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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Cardiff Software, Inc.

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Serial No. 78/039,026

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John M. Kim of Gray Cary Ware & Freidenrich LLP for Cardiff Software, Inc.

Howard Smiga, Trademark Examining Attorney, Law Office 102 (Thomas V. Shaw, Managing Attorney).

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Before Simms, Hohein and Bucher, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Cardiff Software, Inc. has filed an application to register the term "AUTOMERGE PUBLISHER" for "computer software

used to merge source data with form templates for delivery of pre-filled forms."[1]

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

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm 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

[1] Ser. No. 78/039,026, filed on December 12, 2000, which alleges a date of first use anywhere and in commerce of September 21, 2000.

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).

Applicant argues in its brief that the term "AUTOMERGE PUBLISHER" is suggestive rather than merely descriptive of its computer software. Among other things, applicant asserts that "the term 'publisher' is defined as 'a person or corporation whose business is publishing" and maintains that, inasmuch as a "related definition provided by the Examining Attorney is 'one that is engaged in publishing printed material," the "word 'one' naturally refers to a person" (underlining by applicant). Applicant contends, in view thereof, that because its goods "are neither a person nor a corporation," "the relation of the term 'publisher' to computer software is not immediately apparent to a consumer, especially when this word is used in connection with

the term 'AutoMerge' and the mark is properly considered in its entirety."

In addition, applicant observes that "there is no record of any [third-party] use of 'AutoMerge Publisher' to describe a software program used to create pre-filled forms and personalized response documents." "Even more compelling," according to applicant, "is the fact that the Examining Attorney could not find a single reference to 'AutoMerge Publisher' for **any** software program" as a result of his search of the "NEXIS" database (emphasis by applicant). Thus, while admitting that "the Examining Attorney has found articles suggesting that the word 'automerge' may be descriptive of software programs which are all quite different in function and form than applicant's software," applicant insists that the Examining Attorney "has yet to find one article where the applicant's mark **AUTOMERGE PUBLISHER** has been used in a descriptive sense." There being "no evidence that anyone that manufactures a similar software product would need to use the mark **AUTOMERGE PUBLISHER** to describe their product, applicant asserts that "this mark should be considered at least suggestive" when used in connection with its goods because "[t]he competitive needs of others are not damaged by the registration of a composite mark that will never be used by others to describe their goods."

Applicant further argues that, "[e]ven assuming arguendo that 'automerge' is descriptive of a certain type of software program, the overall composite mark ... **AUTOMERGE PUBLISHER** is not immediately descriptive of a software program which creates pre-filled forms and personalized response documents." In particular, applicant urges that:

> When a consumer sees a mark, it is well recognized that they see and consider the mark as a whole. According to the Examining Attorney, a reasonable consumer would see the word AutoMerge and dissect and understand this composite word to be, in the first part, an acronym for "automatic" which is defined in [the excerpt of record from] a computer science dictionary as: "a wide variety of devices that perform unattended operation." This presupposes that a reasonable consumer would be familiar with a definition found in a computer science dictionary. Although this software is used in a computer, the average consumer of this software is not a computer scientist and is not familiar with definitions contained within a computer science dictionary. At the very best, a consumer may understand "automatic" to mean "largely or wholly involuntary", which is the Webster's dictionary definition and commonly understood definition of this word. The next step a consumer would allegedly embark upon is to define the word "merge" to mean "to combine or unite." The final step a consumer would allegedly embark upon is to define "publisher" as "one that is engaged in publishing printed material." Thus, the defined meaning of AUTOMERGE PUBLISHER is "a largely or wholly involuntary combining or uniting by one that is engaged in publishing printed material." After pondering and defining these individual words, a consumer is supposedly able to identify a function,

> feature or characteristic of the underlying goods. However, even after this improper dissection and careful consideration, it is not clear what function, feature or characteristic is identified by the above description. .... Every function [of applicant's software] is controlled by the user which is carried out by the algorithms of the software code. Finally, as mentioned above, since there is no person or corporation doing the publishing (it is a software program), the use of the term "PUBLISHER" is totally incongruous. All of these factors support the argument that the subject mark is suggestive, rather than merely descriptive.

The Examining Attorney, on the other hand, maintains that the issue of mere descriptiveness of the term "AUTOMERGE PUBLISHER" must be determined "from the standpoint of actual or prospective purchasers or users of the Applicant's goods." Such individuals, according to the Examining Attorney, are those "who deal with the collecting, analyzing and processing [of] various pieces of data and information [and] who must join all of this information together as a single document." These individuals, the Examining Attorney contends, will immediately perceive the merely descriptive significance of the term "AUTOMERGE PUBLISHER" as such term is used in connection with applicant's goods.

In particular, applicant's specimens of use and its advertising literature demonstrate that it invariably uses the term "AUTOMERGE PUBLISHER" in the format "AutoMerge Publisher,"

thereby making the constituent elements of such term readily apparent to customers for and users of its goods. Rather than improperly dissecting applicant's asserted mark, the Examining Attorney insists that, due to the manner of use thereof, consumers for applicant's goods would immediately understand that the term "AUTOMERGE PUBLISHER" merely describes a characteristic or feature of the product. Specifically, as explained by the Examining Attorney:

> [T]he term, AUTO, in relation to the computer industry, "refers to a wide variety of devices that perform unattended operation," and merely describes ... a characteristic of the applicant's goods--i.e., that the goods perform specific tasks without human intervention. See Freedman, Alan, *The Computer Glossary*, p. 23 (7th ed. 1995). The term, MERGE, is defined as "to combine or unite: *merging two sets of data*," and merely describes ... a characteristic of the applicant's goods--i.e., that the goods allow the user to combine sets of data. In the instant case, the combined terms, AUTO and MERGE, merely describes [sic] ... a characteristic of the applicant's goods--i.e., that the goods allow the user to combine its data with the data already in a database without human involvement.

As further evidence of the mere descriptiveness of the term "AUTOMERGE," the Examining Attorney points to excerpts from articles retrieved from his search of the "NEXIS" database "in which the term, AUTOMERGE or AUTO MERGE[,] appeared in twenty

stories."[2] Although many of the excerpts are from wire services and thus are of limited probative value,[3] the most pertinent of the other excerpts are set forth below (emphasis added):

> "The scanner also includes an **automerge** feature that stitches together two pieces of [a] large image." -- InfoWorld, July 19, 1993;
>
> "The unit also includes Jam Sync and **Auto Merge**, a feature that merges MIDI data from two sources into one file." -- MacWEEK, June 25, 1991; and
>
> "Scotland is already host to a species of what locals call 'liveware' -- a database that spreads autonomously on Macintosh systems. When two computers are connected, the 'liveware' on one searches out databases on the other, locates the one it wants and then "**auto merges**" its data in a sort of cybernetic date-rape." -- Washington Post, May 6, 1990.

Such evidence, the Examining Attorney contends, shows that combining the descriptive terms "AUTO" and "MERGE" to form the

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[2] While the search request of "('AUTOMERGE' OR 'AUTO MERGE') AND NOT CARDIFF" did indeed find 20 stories, excerpts from only 11 of the 20 articles located through such request were printed and made part of the record.

[3] Specifically, five of the 11 excerpts made of record are from either "Business Wire" or "PR Newswire." Such excerpts are of limited probative value inasmuch as there is no evidence that the stories set forth therein have actually appeared in publications of general circulation in the United States. It therefore cannot be assumed that the excerpts from such articles have had any material impact on consumer perception or attitude as to the meaning of the term "AUTOMERGE" or its equivalent "AutoMerge." See, e.g., In re Appetito Provisions Co. Inc., 3 USPQ2d 1553, 1555 n. 6 (TTAB 1987) and In re Men's Int'l Professional Tennis Council, 1 USPQ2d 1917, 1918-19 (TTAB 1986).

combination "AUTOMERGE" "creates no incongruity" and thus "the mark remains merely descriptive."

With respect to the term "PUBLISHER," the Examining Attorney, besides relying on the definition thereof noted by applicant, additionally cites definitions of the following two terms, which are attached to his brief, from an on-line edition of the Merriam-Webster Dictionary: (i) "desktop publishing," which is defined as "the production of printed matter by means of a desktop computer having a layout program that integrates text and graphics," and (ii) "electronic publishing," which is listed as signifying "publishing in which information is distributed by means of a computer network or is produced in a format for use with a computer."[4] Based on such entries, he argues that (footnotes omitted):

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[4] Although the submission thereof is technically untimely under Trademark Rule 2.142(d), the Examining Attorney's request that the Board "take judicial notice of all on-line dictionary definitions as indicated" in his brief is granted inasmuch as the Board may properly take judicial notice of on-line dictionary definitions where, as here, it is apparent that the on-line dictionary is also available in book form. Compare In re CyberFinancial.Net Inc., 65 USPQ2d 1789, 1791 n. 3 (TTAB 2002) with In re Total Quality Group Inc., 51 USPQ2d 1474, 1476 (TTAB 1999). Moreover, and in any event, we judicially notice in this regard that The American Heritage Dictionary of the English Language (4th ed. 2000) similarly defines "desktop publishing" as connoting "t]he design and production of publications using personal computers with graphics capability." The same dictionary, in pertinent part, also lists "electronic" as "[o]f, relating to, or produced by means of electronics: *electronic navigation; electronic books*" and sets forth "publishing" as "[t]o prepare and issue (printed material) for public distribution or sale" and "[t]o issue a publication." It is well established that the Board may properly take judicial notice of such dictionary definitions. See, e.g., Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330,

> The ... term, PUBLISHER, is a commonly used term in the computer software industry and is regularly used as a modifier of another computer term, i.e., desktop publisher, electronic publisher, web publisher, etc. The term, PUBLISHER, is commonly used in the computer industry to describe a feature, function or characteristic of a particular computer software program ... which allows for the retrieving, indexing, storing, creating, assembling and printing of documents.

In addition, the Examining Attorney "notes that the Applicant's own evidence supports the argument that its mark is [merely] descriptive of its goods." Specifically, applicant's advertising literature contains the following discussions of the capabilities of its software (emphasis added):

> AutoMerge Publisher™ is a powerful new way to **create pre-filled forms and personalized response documents and deliver them automatically using print**, Fax, eMail and Adobe PDF.
>
> **Using** the point & click ***Form Designer***, you can quickly **design "merge templates"**, **that combine with** variable **data**, text, barcodes and graphics **from existing database** and XML applications or as an automated extension to your TELE*form* Information Capture application.
>
> ....
>
> AutoMerge Publisher can **create a wide range of response documents and forms** including

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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 n. 7 (TTAB 1981).

> confirmations, membership cards, coupons and certificates. ....
>
> AutoMerge Publisher supports Adobe ePaper Solutions and XML standards. Through support for Adobe PDF, **merged forms and documents have the look of** 4-color **printed materials**, but can be digitally signed and submitted online. **AutoMerge Publisher**'s XML integration **uses standard** HTML **forms,** XML **data streams and processing rules to trigger the creation and delivery of merge forms or documents**.
>
> ....
>
> You may wish to **create a system that automatically sends merged content** in a specific order .... **Or** you may want to **connect** your **merge templates with** hand-held devices, legacy applications or ERP systems using **data streams to create high-quality invoices, purchase orders or statements**.

In a similar vein, several Internet search results refer to applicant's "AutoMerge Publisher" software as "a powerful way to implement **automated form merge**" (emphasis added). Thus, in the context of applicant's goods, the Examining Attorney maintains that customers for and users of such software "will have no problem determining that AUTOMERGE PUBLISHER relates to the collecting of various pieces of data and information together for the purpose of printing, sending, receiving or 'publishing' the data" and thereby merely describes a characteristic or feature of the goods.

Finally, the Examining Attorney correctly observes that:

> It is well-settled law that the fact [that] an applicant may be the first and only user of a merely descriptive ... designation does not justify registration if the term is merely descriptive. *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018 (TTAB 1983). Additionally, the fact that a term is not found in the dictionary is not controlling on the question of registrability. In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); In re Orleans Wines, Ltd., 196 USPQ 516 (TTAB 1977).

In view of the above, the Examining Attorney concludes that the evidence of record, including dictionary definitions, "NEXIS" excerpts and applicant's advertising literature, is sufficient to demonstrate that the term "AUTOMERGE PUBLISHER" merely describes a significant characteristic or feature of applicant's goods.

We agree with the Examining Attorney that, when considered in its entirety, the term "AUTOMERGE PUBLISHER" is merely descriptive of applicant's "computer software used to merge source data with form templates for delivery of pre-filled forms." We judicially notice, in this regard, that The American Heritage Dictionary of the English Language (4th ed. 2000) sets forth the prefix "auto-" as meaning in relevant part "automatic," which in turn is defined as an adjective connoting in pertinent part "**1a**. Acting or operating in a manner essentially independent of external influence or control: *an automatic light switch* .... **b**. Self-regulating: *an automatic*

*washing machine*." Thus, even if the typical purchasers and users of applicant's goods would not be computer scientists and therefore would not be familiar with a technical definition of "auto" from a computer science dictionary as referring to "a wide variety of devices that perform unattended operation," it is still the case that they would know that the ordinary or everyday meaning of such term is "automatic." See In re Time Solutions Inc., 33 USPQ 1156, 1158 (TTAB 1994) [mark "YOUR HEALTH INSURANCE MANAGER" for software programs for personal record keeping and processing of medical records, health insurance and claims found merely descriptive inasmuch as consumers, although perhaps unfamiliar with computer dictionary meaning of word "manager," would certainly know the ordinary or everyday meaning of such word and, in consequence thereof, "the mark will immediately convey to them information concerning a significant feature or function of applicant's programs, namely, that they manage, i.e., handle with skill, personal health insurance matters"].

Consequently, and in light of the previously indicated meanings of the words "merge" and "publisher," which to reiterate The American Heritage Dictionary of the English Language (3rd ed. 1992) respectively defines as "to combine or unite: *merging two sets of data*" and "one that is engaged in publishing printed material," it is readily apparent that to

customers for and users of applicant's goods, the term "AUTOMERGE PUBLISHER" conveys forthwith, without speculation or conjecture, that applicant's computer software is used to publish printed material, such as pre-filled forms, by automatically combining or uniting source data with form templates. Moreover, consumers of applicant's goods are also likely to be familiar with such terminology as "desktop publishing" and "electronic publishing," given their need for software that, *inter alia*, can publish such printed material as pre-filled forms which incorporate information from a source or sources of data. To those consumers, the term "AUTOMERGE PUBLISHER" immediately conveys information as to a significant characteristic or feature of software that automatically merges a particular source of data into a user-determined format for further use or distribution. There is nothing in the combination of the terms "auto," "merge" and "publisher" into the term "AUTOMERGE PUBLISHER" which is incongruous, ambiguous or otherwise "not immediately apparent" as contended by applicant.

Admittedly, it is possible, as applicant argues, for individually descriptive words to be combined to form a valid, registrable mark which, as a whole, is not merely descriptive. However, as indicated by the Board in, for example, In re

Medical Disposables Co., 25 USPQ2d 1801, 1804 (TTAB 1992), in order for such to be the case:

> [T]he mere act of combining does not in itself render the resulting composite a registrable trademark. Rather, it must be shown that in combination the descriptiveness of the individual words has been diminished, [such] that the combination creates a term so incongruous or unusual as to possess no definitive meaning or significance other than that of an identifying mark for the goods. See In re Calspan Technology Products, Inc., 197 USPQ 647 (TTAB 1977).

In this instance, applicant has not combined the descriptive terms "auto," "merge" and "publisher" in a bizarre or nebulous way, such as "AUTOPUBLISHER MERGE" or "MERGE PUBLISHERAUTO." Instead, the constituent elements of the combined term "AUTOMERGE PUBLISHER," especially in light of applicant's manner of use thereof as "AutoMerge Publisher," have a meaning in combination which is immediately recognizable and identical to that of their separate connotations.

Thus, nothing in the term "AUTOMERGE PUBLISHER," as indicated previously, is so incongruous or unusual as to possess no definitive meaning or significance other than that of an identifying mark for applicant's goods, nor does such composite term otherwise possess a new meaning different from that of its constituent elements. Furthermore, nothing in the composite term, when used in connection with applicant's goods, requires

the exercise of imagination, cogitation or mental processing or necessitates the gathering of further information in order for the merely descriptive significance thereof to be immediately apparent. Plainly, to customers for applicant's computer software, such term conveys forthwith that a principal feature or characteristic thereof is that the goods publish or provide printed material by automatically merging source data with form templates to create pre-filled forms. The term "AUTOMERGE PUBLISHER" is accordingly merely descriptive of applicant's goods within the meaning of the statute. See, e.g., In re Intelligent Instrumentation Inc., 40 USPQ2d 1792, 1794-95 (TTAB 1996) [term "VISUAL DESIGNER" merely describes significant purpose or function of computer programs which permit programming applications to be visually designed instead of being written in a programming language]; and In re Time Solutions Inc., supra.

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