. (The

integrated circuit may be mounted on the board or card). Because the meaning of SURFACE LAMINAR CIRCUIT is not clear, and SURFACE LAMINAR CIRCUIT can have different meanings, it cannot be merely descriptive. It does not give the immediate, clear description of a feature or characteristic of the goods. (Applicant's brief, p. 2).

Many of the articles cited by the Trademark Examining Attorney reference applicant's proprietary technology that applicant claims improves upon the standard printed wiring board. This process provides a high-density surface layer, permitting a direct chip attach process in soldering computer chips directly onto the contacts of the circuit board. This denser wiring permits product density, small size and light weight.³ The patent claims demonstrate that the most significant feature of this circuit board consists of two thin film layers on the surface of a conventional printed circuit board, and as a result, the enhanced capabilities of the top surface of wiring.

The dictionary entries for "laminar" and "circuit" are as follows:

"Laminar: composed of, or arranged in, laminae."

"Laminae: a thin plate, scale or layer"

³ "As a result of the method of this invention, it is possible to provide a very high wiring density of electrically conductive conductors ... only in those regions of the printed circuit board in which semiconductor components are to be attached directly, e.g., in regions with very high requirements regarding I/O density." Patent No. 5,401,909.

"Circuit: the complete path of an electric current...⁴"

Consistent with these definitions, applicant discusses the relationship of the words "laminar" and "circuit," as follows:

"The combination 'Laminar Circuit' may mean a complete path of an electrical current which path is contained in layers..."

Indeed, conventional electronic circuit boards are composed of multiple layers of circuitry. However, the stackable multilayers within this subcomposite are not a distinctive feature of this innovation or of the goods sold under applicant's applied-for-trademark. Rather, in the case of applicant's circuit boards, the "surface laminar circuit" process applies a suitable photosensitive dielectric film to the surface of the board, and then subjects these new surface layers to a complex series of manufacturing steps (likely relevant in a patent infringement case, but well beyond the level of detail required to resolve the trademark issues herein)⁵ involving multiple plating and etching processes. This innovative circuitry consists of an external copper conductive layer separated from another copper conductive layer in the sub-region

⁴ Random House Compact Unabridged Dictionary, Second Edition, pp. 1078, 374 (1996). We also take judicial notice of another definition for the word "Circuit" **a.** A closed path followed or capable of being followed by an electric current. **b.** A configuration of electrically or electromagnetically connected components or devices." *The American Heritage® Dictionary of the English Language, Third Edition* ©1992 by Houghton Mifflin Company.

by a polyamide (e.g., a polymer like nylon). It is critical to this process that the two copper layers have distinctly different wiring densities.

Accordingly, whether one is focusing on the subcomposite of the conventional circuit board, or the new high-density surface of applicant's circuit board (after it has undergone the process described above), it seems that "laminar circuit" clearly describes this plating or layering of contrasting materials within printed circuits.

We conclude then, that the issue of contention between applicant and the Trademark Examining Attorney is whether the entire matter remains descriptive with the addition of the word "surface" to the beginning of the term "laminar circuit."

The Trademark Examining Attorney made of record the following definition of the word "surface":

"Surface: the outer face, outside, or exterior boundary of a thing; outermost or uppermost layer or area."⁶

Applicant argues that "surface" and "laminar" connote different parts of the printed wiring board. However, the word "laminar" means generally to arrange in layers or plates. Its meaning is not restricted to the inner layers. Rather, the word "laminar" leads inextricably to "laminae" which means "thin

⁵ Interestingly, one of the claimed steps in the patent involves a "vacuum laminating press."

plate" or "thin layer." As the evidence demonstrates, the critical feature of this particular circuit board has to do with the improved architecture or structural design of the surface layer. Furthermore, as noted above, the "thin layer" that comprises the "surface layer" involves multiple plating processes and a vacuum laminating press.

Logically then, in taking the three words as a whole, there is no incongruity here at all. The mark as a whole highlights the feature of the printed wiring board's circuitry that makes this product innovative, namely the circuitry within the thin surface layer, which manufacturing process involves even further plating, laminating, and/or layering of various materials.

Finally, applicant points out that most of the printed citations in the LEXIS/NEXIS articles are a direct reference to applicant's process or goods. Although this is an intent to use application where no amendment to allege use has yet been filed, the evidence of record suggests that this term has been widely used by applicant for years in connection with its proprietary processes and printed circuit boards/cards. We agree that the majority of the references made of record by the Trademark Examining Attorney appear to reflect applicant's technology. However, the sole issue herein, under Section 2(e)(1) of the

⁶ Random House Compact Unabridged Dictionary, Second Edition, p. 1914 (1996).

Trademark Act, is whether in combining these three common, English-language words, applicant has coined a composite term having a new and separate, non-descriptive meaning. To the contrary, we conclude that the individual words, when joined to form the term "SURFACE LAMINAR CIRCUIT," retain a meaning identical to the connotation which ordinary usage would ascribe to these words in combination. See In re Intelligent Instrumentation, Inc., 40 USPQ2d 1792 (TTAB 1996) ["VISUAL DESIGNER" immediately describes significant purpose or function of these computer programs since the combined term provides nothing incongruous, indefinite or new]. Similarly, as the Trademark Examining Attorney argues, the relevant purchasers and users of applicant's circuit boards, who are sophisticated and technologically knowledgeable, would readily understand this term. Hence, the record compels us to conclude that the term "SURFACE LAMINAR CIRCUIT" is merely descriptive of these goods.

Decision: We affirm the refusal of the Trademark Examining Attorney to register this matter under Section 2(e)(1) of the Act.

B. A. Chapman

Serial No. 75/183,983

H. R. Wendel

D. E. Bucher

Administrative Trademark
Judges, Trademark Trial and
Appeal Board