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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mahi Networks, Inc.

Serial No. 76222866

Michael J. Hughes of IPLO Intellectual Property Law Offices
for Mahi Networks, Inc.

Anne Madden, Trademark Examining Attorney, Law Office 103
(Michael Hamilton, Managing Attorney).

Before Simms, Hanak and Chapman, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

On March 9, 2001, Mahi Networks, Inc. (a Delaware
corporation) filed an application to register the mark ZERO
DISRUPTION MIGRATION on the Principal Register for the
following goods in International Class 9:

“telecommunications hardware, namely,
optical entrance enclosures; optical
couplers; optical fiber frames,
shelves, trays, and cabinets;
customized optical jumpers and
pigtailed; fiber optic splice closures;
fiber receiver service cables; fiber

loops; integrated optical circuits; transceivers; optical switches; optical waveguides; pressure sensors; interferometers; optical gyros; optical delay lines; optical signal processors; distance measurers; temperature sensors; chemical sensors; biological sensors; fiber optic couplers; multi/demultiplexers; wavelength filters; optical modulators; fiber optic transmitters and receivers; fiber optic cables; fiber optic cable assemblies; fiber optic indicators; and flexible fiber optic light guides."

The application is based on applicant's assertion of a bona fide intention to use the mark in commerce on the identified goods.

The Examining Attorney refused to register the mark as merely descriptive of applicant's goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

When the refusal to register was made final, applicant filed a timely notice of appeal. Both applicant and the Examining Attorney have filed briefs¹; an oral hearing was not requested.

The Examining Attorney contends that the proposed mark merely describes a significant feature or purpose of applicant's goods, specifically that applicant's goods

¹ When this application was sent to the Examining Attorney for her brief, she requested a remand of the application. Her request was granted under Trademark Rule 2.142(d), and upon return of the application to the Board, applicant was allowed time to file a supplemental brief (along with any evidence

migrate data or systems with minimal disruption to the users or to the data.

In support thereof, the Examining Attorney made of record the following dictionary² and encyclopedic definitions:

- (1) **zero** adjective ...b. having no magnitude or quantity: not any...
Merriam-Webster Online Dictionary;
- (2) **disruption** noun form of the verb **disrupt** 1 a: to break apart: rupture... b: to throw into disorder... 2: to interrupt the normal course or unity of.
Merriam-Webster Online Dictionary;
- (3) **migration** A change from one hardware or software technology to another. Migration is a way of life in the computer industry. For example, once known only to the glass-enclosed datacenter, users today understand the meaning of migrating from one operating system to another.
TechEncyclopedia; and
- (4) **data migration** (1) the process of translating data from one format to another. Data migration is necessary when an organization decides to use a new computing systems or database management

submitted in response to the Examining Attorney's new evidence). Applicant filed a supplemental brief on July 21, 2003.

² The Examining Attorney's request in her brief that the Board take judicial notice of the dictionary definitions is granted. See *The 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). See also, TBMP §704.12(a) (2d ed. June 2003).

system that is incompatible with
the current system... Webpedia.

The Examining Attorney also made of record copies of several excerpted stories retrieved from the Nexis database and printouts of pages from a few web sites, examples of both of which are reproduced below, to show that "zero disruption" is used in the industry to mean little or no disruption or interference when migrating data or systems, and other stories and web pages to show that achieving low disruption in data migration is beneficial:

Headline: Tarantella: A Technology Review; Santa Cruz Operation; ...
...Java-enabled Web browser. What separates Tarantella from alternative Java emulators and Web delivery strategies is both the comprehensiveness of its approach and its zero-disruption philosophy. In addition to Java emulation, Tarantella provides a range of servers..., "UNIX Review's Performance Computing," May 1998;

Headline: New Preloaded Software Offerings
...enterprise resource planning from JBA International. The new custom solutions give customers an affordable entry into e-business with "zero risk to upgrade and zero disruption to mission-critical applications," says Roger Koniski, director of IBM AS/400 ISV marketing. "VAR Business," February 16, 1998;

Headline: Enterprise: Optician Drops Single Server
...All the applications have been built on Solaris to allow complete portability between stores and manufacturers. This

should keep disruption to a minimum during the migration, says Specsavers IT director Michael Kahn... "Computing," June 21, 2001;

JAutomator

Churchill Software's JAutomator™ is a J2EE migration framework for real-world, high-performance Oracle Forms applications. ... Jautomator generates multiple clients, including Churchill's innovative NativeForms™ GUI for identical Oracle Forms look-and-feel, providing a zero-disruption end-user transition to Java. ... www.churchill.uk.com; and

AT&T Broadband Begins Migrating Broadband Internet Customers to New High-Speed Network

...AT&T moved its Oregon and Vancouver, Wash., Broadband Internet customers to the new high-speed network during a six-and-a-half hour period overnight and is working to migrate the balance of its customers to the new network in the coming days. ... The company will automatically issue credits to any customers who experience an interruption of service. ... www.att.com.³

³ We note that the Examining Attorney also submitted printouts from a list retrieved by a Google search for "zero disruption migration," which provided limited excerpts from the various web sites listed therein. This search indicated that 9,810 references were found. These excerpts included two short segments from applicant's web site stating the following: "... That's why Mahi Networks developed its offerings with **Zero-Disruption Migration™** in mind: to minimize the operational complexities of network transformation ..." and "... allows an immediate, low-cost, and non-disruptive deployment into the most essential carrier applications, and provides a **Zero-Disruption™ Migration** to the ..." (emphasis in original). However, such a Google search list is not particularly persuasive because it does not include printouts of the pages from the listed web sites, and it is often difficult to understand the context in which the retrieved phrase is used. Thus, the Google search list is of limited probative value in this case.

Applicant argues that the mark must be viewed in its entirety, not as three separate words; that when so viewed, this combination of words is unique and is "at most suggestive of a potential goal to be associated with the overall operation of the goods" (brief, p. 3); that the words do not immediately convey information about applicant's goods, but rather consumers would have to use imagination to "find a nexus between the goods and the mark" (brief, p. 4); and that competitors have no need to use this phrase.

In its supplemental brief (p. 2), applicant specifically stated the following:

Applicant has conceded that each of the terms incorporated into the overall mark have application to the technology involved. It cannot be denied that each term refers to aspects of the goals to be desired from use of the hardware/software components of Applicant. These terms are not arbitrary in usage, and no claim has been made to this effect. However, the fact remains that the combination of terms is unique and has been coined by Applicant in connection with its goods, and that the primary significance of the combined phrase is as a trademark, rather than as a description.

We agree with the Examining Attorney that the phrase "zero disruption migration" is merely descriptive of applicant's telecommunications hardware. The evidence

shows that consumers are well aware of migration of data and systems; that disruption is a possible problem resulting therefrom; and that minimal, or if possible "zero," disruption is a highly sought goal when migrating data or systems. Consumers will understand the phrase as meaning that applicant's goods are intended to carry out migration of data or systems, and doing so with zero (or minimal) disruption of the data or the service.

When we consider the mark ZERO DISRUPTION MIGRATION as a whole, and in the context of applicant's goods (various items of telecommunications hardware), we find that the mark immediately informs consumers that applicant's goods will allow migration of data and/or systems but with no or minimal disruption. That is, the purchasing public would immediately understand a significant purpose and function of applicant's telecommunications hardware.

The combination of these common English words does not create an incongruous or unique mark. Rather, applicant's mark, ZERO DISRUPTION MIGRATION, when used in connection with applicant's identified goods, immediately describes, without need of conjecture or speculation, the essential purpose or function of applicant's goods. No exercise of imagination or mental processing or gathering of further information is required in order for purchasers or

prospective customers for applicant's goods to readily perceive the merely descriptive significance of the mark ZERO DISRUPTION MIGRATION as it pertains to the identified goods on which applicant intends to use said mark. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792 (TTAB 1996); and *In re Time Solutions, Inc.*, 33 USPQ2d 1156 (TTAB 1994).

While evidence of descriptive use of the multiple words together is generally persuasive that such a multiple word mark is merely descriptive, there is no requirement that an Examining Attorney must obtain evidence of all the words used together in order to make a prima facie showing that a multiple word mark is merely descriptive.⁴ See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001) (Court affirmed Board holding THE ULTIMATE BIKE RACK merely descriptive and subject to disclaimer for carrying racks for mounting on bicycles and accessories for bicycle racks, namely attachments for expanding the carrying capacity of a carrying rack.) See also, *In re Shiva Corp.*,

⁴ The Examining Attorney pointed out that the issue here is not whether the phrase ZERO DISRUPTION MIGRATION is generic, but rather, the issue is whether the phrase is merely descriptive in the context of applicant's goods. (Brief, p. 7.)

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48 USPQ2d 1957 (TTAB 1998). Moreover, in this case, the Examining Attorney did submit evidence that the words "zero disruption" are used together in a descriptive manner and that applicant has merely added the descriptive term "migration" thereto.

Decision: The refusal to register on the ground that the mark is merely descriptive under Section 2(e)(1) is affirmed.