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Paper No. 14
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Synplicity, Inc.

Serial No. 75/566,083

Dax Alvarez of Blakely, Sokoloff, Taylor & Zafman for
Synplicity, Inc.

Rebecca Gilbert, Trademark Examining Attorney, Law Office
113 (Meryl Hershkowitz, Managing Attorney).

Before Simms, Walters and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On October 7, 1998, Synplicity, Inc. (applicant) filed
a trademark application to register the mark CERTIFY for
goods identified as "computer software for computer aided
electronic circuit design" in International Class 9.¹

¹ Serial No. 75/566,083. The application alleges a bona fide
intent to use the mark in commerce. In its Amendment to Allege
Use, applicant alleged a date of first use and a date of first
use in commerce of October 22, 1998.

The Examining Attorney refused to register the mark on the ground that the mark, when applied to the goods, is merely descriptive. 15 U.S.C. § 1052(e)(1).

The Examining Attorney's position is that, inasmuch as the term "verify" is descriptive of applicant's software and "verify" and "certify" are near synonyms, the term CERTIFY is merely descriptive when applied to applicant's software.

In her first Office action, the Examining Attorney cited a dictionary definition of "certify" to mean, "to guarantee as meeting a standard."² The Examining Attorney held that the mark would be descriptive for applicant's software because either it acts to create electronic circuit designs, which meet a certain standard, or it acts as a person who certifies that electronic circuit designs meet a certain standard.

In response to the Examining Attorney's inquiry in the first Office action (p. 1), applicant indicated the term "CERTIFY has no significance in the relevant trade, industry or as applied to the goods." Applicant also maintained that the "mark Certify has no descriptive or suggestive connotation to the goods at hand" (p. 3) and

² *The American Heritage Dictionary of the English Language, Third Edition*, (1992).

that the mark "has not been shown to be a common descriptive name of the product for which registration is sought, nor has it been shown to be revelatory of the product's function" (p. 5).

The Examining Attorney made the refusal final on the ground of descriptiveness in her second Office action. In that action, she relied on a product catalog and information from applicant's website. From the catalog, she quoted the following language: "Certify is the first and only synthesis product . . . ASIC [Application Specific Integrated Circuit] prototyping and verification using multiple FPGAs [Field-Programmable Gate Arrays]."

In addition, the Examining Attorney (p. 2) quoted extensively from applicant's literature to demonstrate that applicant's goods have a verification function:

Applicant's web site explains . . . "Verification is the biggest bottleneck for today's complex ASIC designs . . . the bottleneck comes from verifying that the ASIC design is correct before moving to production . . . Certify combines RTL multi-chip partitioning with FPGA synthesis techniques, and is the first and only synthesis product targeting ASIC prototyping and verification using multiple FPGAs . . . Synplicity's Certify product enables system-level verification for ASIC and SoC designs by providing at or near-speed functional prototypes from RTL code. Design verification requirements vary depending on the specific design challenge that must be solved . . . [Certify] makes it possible to perform extensive verification of designs in hardware . . . Certify fills this verification gap through providing an RTL level solution for proving core functionality.

In addition, the Examining Attorney provided dictionary definitions of "verification" as "a confirmation of truth or authority; the evidence for such a confirmation; the act of verifying or the state of being verified" and "verify" as "to determine or test the truth or accuracy of."³

With this evidence, the Examining Attorney held that the software "is used to guarantee that the designs meet a certain standard, i.e. to certify the functionality of the designs" (p. 2) and the mark was, therefore, merely descriptive.

When the Examining Attorney made the refusal final, applicant filed a notice of appeal and a request for reconsideration. Applicant disagreed with the Examining Attorney's suggestion that the words "verify" and "certify" have the identical or interchangeable meanings. "The applicant does not make any claims nor does the software perform any type of certification. It is merely a tool that can be used in the process of verifying the design of an application specific integrated circuit. Applicant reiterates the software CERTIFY does not actually certify anything." Request for Reconsideration, pp. 2-3.

³ *Id.*

The Examining Attorney adhered to her refusal on reconsideration and cited three additional definitions. The first defined "certify" to mean "to give certain information of; to make certain, as a fact, to verify."⁴ Another dictionary listed "verify" as a similar word for "certify."⁵ The same source identified "certify" as a similar word for "verify."⁶

In its Appeal Brief, applicant submits that "certification" and "verification" are distinctly different processes. "Products may be verified by an engineer but not be certified to meet ant particular standard." Brief, p. 3. Responding to the definitions the Examining Attorney made of record in her decision on reconsideration, applicant pointed out that the dictionaries were non-technical dictionaries and that the Examining Attorney did not show sufficient correlation between the terms "certify" and "verify" in the electronic design automation field. "Applicant's software is merely a tool that can be used in the process of verifying the design of an application specific integrated circuit." Brief, p. 4. Finally, "Applicant contends that its software does not guarantee or

⁴ ARTFL Project: Webster Dictionary (1913).

⁵ Wordsmyth: The Educational Dictionary-Thesaurus.

⁶ *Id.*

verify the functionality of circuit designs but merely verifies that the design is correct." Brief, p. 5.

In her Appeal Brief, the Examining Attorney argued that "certify" and "verify" are synonyms or similar words and applicant's software performs verification functions. She reasoned that:

[I]f the applicant admits that the software is used to "verify" the designs, i.e. "to establish the truth or accuracy of; confirm" the designs, then it is axiomatic that the software is used to "certify" the designs, i.e. "to affirm the accuracy or certainty of, confirm" the designs.

Brief, p. 5.

We begin our analysis by noting that a mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information regarding a function, purpose, or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). A term may be descriptive even if it only describes one of the qualities or properties of the goods or services. In re Gyulay, 820 F.2d 1216, 1217, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). We look at the mark in relation to the goods or services, and not in the abstract, when we consider whether the mark is descriptive. Abcor, 588 F.2d at 814, 200 USPQ at 218.

The issue in this case is straightforward: Is the term CERTIFY merely descriptive of computer software that has a verification function. The Examining Attorney's case rests on two pillars. The first pillar is that applicant's software has a verification function. The evidence is overwhelming that applicant's software performs a verification function. Applicant admits that its "software is merely a tool that can be used in the process of verifying the design of an application specific integrated circuit." Applicant's Appeal Brief, p. 4. Applicant's literature supports the position that applicant's software performs a verification function:

First and only synthesis product targeting ASIC prototyping and verification using multiple FPGAs.

Verification is the biggest bottleneck for today's complex ASIC designs.

The bottleneck comes from verifying that the ASIC design is correct before moving to production.

This approach is at the heart of the Certify solution, improving prototype performance, and allowing designers to verify their designs at near real-time speeds.

Since the main goal of prototyping is to verify the ASIC design, designers are very reluctant to make changes to the HDL source solely for the purpose of prototyping.

The record establishes the terms "verify" or "verification" would describe a feature or function of

applicant's software. However, the mark in this case is "certify." The only evidence of the descriptiveness of the word "Certify" consists of several dictionary definitions. Certify has been defined as: (1) to guarantee as meeting a standard and (2) to give certain information of; to make certain, as a fact, to verify. There is no evidence that the software guarantees something as meeting a standard. The second definition is obviously more relevant because it is more general ("to give certain information of; to make certain, as a fact") and it also concludes by including the definition "to verify." This definition appears to be a 1913 edition of Webster's Dictionary. In addition, it is an extremely broad meaning of the word "certify." Even if current prospective purchasers were aware of this definition, it is not clear what feature or function of applicant's software was immediately and unequivocally described by the word "certify."

In addition, the Examining Attorney submitted evidence that shows that "verify" is listed among terms identified as "similar words" for "certify." However, there is a separate category for synonyms and "verify" does not appear in that list. Also included with "verify" as similar words are "corroborate," "certificate," "attest," "substantiate," "document" and "establish." Words appearing with "certify"

as similar words for "verify" include "testify," "prove," "double-check," "witness," "check," "substantiate" and "document." Again, "certify" is not identified as a synonym of "verify." Merely because "certify" appears in a list of words that are similar to a descriptive term does not, by itself, establish that the word "certify" is, itself, descriptive and that prospective purchasers will immediately understand that "certify" describes the verification function in applicant's software. See In re Seats, Inc., 757 F.2d 274, 225 USPQ 364 (Fed. Cir. 1985) (Federal Circuit reversed Board's decision viewing the mark "seats" as a synonym for "tickets" or "reservations").

Thus, the most relevant evidence supporting the argument that "certify" is descriptive of a verification function in software is limited to a single, nebulous, and possibly old dictionary definition and the fact that the words "certify" and "verify" are identified as similar words. It is a well-established principle of trademark law, that if we have any doubts about the descriptiveness of a mark, we are to resolve them in the applicant's favor. In this case, we cannot say that we have no doubt that the mark CERTIFY is descriptive of computer software for computer aided electronic circuit design. Therefore, we must resolve them in applicant's favor.

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Decision: The refusal to register applicant's mark CERTIFY for the identified goods on the ground that the mark is merely descriptive is reversed.