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**THIS DISPOSITION IS NOT  
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Paper No. 13  
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re *Satori Software, Inc.*

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Serial No. 75/630,834

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Patrick Michael Dwyer of Patrick M. Dwyer PC for Satori Software, Inc.

Robin Chosid, Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw, Managing Attorney).

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Before Hohein, Bucher and Rogers, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

*Satori Software, Inc.* has filed an application to register the term "MAILROOM TOOLKIT" for "computer software for adding United States Postal Service (USPS) capabilities to conventional database programs for use by individuals, businesses and organizations."<sup>1</sup>

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<sup>1</sup> Ser. No. 75/630,834, filed on January 29, 1999, which alleges a date of first use anywhere and in commerce of August 12, 1998. The word "TOOLKIT" is disclaimed.

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that, when used in connection with applicant's goods, the term "MAILROOM TOOLKIT" is merely descriptive of them.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We reverse the refusal to register.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services and the possible significance that

the term would have to the average purchaser of the goods or services because of the manner of such use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Thus, "[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).

However, a mark is suggestive if, when the goods or services are encountered under the mark, a multi-stage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See, e.g., *In re Abcor Development Corp.*, supra at 218, and *In re Mayer-Beaton Corp.*, 223 USPQ 1347, 1349 (TTAB 1984). As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See, e.g., *In re Atavio*, 25 USPQ2d 1361, 1362 (TTAB 1992) and *In re TMS Corp. of the Americas*, 200 USPQ 57, 58 (TTAB 1978). The distinction, furthermore, is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. See *In re George Weston Ltd.*, 228 USPQ 57, 58 (TTAB 1985).

Applicant, in its main brief, argues among other things that the term at issue is suggestive because (underlining in original):

"[T]he mark MAILROOM TOOLKIT does not in fact tell the potential customer what the goods are; therefore the goods are not described by the mark. A "Mail-room," in its colloquial usage, can be defined as a physical place where mail is sorted and stamped; mail is not typically addressed there. The American Heritage Dictionary [of the English Language (3d ed. 1992)] definition provided by the Examining Attorney is not to the contrary: "a room in which ingoing and outgoing mail is handled for a company or other organization." .... There is nothing about the goods for which the mark is used that denotes or otherwise relates to any kind of a physical space. Thus the term "mailroom" is not descriptive with respect to the goods. ....

Along a similar vein, a "Toolkit" is a box with tools, or a process used to fix something; and lately, an accessory adjunct to software development. (The Examining Attorney has also provided a TechEncyclopedia entry for "toolkit": "an integrated set of software routines or utilities (tools) that are used to develop and maintain applications and databases", which is also not to the contrary.) Applicant's goods are a toolkit in this sense, but significantly there is no established linguistic or technical connection between these two terms whatsoever. And the Examining Attorney has never offered any evidence that they are so connected.

Furthermore, the mark as a whole does not tell the potential customer what any of the characteristics, uses, purposes or ingredients of the goods are. In order for

the mark to be considered descriptive at all, it ... must, as used (and as a whole), directly convey an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods. [Citations omitted.]

....

The Examining Attorney has incorrectly assessed the goods as "software used to recreate the functions of a mailroom" The goods, as stated in the application, are used as a toolkit for developing database applications to assist with mail related functions. The Examining Attorney notes in passing the advertised functions of the goods, such as filling in correct cities, standardizing and adding zip+4 to an address, printing certain USPS forms and presorting mail, and then mislabels them as "mailroom functions". As most of these functions (possibly excepting only pre-sorting) are not typically performed in a mailroom, her label is disingenuous and misleading.

Even if the advertised functions of the goods (functions available to developed database applications only after application of the goods to those database applications) could fairly be considered "mailroom" functions, however, it would still not make the mark as a whole descriptive of the goods. For the goods remain only a development toolkit for other software; they cannot be used by themselves to accomplish anything else. The goods are not intended to stand alone, and by themselves do not perform any of the functions noted by the Examining Attorney. Thus the mark as a whole is ... not "merely descriptive" of the goods because the goods are only a toolkit to help other developers create applications (not mailrooms, and it is only these developed applications that will be able to

assist with mail activities, not the Applicant's goods themselves.

Applicant, citing *In re TBG Inc.*, 229 USPQ 759 (TTAB 1986), in which the mark "SHOWROOM ONLINE" was held suggestive, rather than merely descriptive, of the services of "leasing computer databases and video disks in the field of interior furnishings and related products of others," additionally contends that, likewise, "[e]ven if both of the words of the mark were themselves individually 'merely' descriptive of some other goods or services (which Applicant does not here admit)," the combination of such merely descriptive terms has been held registrable "if the juxtaposition of the words is inventive or evokes a unique commercial impression, or if the term has a bizarre or incongruous meaning as applied to the goods." In view thereof, applicant asserts that:

MAILROOM TOOLKIT ... is a metaphysical linguistic creation easily fitting into the ... category of bizarre or incongruous that only takes on a commercial meaning through branding and expansion of goodwill by Applicant. Part of it, [such as "mail" or "tool,"] ... may conjure [up] images that in some way relate to the goods of Applicant, but the mark is a fictional, mentally suggestive aid, not a description. .... The mark ... is "suggestive", because the exercise of imagination or thought will enable a user to reach a conclusion as to the nature of the goods, but "suggestive" marks are *per se* registrable.

The Examining Attorney, on the other hand, maintains in her brief that the term "MAILROOM TOOLKIT" is merely descriptive of applicant's goods "inasmuch as the mark immediately conveys to the average prospective purchaser of the goods a characteristic, use, feature or purpose of the goods." Observing, in particular, that applicant's advertising indicates that its goods are designed for use by "individuals, businesses or organizations using computer software for adding postal capabilities, such as Zip + 4 to an address, or someone who prints required USPS documentation and/or presorts mail for the lowest postage rates," the Examining Attorney insists that "one who is [in] need of the Applicant's goods will have no problem determining that MAILROOM TOOLKIT relates to such computer software." In particular, based upon the excerpt of record from TechEncyclopedia, which defines "toolkit" as "[a]n integrated set of software routines or utilities (tools) that are used to develop and maintain applications and databases" and further states that "[t]here are toolkits for developing almost anything,"<sup>2</sup> the Examining Attorney asserts that (footnote omitted):

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<sup>2</sup> It is noted that besides the definition of "mailroom" previously referred to by applicant from The American Heritage Dictionary of the English Language (3d ed. 1992), the record also contains a definition of "toolbox, toolkit," which The Computer Glossary (7th ed.) lists as meaning "[a] set of software routines that allow a program to be written for and to work in a particular environment. The routines are called by the application program to perform various functions, for

MAILROOM TOOLKIT [merely] describes a set of software routines or utilities, called tools, used to develop and maintain mailroom or postal applications or functions in conjunction with conventional database programs. The software is used to recreate several [of] the functions of a mailroom.

As to applicant's contention that a mark comprising a combination of merely descriptive words is nevertheless registrable if the combination of words creates a mark with a unique, nondescriptive meaning or one which has a bizarre or incongruous meaning as applied to the goods, the Examining Attorney points out that "the mere combination of multiple words does not automatically create a nondescriptive new word." Citing such cases as, *inter alia*, *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) ["AGENTBEANS" held merely descriptive of computer software for use in developing and deployment of application program on global computer network]; *In re Putnam Publishing Co.*, 39 USPQ2d 2021 (TTAB 1996) ["FOOD & BEVERAGE ONLINE" found merely descriptive of news and information service

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example, to display a menu or draw a graphic element." In addition, we judicially notice that The Random House Dictionary of the English Language (2d ed. 1987) defines "mailroom" as a noun meaning "a room used for handling incoming and outgoing mail, as in a large organization" and as an adjective meaning "of or pertaining to a mailroom: *mailroom employee*." It is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 (TTAB 1981) at n. 7.

for the food processing industry]; and In re Copytelle Inc., 31 USPQ2d 1540 (TTAB 1994) ["SCREEN FAX PHONE" held merely descriptive of facsimile terminals employing electrophoretic displays], the Examining Attorney (like applicant) correctly notes instead that "the registration of a mark created by combining two or more unregistrable words depends on whether in combination a new and different commercial impression is created, and/or the mark so created imparts a bizarre or incongruous meaning as used in connection with the goods." Here, the Examining Attorney urges, because the combination of the merely descriptive words "MAILROOM" and "TOOLKIT" "creates no incongruity, and no imagination is required to understand the nature of the goods, the mark remains merely descriptive."

In particular, the Examining Attorney explains that  
(footnote omitted):

Applicant's contention that its mark is not descriptive, but merely ... suggestive, is not accurate based on the ... description of its goods ... and the advertisement ... supplied as a response to the request for more information. Specifically, ... the Applicant's identification [of its goods] refers to the United States Postal Service (USPS). The computer software (or "toolkit") works with other databases that an individual or organization is already using and can be used to support certain mailroom functions. Supporting the descriptiveness of the "mailroom" aspect of the mark, is the fact that the computer software meets USPS standards--immediately apparent and relevant to the users because

the applicant's identification of goods includes that fact in the description. It does not matter if the software is not necessarily [to] be used in a mailroom, nor does it necessarily create a mailroom. The fact is that the software is a toolkit used to "assist with mail related functions" [according to applicant's main brief]--the tools work in conjunction with a database the user is already using and using the information contained in the database, it recreates some of the functions, purposes or characteristics of a mailroom. The combination of the terms MAILROOM TOOLKIT is not incongruous, but immediately descriptive to the intended users of the software. Therefore the mark is [merely] descriptive of a feature, purpose, use, or characteristic of the applicant's goods.

Applicant, in its reply brief, takes strong exception to the Examining Attorney's assertions that its goods are used to recreate "several" or "some" of the functions of a mailroom. According to applicant, its goods are instead "used as a toolkit for developing or augmenting database applications, and it is only these developed applications that are capable of assisting with mail related functions, not the goods," and "[t]he advertised functions, such as filling in correct cities, standardizing and adding zip+4 to an address, printing certain USPS forms and presorting mail, are only activated by installing and integrating Applicant's software goods into an address database" (underlining in original).

Finally, applicant appears to concede that there is such a characteristic, feature or purpose of its goods as the

capacity or ability to add "mailroom functions" to existing database applications of its customers when it reiterates, in its reply brief, that "[a]pplicant's product is directed to development of database applications, not the provision of *mailroom functions* by itself" (emphasis added). Applicant, however, steadfastly maintains in conclusion that (underlining in original):

The mark MAILROOM TOOLKIT does not in fact tell the potential customer what the goods are; the goods are not a toolkit for some mailroom. They are not even an out of the box set of postal capabilities. MAILROOM itself is not a quality, characteristic, ingredient, or use of Applicant's goods. The word MAILROOM is not descriptive of USPS certified OCX based database controls intended for use in a database application. The goods meeting USPS standards does not support a determination of descriptiveness for the mark, much less a determination of mere descriptiveness. Surely it is clear that not every reference to the postal authority is a reference to a mailroom. It is misleading to say that Applicant's software is "used to assist with mail related functions . . .," as if the goods could do so right out of the box. She also incorrectly characterizes the goods as "using the information contained in the [customer's] database, [so that] it recreates some of the functions, purposes and characteristics of a mailroom." But there is no mailroom, only some mail related functions, unusable until integrated with a database application that is not included, and mail related functions are not the equivalent of a mailroom. The goods themselves do not recreate anything; the goods only allow the customer's own

database to perform some mail related functions.

In the present case, we agree with applicant that, when considered in its entirety, the mark "MAILROOM TOOLKIT" is, on this limited record, suggestive rather than merely descriptive of applicant's "computer software for adding United States Postal Service (USPS) capabilities to conventional database programs for use by individuals, businesses and organizations." While, as applicant ultimately admits, the term "TOOLKIT" is merely descriptive of its goods and has accordingly been disclaimed, there is simply no showing that the word "MAILROOM" is the equivalent of or otherwise immediately connotes United States Postal Service capabilities or that a typical mailroom function is to add such capabilities to conventional or other database programs.<sup>3</sup> Although applicant's goods obviously can be used to help expedite the mailing process performed by a mailroom facility, they do so through the indirect route or further step of modifying existing database programs, such as those containing mailing lists, so as to standardize the information contained therein. Specifically, according to applicant's advertisement, its computer programs

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<sup>3</sup> Other than a single product advertisement, the only information of record with respect to applicant's goods is the following statement, which appears on the specimens showing applicant's use of its mark: "MailRoom ToolKit is published bimonthly by Satori Software, Inc., which holds a non-exclusive license from the U.S. Postal Service to

are variously used to change database applications so as to add "Zip+4 to an address," fill in automatically "correct City / State data," print "USPS Form 3553" and other "required USPS documentation," and presort "mail for lowest postage rates." Nothing in the record, however, demonstrates that the addition of such capabilities to existing database programs constitutes or "recreate[s] the functions [of] a mailroom" as contended by the Examining Attorney.

Moreover, even if the word "MAILROOM" were to be considered, like the term "TOOLKIT," to be merely descriptive of applicant's goods, the amalgam formed by joining the word "MAILROOM" and the term "TOOLKIT" is more than just a combination of two descriptive designations which lose none of their descriptiveness when combined. The mark "MAILROOM TOOLKIT," instead, creates just enough of an initial double entendre, or perhaps even an incongruity, when utilized in association with computer software for adding United States Postal Service (USPS) capabilities to conventional database programs, as to require a modicum of imagination, perception or thought in order for consumers to comprehend or conclude that such goods are for use in modifying database programs relating to mailing and other mailroom functions rather than literally a

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publish and sell Zip+4 information. Use of this disc beyond the expiration date is unauthorized."

toolkit program for mailroom use. The mark requires imagination or cogitation as an additional mental step in order for applicant's customers to perceive that it is a toolkit designed to create "mailroom friendly" database programs. Stated otherwise, combining the word "MAILROOM" with the term "TOOLKIT" so as to form the mark "MAILROOM TOOLKIT" does not result in a term which directly imparts, with any degree of particularity, information about the nature, purpose, function, use, characteristics, features or other significant aspects of applicant's goods. Consequently, on the basis of the limited record before use, the mark is at most only suggestive of applicant's goods rather than merely descriptive.

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