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Paper No.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re IA Corporation

\_\_\_\_\_  
Serial No. 75/419,109

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Elliot B. Aronson, Esq. for IA Corporation.

Dominic J. Ferraiuolo, Trademark Examining Attorney, Law Office  
102 (Thomas V. Shaw, Managing Attorney).

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Before Hanak, Hohein and McLeod, Administrative Trademark  
Judges.

Opinion by Hohein, Administrative Trademark Judge:

IA Corporation has filed an application to register  
the mark "INFOXTRACT" for "computer software for extracting  
selected data content from computer formats, namely, print data

streams, report formats and database formats, and user manuals sold as a unit."<sup>1</sup>

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

Applicant has appealed. Briefs have been filed, but an oral hearing was not held. We reverse the refusal to register.

By way of background, applicant notes that its goods are what are more commonly known as "data mining" programs. As explained by applicant:

This type of software is typically used by large enterprises that have large computerized archives of data about their customers, vendors, and business operations. The software is used to search the company's data stores and retrieve data meeting specified criteria. Large enterprises usually have massive amounts of data stored in various places on a number of computers and in a variety of formats[, ] ranging from common database formats for commercially popular database software to customized report formats specific to the enterprise, that are usually being continually revised. The identification of the goods enumerates print data streams, report formats and database formats to convey the idea that [the] software is intended to be used for such massive collections of varied data.

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<sup>1</sup> Ser. No. 75/419,109, filed on January 16, 1998, which alleges a bona fide intention to use such term in commerce.

Search and retrieval software used to deal with such a problem has come to be referred to in the industry as "data mining" software. ....

While further noting that the Examining Attorney, in support of the refusal to register, has made of record definitions from Webster Dictionary (1999) which define "info" as a noun meaning "information" and list "extract" in relevant part as a verb signifying "**1 a** : to draw forth (as by research) <extract data>" and "**5 a** : to select (excerpts) and copy out or cite," applicant maintains that the mark "INFOXTRACT" is not merely descriptive of a feature, purpose or use of its goods, as contended by the Examining Attorney, but is only suggestive thereof. Citing language from *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980), that (footnote omitted) "[a] mark is merely descriptive if it immediately conveys to one seeing or hearing it knowledge of the ingredients, qualities, or characteristics of the goods or services with which it is used; whereas, a mark is suggestive if imagination, thought, or perception is required to reach a conclusion on the nature of the goods or services," applicant insists that mere descriptiveness of a mark "requires immediacy in the conveyance of the feature, purpose or use" of the associated goods or services. According to applicant, if a mark "requires a modicum of imagination or thought before one is able

to determine the nature of applicant's product," then the mark is at most highly suggestive of the goods or services with which it is used, citing *BellSouth Corp. v. Planum Technology Corp.*, 14 USPQ2d 1555, 1556 (TTAB 1990).

In light of the above, applicant contends that the Examining Attorney "has not focused on the immediacy of the meaning or on any quantum of imagination, thought or perception, but rather on the strength of the suggestion" imparted by the mark "INFOXTRACT." While applicant concedes that such mark, with respect to its computer software for extracting selected data content from computer formats, "strongly suggests a property or function of the goods," applicant asserts that because "a quantum of imagination, thought or perception is required, there is no immediacy" as to the meaning of the mark "INFOXTRACT" and hence it is not merely descriptive of the goods. In particular, applicant urges that not only does the mark "INFOXTRACT" not have any dictionary meaning or any usage in the data mining software field, but the Examining Attorney "has not shown or asserted that the term has any well understood and recognized meaning in the field or that it is even used at all in the field" by others.

Applicant also argues that the effects of certain visual and phonetic elements of its mark preclude the immediate

recognition of any merely descriptive significance. Applicant specifically maintains, in this regard, that:

In addition, the sound and appearance of the mark give the mark a distinct trademark look and feel beyond any suggestive or descriptive overtones. The mark has a design integrity achieved because of the central position of "X" for the English syllable "ex" which has the visual effect of a fulcrum balancing "info" to the left and "tract" to the right. That is, the mark is more than a misspelled juxtaposition of two English words; it has a visual design aspect to it that is not lost on consumers and that contributes to the quantum of imagination, thought or perception needed to understand the meaning conveyed by the mark.

As a word of the English language or juxtaposition of two words, the mark is ungrammatical. Grammatically correct constructions are "info-extracting" software or "info-extraction" software. The only reasonable reaction to hearing "INFOTRACT software" is that it is a marketing name for a kind of software that probably has something to do with extracting information from something. But even here the nature of the software suggested by the mark is ambiguous. Is it statistical-analysis software used to look for trends in data and thereby extract information from the data, or is it data-mining (search and retrieval) software used to extract raw data from files stored on computer media (without regard to any information that the data may contain). The whole point of a suggestive mark is to suggest something about the goods. If the meaning is not immediate, the mark is not merely descriptive.

Here the meaning is not immediate because (a) the appearance of the mark (the use of X for "ex" and the contraction into a single word), which has the commercial

impression of a made-up term in a characteristic trademark format; (b) the ungrammatical construction, which is not even in the form of any readily apparent non[-] grammatical vernacular usage; [and] the ambiguity of meaning (information-analysis software or data-mining software). It takes a modicum of thought and perception if not imagination to sort it out.

The Examining Attorney, on the other hand, contends that because a principal purpose, function or use of applicant's software "is extraction of information," the term "INFOXTRACT" is merely descriptive thereof. In particular, the Examining Attorney argues that:

The dictionary definitions of the terms "info" and "extract" provided in the final office action ... include the following meanings: "information," and "to select (excerpts) and copy out or cite." The applicant's goods are computer software for the purpose, at least in part, of extracting selected data or information. The software provides the toll [sic] by which information is selected and extracted. The goods in fact serve the purpose, function and/or use of extracting information and as such the proposed mark is highly likely to be recognized by prospective purchasers as identifying such function, feature, purpose and/or use.

With respect to applicant's remaining arguments, the Examining Attorney contends that:

A slight misspelling of a word will not turn a descriptive word into a non-descriptive mark. See *C-Thru Ruler Co. v. Needleman*, 190 USPQ 93 (E.D. Pa. 1976) (C-THRU held to be the equivalent of "see-through" and therefore merely descriptive of

transparent rulers and drafting aids). The fact that a term, such as "INFOXTRACT," is not found in the dictionary is not controlling on the question of registrability where the examining attorney can show that the term is highly likely to have a well understood and recognized meaning for purchasers and/or users of the goods based upon the meaning of the term as [a] whole. See *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE held generic for premoistened antistatic cloths for cleaning computer and television screens); *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977) (BREADSPREAD held merely descriptive of jellies and jams).

In consequence thereof, the Examining Attorney concludes that the term "INFOXTRACT" is merely descriptive of applicant's goods inasmuch as:

The average purchaser of the applicant's goods is highly likely to understand that the term "extract" as it appears in the proposed mark "INFOXTRACT" is meant to convey functional aspects of the goods. The term "extract" has specific meaning in relation to the applicant's software that provides a means to gather information. Through the use of applicant's software, the user of these goods will be able to extract information through the use of a computer. .... Purchasers and users of these goods are highly likely to comprehend this meaning and realize that the applicant's software is, at least in part[, ] a tool for the purpose of extracting information.

It is well settled that a term 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, e.g., 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). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

However, a mark is suggestive if, when the goods or services 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, e.g., In re

Abcor Development Corp., supra at 218, and In re Mayer-Beaton Corp., 223 USPQ 1347, 1349 (TTAB 1984). As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See, e.g., In re Atavio, 25 USPQ2d 1361 (TTAB 1992) and In re TMS Corp. of the Americas, 200 USPQ 57, 58 (TTAB 1978). The distinction, furthermore, is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. See In re George Weston Ltd., 228 USPQ 57, 58 (TTAB 1985).

In the present case, we are constrained to agree with applicant that, in light of the use of the term "INFO" instead of the word "INFORMATION" and the utilization of the letter "X" in place of the syllable "EX" in the word "EXTRACT," the phonetic and visual effects imparted thereby to the mark "INFOXTRACT" are sufficient to slow or delay recognition of the pertinent meaning of the mark, even among the technically knowledgeable purchasers and users of applicant's goods. Specifically, while those in the field of computer software for data mining would readily understand information extraction as a purpose, function or use of such goods, the combination of the word "INFO" with the terminology "XTRACT" results in a mark,

when first encountered, would just as immediately be regarded as if it were "IN-FOX-TRACT" rather than "IN-FO-X-TRACT." Stated otherwise, the amalgam formed by joining the term "INFO" and the terminology "XTRACT" is more than simply a slight misspelling of the designation "INFOEXTRACT" (which combination would tend to be pronounced the same as if it were the separate words "INFO EXTRACT"). Instead, the mark "INFOXTRACT" creates just enough of an initial ambiguity as to require a modicum of imagination, perception or thought in order for even sophisticated customers, such as those who would utilize applicant's computer software for extracting selected data content from computer formats, to pause slightly before comprehending that the mark designates a product designed to extract info from a database. As such the mark "INFOXTRACT" is no more than highly suggestive of applicant's data mining software. See, e.g., In re C. J. Webb, Inc., 182 USPQ 63, 64 [term "Brakleen" held suggestive rather than merely descriptive of a chemical composition for cleaning and degreasing automotive brake parts].

At the very least, we have doubt that applicant's mark immediately conveys the purpose, function or use of its goods. In view thereof, we resolve such doubt, in accordance with the Board's practice, in favor of the publication of applicant's mark for opposition. See, e.g., In re Conductive Systems, Inc., 220 USPQ 84, 86 (TTAB 1983); In re Morton-Norwich Products,

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Inc., 209 USPQ 791 (TTAB 1981); and In re Gourmet Bakers, Inc.,  
173 USPQ 565 (TTAB 1972).

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

E. W. Hanak

G. D. Hohein

L. K. McLeod  
Administrative Trademark  
Trademark Trial and Appeal

Judges,  
Board