

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

4/30/02

Hearing:
March 6, 2002

Paper No. 18
TJQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hitachi Software Engineering Co., Ltd.

Serial No. 78/007,276

Edward M. Prince of Alston & Bird for applicant.

Michael Ryan Tanner, Trademark Examining Attorney, Law
Office 102 (Thomas Shaw, Managing Attorney).

Before Quinn, Hairston and Drost, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Hitachi Software
Engineering Co., Ltd. to register the mark SHAREWIZARD for
"computer application software used by business for
telephone conference and network conference connections."¹

The Trademark Examining Attorney has refused
registration on the ground that applicant's mark, as

¹ Application Serial No. 78/007,276, filed May 8, 2000, alleging
a bona fide intention to use the mark in commerce. Applicant
subsequently submitted, on August 3, 2001, an amendment to allege
use setting forth a date of first use anywhere and a date of
first use in commerce of October 2000.

applied to applicant's goods, is merely descriptive of them.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs, and applicant's counsel and the Examining Attorney appeared at an oral hearing before the Board.

At the outset, it should be noted that applicant has filed an alternative amendment to seek registration on the Supplemental Register. See: TMEP § 1212.02(c); and TBMP § 1215. Applicant, in the papers filed August 3, 2001, requested that the application be amended to one seeking a Supplemental Register registration in the event the Board found the mark to be merely descriptive. In response, the Examining Attorney indicated that the alternative amendment was acceptable.

Applicant explains that its product is "collaborative software which allows one to connect its members at far cites." Users "can have voice communication while making annotation on shared data" and "[w]ith a simple click on a specially designed pen, the annotations made on one screen will be projected on screens at remote sites as if by magic while simultaneously permitting voice conferencing." (emphasis in original). According to applicant, "as if by magic or through wizardry, the annotations made at remote

locations are projected on a teleconferencing computer screen and combined with voice inputs." (brief, pp. 5-6). Applicant argues that its mark is a nonsensical, suggestive term and that others in the trade do not have a competitive need to use the term in connection with their similar products. Applicant urges that any doubt with respect to mere descriptiveness must be resolved in its favor. In support of its arguments, applicant submitted literature regarding its product, and several third-party registrations showing, according to applicant, that similar marks in the technology field were found to be not merely descriptive. Applicant contends that the registrations establish a consistency in Office practice which is not followed in this case.

The Examining Attorney maintains that the mark describes "a desired feature or function of the applicant's software and the means by which the desired function is implemented, namely, a utility interface--or 'wizard'--that helps the user employ or use the desired function of the software application--namely, voice and data sharing over a telecommunications network with no limit as to the number of connections." (brief, p. 5). In essence, according to the examining attorney, "the purpose of applicant's easy-to-use interface utility is to make data and document

sharing possible during conference calls." (brief, p. 7). With respect to the third-party registrations, the Examining Attorney states that they are not conclusive on the descriptiveness issue in the present case. In support of the refusal, the Examining Attorney submitted dictionary definitions of the words "share" and "wizard," and excerpts of articles retrieved from the NEXIS database showing uses of "share" and "wizard" in the same article.

It is well settled that a term is considered to be merely descriptive of goods, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods. 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 in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods for which registration is sought. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

The word "share" is defined as "to participate in, use, enjoy, or experience jointly with another or others." Dictionary.com The word "wizard," as defined by Webopedia, means as follows: "A utility within an application that helps you use the application to perform a particular task. For example, a 'letter wizard' within a word processing application would lead you through the steps of producing different types of correspondence."

Applicant's product literature shows that its software is used to share data and, thus, the term "share" describes a function or feature of the software. We also find that a feature of applicant's software is encompassed within the broad definition of the term "wizard" as set forth above. The NEXIS articles appear to use the term "wizard" in a broad sense, as for example: "Windows ME has new software wizards that help the user set up home networks" (*Dayton Daily News*, July 9, 2000); "the new operating system has a 'wizard' that makes [networking] easier" (*Los Angeles Times*, July 3, 2000); and "a 'wizard,' or small program, surveys the major pieces of hardware and software on your machines" (*The Washington Post*, August 21, 1995).

Applicant's literature indicates that applicant's product is "data sharing software" which "allow[s] you to share your PC data with others, then make an annotation on

sharing data interactively" through use of "ShareWizard Pen" and "ShareWizard Talk." The literature describes the SHAREWIZARD feature as an "easy to use" and "simple" interface.

Accordingly, we conclude that the term SHAREWIZARD immediately describes, without conjecture or speculation, a significant feature of the goods, namely, the utility within applicant's software application that helps the user share data (e.g. annotations) and voice communications with others.

The third-party registrations have been carefully considered, but this evidence does not compel a different result. Applicant and the Examining Attorney have argued at some length about the practice of the Office relative to the registrability of marks having either of the words "share" or "wizard" as a portion thereof. Suffice it to say, this evidence is of little moment in deciding the present appeal. While uniform treatment under the Trademark Act is an administrative goal, our task in this appeal is to determine, based on the record before us, whether applicant's particular mark is merely descriptive. As often noted, each case must be decided on its own merits. We are not privy to the records in the cited registrations and, moreover, the determination of

registrability of a particular mark by the Office cannot control the result in the case now before us. See: In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to [applicant's application], the PTO's allowance of such prior registrations does not bind the Board or this court."].

Decision: The Section 2(e)(1) refusal to register on the Principal Register is affirmed. Inasmuch as the Examining Attorney has accepted the alternative amendment to the Supplemental Register, the application file will be forwarded in due course to the Examining Attorney for appropriate action.²

² As indicated by the Examining Attorney in the Office action dated October 17, 2001, the application will be given a new filing date of August 3, 2001 (see Trademark Rule 2.75(b) and TMEP § 1115.02) and the Examining Attorney will conduct a new search of Office records for any confusingly similar marks under Section 2(d).