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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bell & Howell Document Management Products Company

Serial No. 74/166,555

Howard B. Rockman of Welsh & Katz, Ltd. for applicant.

Mary Crawford, Trademark Examining Attorney, Law Office 102
(Mickey Kurzbard, Managing Attorney)

Before Simms, Hanak and Hairston, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Bell & Howell Document Management Products Company
(applicant) seeks registration of IMAGE SEARCH in typed
capital letters for "microfilm computer-assisted document
management and retrieval system, comprising microfilm
camera, microfilm reader/printer, computer record server,
computers, computer monitors, computer printers and system
software, all for the storage, retrieval and management of
documents and information." The application was filed on
May 13, 1991 with a claimed first use date anywhere and in
commerce of March 31, 1987.

The Examining Attorney has refused registration on the basis that the term IMAGE SEARCH is generic. In addition, the Examining Attorney contends that "the evidence submitted [by applicant] to support a showing of [acquired] distinctiveness is ... insufficient even if the term 'image search' is capable of registration." (Examining Attorney's brief page 2).

When the refusal was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs and were present at a hearing before this Board on April 8, 1997.

Applicant and the Examining Attorney agree that there are two issues before this Board. First, is the term IMAGE SEARCH generic for the goods set forth in applicant's application? Second, if the term IMAGE SEARCH is not generic but merely descriptive for said goods, has this term acquired distinctiveness such that it now functions as a trademark to identify applicant's goods and distinguish these goods from the goods of others? (Applicant's brief page 3; Examining Attorney's brief page 2).

It has been repeatedly stated that "determining whether a mark is generic ... involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that

genus of goods or services?" H. Marvin Ginn v. International Association of Fire Chiefs, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Of course, in a proceeding such as this, the genus of goods at issue are the goods set forth in the description of goods in the application itself. Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) ("Thus, a proper genericness inquiry focuses on the description of [goods or] services set forth in [the application or] certificate of registration."). The fact that the term IMAGE SEARCH may be generic for goods which are similar to or even closely related to the goods as described in the application does not establish that IMAGE SEARCH is also generic for the latter goods. By way of example, the fact that the term TOUCHLESS was generic for automobile washing equipment did not establish that said term was likewise generic for automobile washing services. Magic Wand, 19 USPQ2d at 1553. Cf. In re The Stroh Brewery Co., 34 USPQ2d 1796, 1797 (TTAB 1995) ("In addition, the fact that a term may be descriptive of certain types of goods does not establish that it is likewise descriptive of other types of goods, even if the goods are closely related.").

Thus, the burden rests with the Examining Attorney to establish that the mark sought to be registered is generic for the goods as described in the application. In re Merrill Lynch, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir.

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1997). Moreover, it is incumbent upon the Examining Attorney to make a "substantial showing ... that the matter is in fact generic." Merrill Lynch, 4 USPQ2d at 1143. Indeed, this substantial showing "must be based on clear evidence of generic use." Merrill Lynch, 4 USPQ2d at 1143. Thus, it is beyond dispute that "a strong showing is required when the Office seeks to establish that a term is generic." In re K-T Zoe Furniture Inc., 16 F.3d 390, 29 USPQ2d 1787, 1788 (Fed. Cir. 1994). Moreover, any doubt whatsoever on the issue of genericness must be resolved in favor of the applicant. In re Waverly Inc., 27 USPQ2d 1620, 1624 (TTAB 1993).

The record in this case dates to 1991 and is, to say the least, quite massive. In support of her contention that IMAGE SEARCH is generic, the Examining Attorney has made of record a large number of excerpts of articles and a few full text articles taken from the Nexis database. The time period for these excerpts and articles spans from 1983 to 1994. However, most of these excerpts and articles are from the 1990's. There is a small minority of excerpts and articles from the 1980's. This distinction is of importance because with regard to the excerpts and articles from the 1990's, the vast majority of them use the term "image search" in a descriptive manner to describe a category of systems which, as will be discussed in greater length in a

moment, are quite different from applicant's IMAGE SEARCH document management and retrieval system. On the other hand, some of the excerpts and articles from the 1980's use the term "image search" in a descriptive manner to describe systems which apparently are somewhat similar to applicant's system. We use the term "apparently" because even the Examining Attorney, in discussing these 1980's excerpts and articles, has stated that said excerpts and articles concern "systems [which] appear to be of the same genus as the applicant's system." (Examining Attorney's brief page 12, emphasis added). We will begin our analysis with the vast majority of excerpts and articles from the 1990's which use the term "image search" to describe systems which are quite different from applicant's system, and then conclude our analysis by considering the limited number of excerpts and articles from the 1980's which use the term "image search" to describe systems which appear to be somewhat similar to applicant's system.

In reviewing the 1990's evidence, it is clear that "image search" is a descriptive term for a certain type of product. However, the type of product for which the term "image search" is descriptive is not the product described in the application. At a minimum, the Examining Attorney's 1990's evidence simply does not constitute the "substantial showing" (Merill Lynch) or the "strong showing" (K-T Zoe)

required to prove that applicant's mark IMAGE SEARCH is a generic term for applicant's goods as described in the application.

As previously noted, applicant's description of goods is as follows: "microfilm computer-assisted document management and retrieval system, comprising microfilm camera, microfilm reader/printer, computer record server, computers, computer monitors, computer printer and system software, all for the storage, retrieval and management of documents and information." Stripping away the recitation of the components and the somewhat redundant final verbiage, applicant's goods are a "microfilm computer-assisted document management and retrieval system."

Applicant has been quite forthright in submitting for the Examining Attorney's inspection large amounts of literature describing applicant's IMAGE SEARCH microfilm computer-assisted document management and retrieval system.¹

¹ The dissent disparagingly accuses the majority of giving "lip service to the principle that the issue of descriptiveness/genericness should be evaluated in terms of the identification [of goods] in the application." Suffice it to say that the identification of goods is a full and accurate description of applicant's actual goods. The identification was carefully considered by the Examining Attorney in Office Action Nos. 1, 2 and 3. In actions 2 and 3, the Examining Attorney had the benefit of being able to review the aforementioned large amounts of product literature forthrightly provided by applicant. Unlike the dissent, the Examining Attorney in her brief never even suggested that the issue of genericness would be decided differently based upon whether the focus was on applicant's actual goods or on applicant's identification of goods. Indeed, quite to the contrary, the Examining Attorney stated that the relevant "genus of goods includes the 'applicant's goods

Put in simple terms, such a document management and retrieval system works in the following fashion. Documents (i.e. letters, invoices, patient records etc.) are microfilmed. The microfilmed versions of the documents are then indexed according to the guidelines established by applicant's customers, usually with the assistance of applicant. For example, one of applicant's customers may wish to index letters by author, recipient, subject matter and date. This indexing is done with a computer, and the indexed, microfilm version of the document is entered into a computer system. When the microfilm version of the document needs to be retrieved, an image of the document appears on a computer screen. The computer screen could be located in the same building as the main computer containing all of the indexed documents, or it could be located thousands of miles away from the main computer. Moreover, more than one employee of applicant's customer can retrieve or access the same indexed, microfilm document at the same time. Thus, an

specifically' as stated in the identification of goods."
(Examining Attorney's brief page 8).

In view of the above, it appears that the dissent refuses to adhere to the Board's practice of resolving questions of genericness in applicant's favor. That is to say, given the full and accurate identification of goods, it is hard to fathom how the dissent can be so certain that IMAGE SEARCH is generic with respect to the identification of goods when the dissent concedes that, at a minimum, IMAGE SEARCH "may not be generic with respect to applicant's actual [goods]."

employee in New York could retrieve or access the identical document which is simultaneously being retrieved or accessed by an employee in San Francisco. The vast majority of documents entered into applicant's IMAGE SEARCH system consist of text and not pictures, although some documents do consist of text and simple pictorial representations. However, the key to applicant's IMAGE SEARCH system is the initial indexing. For example, if a letter has been indexed only by author, recipient, subject matter and date, it cannot be later retrieved by searching for copy recipients. Applicant's IMAGE SEARCH document management and retrieval system cannot retrieve all documents mentioning, for example, Mr. Jones somewhere in the bodies of the documents. Rather, said system can only retrieve those documents which were initially indexed under the name Mr. Jones. Likewise, applicant's system is unable to search for all documents containing the pictorial representations of a certain item.

In reviewing the numerous 1990's excerpts and articles from the Nexis database made of record by the Examining Attorney, it appears that the descriptive term "image search" is used to describe various related systems which are simply not the document management and retrieval system described in the application. Because many of the excerpts made of record by the Examining Attorney are very truncated, it is difficult to state with certainty the precise nature

of the systems for which the term "image search" is descriptive. However, it appears that the descriptive term "image search" is used to describe large photographic libraries which are placed on computers and which can be accessed by multiple customers of the owner of the library. For example, in the December 13, 1993 issue of InfoWorld there appears an article entitled "Kodak Picture Exchange offers browsing of stock photo CDs." The very truncated excerpt of that article reads, in part, as follows: "For \$399, customers receive Kodak's access software and are charged \$1.42 per minute for conducting image searches." An article in the October 1992 issue of Information Today speaks of a company founded by Bill Gates whose "technology makes image searches easier and quicker for the user." Continuing, the article notes that "these developments make possible the creation of vast libraries of visual information. People will be able to access an image on a display screen as easily as they pull a book from a library shelf." The article states that the beneficiaries of such technology would include museums, schools, publishers, businesses and individuals. The article then notes that "individuals may access image databases in their homes as visually oriented tools for learning, discovery and entertainment. For example, people could select images of

historical or current events to have delivered to them electronically."

Another article discusses a more sophisticated product "still in its infancy that will allow users to search for an image stored in a database, such as a film library, based on the image content," as opposed to searching for images by words or file names. See Network World of April 27, 1992. This more sophisticated system would allow subscribers to the library to search for all pictures containing, for example, the representation of an elephant, as opposed to being limited to word searches where some pictures containing the representation of an elephant were indexed under the word "elephant," and others were not.

The foregoing products described in the 1990's excerpts and articles submitted by the Examining Attorney wherein the words "image search" are used in a descriptive fashion are quite different from applicant's IMAGE SEARCH microfilm computer-assisted document management and retrieval system. There are a number of differences, but two differences stand out. First, the products described in the 1990's excerpts and articles submitted by the Examining Attorneys are libraries available, usually for a fee, to a virtually unlimited number of customers. These libraries described in the Examining Attorney's evidence have pictorial images which are of interest to a significant number of

subscribers. Moreover, there is nothing "confidential" about the images in these libraries. In contrast, applicant's IMAGE SEARCH computer-assisted document management and retrieval system is designed to contain proprietary documents which can only be accessed by employees of the owner of said documents.

Second, the products described in the 1990's excerpts and articles made of record by the Examining Attorney contain pictures, such as famous works of arts, clip art etc. Subscribers to these libraries are truly searching for particular images or pictures. In contrast, the material in applicant's IMAGE SEARCH system consists primarily of documents containing exclusively text. While there is no doubt that documents containing diagrams or other pictures could be placed into applicant's IMAGE SEARCH document management and retrieval system, this does not mean that applicant's system serves as a pictorial library.

We now turn to consider the small minority of excerpts and articles submitted by the Examining Attorney from the 1980's. As previously noted, some of these excerpts and articles use the term "image search" to describe products which appear to be similar to applicant's IMAGE SEARCH document management and retrieval system. One such article is from the February 1985 issue of Modern Office Technology. The title of the article is "A Marriage Made in Charleston;

Electronic filing at Union Carbide," and the article reads, in part, as follows: "Electronic filing ... is at the heart of the new accounts payable information management system at Union Carbide's sprawling South Charleston, West Virginia, complex. Computer terminals throughout the facility and in locations as far away as Louisiana and New Jersey are now used as remote request terminals for finding and retrieving documents stored on microfilm. The system lets Union Carbide capitalize on microfilm's ability to store virtually unlimited quantities of information ... while tapping an IBM 370 computer's power to index, sort, and search. ... The relatively new filing system replaces a less sophisticated microfilm system. The old system required those who wanted paper copies of stored data to fill out forms, or go to retrieval centers for document image searches." Obviously, the product described in this February 1985 article, as well as a few other products described in some of the other articles from the 1980's, appear to be similar to applicant's IMAGE SEARCH document management and retrieval system. However, in none of these excerpts or articles from the 1980's is the term "image search" used as a generic term for the name of any product. Rather, the term "image search" is used simply to describe one aspect of these products. Indeed, in reviewing this February 1985 article,

it appears that if there is any generic term for the product discussed, said generic term is "electronic filing."

Thus, while some of the excerpts and articles from the 1980's (which represent a small minority of the Examining Attorney's evidence) discuss products which appear to be similar to applicant's system, the important point to remember is that when the term "image search" is used, it is used not as the generic name for a product. Rather, it is used simply to describe an aspect of the products.

Moreover, the issue before this Board "is whether [IMAGE SEARCH] is now the common descriptive or generic name for applicant's" document management and retrieval system. In re Montrachet, 878 F.2d 375, 11 USPQ2d 1393, 1394 (Fed. Cir. 1989) (emphasis added). Even if some of these 1980's excerpts and articles had used the term "image search" as the generic name for a product similar to applicant's system (which they did not), the 1980's excerpts and articles would not be sufficient to prove that applicant's mark IMAGE SEARCH is currently the generic name for applicant's system, especially in light of the fact that the vast majority of the excerpts and articles submitted by the Examining Attorney (i.e. those from the 1990's) now use the term "image search" to describe a function of products which are totally different from applicant's IMAGE SEARCH document management and retrieval system.

Having determined that the Examining Attorney has simply not made the "substantial showing" or "strong showing" required to prove that IMAGE SEARCH is now the generic term for the goods identified in applicant's application, or indeed is the generic term for any goods, we will now consider whether or not applicant has established that the descriptive term IMAGE SEARCH has become distinctive of its goods pursuant to Section 2(f) of the Lanham Trademark Act. In support of its claim of acquired distinctiveness, applicant relies upon the fact that not only has it made continuous use since March 1987 of its mark IMAGE SEARCH on computer-assisted document management and retrieval systems, but in addition upon the fact that it has used this same mark since 1981 on microfilm reader/printers. Moreover, applicant submitted the October 9, 1992 declaration of Larry Turner, its product manager for its IMAGE SEARCH products. Mr. Turner declared that not only had applicant sold as of June 30, 1992 over \$9.2 million worth of IMAGE SEARCH document management and retrieval systems, but in addition, applicant had sold since 1981 over \$8.3 million worth of IMAGE SEARCH microfilm reader/printers. Furthermore, Mr. Turner declared that applicant's IMAGE SEARCH products are not products which are sold to ordinary consumers, but rather are products which are sold to a relatively limited number of institutions

which have the need to manage large amounts of documents. These institutions would include the U.S. Department of Defense, local police departments, banks and hospitals. Thus, applicant argues that its sales figures are quite substantial given the limited customer base for its IMAGE SEARCH products.

In addition, applicant also relies upon the numerous brochures, owner manuals and advertisements for its IMAGE SEARCH products which were discussed earlier in this opinion as further proof that IMAGE SEARCH has acquired distinctiveness among this rather narrow customer base. Moreover, applicant has made of record a number of articles from technical and professional journals which discuss applicant's IMAGE SEARCH computer-assisted document management and retrieval system.

Finally, applicant has submitted three additional declarations. One of these declarations is from an employee of a large hospital which utilizes applicant's IMAGE SEARCH document management and retrieval system. The other two declarations are from managers of two different companies which distribute document management systems. All three individuals state that they, and to the best of their knowledge, the individuals that they deal with, recognize IMAGE SEARCH as a trademark of applicant. Furthermore, the declaration of one of the two distributors (Gene Erfeldt)

further confirms applicant's assertion that the customer base for applicant's IMAGE SEARCH document management and retrieval system is quite limited. Mr. Erfeldt states, in part, as follows: "[Applicant's] IMAGE SEARCH systems are considered to be high end price range products and are sold to a limited community of consumers. When I meet with customers it has been my experience that among this class of consumers who are in the market for computer-assisted document management systems, the trademark IMAGE SEARCH is recognized as designating a computer-assisted document management system originating with one source - [applicant]."

In view of the foregoing, we find that applicant has demonstrated that its mark IMAGE SEARCH has acquired distinctiveness pursuant to Section 2(f) as indicating computer-assisted document management and retrieval systems originating from one source, namely, applicant.

Decision: The refusal to register is reversed.

E. W. Hanak

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial
and Appeal Board