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Paper No. 14
HWR

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Platinum Technology, Inc.

Serial No. 75/358,543

Matthew W. Walch of Latham & Watkins for Platinum
Technology, Inc.

Rebecca Gilbert, Trademark Examining Attorney, Law Office
113 (Odette Bonnet, Acting Managing Attorney).

Before Seeherman, Wendel and Drost, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Platinum Technology, Inc. has filed an application to
register the mark INDEX EXPERT for "computer software for
use by computer programmers, database administrators,
computer system administrators and other computer
professionals for the organization, administration,
management and programming of databases, and for the

programming of databases,¹ and user manuals distributed as a unit therewith."²

Registration has been finally refused under Section 2(e)(1) of the Trademark Act on the ground that the mark, as used on applicant's goods, is merely descriptive thereof. The refusal has been appealed and both applicant and the Examining Attorney have filed briefs. No oral hearing has been requested.

The Examining Attorney maintains that the term INDEX EXPERT is merely descriptive of applicant's software in that the software acts as an "index expert" when performing its database organization, administration and management tasks. To support this argument she relies upon ordinary dictionary definitions of "index" as "something that serves to guide ... or otherwise facilitate reference" and of "expert" as "a person with a high degree of skill in or knowledge of a certain subject," as well as a computer science definition of the term "expert system" as "a program that uses available information, heuristics and inference to suggest solutions to problems in a particular

¹ This second recitation of "programming of databases" appears to be redundant and should be deleted prior to publication of the application.

² Serial No. 75/358,543, filed September 17, 1997, based on an allegation of a bona fide intention to use the mark in commerce. An amendment to allege use was filed January 26, 1999, claiming first use dates of April 22, 1998.

discipline."³ She has also made of record copies of several third-party registrations for marks containing the word EXPERT for various software products in which EXPERT has been disclaimed. In addition, she argues that the term INDEX EXPERT is merely descriptive because the software is for use by index experts, asserting that those computer professionals named in the identification of goods fall within this category.

Applicant has countered the Examining Attorney's evidence with its own compilation of third-party registrations in which the term EXPERT has not been disclaimed when used in marks for software products.⁴ Applicant contends that the Office has followed no particular policy with respect to this term and that each mark must be considered on its own merits. Applicant further argues that the Examining Attorney has failed to consider the mark as a unitary term and notes that no evidence has been made of record of use of the term "index

³ All definitions were taken from *The American Heritage Dictionary of the English Language* (3rd ed. 1992).

⁴ The Examining Attorney has objected to all of the third-party registrations submitted by applicant as attachments to its brief. We note, however, that the registrations included in Exhibits A and C were previously referred to by applicant in its response of September 20, 1999. Accordingly, and since the Examining Attorney made no objection at that time, the registrations included in Exhibits A and C have been considered. Exhibit B is untimely and has been given no consideration.

expert" in the software field. Applicant asserts that its goods are neither "index experts" nor used by "index experts," and that the mark INDEX EXPERT only suggests the functions which these goods provide for computer professionals rather than immediately describing them.

A term or phrase is merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act if it immediately conveys information about a characteristic or feature of the goods or services with which it is being used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Whether or not a particular term or phrase is merely descriptive is determined not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which the designation is being used, and the significance the designation is likely to have to the average purchaser as he or she encounters the goods or services bearing the designation, because of the manner in which it is used. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).

Upon review of the record, we find it clear that applicant's software performs an indexing function. In the press release dated April 7, 1998, which applicant attached to its response of September 20, 1999, statements such as the following are found:

...Platinum Technology, Inc. ... today announced Index Expert, the first index design tool available for mainframe DB2 databases;

With Index Expert, indexes can quickly be conceived from automated analysis of thousands of lines of code; and

By allowing IT staff to automate the design of all the optimal and necessary indexes, Index Expert greatly enhances database and application efficiency.

Applicant has acknowledged that its software is used for "organizing indexes, files and records within databases."

Brief, p. 2.

The evidence of record does not establish, however, that the term "expert" is as directly informational when used in connection with applicant's software. The only definition proffered by the Examining Attorney is from a standard dictionary, which refers to an expert as a "person" with a certain degree of skill. There is no evidence that the term "expert" has acquired any special meaning in the software field. Although the Examining Attorney relies heavily upon the third-party registrations in which the term has been disclaimed when used in marks for software products, applicant has shown that a similar number of registrations exist in which the term has not been disclaimed. Since we are without the benefit of the file histories for any of these third-party registrations, we can draw no conclusions as to why the disclaimers were

or were not made. Instead, we are left with the standard admonition that each case must be decided on its own merits.

Although a computer-recognized definition has been shown to exist for the term "expert system," we have no evidence that the present software operates by means of such a system. Moreover, the mark is not INDEX EXPERT SYSTEM. Thus, we are limited to the interpretation of an "index expert" as a person highly skilled in the field of indexing. As such, we find the term no more than suggestive when used with inanimate software products that perform an indexing function. We do not agree that the mark INDEX EXPERT is merely descriptive of applicant's software because the software "acts like an expert." Purchasers would not immediately associate software with an "expert"; they would have to go through some mental steps or exercise some degree of imagination.

Insofar as the Examining Attorney's alternative line of reasoning is concerned, i.e., that the intended users are "index experts," there is simply no evidence to support this conclusion. In order to make such a finding, we must have evidence that the mark describes the type of individuals to whom at least an appreciable number of the party's goods are directed. See *In re Camel Manufacturing*

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Company, Inc, 222 USPQ 1031 (TTAB 1984) and the cases cited therein. Here, we have no basis for assuming that those persons identified in the application as the users of applicant's software would be classified as "index experts."

Finally, if any doubt remains, we find it appropriate to resolve this doubt in applicant's favor, inasmuch as any person who believes that he or she would be damaged by the registration of the mark will have the opportunity to file an opposition thereto. See *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 4 USPQ 1141 (Fed. Cir. 1987).

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