

1/5/01

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 15  
RLS/cv

UNITED STATES PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

In re Nicolet Instrument Corporation

---

Serial No. 75/425,818

---

Lydie Arthos Hudson of Lathrop & Clark LLP for Nicolet Instrument Corporation.

Michele-Lynn Swain, Trademark Examining Attorney, Law Office 103 (Michael A. Szoke, Managing Attorney).

---

Before Simms, Seeherman and Hairston, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Nicolet Instrument Corporation (applicant), a Wisconsin corporation, has appealed from the final refusal of the Trademark Examining Attorney to register the mark SATELLITE for "scientific instruments, namely, infra-red spectrometers."<sup>1</sup> The Examining Attorney has refused registration under Section 2(e)(1) of the Act, 15 U.S.C.

---

<sup>1</sup> Application Serial No. 75/425,818, filed January 29, 1998, based upon applicant's bona fide intention to use the mark in commerce. According to one definition of record, a spectrometer

§1052(e)(1), on the basis that the mark SATELLITE is merely descriptive of a feature or use of applicant's goods--that is, that applicant's spectrometers may be used on satellites.<sup>2</sup> Applicant and the Examining Attorney have submitted briefs but no oral hearing was requested.

We affirm.

Relying upon dictionary definitions, excerpts from a Nexis computer search and an Internet search, the Examining Attorney contends that applicant's spectrometers may be carried on satellites and that the relevant public seeing the asserted mark SATELLITE used in connection with

---

is "a spectroscope equipped with scales for measuring wavelengths or indexes of refraction."

<sup>2</sup> In the Examining Attorney's first refusal, issued January 7, 1999, the Examining Attorney indicated that applicant's mark was merely descriptive because "a satellite is a component of a spectrometer." In the final refusal, issued May 12, 1999, the Examining Attorney maintained the refusal stating that "spectrometers and satellites can be used interchangeably. Spectrometers are components of satellites and satellites are components of spectrometers. Moreover, spectrometers can be specially configured for use with satellites."

In her brief, the Examining Attorney contended that the mark was merely descriptive because:

Since satellites utilize spectrometers, consumers seeing the mark SATELLITE used in connection with applicant's goods will at once be informed as to the nature of the goods. No mental leap or supposition is required to conclude that the intended mark, when used in relation to spectrometers, refers to spectrometers intended for use with satellites.

It appears, therefore, that the Examining Attorney is no longer contending that the mark is merely descriptive because "satellites are components of spectrometers."

spectrometers will be immediately informed as to the nature or use of applicant's spectrometers--that they are spectrometers for use aboard satellites. Also, the Examining Attorney contends that there is no evidence in this record to indicate that applicant's goods will not include infrared spectrometers for use on satellites.

The Nexis and Internet evidence includes evidence that satellites have been launched into space carrying spectrometers. Some of the Internet evidence is excerpted below:

Australia may launch the world's first satellite-based imaging spectrometer if the project is given the go-ahead by a feasibility study currently...

...in-orbit calibration of the satellite spectrometers during the long time missions to observe the instrument behaviour and to secure the reliability of the data...

The medium-energy concentrator spectrometer on board the BeppoSAX X-ray astronomy satellite...

The INTEGRAL science payload consists of two main instruments, the spectrometer SPI and the imager IBIS supplemented by two subsidiary instruments...

The Extreme Ultraviolet Explorer satellite, launched by NASA on June 7, 1992, contains three EUV spectrometers with grazing-incidence optics built at UC Berkeley.

The EUVE satellite spectrometers observed the prototype eclipsing binary Algol over nearly 1.5 orbital periods.

...and remote sensing of atmospheric trace species using high-resolution ground-based and satellite spectrometers.

Meanwhile, scientists were closely eyeing the readout from a pressure gauge inside the satellite's spectrometers.

Satellite spectrometers for global Ozone...

Satellite spectrometers for pollutants SO<sub>2</sub>, NO<sub>x</sub>...

Applicant, on the other hand, argues that the mark SATELLITE is an arbitrary and fanciful term for a particular scientific instrument which measures a spectrum of light. Applicant states that spectrometers have a number of uses having nothing to do with satellites, including uses by universities and chemical companies to analyze properties of chemicals. Applicant does acknowledge, however, that sometimes satellites are launched carrying spectrometers. However, applicant argues that "SATELLITE" is not descriptive of a *function* of spectrometers even if satellites carry spectrometers into orbit. Applicant has submitted an affidavit and a letter from an associate professor of chemical engineering. According to this evidence, most spectrometers have nothing to do with satellites but rather are used for spectrum analysis in laboratories. However, it is acknowledged that the HUBBLE space telescope satellite contains spectrometers

**Ser. No. 75/425,818**

to allow observation of radiation from planets and space.

Also,

...use of the word Satellite as a model name for another FTIR spectrometer would be suitable and appropriate, and would cause no confusion among the user community with the very different case of a spectrometer launched into space on a satellite.

Letter of Thatcher W. Root, dated July 22, 1999.

Upon careful consideration of this record and the arguments, we believe that the Examining Attorney has established that the term SATELLITE is merely descriptive of an intended use of spectrometers, at least with respect to spectrometers which are launched into space aboard satellites. In this regard, we observe that applicant's application is unrestricted in nature and could include both ground-based and satellite-launched spectrometers. As the Examining Attorney has noted, a term need not describe all purposes or uses of a product in order to be merely descriptive. It may be merely descriptive if it describes one of the purposes or intended uses. Accordingly, we conclude that the mark SATELLITE is merely descriptive of applicant's goods as described.

Decision: The refusal of registration is affirmed.