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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SPX Corporation

Serial No. 75/878,287

John H. Weber of Baker Hostetler LLP for SPX Corporation.

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

Before Seeherman, Holtzman and Drost, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

SPX Corporation has appealed from the final refusal of the Trademark Examining Attorney to register E-DIAGNOSTICS for "electronic engine analysis system comprised of a hand-held computer and related computer software."¹ Registration has been refused on three grounds: applicant's mark is merely descriptive within the meaning of Section 2(e)(1) of

¹ Application Serial No. 75/878,287, filed December 22, 1999, and asserting a bona fide intent to use the mark in commerce.

the Trademark Act, 15 U.S.C. 1052(e)(1); applicant has failed to comply with the requirement to submit an acceptable identification of goods; and applicant has failed to comply with the requirement to provide information about its goods.

Applicant and the Examining Attorney have submitted appeal briefs.² Applicant had requested an oral hearing, but subsequently withdrew that request.

This case bears many similarities to another appeal filed by applicant for the mark E-AUTODIAGNOSTICS, **In re**

² With their briefs applicant and the Examining Attorney have submitted certain dictionary definitions. The Board may take judicial notice of dictionary definitions, and we have therefore considered this material. **University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.**, 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

In its appeal brief, applicant also objects to an excerpt submitted by the Examining Attorney from the on-line Acronym Finder. Applicant claims that the Board has previously stated that no evidence from this web-site should be considered as evidence, but has provided no authority to support this claim. (The case cited by applicant is non-precedential, and has not been considered.) Applicant also discusses statements allegedly made in the preface for the web-site, but these claims are unsupported. Applicant did not submit a copy of the preface, despite the fact that the Acronym Finder excerpt was made of record by the Examining Attorney in the first Office action, and applicant clearly had an opportunity to submit evidence in response. Accordingly, we have considered the Acronym Finder evidence. We would point out, however, that this evidence, namely, that "E" is an acronym for "electronic," is supported by the other evidence of record.

Finally, applicant states in its brief that the trademark database contains numerous registrations for the letter "E" without a disclaimer. Applicant did not submit copies of any such registrations, and we consider this mere conclusory statement to have no probative value.

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SPX Corporation, __USPQ2d__, Serial No. 75/877,999 (TTAB April 5, 2002) and we will therefore refer to some of the statements we made in that opinion in the present case.

We turn first to the requirement that applicant submit information about its goods. In the first Office action the Examining Attorney stated that "applicant must submit samples of advertisements or promotional materials for the goods or, if unavailable, for goods of the same type," and "if such materials are not available, the applicant must describe the nature, purpose, and channels of trade of the goods in the application." Applicant, in its response to this Office action, simply ignored the request for information, and the requirement for such information was therefore made final in the next Office action. Applicant did not attempt to comply with the requirement by filing a request for reconsideration, and did not mention the requirement in its appeal brief. The Examining Attorney discussed applicant's failure to respond to the information requirement in her brief; applicant did not file a reply brief.

Thus, applicant has neither attempted to comply with the Examining Attorney's requirement for information, nor has it provided any explanation for its failure to comply.

Trademark Rule 2.61(b) provides that the Examining Attorney may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application. Applicant has clearly not complied with this requirement. Rather it has totally ignored the request for information. Accordingly, we affirm the refusal based on applicant's failure to comply with the requirement for information concerning its goods. See **In re Babies Beat, Inc.**, 13 USPQ2d 1729 (TTAB 1990).

We turn next to the requirement for an acceptable identification of goods, since the identification of goods is relevant to our consideration of the refusal based on mere descriptiveness. The Examining Attorney asserts that applicant's identification—electronic engine analysis system comprised of a hand-held computer and related computer software—is indefinite because the term "related computer software" is unclear in that it does not indicate the function of the software. It is the Examining Attorney's position that, as identified, the software could be used for any function, including "system operating software, operating software for the hand-held computer, some type of communication software for communications between the hand-held computer and an electronic engine, or

it could have any of a number of other functions." Brief, p. 8.

We disagree. Although certainly an additional phrase in the identification stating the function of the software would provide more information as to exactly what the software does, we do not believe it to be necessary in order to provide the public with notice as to the nature of applicant's goods. The identification indicates that the software is used as part of an electronic engine analysis system, and this language is sufficiently limiting that it would not be reasonable to interpret the software as general system operating software, etc. Thus, the identification is adequate to indicate the scope of any registration which applicant might obtain.

This brings us to the refusal under Section 2(e)(1). Section 2(e)(1) of the Act prohibits the registration of a mark which is merely descriptive of the identified goods. Both applicant and the Examining Attorney have set forth the principles which govern the determination of whether a mark is merely descriptive, and therefore we will not repeat them here.

In support of her position that the mark is merely descriptive, the Examining Attorney has submitted various dictionary definitions:

e-: (Electronic-) The "e-dash" prefix may be attached to anything that has moved from paper to its electronic alternative, such as e-mail, e-cash, etc.³

E stands for electronic. But it's become the all-purpose Internet and Web prefix. Stuck on the front of any term you want, it means to make that thing happen over the Internet/Web, e.g., e-commerce, e-mail, e-check.⁴

diagnostic: the art or practice of diagnosis—often used in pl.⁵

diagnosis: investigation or analysis of the cause or nature of a condition, situation, or problem <~ of engine trouble>

In addition, the Examining Attorney has submitted a substantial number of excerpts taken from the NEXIS database, including the following:

When you see a technological term that starts with the letter 'e' and a hyphen, it most likely is an e-commerce-driven term. And nine times out of 10, the "e" means electronic.
"USA Today," July 8, 1998

In automotive applications, Blue-tooth will be used to connect hand-held devices to onboard electronics to enable hands-free phone use, for example, or engine diagnostics and GPS information over PDAs or similar devices.
"Purchasing," November 16, 2000

³ The Computer Glossary, 8th ed. © 1998.

⁴ Newton's Telecom Dictionary, 16th ed., © 2000.

⁵ Merriam-Webster's Collegiate Dictionary, 10th ed., © 1998.

Anyone who owns an off-brand car should think twice before venturing far from a dealership or garage that can fix it, he says. Nobels said that computerized diagnostic equipment is specialized and very expensive these days.

"The Orlando Sentinel," July 27, 2000

Both engine manufacturers and after-market suppliers have developed sophisticated hardware and software systems designed to make engine diagnostics and troubleshooting quicker and more intuitive. ... Cummins' new QuickCheck system piggybacks upon the expanding capabilities of Palm handheld devices to enable them to read and capture SAE J1587 engine data quickly and conveniently from any electronic diesel engine.

"Diesel Progress North American Edition," July 1, 2000

It could also help make engine diagnostics at the repair shop easier, allowing a mechanic to just park the car next to a shop console without having to wriggle under the hood to connect a cable.

"Electronic News," January 8, 2001

Martin County residents interested in an automotive career will be able to get their hands on the latest diagnostic equipment, engine analyzers, scanners, lab scopes and automotive software in a new state-of-the-art automotive laboratory....

"The Stuart News/Port St. Lucie News (Stuart, FL)," November 26, 2000

We have no doubt, based on the evidence of record, that "DIAGNOSTICS" describes the identified engine analysis system. As the dictionary definition for "diagnostic"

points out, this term is often used in the plural, and means "diagnosis,"⁶ and the word "diagnosis" is defined with the very word used in applicant's identification—the analysis of the cause or nature of a condition, situation or problem. In fact, the dictionary's example of use of this word is in terms of the function of applicant's goods: diagnosis of engine trouble. The NEXIS evidence also shows that "diagnostics" is a recognized term for engine analysis.

Applicant does not dispute the descriptive nature of the word "diagnostics." However, applicant argues that the presence of the prefix "E-" in the mark prevents the mark as a whole from being merely descriptive. Applicant contends that because the dictionary definition of "E-" states that this prefix may be attached to anything that has moved from paper to its electronic alternative, the term E-DIAGNOSTICS does not make any real sense, since an engine analysis system would not be converted to electronic form from paper. Applicant also argues that the "E-" prefix is recognized by the public to represent services provided over the Internet, but because applicant is

⁶ We take judicial notice of the dictionary definition of "diagnostics" in The American Heritage Dictionary of the English Language © 1970 meaning "diagnosis".

applying the prefix to goods, it creates a unique commercial impression. Finally, applicant claims that there is an incongruity in combining the "E-" prefix with DIAGNOSTICS because the function of the goods, diagnostics, cannot be electronic.

We are not persuaded by these arguments. The dictionary definition shows that the "E-" prefix means "electronic." Applicant's goods are identified as an electronic engine analysis system. Further, although "E-" is frequently used in connection with the Internet, many associate the prefix with computers in general and activities that are performed by computers. As the identification states, applicant's electronic engine analysis system uses, that is, is comprised of, a computer and related software. It is, in fact, an electronic diagnostic system. When the prefix is combined with DIAGNOSTICS, and used in connection with an "electronic engine analysis system comprised of a hand-held computer and related computer software," the resulting mark E-DIAGNOSTICS mark will immediately convey to consumers that this is an electronic system using computer technology to analyze engines.

There are two final points we must address. Applicant claims that its mark is a double entendre because the

definitions for "E" include "earth, engineer, excellent, and English." However, because the determination of whether a mark is merely descriptive must be made in relation to the goods on which the mark is used or proposed to be used, and because applicant's goods are identified as "electronic," it is this meaning of the word that consumers will ascribe to the mark. The second point concerns statements made by the Examining Attorney in her brief. While she argues that the identified engine analysis system is electronic (e.g., "the diagnostic devices are electronic", brief, p. 4), she also has made certain statements that the mark is merely descriptive because the goods are electronic diagnostic systems used for analyzing the condition of electronic engines. We do not read applicant's identification as being an analysis system for electronic engines; rather, the term "electronic" modifies the kind of system that it is, not the kind of engines that the system analyzes. As noted above, we find that E-DIAGNOSTICS is merely descriptive because it describes a characteristic of the goods, namely, that it is an electronic system used to analyze engines. (The Board need not find that the Examining Attorney's rationale is correct in order to affirm the refusal to register. See TBMP §1217, and cases cited therein.)

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Decision: The refusal based on the unacceptability of the identification of goods is reversed; the refusals based on the ground that the mark is merely descriptive of the goods and the requirement for information are affirmed.