

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JAN. 11, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Phoenix Technologies Ltd.
v.
Tesco, Inc. and Mark Ismach, joined
as a party defendant

Cancellation No. 21,866

Jefferson F. Scher of Fenwick & West for Phoenix
Technologies Ltd.

Marc A. Bergsman of Dickinson, Wright, Moon, Van Dusen &
Freeman for Tesco, Inc. and Mark Ismach, joined as a party
defendant.

Before Seeherman, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

A petition has been filed by Phoenix Technologies Ltd.
to cancel the registration of the mark BIOS for personal
computers.¹ As grounds for cancellation, petitioner alleges
that BIOS stands for Basic Input/Output System and is the

¹ Registration No. 1,430,061 issued February 24, 1987; Sections
8 & 15 affidavit filed.

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generic name in the computer industry of a certain type of computer program; that a BIOS is an essential component of a personal computer in that it initiates contact between the personal computer and its peripheral devices and then controls the interface between the personal computer and the specific devices; that there are several hundred different versions of BIOS programs; that petitioner develops and licenses "BIOSes" for computers and computer components; that it has used the term BIOS in connection with such programs since at least as early as 1984; that respondent, through a subsidiary or affiliate, has asserted that petitioner's use of the term BIOS on labels affixed to ROM chips containing petitioner's products infringes respondent's rights under the involved registration; that respondent, prior to filing the application which issued into the involved registration, knew or should have known that BIOS had been widely used as a generic term; and that respondent committed fraud by failing to disclose this to the Office.²

Respondent, in its answer, has denied the salient allegations of the petition to cancel.

The record consists of the file of the involved registration; the testimony deposition (with exhibits) of petitioner's witness, George Adams; petitioner's notices of

² Petitioner made no mention of the fraud ground in its brief on the case, and thus we consider the ground to have been dropped.

reliance on excerpts from various printed publications and respondent's responses to petitioner's interrogatories; and respondent's notice of reliance on excerpts from The Computer Desktop Encyclopedia (1996).

Both parties filed briefs on the case, but an oral hearing was not requested.

George Adams, petitioner's vice president of marketing and business development, testified that BIOS stands for Basic Input/Output System and is the generic name for a computer program that translates the input or output requests of another computer program into the specific machine instructions required by particular input and output devices, such as monitors and disk drives. According to Mr. Adams the first BIOS was developed in the 1970's, and today every personal computer must have a BIOS or the hardware cannot communicate with the computer's operating system. Mr. Adams testified that most manufacturers embed the BIOS in a ROM chip plugged into a socket on a printed circuit board inside the personal computer. Petitioner has four BIOS products--PC ROM BIOS for personal computers; Note BIOS for notebook computers; Server BIOS for servers; and PICO BIOS for small, hand-held portable and consumer devices. According to Mr. Adams, at least six companies, including petitioner, license "BIOSes" commercially and a number of other companies develop "BIOSes" for their own use. Mr.

Adams identified a dictionary entry for the term BIOS and a number of excerpts from publications wherein the term BIOS is used in a generic manner to indicate a computer program which controls the computer's peripheral devices. The following are the dictionary entry and representative samples of the excerpts:

BIOS: An acronym for BASIC INPUT/OUTPUT SYSTEM. In some operating systems, the part of the program that customizes it to a specific computer. [Webster's New World Dictionary of Computer Terms, 3d. edition (1988)];

Before preparing actual assembly language programs, let's turn our attention to some of the details of the IBM PC. In particular, let's examine **BIOS**, the Basic Input and Output System. The term **BIOS** is used often in personal computer architecture and literature. A system **BIOS** refers to the manner in which the system allows access to the peripheral devices used by the computer. [J. W. Coffron, Programming the 8086/8088 (1983)];

A computer's **BIOS** (Basic Input/Output System) is a set of routines that--in response to requests from the operating system or individual applications-- provides primitive control of the computer's devices such as video adapters, printers, and disk drives. Stored in read-only memory (ROM) within the machine, these instructions form a permanent part of the computer. The three most common **BIOSes** found in PC's and compatibles (other than those from IBM, Compaq, and some of the larger system manufacturers who write their own) come from AMI, Award, and Phoenix Technologies. ["Tutor-- Computer Terms: Part 1," PC Magazine, April 14, 1992]; and

The Basic Input/Output System (**BIOS**) is a set of program instructions held in read-only (ROM). These instructions provide programs with a common means of activating system functions that is independent of the underlying hardware design. In effect the **BIOS** determines the software compatibility of motherboard hardware. ["The Perfect PC," PC Magazine, July 1992).

The only information we have about respondent comes from its responses to petitioner's interrogatories. Respondent indicated therein that it is a computer wholesaler. Respondent sells to computer dealers and value added resellers. Respondent adopted the BIOS mark for its personal computers around mid-1985 and chose this mark because it desired to create the image of an essential piece of equipment.

This record establishes that BIOS is an acronym for Basic Input/Output System and is the generic term for a computer program or software which controls the computer's peripheral devices. Moreover, respondent has conceded that "[a] BIOS is part of the operating system for a personal computer providing detailed instructions to activate peripheral devices." (Brief, p.1). However, the critical issue here is whether BIOS designates the class of goods to which respondent applies the term, i.e., personal computers.

After careful review of the record herein, we find that petitioner has not established that BIOS is a generic term for personal computers. Petitioner maintains that

"[b]ecause personal computers and BIOSes are so closely related, the term BIOS is generic for personal computers as well as software, and Tesco cannot usurp the term BIOS in relation to its products." (Brief, p. 2)

However, it is not enough that "BIOSes" and personal computers are related. Stated differently, although a BIOS is a significant feature or component of personal computers, it does not automatically follow that BIOS is generic of personal computers themselves.³ In this case, there is simply no evidence that the term BIOS is understood by the relevant public as primarily referring to personal computers. See *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1987); and *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). [The test for determining whether a term is generic is its primary significance to the relevant public, that is, whether the term is used or understood, by purchasers or potential purchasers of the goods or services at issue, primarily to refer to the class of such goods or services.]

³ We would point out that the issue of whether BIOS is merely descriptive of personal computers is not before us as this ground was unavailable to petitioner because the petition to cancel was filed more than five years after issuance of respondent's registration.

We note petitioner's concern that it is threatened by the continued existence of the involved registration. In particular, petitioner points to a cease and desist letter sent by respondent claiming that petitioner's use of the term BIOS to refer to its "BIOSes" infringes respondent's rights. However, in view of respondent's concession that "the relevant public primarily refers to 'BIOS' as part of the operating system of a personal computer; that is system software" (Brief, p. 6), respondent should have no objection to petitioner's use of BIOS in a generic manner to describe its computer programs.

Decision: The petition to cancel is denied.⁴

E. J. Seeherman

P. T. Hairston

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial and
Appeal Board

⁴ We note petitioner's alternative request in its reply brief that the registration be restricted to exclude computer software. Not only is the request untimely, it is not well taken since it does not appear that personal computers encompass computer software.