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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Kraus Productivity Organization Limited

Serial No. 78237417

David P. Cooper of Kolisch Hartwell, P.C. for Kraus Productivity Organization Limited.

Gene V.J. Maciol, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Seeherman, Drost, and Kuhlke, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On April 14, 2003, applicant (Kraus Productivity Organization Limited) applied to register the mark PRODUCTIVITY PRESS (in typed or standard character form) on the Principal Register for goods and services ultimately identified as follows:

> Software for advanced management and manufacturing methodologies to improve efficiency in manufacturing industries; downloadable electronic publications,

namely books and newsletters in the field of improving efficiency in the manufacturing industries in Class 9.

Books and training manuals to improve efficiency in manufacturing industries in Class 16.

Electronic publishing services, namely, publication of text and graphic works of others in a desired format, namely on-line, CD and DVD featuring information on improving efficiency in manufacturing industries; providing on-line publications, namely books and newsletters in the field of improving efficiency in manufacturing industries in Class 41.[1]

Applicant has disclaimed the word "Press." The application was also amended to claim ownership of Registration No. 1,221,304 for the mark shown below on the Supplemental Register for a "monthly newsletter" in Class 16:[2]

The examining attorney refused to register the mark on the ground that the mark PRODUCTIVITY PRESS is merely

[1] Serial No. 78237417. The application is based on applicant's allegation of a date of first use and a date of first use in commerce of 31 October 1998 (Class 9), 31 October 1983 (Class 16), and 30 April 2002 (Class 41).

[2] A "registrant owner of a Supplemental Register registration impliedly admits that the registered term was descriptive (or deceptively misdescriptive) at least at the time of the registrant's first use of the term." Perma Ceram Enterprises Inc. v. Preco Industries Ltd., 23 USPQ2d 1134, 1137 n.11 (TTAB 1992).

descriptive of the goods and services. 15 U.S.C. § 1052(e)(1). In addition, the examining attorney has objected (Brief at 7) to applicant's specimen of use for Class 41 because it is "inadequate to show use of the mark in the sale or advertising for the services." After the examining attorney made the refusals final, this appeal followed.

The examining attorney's position (Brief at 4, footnotes omitted) is that:

> "Productivity Press" is merely descriptive of the applicant's software, publications and publishing services for use in improving efficiency in manufacturing industries. Specifically, the mark merely describes the subject matter, purpose and use of the goods and services. The applicant offers goods and services on the subject and for the purpose of improving productivity. "Productivity" is defined as a measure of efficiency. Manufacturing productivity is used throughout sectors of the economy and within businesses to describe performance and efficiency. "Productivity" immediately describes the core purpose and use of the goods and services, namely improving efficiency. The inclusion of "Press" does nothing to change this conclusion. "Press" is a generic business entity designation devoid of trademark significance.

Regarding the specimen for Class 41, the examining attorney argues that "nowhere on the specimen does it reference the applicant as the publisher, nor does it reference the availability of these books on line in a non-downloadable format." Brief at 7.

Applicant argues that "consumers will have to think because the mark consists of a phrase that is unfamiliar with respect to manufacturing efficiency software and publications. Second, they may think the mark refers to a mechanical press or an hydraulic press." Brief at 4.[3]

A mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information regarding a function, purpose, or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). See also In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Courts have long held that to be "merely descriptive," a term need only describe a single significant quality or property of the goods. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959). An important consideration in descriptiveness cases involves how we consider the mark. The test is not whether potential customers can guess what the goods and services are when they encounter the mark. Instead, we must consider the mark in relation to the goods

[3] Applicant did not respond to the examining attorney's objection to the specimen for the services in Class 41.

or services, to determine if the term is merely descriptive. Abcor, 200 USPQ at 218.

We begin our analysis here by looking at the individual words in the marks. "Productivity" is the first word that we consider. Applicant's goods and services (software, publications, and services) all involve improving efficiency in manufacturing industries. The examining attorney has included definitions of "productivity" as attachments to his first Office Action:

> The amount of output per unit of input (labor, equipment, and capital). There are many different ways of measuring productivity. For example, in a factory, productivity might be measured based on the number of hours it takes to produce a good, while in the service sector productivity might be measured based on the revenue generated by an employee divided by his/her salary.
>
> A measured relationship of the quantity and quality of units produced and the labor required per unit of time.
>
> The amount of output per unit of input, such as the quantity of a product produced per hour of capital employed.

Also, in this Office Action, the examining attorney introduced a definition of the term "efficient" as "productive of desired effect, *especially*: Production without waste." The examining attorney included several articles that use the term "productivity" in association with manufacturing activity.

> Despite the employment downturn, manufacturing productivity is strengthening.
> *Washington Times*, 07 October 2003.

> Improving manufacturing productivity is a critical part of the company's long-term strategy. For example, the new national labor agreement with the UAW imposes more stringent punishment on absent workers.
> *Automotive News*, 06 October 2003.

> With employment falling and output rising, America has enjoyed soaring manufacturing productivity, a feat repeated to some extent elsewhere in the rich world.
> *Charlotte Observer*, 05 October 2003.

> The previous UAW contract, signed four years ago, prohibited automakers from closing any plants. But Harbor and Associates, which tracks manufacturing productivity, says there is enough capacity in North America to build 20 million vehicles, but automakers likely will sell fewer than 17 million this year, and about 20% of those will be imports.
> *USA Today*, 19 September 2003.

> "We have 2,000 workers that have been trained in Kaizen (a manufacturing productivity and quality improvement method) and just in-time manufacturing." McKnight said.
> *The Tennessean*, 24 August 2003.

Applicant's specimens indicate that its goods and services are directed to improving manufacturing efficiencies or productivity. For example, some of its books listed in its specimen are entitled *Fast Track to Waste-Free Manufacturing*, *Cycle Time Management*, *Do It Right the Second Time*, *Cost Reduction Systems*, *Creating Continuous Flow*, *Becoming Lean*, and *Benchmarking*. When the word "Productivity" is viewed in association with software, publications, and services directed to improving

efficiencies in manufacturing industries, it is clear that the term would be understood as describing the goods and services. Productivity involves the amount of output per unit of input, such as the quantity of a product produced per hour of capital employed. A goal of business would be to improve manufacturing productivity. Goods and services devoted to improving manufacturing productivity would be accurately described by the term "Productivity."

Next, we address whether the term "Press" is also descriptive of applicant's goods and services. We note that applicant has disclaimed this term. The examining attorney has included dictionary definitions of "Press" with the first Office Action that defines the term as: "The art or business of printing and publishing" and "a printing or publishing establishment." The examining attorney has included printouts that indicate that producers of software are referred to as "publishers."

> Websitepipeline, a Greenville-based publisher of Web development software, has launched a brochure Web site.
> *Greenville News*, 05 October 2003.
>
> Macrovision, meanwhile, introduced FlexNet, which can be embedded into a software publisher's source code…
> *InfoWorld Daily News*, 06 October 2003.
>
> A Framingham man pleaded guilty in federal court to charges of securities fraud and causing false reports to be filed with the Securities and Exchange Commission to bolster quarterly revenues by Inso

Corp., a Boston software and electronic publishing company.
Boston Globe, 01 October 2003.

Previously, the board held that "the word PRESS, when used by or in connection with 'publishing establishments,' is in the nature of a generic entity designation which is incapable of serving a source-identifying function… If applicant were seeking to register its mark as a service mark for its publishing services, we would not hesitate to find PRESS to be unregistrable for such services." In re Taylor & Francis [Publishers] Inc., 55 USPQ2d 1213, 1215 (TTAB 2000). The board went on to find that the "word is merely descriptive of applicant's books because it directly and immediately conveys to purchasers that the books originate from a 'press,' that is 'a printing or publishing establishment.' We have repeatedly held that a mark which names the type of commercial establishment from which particular goods come is merely descriptive of those goods." Id. at 1216 (internal quotation marks in last sentence omitted).

There appears to be nothing incongruous about the application of the term "press" to applicant's goods and services. Indeed, as indicated earlier, the dictionary definition that the examining attorney included with the first Office Action defines "press" as "a printing or

publishing establishment." Producers of electronic publications are referred to as "publishers." The term "Press" is at least descriptive of publishing services and it is also descriptive of books, software, and online publications inasmuch as it names the establishment from which applicant's goods and services originate. Taylor & Francis, 55 USPQ2d at 1216.

Despite the descriptiveness of the individual terms, we must consider the mark PRODUCTIVITY PRESS as a whole because the combined term may not be descriptive even though the individual terms are. Here, PRODUCTIVITY PRESS would certainly describe the online publishing by a publishing establishment of books and other works concerning improving efficiencies in manufacturing industries. It also describes the type of commercial establishment from which come applicant's books and software on improving efficiencies in manufacturing industries. Therefore, the term is merely descriptive of these goods and services all directed to improving manufacturing efficiencies or productivity. We cannot accept applicant's argument (Brief at 4) that prospective purchasers, upon seeing the mark in relation to books, software, and services of providing online publications, would conclude that the term is referring to "a mechanical

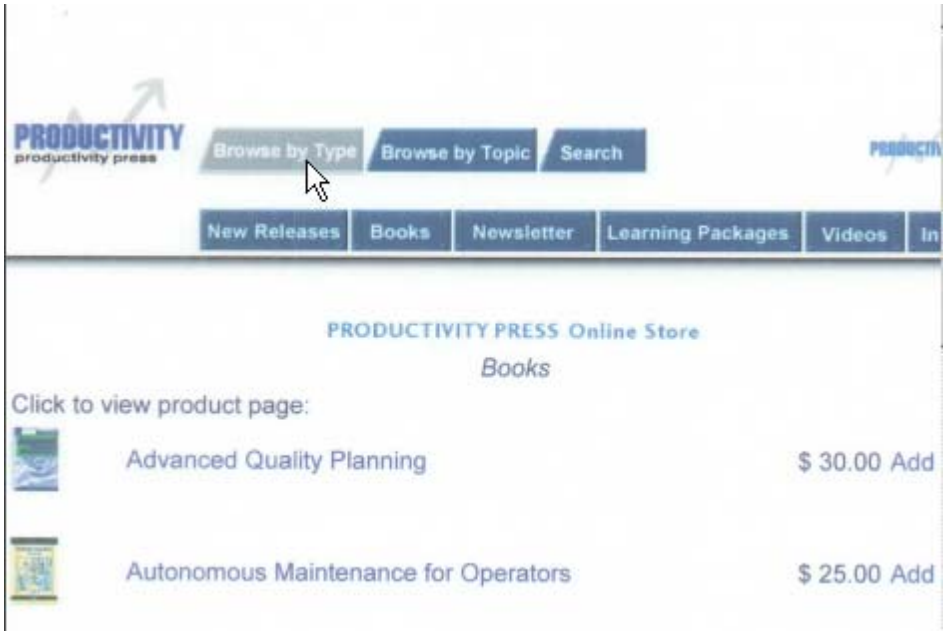
press or an hydraulic press (for manufacturing or other applications)." Nor does the fact that both words begin with the letter "P" create a unitary term or somehow change a descriptive term into a suggestive term. That is not the holding of In re Kraft, Inc., 218 USPQ 571 (TTAB 1983).[4] Rather these purchasers would immediately understand the descriptive meaning of this term. We emphasize that the potential purchasers of these goods and services would not view the term in a vacuum. They would view the term in connection with applicant's books, software, and electronic publishing services that all involve improving efficiency in manufacturing industries. When viewed in this context, the mark in its entirety is merely descriptive.

The other issue in this case is whether applicant's specimen for Class 41 is acceptable. The examining attorney argues that the specimens "do not show use of the mark in the sale or advertising of the services" in Class 41 because "nowhere in the specimen does it reference the applicant as the publisher, nor does it reference the availability of these books online in a non-downloadable format. Instead, the average consumer seeing the mark would equate use with retail store services on the actual

[4] We have not considered applicant's cited non-precedential board opinion. TBMP § 103 (2d rev. 2004).

goods themselves, as in a catalog for the goods." Brief at 6-7.

Applicant's electronic publishing services in Class 41 appear to involve two different activities. The first service concerns the "publication of text and graphic works of others in a desired format, namely on-line, CD and DVD featuring information on improving efficiency in manufacturing industries." The second involves "providing on-line publications, namely books and newsletters in the field of improving efficiency in manufacturing industries." An applicant only has to provide a specimen to show its use on one of the services in a class. Applicant has submitted a specimen that shows that it offers various titles of works on improving manufacturing efficiency or productivity. A portion of the specimen is set out below:



It appears that this specimen is simply a list of books that applicant sells over the Internet. It is not entirely clear in what format applicant is offering these books.[5] However, in one of its specimens for *LeanSpeak*, the specimen indicates that it is "an ebook available in multiple electronic formats, including Palm Pilot." The specimen goes on to identify the formats as Microsoft Reader, Adobe Acrobat Reader, and Palm Reader as well as also being available "in paperback." These specimens, taken together, indicate that applicant is offering online publications, namely books and newsletters in the field of improving efficiency in manufacturing industries. However, applicant's electronic publication services specify that its services involve the "publication of text and graphic works of others." There is no indication that applicant is publishing the works of others. Indeed, there are no authors listed and, regarding the *LeanSpeak* book, applicant's description claims that: "To address these needs Productivity Press created LeanSpeak – the original and authoritative compendium of improvement terms."

[5] While applicant itself has not offered an explanation or otherwise responded in its brief to the requirement for an acceptable specimen, we have not treated applicant's silence as a concession that its specimens are unacceptable.

Therefore, the specimen does not support the first identified service.

Applicant's other service consists of "providing on-line publications, namely books and newsletters in the field of improving efficiency in manufacturing industries." Applicant specimens show that it is providing online its books and newsletters in the field of improving manufacturing industries. Therefore, because applicant's specimen supports use of its mark for one of the identified services in Class 41, we reverse the examining attorney's requirement for an acceptable specimen.

Decision: The examining attorney's requirement for an acceptable specimen for the services in Class 41 is reversed. The examining attorney's refusal to register the term PRODUCTIVITY PRESS on the ground that the mark is merely descriptive of the involved goods and services is affirmed.