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Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Expand Beyond Corporation[1]

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Serial No. 76189418
Serial No. 76189419
Serial No. 76189421

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Darren S. Cahr of Gardner, Carton & Douglas for Expand Beyond Corporation.

Cynthia Sloan, Trademark Examining Attorney, Law Office 116 (Meryl Hershkowitz, Managing Attorney).

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Before Quinn, Bottorff and Drost, Administrative Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

On December 29, 2000, applicant filed the three above-captioned applications, by which it seeks registration of the marks POCKET PERFORMANCE VIEWER (Serial No. 76189418), POCKET OBJECT VIEWER (Serial No. 76189419) and POCKET

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[1] By change of name from pocketDBA Systems, L.L.C., recorded on February 14, 2002 at Reel 2451, Frame 0770.

COMMAND CENTER (Serial No. 76189421), all for goods identified in each of the applications, as amended, as "computer software to monitor, manage, and troubleshoot databases via wireless devices such as personal digital assistants or cellular telephones," in Class 9. All three applications are based on applicant's allegation of a bona fide intent to use the marks in commerce, under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

In each of the applications, the Trademark Examining Attorney has made final her refusal to register the mark on the ground that it is merely descriptive of applicant's goods. *See* Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1).[2] Applicant has appealed the final refusal in each case. Applicant and the Trademark Examining Attorney have filed briefs in each of the appeals, but applicant did not request an oral hearing.

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[2] In each of the applications, the Trademark Examining Attorney also issued a final requirement, pursuant to Trademark Rule 2.61(b), for submission of information regarding the significance of the wording in the marks. However, in her briefs, she failed to make any argument (or mention) of the requirement. We therefore deem the requirement waived and shall give it no further consideration. (We note as well that applicant, in its responses to the first Office actions in each case, appears to have adequately responded to the requirement by stating that it is unaware that the wording has any significance in the relevant trade or industry.)

Because the three appeals involve common questions of law and fact, we shall decide them in this single opinion, which shall be entered in each of the application files.

The evidence of record on appeal consists of various dictionary definitions submitted by applicant and the Trademark Examining Attorney, as well as various excerpted articles from the NEXIS database and various Internet materials, submitted by the Trademark Examining Attorney. However, we have not considered the printout from the Office's TESS database (purporting to show applications and registrations involving marks with the word PERFORMANCE) submitted for the first time with applicant's appeal brief in Serial No. 76189418. The Trademark Examining Attorney properly objected to this evidence as untimely. *See* Trademark Rule 2.142(d).

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose 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). A term need not immediately convey an idea of each and every specific feature of the applicant's

goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. *See In re H.U.D.D.L.E.,* 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). 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 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 its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).[3] It is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); *see also In re*

[3] Thus, we are not persuaded by applicant's argument, repeated throughout its briefs, that because the words which comprise its marks have numerous additional (or more common) meanings which are not related to computer software in general or to applicant's software in particular, the words cannot be deemed to be merely descriptive of applicant's software.

Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985). Similarly, as the Board has explained:

> …the question of whether a mark is merely descriptive must be determined not in the abstract, that is, not by asking whether one can guess, from the mark itself, considered in a vacuum, what the goods or services are, but rather in relation to the goods or services for which registration is sought, that is, by asking whether, when the mark is seen on the goods or services, it immediately conveys information about their nature.

In re Patent & Trademark Services Inc., 49 USPQ2d 1537, 1539 (TTAB 1998).[4]

The record on appeal in these cases includes a printout from applicant's website, in which applicant describes its goods as follows:[5]

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[4] Thus, applicant misstates the law when it argues, at page 5 of each of its briefs, that "[a] mark is only descriptive if the consumer is able to *immediately* determine the nature of Applicant's goods from the mark." (Emphasis in original.) Similarly, at page 3 of each of its briefs, applicant misstates the applicable test when it argues that, "[w]hen faced with the mark [involved in each case], the consumer will not immediately understand the nature of Applicant's goods." (Emphasis added.)

[5] The quoted language from applicant's website also appears in the record in a printout of an advertisement for applicant's product carried on the website of Athena Group Inc, attached to the Trademark Examining Attorney's January 9, 2003 supplemental final action in application Serial No. 76189418.

PocketDBA™

Bring the wireless revolution to your databases

Imagine the freedom to manage your Oracle databases from any location, at any time, all from the palm of your hand. Free your DBA[6] and your company from the limitations of workstations and dial-up connections.

PocketDBA is the first wireless database administration tool, offering DBAs complete control of Oracle databases through a wireless Palm Pilot device. Far more than offering a mere snapshot of status information, PocketDBA offers DBAs much of the same functionality that could be had working directly on the database server – it lets the user get inside the database to perform almost any task. PocketDBA also incorporates user-friendly graphs and charts to facilitate ease-of-use.

PocketDBA is a comprehensive wireless solution for almost every database administration need, from basic routines to critical procedures.

PocketDBA is divided into four main modules:

Pocket User Manager™
Perform important daily tasks concerning the management of users. The DBA can see who is connected to the database, and quickly learn about the locks, memory, rollback segments, SQL, sorts and other information on each connected session. The DBA can also resolve locking issues and security by selectively "killing" existing connections to the database. Users may be added to or removed from the database, while passwords and default

[6] We take judicial notice that DBA is an acronym for "database administrator." See Microsoft Computer Dictionary (5th ed. 2002) at 141, 146. The Board may take judicial notice of dictionary definitions. *See, e.g., University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.,* 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *see also* TBMP §704.12(a).

permissions can be set and adjusted. The Pocket User Manager can also be used to view and modify security privileges throughout the database.

Pocket Object Viewer™
Browse all database objects organized by schema, or by object type. This includes constraints, functions, indexes, package specifications and bodies, procedures, rollback segments, sequences, tables, triggers, views, and other data types. Exploration and navigation among objects is simple – for example, the DBA can drill-down from a table into its statistics, storage parameter information, or table description, among other options. View extensive details on the physical attributes of database files, including size, directory, and status information. The DBA can also change the storage sizes of various objects as needed.

Pocket Performance Viewer™
View and analyze vital database performance issues. Memory usage, disk usage, and performance statistics can be reviewed in user-friendly graphs and charts. Using the Pocket Performance Viewer, the DBA can quickly identify problematic areas of database performance, and detect potential problems in a proactive manner before the impact database and application productivity. For example, problematic SQL statements, poorly sized objects, and hit ratios can be identified. Dozens of built-in performance measures are provided.

Pocket Command Center™
Pocket DBA includes the Pocket Command Center as an all-purpose interface to issue any command or run any database query. The Pocket Command Center may be easily customized on a query-by-query basis to view results clearly, even on a mobile device’s small screen. The Pocket Command Center completes the PocketDBA product, as it allows for any command or query

> not included in the other modules, which may be necessary for the user's specific applications.

We reject applicant's argument that this evidence from its website is not probative on the issue of mere descriptiveness. Applicant contends that

> [a] mark is only descriptive if the consumer is able to *immediately* determine the nature of Applicant's goods from the mark. [citations omitted]. Although Applicant's website makes reference to [the words in applicant's marks, e.g., PERFORMANCE, OBJECT], it is not until the consumer accesses this website that he or she will be able to determine what is meant by the mark's reference to [these words]. … Accordingly, because the consumer must reference Applicant's marketing material to determine the goods at issue, the consumer cannot, by definition, *immediately* determine the nature of Applicant's goods from the mark alone; the consumer must turn to external documentation to truly understand the nature of Applicant's goods in connection to the mark. (Emphasis in original.)

First, applicant's contention that the consumer cannot immediately "determine the nature of Applicant's goods from the mark alone" misstates the applicable legal test for mere descriptiveness. As noted above, "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them."

In re Tower Tech Inc., *supra*, 64 USPQ2d at 1317. Second, it is settled that the applicant's own usage of the terms at issue in its marketing materials is highly probative evidence on the issue of genericness, and by extension, the issue of mere descriptiveness. *See In re Gould Paper Corp.*, 835 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); *In re Westminster International Co. Inc.*, 23 USPQ2d 1958 (TTAB 1992). Accordingly, we have considered this evidence of applicant's own usage of the terms at issue in our determination of whether applicant's marks are merely descriptive.

POCKET PERFORMANCE VIEWER

According to applicant's identification of goods, applicant's software allows the user to monitor, manage and troubleshoot databases "via wireless devices such as personal digital assistants or cellular telephones." Applicant's website similarly describes applicant's software as "offering DBAs complete control of Oracle databases through a wireless Palm Pilot device." The NEXIS evidence of record shows that these types of devices are called "pocket" devices. See, for example:

> **Using a wireless device – such as a tablet computer, a laptop, or a PDA, which are pocket**

> **devices** – is the way the healthcare workers want to work.
> Healthcare Financial Management (August 1, 2001). (Emphasis added.)
>
> Consider employees at Ericsson's Berkeley Wireless Center, where there are no fixed office connections. Instead employees use **wireless phones, personal digital assistants or other pocket devices.**
> Wireless Week (October 16, 2000). (Emphasis added.)
>
> For those who are Palm-free, there's **another pocket device** that offers wireless Web surfing and other services – **the cellular phone.**
> Black Enterprise (April 2000). (Emphasis added.)

We also take judicial notice that in Peter Dyson, Dictionary of Networking at 291 (3d ed. 1999), "personal digital assistant" is defined as follows: "Abbreviated PDA. A tiny, pen-based, battery-powered computer that combines personal organization software with fax and e-mail facilities into **a unit that fits into your pocket**." (Emphasis added.) We likewise take judicial notice that in Dick Pontaine, The New Penguin Dictionary of Computing at 356 (2001), the entry for "Palm" is: "A range of **pocket** computers manufactured by Palm Computing Inc. (a division of 3COM CORPORATION). They are notable for using the GRAFFITI handwriting recognition system instead of a keyboard, **for their small size (they fit into a shirt pocket**), and for their ability to HOTSYNC with a desktop

computer by pressing a single button…" (Emphasis added.) The same dictionary includes (at page 375) the following definition of "pocket computer":

> A category of computer even smaller than a hand-held computer, and which can be carried about the person, in a shirt or jacket **pocket**. To qualify as a **pocket computer**, such a machine must be able to load and run new software, unlike a fixed-function POCKET CALCULATOR. Examples include the PALM range, various models based on Microsoft's POCKET PC specification, and several models from PSION and CASIO. (Emphasis added.)

Based on this dictionary evidence and on the NEXIS evidence showing how the term is used in the press, we find that the word POCKET in applicant's mark is merely descriptive of a feature or characteristic of applicant's software; it merely describes the type of wireless devices, i.e., pocket devices, on which the software is designed to be loaded and via which the software is used to perform its database monitoring, managing and troubleshooting functions.

We are not persuaded by applicant's argument that although POCKET may describe the devices on which the software runs, it does not describe the software itself. A significant feature of the software itself is that it may be loaded and run on pocket devices. POCKET merely describes this feature of the software. Likewise, we are

not persuaded by applicant's argument that because the word POCKET has other, non-descriptive meanings in different contexts, it is not merely descriptive of applicant's goods. As noted above, we must determine the mere descriptiveness of applicant's mark in the context of applicant's goods, not in a vacuum or in the abstract. *In re Tower Technology, supra*. Persons familiar with the features of applicant's software will readily understand that the word POCKET in applicant's mark refers to one such feature of the software, i.e., that it runs on pocket devices. POCKET therefore is merely descriptive of applicant's goods.

We also find that the words PERFORMANCE VIEWER in applicant's mark are merely descriptive of applicant's software. According to applicant's own website, a function or purpose of the software is to allow the user to

> **[v]iew** and analyze vital database **performance** issues. Memory usage, disk usage, and **performance** statistics can be **reviewed** in user-friendly graphs and charts. Using the Pocket Performance Viewer, the DBA can quickly identify problematic areas of database **performance**, and detect potential problems in a proactive manner before they impact database and application productivity. For example, problematic SQL statements, poorly sized objects, and hit ratios can be identified. Dozens of built-in **performance** measures are provided. (Emphasis added.)

Thus, a function or feature of applicant's software is that it allows database performance issues to be viewed by the user; the software functions as a performance viewer. Persons familiar with the features of applicant's software will directly perceive that the words PERFORMANCE VIEWER in applicant's mark refer to this feature of the software. The fact that "performance viewer" might have different meanings in other contexts (such as binoculars used to view a concert performance, in applicant's example), is irrelevant; the mere descriptiveness of the words must be determined in the context of applicant's goods.

In some cases, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, nondescriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods. *See, e.g., In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968)(SUGAR & SPICE held not merely descriptive of bakery products); *In re Shutts,* 217 USPQ 363 (TTAB 1983)(SNO-RAKE held not merely descriptive of a snow removal hand tool). This is not such a case. Applicant cites this proposition, but fails to identify any new, unitary or incongruous commercial impression that is created by the combination of the words POCKET PERFORMANCE VIEWER. Nor do

we see anything incongruous or unique which results from applicant's combining of these three merely descriptive terms. Consumers familiar with the features of applicant's software will directly and immediately perceive, without resort to imagination or reflection, that the mark describes a significant function, and a significant feature, of the software, i.e., that the software allows the user to **view** database **performance** issues, and that it allows such viewing of performance issues to be accomplished via wireless **pocket** devices such as personal digital assistants and cellular telephones.

For the reasons discussed above, we conclude that POCKET PERFORMANCE VIEWER is merely descriptive of applicant's goods, and that the Trademark Examining Attorney's Section 2(e)(1) mere descriptiveness refusal is proper.

POCKET OBJECT VIEWER

We also find that applicant's mark POCKET OBJECT VIEWER is merely descriptive of applicant's software. For the reasons discussed above, we find that the word POCKET is merely descriptive of a feature of applicant's software, i.e., that it is designed to run on or via pocket devices. OBJECT VIEWER likewise is merely descriptive of a function

of applicant's software; the words immediately inform the consumer that the software allows the user to view database objects. This is apparent from applicant's own description of the software (on its website):

> Browse all database **objects** organized by schema, or by **object** type. This includes constraints, functions, indexes, package specifications and bodies, procedures, rollback segments, sequences, tables, triggers, views, and other data types. Exploration and navigation among **objects** is simple – for example, the DBA can drill-down from a table into its statistics, storage parameter information, or table description, among other options. **View** extensive details on the physical attributes of database files, including size, directory, and status information. The DBA can also change the storage sizes of various **objects** as needed.

Likewise, one page of applicant's website (a printout of which is attached to the Trademark Examining Attorney's December 20, 2001 final action) is entitled "Browse By Type of Object." It includes a "sample screen" showing the software in use, on which is displayed the following wording: "The database has the following objects. Click on the object type for more information." The webpage text appearing alongside the sample screen reads as follows:

> Shown on the left is a list of all types of objects in the database. **The name of each type**

> **of object is displayed along with the total number of objects of that type.** Object types include cache, cluster, constraint, function, package, table, rollback, sequence, and synonym, among many others. **The DBA can click on the object type to drill down into more information on the objects** in the database of that type. (Emphasis added.)

It is clear from this evidence from applicant's own marketing materials that a significant function of the software is that it displays the types of objects in the database so that they may be viewed by the user. The words OBJECT VIEWER directly and immediately describe this function or feature of the software.

Viewing applicant's mark in its entirety, we find that POCKET OBJECT VIEWER is merely descriptive of a significant function, and of a significant feature, of applicant's software. The software allows the user to **view** database **objects**, and it allows such viewing of objects to be accomplished via wireless **pocket** devices such as personal digital assistants and cellular telephones. Moreover, the mere descriptiveness of each of the words in applicant's mark is not negated when they are combined into the three-word composite mark; such combining of the words results in no new unique, incongruous or otherwise distinctive commercial impression. The words are as merely descriptive

when considered together as they are when considered separately.

For the reasons discussed above, we conclude that POCKET PERFORMANCE VIEWER is merely descriptive of applicant's goods, and that the Trademark Examining Attorney's Section 2(e)(1) mere descriptiveness refusal is proper.

POCKET COMMAND CENTER

Finally, we find that applicant's POCKET COMMAND CENTER mark is merely descriptive of applicant's software. As discussed above, the word POCKET merely describes a feature of the software, i.e., that it is designed to run on or via wireless pocket devices. The words COMMAND CENTER also are merely descriptive of a feature or function of the software, i.e., its capability to function as a means by which the user can issue necessary commands.

The Trademark Examining Attorney has made of record the following definition of "command" from the Random House Computer & Internet Dictionary (3d ed. 1999): "an instruction to a computer or device to perform a specific task." It is apparent from applicant's description of its product (on its website) that a significant function or

feature of the software is that it is used to issue such commands:

> Pocket DBA includes the Pocket Command Center as an **all-purpose interface to issue any command** or run any database query. The Pocket Command Center may be easily customized on a query-by-query basis to view results clearly, even on a mobile device's small screen. The Pocket Command Center **completes the PocketDBA product, as it allows for any command or query not included in the other modules, which may be necessary for the user's specific applications.**

Applicant argues that COMMAND CENTER is not merely descriptive of the goods because it is a "metonymy,"

> a figure of speech wherein one thing is used to represent another. Examples of metonymy include the use of the phrase 'the bottle' to suggest 'strong alcohol,' or the use of 'the crown' to suggest 'the king.' It is a purely allusive pattern of speech, which by definition cannot be descriptive, and is in fact an unalloyed form of suggestion.

(Brief at 4.) Applicant cites no authority for its contention that a metonymy (if that indeed is what "command center" is) by definition cannot be deemed to be merely descriptive. In any event, the Trademark Examining Attorney has made of record NEXIS article excerpts and advertisements from the Internet which show that "command center" often is used in various areas of the computer field to describe software that is used to issue commands

necessary to operate computer products or systems.

Examples are:

> Launch'Em 3.1 is the most advanced applications launcher available for Palm OS(R), allowing you to organize your files with convenient tabbed folders, with the simplicity of drag-n-drop interface. Launch'Em 3.1 boasts several new improvements, making your favorite Palm OS(R) **command center** even better! An improved user interface, expandable plugin architecture, enhanced security support, customizable list view, tab preferences, gadget settings, and HackMaster extensions top off the list of features for this must-have update.
> (Palm Boulevard website, printout attached to Trademark Examining Attorney's January 30, 2003 supplemental final action.)
>
> TeleWare's program took advantage of graphical user interface features that made accounting software easier to use. It introduced a **command center** that allowed graphical navigation through the system.
> Accounting Technology (January 1997).
>
> …FiberCycle's content acceleration multiprocessor architecture, ultra-dense server, front-end Web server component integrator and WebBunker **command center software.** The WebBunker 206 software targets the data center requirements of reduced power consumption and increased rack density…
> Fiber Optics News (March 19, 2001).
>
> …when an e-mail message comes in from their most strategic customer, which happens to be General Electric, they would like the **command-center software** technology to be able to discern that and prioritize it.
> InfoWorld (November 8, 1999).
>
> That is where Ikonic comes in. The 10-year-old company has developed **interface software** to run

> the set-top boxes that are the **command centers** of interactive television.
> San Francisco Business Times (September 8, 1995).

Based on this evidence of descriptive usage by the industry and in the press of "command center" in reference to software, we find that consumers will directly and immediately perceive that the words COMMAND CENTER in applicant's mark refer to this function or feature of applicant's software, i.e., that the software provides a central interface by which the user can effect or control the software's issuance of the commands necessary for performance of its database management functions.

Viewing the mark as a whole, we find that applicant's combining of the descriptive word POCKET with the descriptive words COMMAND CENTER does not result in a composite which is new, incongruous or otherwise distinctive. The composite POCKET COMMAND CENTER is as merely descriptive as the separate words are when considered individually.

Thus, we find that POCKET COMMAND CENTER is merely descriptive of applicant's goods, and that the Trademark Examining Attorney's Section 2(e)(1) mere descriptiveness

refusal accordingly is proper.

CONCLUSION

For the reasons discussed above, we find that the marks in each of the applications on appeal are merely descriptive of the goods identified in the applications, and that registration of the marks accordingly is barred by Section 2(e)(1) of the Trademark Act. We have considered all of applicant's arguments to the contrary (including those not specifically addressed in this opinion), but we find them unpersuasive of a different result.

Decision: The refusal to register in each of the three involved applications is affirmed.