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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jay Wilkinson

Serial No. 78041013

Andrew S. Pollock of Andy Pollock Law PC LLO for Jay Wilkinson.

Andrea Koyner Nadelman, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Rogers, Holtzman, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On December 29, 2000, Jay Wilkinson (applicant) applied to register the mark DIGITAL IMS, in typed form, on the Principal Register for services ultimately identified as follows:

Business management services, namely, managing and organizing databases containing information on employees, customers, vendors, time card systems, scheduling and planning, company news and information;

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managing and organizing records and documentation for others, including ISO documentation; business management, namely, managing and organizing administrative systems for others in International Class 35 and

Computer software design, installation and maintenance, namely, design, installation and maintenance of software applications used for database management and software applications used to manage database information online utilizing the internet, intranets, extranets and other related modes of electronic communication, for others; computer services, namely, designing, maintaining and hosting web sites for others in International Class 42.

While the application (Serial No. 78041013) was originally based on an allegation of a bona fide intention to use the mark in commerce, on October 11, 2002, applicant filed an amendment to allege use. The amendment alleged that applicant first used the mark anywhere and in commerce in January 2001.

The examining attorney¹ refused to register applicant's mark on the ground that the mark was merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), because it "describes a feature of the services with which applicant uses the mark, namely, information and data management through digital information management systems." Examining Attorney's Brief at 12. Applicant, on the other hand, submits that DIGITAL IMS

¹ The current examining attorney was not the original examining attorney in this case.

"requires significant imagination on the consumer's part to cull a direct message from the mark about the nature of the applicant's business management, computer software design and web site services." Applicant's Brief at 4 (internal quotation marks omitted).

After the examining attorney made the refusal final, applicant appealed to this board.

For a mark to be merely descriptive, it must immediately convey knowledge of the ingredients, qualities, or characteristics of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); In re Quik-Print Copy Shops, Inc., 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980). Courts have long held that to be "merely descriptive," a term need only describe a single significant quality or property of the goods or services. Gyulay, 3 USPQ2d at 1009; Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959). Descriptiveness of a mark is not considered in the abstract, but in relation to the particular goods or services for which registration is sought. In re Abcor Dev. Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

We begin our analysis by first clarifying the record. We note that the application as filed contained a disclaimer of the term "digital." In the first Office

action, the examining attorney refused registration on the ground that the mark was merely descriptive of the services. The examining attorney argued and submitted evidence that the letters IMS stood for "information management system." In his response, applicant did not agree. However, applicant admitted that the letters stood for "integrated marketing solutions," which applicant indicated "may be descriptive of other services applicant provides." Response dated December 31, 2001 at 2.

Therefore, applicant disclaimed the letters IMS in his response. Applicant has consistently maintained that he has disclaimed the letters IMS. See Reply Brief at 1 ("Applicant has disclaimed IMS, and has maintained that position in all of its arguments before the Examining Attorney... The Applicant does not dispute that IMS describes certain elements of his services (though not by reference to the words the Examining Attorney continues to reference). This fact does not matter. Applicant has disclaimed IMS.")

Regarding the disclaimer of the term "digital," the examining attorney in her brief noted that "[p]resumably, the applicant intended to withdraw the disclaimer of the term DIGITAL, as the basis for the applicant's appeal is his argument that the term DIGITAL is not descriptive."

Examining Attorney's Brief at 6. We agree with the examining attorney that applicant must have withdrawn the original disclaimer. During the prosecution, no mention was made of this disclaimer until the new examining attorney in her brief pointed out the inconsistency of disclaiming all the terms in the mark and therefore theorizing that the disclaimer was withdrawn.

We now begin our analysis of whether applicant's mark DIGITAL IMS is merely descriptive of applicant's identified services. As noted above, applicant has disclaimed the term IMS, although applicant and the examining attorney have different theories as to the meaning of the term. Applicant argues that the term means "integrated marketing solutions" (Response dated January 2, 2002 at 2) and the examining attorney maintains that it means "information management system" (Examining Attorney Brief at 6). The examining attorney included a list from an acronym dictionary that identified "information management system" as one of the meanings of the abbreviation IMS. "Integrated marketing solutions" was not listed as a recognized meaning.

The examining attorney also included printouts, a sample of which are set out below, to show that the term "information management system" is used descriptively to

refer to "managing databases of information and computer software used [to] manage database information." Office Action dated July 3, 2001 at 2.

Nathan & Lewis combines producer and client "friendly" information management systems, a full array of products and services and competitive compensation to create a logical and comprehensive strategy for promoting growth of your independent financial services business.

Financial Planning, June 1, 2001.

The answer is yes. In particular, the uptake of electronic information management systems is rising dramatically.

Contract Journal, May 16, 2001.

MedPlus is a provider of information management systems for health care organizations.

ABI/INFORM, May 7, 2001.

Arlington Public Schools will spend about \$459,000 to complete installation of a computerized student information management system that has been piloted in several county schools.

Washington Post, May 3, 2001.

The reduction was part of an efficiency drive and the advent of information management systems made possible by technology.

Washington Post, April 30, 2001.

Robertson said the outage also affected the district's information management system for student and financial records.

Fort Worth Star-Telegram, April 17, 2001.

We also take judicial notice² of the following definitions of IMS as: (1) "Information Management System.

² University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Synonym for IMS/VS [Virtual Storage]"³ and (2) "Abbreviation for Information Management System. A program product that uses OS (operating system) BTAM [Basic Telecommunications Access Method] to allow IMS applications to operate on the remote terminal system. Remote display stations require non-switched lines."⁴

Applicant's identified services include the management of information such as "managing and organizing databases containing information on employees, customers, vendors, [and] time card systems"; "managing and organizing records and documentation for others"; and designing, installing, and maintaining "software applications used for database management and software applications used to manage database information online." We note that if applicant's mark is descriptive for some of the services, the examining attorney does not need to establish that it is descriptive for all the services in that class. In re Pencils, Inc., 9 USPQ2d 1410, 1411 (TTAB 1988) ("We agree with applicant that the sale of pencils is not the central characteristic of applicant's services. Nevertheless, pencils are significant stationery/office supply items that are typically sold in a store of applicant's type, that is, a

³ McDaniel, *IBM Dictionary of Computing* (1994).

⁴ Sippi, *Computer Dictionary* (1984).

stationery and office supply store. While applicant's stores may carry a variety of products, pencils are one of those products, and, thus, the term 'pencils' is merely descriptive as applied to retail stationery and office supply services"). Accord In re CyberFinancial.Net Inc., 65 USPQ2d 1789, 1791 (TTAB 2002) ("[I]f applicant's mark BONDS.COM is generic as to part of the services applicant offers under its mark, the mark is unregistrable").

When we consider the services involving the management of information for which applicant uses the term IMS, prospective purchasers will likely believe that the term IMS is simply a reference to the fact that its services involve information management systems. We also add that applicant has provided little evidence from which to conclude that prospective purchasers would view IMS as an abbreviation for "integrated marketing solutions." The term would therefore be descriptive of applicant's services.⁵

Next, we look at the term "digital." The examining attorney has referred to *The Computer Desktop Encyclopedia*

⁵ We are aware that applicant has already disclaimed IMS and admitted that it has some descriptive significance in relation to his services. The foregoing discussion was necessary to determine the meaning of the individual terms before we address what the mark as a whole would mean to prospective purchasers.

(2002) that indicates that "Today, digital is synonymous with computer."⁶ Office Action dated January 16, 2003 at 1. Applicant admits that "[w]ithout a doubt, the word DIGITAL has become popular in this world of electronic commerce and correspondence." Applicant's Brief at 5. The examining attorney also cited the case of In re Cambridge Digital Systems, 1 USPQ2d 1659, 1662 (TTAB 1986), in which the board referred to the disclaimed term "digital" as a "highly descriptive word" in relation to computer systems. When we view the use of the word "digital" in relation to applicant's services we find that it would, as defined in the dictionaries, have the meaning, of being synonymous with "computer." This meaning would simply indicate to prospective purchasers that applicant's database and information management services are performed in a computer or digital environment.

Applicant makes two specific arguments regarding the term "digital." First, applicant relies on the case of In re Hutchinson Technology Inc., 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988). That case involved the issue of whether the mark HUTCHINSON TECHNOLOGY was primarily merely a surname, which is obviously not the issue in this case. To the extent the court discussed the descriptiveness of the

⁶ See also Freedman, *The Computer Glossary* (2001) (same).

term "technology," it found that it is "a very broad term" that "does not convey an immediate idea" of the characteristics or features of the applicant's etched metal electronic components and similar products. 7 USPQ2d at 1493. In effect, the Federal Circuit held that when prospective purchasers viewed the term "technology" in relation to etched metal electronic components it would not immediately inform them of any specific feature or characteristic of the goods. That is not the case with the term "digital" here. The term may be widely used but its meaning is straightforward, i.e., computer.⁷

Second, applicant attached several registrations in the record that include the term "digital" without a disclaimer of the term. These registrations are for the marks DIGITAL CEMENT, DIGITAL SOLUTIONS FOR THE GLOBAL COMMODITY MARKET, DIGITAL-TELEPATHY, DIGITAL@JWT, DIGITALPC.COM, DIGITALCANDLE, and THE DIGITAL BUILDING. The examining attorney submitted copies of registrations for marks such as GYRO DIGITAL, DIGITAL ARCHITECTS, DIGITAL ICE³, DIGITAL COWBOYS, DIGITAL SYSTEMS INTERNATIONAL CORPORATION, DIGITAL PERSONA, DIGITAL GRAFFITI, DIGITAL

⁷ While both applicant and the examining attorney make analogies to the words "technology" and "digital," the Hutchinson Technology case did not discuss the term "digital." Whether that term is descriptive must be determined based on the present record.

CONNECTION, DIGITAL SYSTEM RESOURCES, DIGITAL WIDGETS, DIGITAL CAFFEINE, DIGITAL DAY, and DIGITAL CARPENTERS in which the word "digital" was disclaimed. The evidence of applicant and the examining attorney suggests that the Office has considered each application based on its own individual record. The identified goods and services, the relationship of the mark to the goods and services, and the display of the mark can all influence whether a disclaimer is appropriate. Applicant has certainly not demonstrated that there is anything inconsistent with the examining attorney's conclusion that the term "digital" was descriptive of the services in the present application. We add that even "if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court." In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Finally, we must consider whether the mark DIGITAL IMS as a whole is merely descriptive, and not just the individual components. The test is not whether prospective purchasers can guess what applicant's services are after seeing applicant's mark alone. Abcor Dev., 200 USPQ at 218 ("Appellant's abstract test is deficient - not only in denying consideration of evidence of the advertising

materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as required by statute").⁸

In this case, when prospective purchasers encounter the mark DIGITAL IMS for services involving, inter alia, managing and installing information management software, they will immediately understand that the mark describes the fact that applicant's services concern information management systems deployed on a computer. There is nothing incongruous or left to the imagination when applicant's mark is viewed in relation to these services. While applicant has submitted evidence that some people now recognize its term as referring to applicant, we note that applicant acknowledges that he "has not amended [the application] to seek registration under Section 2(f)." Applicant's Brief at 6 n.5. Applicant also argues that his "extensive use shows the degree of marketing needed to bridge the mental gap, thus demonstrating the width of the gap." Id. Applicant's evidence of use and advertising and

⁸ The statements from Al Karnavicus, Deb Loeser, and Kaye Black all seem to suggest that the meaning of applicant's mark was not clear in the abstract, but it was apparent when viewed in relation to applicant's services. The individuals report that they "did not immediately associate [the term] with the Web site services the company [applicant/PrinterPresence] provides." It was "during a seminar for PrinterPresence that I first associated the name Digital IMS with the services the company provides."

consumer recognition is more appropriate for determining whether a mark has acquired distinctiveness. To the extent that we consider the evidence in relation to the question of descriptiveness, it does not persuade us that the examining attorney's refusal should be reversed.⁹ The evidence of advertising, sales, and customer recognition, simply indicates that applicant's mark is capable of serving as a trademark not that it inherently functions as one. Most of the evidence seems to be limited to applicant's "computer services, namely, designing, maintaining and hosting web sites for others" as opposed to applicant's managing and organizing information databases and designing and installing software for database management. Therefore, we find that applicant's term is merely descriptive of the services identified in the application.

Decision: The refusal to register under Section 2(e)(1) of the Trademark Act is affirmed.

⁹ We, of course, do not address whether the evidence shows that the mark has acquired distinctiveness, which is an issue not before us.