

03/26/01

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

Paper No. 11
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re eOn Communications Corporation

Serial No. 75/439,399

Betty K. Steele of Baker, Donelson, Bearman & Caldwell for
eOn Communications Corporation.

John C. Tingley, Trademark Examining Attorney, Law Office
106 (Mary I. Sparrow, Managing Attorney).

Before **Cissel**, Hohein and Drost, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On February 24, 1998, the above-referenced application
was filed¹ to register the mark "VOICECLUSTERS" on the
Principal Register for "voice processing systems comprised
of interactive computer telephony integration," in Class 9.

¹ The application was originally filed in the name of Cortelco
Systems, Inc., a Delaware corporation, but applicant changed its
name to eOn Communications Corp. as of November 16, 1999, and
forwarded the amended certificate of incorporation to the
assignment division of the United States Patent and Trademark
Office on March 8, 2000. The assignment is recorded on Reel
002045 at Frame 0490.

The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with the goods.

The Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act on the ground that the mark sought to be registered is merely descriptive of the goods set forth in the application. His position was that "[t]he mark merely describes a feature of the software used in voice clusters telephone interaction."

Attached in support of the refusal to register were copies of excerpts from a number of items retrieved from a database of publications. The first, from the New York Times, relates to a musical performance. It states:

"... cords that breathe in a smooth succession, or overlap, or grow separated by calm pauses. In other sections, the voices cluster to cause the acoustic phenomenon of beats (throbbing phantom notes, in short chromatic runs or sustained tones..."

Another excerpt, likewise of little probative value because of its content, in addition to the fact that it is from a newspaper from outside this country, relates to a novel.

It states:

"... a kind of collage of the experiences of America's Blacks, from slavery to the 1920s. In true Morrison fashion, a host of anonymous voices cluster around the central story, and add their stories and anecdotes to form a common united history.

A third excerpt, titled "Practical production testing of ISDN circuit boards," is from a paper presented to a conference of electrical engineers. It states:

"... Abstract: with cluster specification or edge connector specification tests. These specification tests can be broken into three categories: digital VLSI tests: S-bus cluster tests; and voice cluster tests."

A fourth excerpt is taken from a U.S. Patent for "modular-accessible-units for use in floor, ceiling, wall or partition systems." It states:

"... accessible node sites 215, and potential modular accessible node sites 216. Also shown are cluster panels 231 depicted as a data cluster panel 273, a voice cluster panel 274, and a power cluster panel 275. The cluster panels feed one or more modular accessible node sites 211, 215, and 216 with matrix... a voice branch panel 278 feeding one or more voice cluster panels 274, and as a power branch panel 279 feeding one or more power cluster panels 275."

Responsive to the first Office Action, applicant amended the identification-of-goods clause to read as follows: "telephone apparatus, namely a voice mail and/or messaging server that controls and routes voice mail to multiple locations."

Applicant also provided argument that the refusal to register was not well taken because the mark, in connection with the products on which applicant intends to use it, is suggestive, rather than merely descriptive of the goods. Applicant pointed out that the first article excerpt

submitted by the Examining Attorney refers to a musical performance and the second apparently relates to a literary device, both of which are altogether different from and unrelated to applicant's telephone voice mail and/or messaging server that controls and routes voice mail to multiple locations. Applicant further argued that the other excerpts submitted by the Examining Attorney refer to telephone switching equipment that controls telephone lines, stations or trunks, all of which are different from the server device identified in the application. Similarly, the references to voice cluster capacity are argued by applicant to refer to the capacity of a PBX system.

The Examining Attorney was not persuaded by applicant's arguments, and in his second Office Action, made the refusal to register under Section 2(e)(1) final. Attached to that Office Action was an entry from a glossary of computer terminology. The term "cluster" is defined therein as "some number of disk sectors (typically two to 16) treated as a unit. The entire disk is divided into clusters, each one a minimum unit of storage. Thus, a 30-byte file may use up 2,048 bytes on disk if the disk cluster is four 512-byte sectors."

Applicant timely filed a Notice of Appeal, accompanied by a request for reconsideration of the final refusal to register. Submitted with the request for reconsideration was the affidavit of Steve Jones, the co-director of the Applied Research Institute of the Center for Information and Communication Services of Ball State University. Attached as an exhibit to the affidavit was a letter Mr. Jones offered regarding applicant's "unique telephony system." In the letter, Mr. Jones states that when "cluster" is analyzed in regard to shared networked services, "... it represents the ability of a group of either similar or disparate systems to act as a singular system through shared resources." He goes on to state his belief that "... the particular nature of... [applicant's] system allows it to use the nomenclature chosen to define its' (sic) purpose. It cannot be classified as simply a voice and fax sharing device because of the networking capability that it possesses. It cannot be simply defined as a network server because it has the ability to present itself as a transparent device to across the entire enterprise for voice and fax services."

The Trademark Trial and Appeal Board instituted the appeal, but suspended action on it and remanded the application file to the Examining Attorney for

reconsideration in view of applicant's evidence and arguments.

The Examining Attorney reconsidered the refusal to register, but maintained that the mark applicant seeks to register is merely descriptive of the goods set forth in the application. An excerpt from a telecommunications dictionary was attached to his response. In it, the term "cluster" is defined as a "collection of terminals or other devices in a single location," and as "a group of computers and storage devices that function as a single system."

The application file was then returned to the Board, which resumed action on the appeal. Applicant filed an appeal brief and the Examining Attorney filed a brief in response to it. Applicant did not request an oral hearing before the Board.

Based on careful consideration of the record and arguments before us in this appeal, we find that the Examining Attorney has failed to establish the descriptiveness of applicant's mark.

The test for determining whether a mark is merely descriptive within the meaning of Section 2(e)(1) is well settled. A mark is merely descriptive of the goods with which it is or will be used if it immediately and forthwith imparts information, with some degree of specificity or

particularity, about a significant ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979); In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Metpath Inc., 223 USPQ 88 (TTAB 1984). The Examining Attorney bears the burden of establishing that the term sought to be registered is merely descriptive. Whether the mark is merely descriptive or only suggestive of the goods with which it is or will be used has been recognized as a question of a highly subjective nature, and any doubts in regard to this question must be resolved in favor of the applicant. In re Aid Laboratories, Inc., 221 USPQ 215 (TTAB 1983).

Simply put, the Examining Attorney has not met his burden of supporting the refusal to register with evidence upon which we can conclude that without a doubt, "VOICECLUSTERS" would immediately and forthwith convey information about a significant feature, characteristic, function, purpose or use of a voice mail and/or messaging server that controls and routes voice mail to multiple locations.

We certainly do not claim any particular expertise in the field of telecommunications equipment. The Examining Attorney contends that "VOICECLUSTERS" is merely

descriptive of the goods set forth in the application because it conveys information about a significant characteristic or feature of the telephone apparatus identified in the application, but it is not clear to us just what that information might be. In a similar sense, it would be a misrepresentation for us to contend that the letter from Mr. Jones makes plain to us the reason why applicant believes the mark it seeks to register is suggestive in connection with the goods specified in the application. As noted above, however, applicant does not bear the burden on the issue of mere descriptiveness. The Examining Attorney does.

The mark includes two words that individually appear to relate in some way to a server that controls and routes voice mail to multiple locations. "VOICE" is clearly descriptive in connection with an apparatus that processes voice data such as voice mail, and "CLUSTERS" has been shown to relate to a grouping of different devices that function as a single system, but the evidence of record in this appeal does not demonstrate how that term is used in connection with telephone servers. Moreover, exactly what these two words, when combined into the mark "VOICECLUSTERS," convey about the servers identified in the application, as amended, is just not clear to us. As

applicant points out, some of the evidence submitted by the Examining Attorney obviously relates to music, literature or something else unrelated to servers for voice messaging. Other evidence seems to have something to do with computers, which we recognize are integral parts of telecommunications networks, but the evidence of record in this appeal does not make it at all clear that the combined term "VOICECLUSTERS" would immediately and forthwith convey specific information concerning a significant characteristic, feature, purpose, function or use of the voice mail and/or messaging servers identified in the application.

Accordingly, the refusal to register under Section 2(e)(1) is reversed.