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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gibson Piano Ventures, Inc.

Serial No. 76366419

Lucian Wayne Beavers of Waddey & Patterson P.C. for Gibson Piano Ventures, Inc.

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

Before Chapman, Bucher and Rogers, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Gibson Piano Ventures, Inc. (a Delaware corporation) filed on February 1, 2002 an application to register the mark CLASSROOM MANAGER on the Principal Register for "computer software for use as a teacher control interface for hardware music teaching systems, for providing a linking environment for other music instructional software; for relating to non-teaching techniques in music education,

particularly, gradebook usage, for attendance and seating information and for student progress tracking all used in the field of music education" in International Class 9. 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 registration on the ground that applicant's mark, CLASSROOM MANAGER, is 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 was made final, applicant appealed to the Board. Both applicant and the Examining Attorney have filed briefs; an oral hearing was not requested.

Applicant contends that its mark is a combination of terms which creates an incongruous meaning as applied to applicant's goods; that applicant's goods do not proactively direct, control or manage the students or the classroom, but rather, "applicant's goods relate to computer software for linking to other software and other passive functions such as tracing non-teaching techniques in music education, particularly for following attendance of the students, tracking seating chart information and following student progress" (emphasis in original) (brief, p. 5); and that doubt is resolved in applicant's favor.

Further, applicant contends that the USPTO'S prior determination of lack of descriptiveness of this mark for these goods in Registration no. 1913049¹ is persuasive herein.

The Examining Attorney contends that the term "manager" is descriptive of a type of software used for managing activities or functions, and the term "classroom" is descriptive of the place or type of activity for which the software is used; and that the proposed mark, in its entirety, is merely descriptive of a significant use and function of the goods, such as the software will be used to manage classroom functions including attendance, seating and student progress. The Examining Attorney also contends that the prior decision of the USPTO in allowing Registration No. 1913049 is not probative in this case.

In support of the descriptiveness refusal, the Examining Attorney has made of record (i) dictionary definitions, (ii) third-party registrations of marks which

¹ Applicant included a printout of Reg. No. 1913049 from the USPTO'S Trademark Electronic Search System (TESS) for the first time with its brief on appeal. Although this would normally be untimely under Trademark Rule 2.142(d), the Examining Attorney did not object thereto and treated the argument on the merits. Thus, the registration has been stipulated into the record.

Reg. No. 1913049 issued August 22, 1995 for the same mark CLASSROOM MANAGER ("classroom" disclaimed) for the same goods as involved in the application now before us. In 2002, the registration was cancelled under Section 8 of the Trademark Act. (Applicant was the owner by assignment of this registration.)

include the word "manager" for computer software with the term disclaimed or registered under Section 2(f) or on the Supplemental Register, and (iii) excerpted stories retrieved from the Nexis database to show "manager" is used to describe a type of computer software.

The test for determining whether a mark is merely descriptive is whether the term or phrase immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used or is intended to be used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Eden Foods Inc.* 24 USPQ2d 1757 (TTAB 1992); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used or is intended to be used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).

Consequently, "[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). Rather, the question is whether someone who knows what the goods or services are will understand the term or phrase to convey information about them. See In re Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990).

The issue before the Board is whether, applicant's mark, as a whole, is merely descriptive. Initially we note that applicant stated (brief, p. 8) that "the Examining Attorney's evidence indicates that MANAGER is descriptive of goods that proactively direct or control" and that "applicant agrees with the Examining Attorney that the excerpts do demonstrate that the word MANAGER may be used to describe a type of computer software which performs a proactive function."

Examples of the excerpted stories retrieved from the Nexis database submitted by the Examining Attorney to show that the word "manager" is used to describe a type of software are reproduced below:

Headline: Basics; Now Your Cellphone Can Remember Mom's Birthday
...version for free downloading from www.apple.com by OS X 10.2 users, works with Sony Ericsson T68i and a handful of

other Ericsson phones. The catch is that the Mac data must reside in Apples own Address Book or iCal personal information manager software. ... "The New York Times," December 26, 2002;

Headline: Personal Technology;
Technofile

...The unit also includes Royal's own personal computer information manager software for the PC, plus an expense-manager program, a calculator that can convert foreign currency and metric measurements, a world-time clock and games. ... "The San Diego Union-Tribune," December 23, 2002;

Headline: Technology; No Tapes, No Discs, No Top-10 Limit

...PhatNoise also provides music-manager software, which offers a guide to converting audio tracks from CD's into MP3 or Windows Media Audio files and to designing customized playlists. ... "The New York Times," October 23, 2002; and

Headline: Dan Gilmor Column

...For more than a year, Kapor and his small team have been working on what they are calling an open-source "interpersonal Information Manager." The software is being designed to securely handle personal e-mail, calendars, contacts and other such data in new ways, and to make it simple to collaborate and share information with others without having to run powerful, expensive server computers. "San Jose Mercury News," October 21, 2002.

In addition, the Examining Attorney made of record the following definitions from The American Heritage Dictionary (Fourth Edition 2000):

- (1) **classroom** noun a room or place especially in a school in which classes are conducted; and
- (2) **manager** noun 1. one who handles, controls, or directs, especially:
 - a. one who directs a business or other enterprise...

When we consider the mark CLASSROOM MANAGER as a whole, and in the context of applicant's goods ["computer software for use as a teacher control interface for hardware music teaching systems, for providing a linking environment for other music instructional software; for relating to non-teaching techniques in music education, particularly, gradebook usage, for attendance and seating information and for student progress tracking all used in the field of music education"], we find that the mark immediately informs consumers that applicant's goods will assist in managing the classroom in some manner. That is, the purchasing public would immediately understand a significant use and function of applicant's computer software, even if they are not aware of the uses as precisely listed and worded in applicant's identification of goods.

Applicant's asserted distinction that its computer software does not directly control or manage either the classroom or the students, but rather it relates to

"passive functions" is unpersuasive. Based on applicant's own identification of goods it is clear that the goods do not involve only "passive functions." Instead, applicant's computer software manages several active functions such as "for use as a teacher control interface for hardware music teaching," "for providing a linking environment for other music instructional software," and "for student progress tracking." All of these examples are management of various classroom functions.

The combination of these two common English-language words does not create an incongruous or unique mark. Rather, applicant's mark, CLASSROOM MANAGER, when used in connection with applicant's identified goods, immediately describes, without need of conjecture or speculation, the essential character 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 CLASSROOM MANAGER as it pertains to applicant's goods. See *In re Time Solutions, Inc.*, 33 USPQ2d 1156 (TTAB 1994) (YOUR HEALTH INSURANCE MANAGER for software programs for personal record keeping and processing of medical records, health insurance and claims held merely descriptive). See also,

In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and In re Omaha National Corporation, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987).

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 for evidence showing all the words used together in order to hold a multiple word mark to be merely descriptive. 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., 48 USPQ2d 1957 (TTAB 1998).

We disagree with applicant's argument that the previous registration (No. 1913049) is "highly relevant." (Brief, p. 10.) To the contrary, neither the Board nor any Court is bound by prior decisions of Trademark Examining Attorneys, and each case must be decided on its own merits, on the basis of the record therein. See In re Nett Designs Inc., supra. See also, In re Kent-Gamebore Corp., 59 USPQ2d 1373 (TTAB 2001); and In re Wilson, 57 USPQ2d 1863 (TTAB 2001).

We acknowledge that in this case, the prior registration is for the same mark and the same goods. However, the registration includes a disclaimer of the term "classroom," and the history of the application that matured into Registration No. 1913049 is not before us. The issue now before the Board is whether the mark CLASSROOM MANAGER is merely descriptive for the identified goods, not whether the Examining Attorney who examined the application which issued as Registration No. 1913049 acted appropriately. We can only speculate as to what was involved when the prior application was examined and allowed for publication prior to registration.²

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

² We note that the Examining Attorney further argues, citing the case of *In re Styleclick.com, Inc.*, 58 USPQ2d 1523, 1527 (TTAB 2001), that in the context of evolving terminology and in relation to computers and the Internet, the meaning of the word "manager" could have changed in the context of computer software between 1994 when the prior application was allowed and 2003 in the examination of the current application. There is no evidence of record specifically illustrating this, but we do note that the Examining Attorney's Nexis excerpted stories are very recent.