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Paper No. 16
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Touch Technology International, Inc.

Serial No. 75/728,366

R. Lee Fraley of Snell & Wilmer for Touch Technology International, Inc.

Stacy B. Wahlberg, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Cissel, Walters and Holtzman, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Touch Technology International, Inc. has filed an application to register the mark POCKETSERVER for "computer software for operating smart-card information and transaction processing systems and for operating network communications systems."¹

¹ Serial No. 75/728,366, in International Class 9, filed June 14, 1999, based on an allegation of a bona fide intention to use the mark in commerce.

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The Trademark Examining Attorney has finally refused registration, under Section 2(e)(1) of the Trademark Act,

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U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its goods.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

The Examining Attorney contends that "applicant's software functions as a server and it is very small of 'pocket' size"; that the fact that the term "server" also identifies computer hardware does not detract from the fact that, in this case, "applicant has server software for smart card systems"; and that the individual terms comprising the mark form a compound term that, considered in connection with the identified goods, precisely describes the size and function of these goods.

In support of her position, the Examining Attorney submitted dictionary definitions of "pocket" and "server." "Pocket" is defined, in pertinent part, as "adj., 1. suitable for or capable of being carried in one's pocket. 2. small; miniature." [*American Heritage Dictionary of the English Language*, 3rd ed. 1992.] "Server" is defined, in pertinent part, as "a program which provides some service to other (client) programs. The connection between client and server is normally by means of message passing, often over a network, and uses

some protocol to encode the client's requests and the server's responses." [*The Free On-line Dictionary of Computing*, © 1993-2001 Denis Howe.] We additionally take judicial notice of the following definition of "server" as "a computer in a network that is used to provide services (as access to files or shared peripherals or the routing of e-mail) to other computers in the network." [*Merriam Webster Collegiate Dictionary*, 2002.]

The Examining Attorney also submitted excerpts of articles appearing in the LEXIS/NEXIS database to establish the nature of the use of the terms "pocket" and "server" in connection with hardware and software products. The record includes four excerpts using the term "pocket server" to refer to a type of printer server, e.g., "[t]he DirectNet line of external, internal and pocket servers features a standard setup and installation utility across the line for easier printer resource management." [*Computer Reseller News*, October 3, 1994.] Additionally, the following are several examples of excerpts using the term "pocket computer":

Lieser, a fire controlman on board the guided missile destroyer McFaul, said his new pocket computer will allow him to download e-mails, read day plans and find maintenance instructions without the hassle of waiting to use a desktop." [*The Virginian-Pilot*, July 26, 2000.]

Computer hard-drives in homes, pocket computers and e-mail are becoming more frequently used sources of evidence in crimes," [Newsday, June 25, 2000.]

IBM Corp. said Tuesday it's nearly ready to ship a matchbook-size hard disk drive that stores up to 1 billion bytes of information for hand-held devices such as digital cameras, pocket computers and cellular phones. [Investor's Business Daily, June 21, 2000.]

Applicant contends that the references to "pocket computer" and "pocket server" are inapposite because the examples of "pocket computer" refer to "fully functional computer hardware devices" and the examples of "pocket server" refer to "portable printer servers"; and that these goods are "fundamentally different from applicant's goods." Applicant contends that its mark is incongruous because its goods are computer software rather than hardware; and that its mark "conveys an impression of 'serving the user with Smart Card information,' or for 'serving the user with transaction processing information and interfacing to network communications systems.'" Applicant asks that doubts as to descriptiveness be resolved in its favor.²

² Applicant asks, alternatively, in its brief, that if it would overcome the refusal, applicant should be allowed to amend its identification of goods to exclude "hand held interactive personal computers and printing peripherals." The Examining Attorney responded in her brief that such a proposed amendment was untimely and, in any event, would not overcome the refusal to register. We agree that such an amendment is untimely. Further, remand for consideration is unnecessary because the Examining

In support of its position, applicant submitted a sample of its proposed goods. The sample is a plastic card not unlike a credit card, with the mark appearing thereon. Applicant also submitted copies of Internet web pages for the goods identified in several of the LEXIS/NEXIS excerpts submitted by the Examining Attorney; and copies of articles excerpted from the LEXIS/NEXIS database about applicant and its POCKETSERVER product. Although this is an intent-to-use application, we find it useful to consider what the following articles state about applicant and its POCKETSERVER product:

At its second annual Smart Card Business Development Conference, Microsoft ... generated some news with the release of Windows for Smart Card Toolkit 1.1, More importantly, the software powerhouse showed developers it is gaining momentum for its smart card technology, which is competing with Java programming language for the affections of smart card makers. About a dozen companies [including applicant] demonstrated support for the Windows for Smart Cards, the tiniest of all the Windows operating systems [*TechWeb News*, July 3, 2000.]

Phoenix-based TTI [applicant], a provider of smart-card products, will release PocketServer 1.0, a suite of e-commerce and productivity applications for smart cards on May 31. PocketServer allows users to keep browsing, purchasing and correspondence information at their fingertips. The PocketServer 1.0 card features the following applications:

Attorney has stated in her brief that the proposed amendment will not result in her withdrawal of the refusal to register.

- An editable list of favorite Web site addresses, user names and passwords.
 - Address information that can be automatically entered at e-commerce sites.
 - Information for credit card transactions.
 - Personal contact data including phone numbers, e-mail and postal addresses.
- [*The Arizona Republic*, May 4, 2000.]

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

The Examining Attorney has provided ample evidence that "pocket" is merely descriptive of something small, in this case the card that contains applicant's software. Based on the definitions of "server," it is clear that this term does not pertain only to printers; that servers include software; and that servers facilitate, *inter alia*, networking and interaction with multiple applications, which is the case with the product with which applicant intends to use the term it seeks to register. We find nothing incongruous about the combination of the two terms, "pocket" and "server," into the compound mark, POCKETSERVER. We have no doubt that POCKETSERVER is merely descriptive in connection with the identified goods. We are not persuaded otherwise by applicant's arguments.

When applied to applicant's goods, the term POCKETSERVER immediately describes, without conjecture or speculation, a significant feature or function of applicant's goods, namely their size and function. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers or prospective customers of applicant's services to perceive readily the merely

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descriptive significance of the term POCKETSERVER as it pertains to applicant's goods.

Decision: The refusal under Section 2(e)(1) of the Act is affirmed.