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Paper No. 18  
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Intera Multimedia Inc.

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Serial No. 75/355,201

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Lawrence E. Abelman of Abelman, Frayne & Schwab for Intera Multimedia Inc.

Alan C. Atchison, Trademark Examining Attorney, Law Office 102 (Thomas Shaw, Managing Attorney).

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Before Hohein, Chapman and Bottorff, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On September 11, 1997, Intera Multimedia Inc. (a Canadian corporation) filed an application to register the mark MEMORIAL MEDIA on the Principal Register for "computer software for use in locating deceased individuals in cemeteries, mausoleums and columbariums; interactive computer kiosks for use in locating grave locations and deceased remains of individuals in cemeteries, mausoleums and columbariums" in International Class 9; "voice messaging services involving an interactive computer kiosk which records, stores and transmits messages concerning

deceased individuals and grave locations and deceased remains of individuals in cemeteries, mausoleums and columbariums" in International Class 38; and "information services provided via an interactive computer kiosk which contains biographies, video, pictures and text of deceased individuals and grave locations and deceased remains of individuals in cemeteries, mausoleums and columbariums and information about products and services of the funeral industry" in International Class 42.

Applicant's application was originally based on (1) Section 1(b) of the **Trademark Act**, 15 U.S.C. §1051(b), and (2) a claim of priority under Section 44(d) of the **Trademark Act**, 15 U.S.C. §1126(d), in light of Canadian application No. 841,324 (filed April 3, 1997).

Subsequently, applicant submitted its Canadian Registration No. TMA494,194, which issued from Canadian application No. 841,325 (filed April 3, 1997)<sup>1</sup>, and deleted its Section 1(b) basis for the U.S. application. The Board remanded the application to the Examining Attorney to determine whether the Canadian registration forms a basis for the services (International Classes 38 and 42) listed in applicant's U.S. application. By Examiner's Amendment dated March 1,

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<sup>1</sup> The term "media" is disclaimed in applicant's Canadian registration.

2001, the Section 1(b) basis for the application was reinstated. Thus, the application is now based on Section 1(b) as well as on Section 44 of the **Trademark Act**.

The Examining Attorney refused registration on the ground that applicant's mark, MEMORIAL MEDIA, is merely descriptive of the goods and services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

When the refusal was made final, applicant appealed to this Board. Both applicant and the Examining Attorney have filed briefs; an oral hearing was not requested.

The Examining Attorney contends that, in the context of applicant's goods and services, the term "memorial" means or refers to the remembrance of a person through multimedia images, voice and text, and the word "media" refers to various types of media used in connection with computer services and computer software; that the mark MEMORIAL MEDIA "in the context of information relating to deceased individuals, does convey to prospective purchasers that applicant's [goods and services] feature *memorial* information about deceased persons" (emphasis in original, brief, p. 4). Stated another way, the Examining Attorney also said, "The term 'media' describes the text, video and images contained on the computer kiosks and 'memorial' describes the subject matter therein." (Brief, p. 7.)

In support of the descriptiveness refusal, the Examining Attorney has made of record the following dictionary definitions:

- (1) "media" is defined as "(1) Objects on which data can be stored. These include hard drives, floppy disks, CD-ROMs, and tapes... (3) The form and technology used to communicate information. Multimedia presentations, for example, combine sound, pictures, and videos, all of which are different types of media." Random House Personal Computer Dictionary (1996); and
- (2) "memorial" is defined as "n. 1. Something, such as a monument or holiday, intended to celebrate or honor the memory of a person or an event.... adj. 1. Serving as a remembrance of a person or an event; commemorative." The American Heritage Dictionary (1992).

In addition, the Board, pursuant to Fed. R. Evid. 201, hereby takes judicial notice of the following dictionary definition from Webster's Ninth New College Dictionary wherein "memorial park" is defined as "n. (ca. 1928): cemetery." See TBMP §712.01, and cases cited therein.

The Examining Attorney also submitted (i) several third-party registrations to show that the words "memorial" and "media" have each been disclaimed when the word formed part of a mark for products or services such as memorial

cards, tombstones, computer services, or computer software; and (ii) a few stories reprinted from Nexis to show how applicant and others use the words "memorial" and "media" to describe the involved goods and services. Finally, the Examining Attorney relies on applicant's own identifications of goods and services as evidence that the information contained in applicant's computer kiosks includes memorials of deceased individuals.

Applicant argues that the mark MEMORIAL MEDIA is a unique combination of words coined by applicant; that applicant's mark is alliterative and is at most suggestive; that applicant's goods and services (computer software, voice messaging services and information services, all as specifically identified above) do not relate to any of the several definitions of "memorial" submitted by the Examining Attorney because applicant's goods and services are not used to celebrate or honor the memory of the deceased, but are limited to gathering and disseminating information; that there are several computer-related definitions of the term "media" as well as the Webster's Deluxe Unabridged Dictionary (2nd ed.) meaning of "media" as the plural of "medium"; that applicant does not use the terms "commemoration" or "memorial" in its identifications of goods and services; and that, the mark taken as a whole,

would require mental gymnastics in order for purchasers to ascertain the purpose or characteristics of applicant's goods and services.

Further, applicant contends that the third-party registrations submitted by the Examining Attorney to show that the word "memorial" was disclaimed are distinguishable from applicant's current application; and applicant submitted other third-party registrations which do not include disclaimers of the term "memorial." Applicant contends that the Nexis stories submitted by the Examining Attorney show use the words "multimedia memorials" or "memorial kiosk" or "digital memorial" but not the words MEMORIAL MEDIA (except where it is a reference to applicant's goods and services and it appears in capital letters -- "Intera Multimedia Inc. is planning to bring its Memorial Media Interactive Kiosks to Calgary and hopes to have them in cemeteries soon," "The Calgary Sun," December 6, 1998<sup>2</sup>), and therefore these stories do not constitute evidence that applicant's mark is merely descriptive. Finally, applicant argues that registration of applicant's

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<sup>2</sup> While the Board would not normally consider stories appearing in foreign publications, applicant herein is a Canadian corporation, basing its application, in part, on a Canadian registration. Thus, we have considered the Nexis stories submitted by the Examining Attorney which appeared in Canadian publications to the extent they serve to explain the nature of applicant's goods and services.

mark will not inhibit competitors, who are free to use terms such as 'grave locator' or 'deceased person locator' to identify the involved goods or services; and that the Examining Attorney has not provided any evidence of the mark actually used by others in connection with any such goods or services.<sup>3</sup>

The test for determining whether a mark is merely descriptive is whether the term immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used on or in connection

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<sup>3</sup> In its reply brief, applicant argued for the first time that "although not per se controlling," nonetheless, the Board should consider Article 6 of the Paris Convention inasmuch as Canada does not register merely descriptive marks, "as a factor in favor of granting registration." (reply brief, p. 5.) The Board is unpersuaded by this late-raised, unsupported argument.

with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991). Consequently, “[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). Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990).

We agree with the Examining Attorney that applicant’s mark immediately and directly conveys to purchasers that applicant’s goods and services feature memorial information about deceased persons. The term MEDIA is disclaimed in applicant’s Canadian registration; and clearly, computer software and interactive computer kiosks are types of media, that is, these are objects on which data can be or is stored. (See the dictionary definition of “media” set forth above). Even applicant stated that “Applicant’s use of MEDIA in the mark should not result in a determination of descriptiveness of the mark as a whole.” (Request for Reconsideration, p. 6, and brief, p. 12.)

The dictionary listings establish that "MEMORIAL" refers to commemorating, honoring, celebrating and/or remembering a person (or an event). Further, the Nexis evidence, examples of which are reproduced below, demonstrates that the content of applicant's kiosks is "memorials":

- (1) ...Corey Wood, Intera Multimedia's western representative in Calgary, tells me the kiosks can hold up to 6,000 multimedia **memorials**. Each includes a photographic and word **memorial** of a departed one. When visiting a kiosk at a cemetery, you just call up a video presentation and look at fond memories....Cemeteries generally charge \$250 a family to store and activate the **memorial**. "The Calgary Sun," December 6, 1998; and
- (2) ...It's a stainless-steel obelisk, in a public room off the cemetery's central office, with a computer screen bearing the mathematical sign of infinity....The **memorial** kiosk is only the newest, most futuristic example of tombstone technology that promises to transform cemeteries from place bound by granite into playgrounds for the imagination. "The Orange County Register," March 29, 1998.

When we consider the mark as a whole, and in the context of applicant's goods and services (involving computer software and interactive computer kiosks for use

in locating graves and deceased individuals, and voice messaging services and information services, both involving an interactive computer kiosk which contains pictures and text of deceased individuals and grave locations), the ordinary, commonly understood meaning of the words MEMORIAL MEDIA immediately informs prospective purchasers that applicant's goods and services are intended to assist in identifying and/or locating a variety of memorial information on deceased persons. Thus, when the mark MEMORIAL MEDIA is viewed in the context of applicant's goods and services, the purchasing public would immediately understand the nature and purpose of the goods and services. That is, purchasers would immediately understand that these goods and services involve the act or process of obtaining memorial information, not limited to location,<sup>4</sup> about deceased individuals. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792 (TTAB 1996); and *In re Time Solutions, Inc.*, 33 USPQ2d 1156 (TTAB 1994).

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<sup>4</sup> Applicant's respective identification of services lists "messages concerning deceased individuals and grave locations"; and "biographies, video, pictures and text."

Applicant's argument that other words are available to competitors to describe their goods and services is not persuasive. In order to show that that a mark is merely descriptive, it is not necessary to show that others are using the specific involved word(s). It is well established that a term may be merely descriptive even if an applicant is the first or is the only entity currently using it.<sup>5</sup> See *In re Tekdyne Inc.*, 33 USPQ2d 1949, 1953 (TTAB 1994); and *Pennzoil Products*, supra at 1756.

The third-party registrations submitted by applicant to show examples where the term MEMORIAL was not disclaimed, and the third-party registrations submitted by the Examining Attorney to show examples where the term MEMORIAL or the term MEDIA was disclaimed, are not persuasive. While uniform treatment under the **Trademark Act** is an administrative goal, the Board's task in an ex parte appeal is to determine, based on the record before us, whether applicant's mark is merely descriptive. As often noted by the Board, each case must be decided on its own merits. We are not privy to the records of the third-party registration files, and moreover, the determination of

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<sup>5</sup> Applicant's use appears to be in Canada. There is no clear evidence that applicant has commenced use of its mark in the United States.

registrability of those particular marks by the Trademark Examining Groups cannot control the merits in the case now before us. See *In re Nett Designs Inc.*, \_\_ F.3d \_\_, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to [applicant's application], the PTO's allowance of such prior registrations does not bind the Board or this court.") See also, *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1862 (TTAB 1998).

**Decision:** The refusal to register on the ground that the mark is merely descriptive under Section 2(e)(1) is affirmed.