

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 12/22/99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Lattice Semiconductor Corporation*

Serial No. 74/638,085

Frank S. Hiscox of Skjerven, Morrill, MacPherson, Franklin & Friel LLP for applicant.

Dominick J. Salemi, Trademark Examining Attorney, Law Office 107 (*Thomas J. Lamone*, Managing Attorney).

Before Rice, *Seeherman* and *McLeod*, Administrative Trademark Judges.

Opinion by *McLeod*, Administrative Trademark Judge:

Lattice Semiconductor Corporation has filed an application to register the designation shown below on the Supplemental Register for "integrated circuits and computer programs for use with integrated circuits."¹

isp

¹ Application Serial No. 74/638,085, filed February 22, 1995, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). On June 18, 1997, applicant filed an amendment to allege use, and

The Trademark Examining Attorney has refused registration under Section 23 of the Trademark Act, 15 U.S.C. Section 1091, on the ground that applicant's designation, when applied to applicant's goods, is generic and incapable of identifying and distinguishing applicant's goods from those of others.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

Before turning to the merits of the appeal, we note that this application was originally filed as an intent-to-use application on the Principal Register. The Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1), on the ground that the designation is merely descriptive of the goods identified in the application. Applicant responded by filing a disclaimer of the term "ISP" apart from the mark as shown, and asserted that it did not intend to claim any rights to the acronym itself, apart from the stylized presentation. When the Examining Attorney issued his final refusal under Section 2(e)(1), applicant filed an amendment to allege use and an amendment to the Supplemental Register.

specimens, alleging dates of first use and first use in commerce on February 26, 1996.

Subsequent to its amendment to the Supplemental Register and disclaimer, applicant has at times continued to argue that the mark is registrable on the Principal Register. Indeed, applicant has devoted a substantial portion of its appeal briefs to various alternative claims for registration on either the Principal or Supplemental Register. However, a review of the file shows that applicant, in making the amendment to the Supplemental Register in a response filed June 18, 1997, did not characterize or otherwise indicate in any fashion that the amendment was an alternative one. See TMEP Section 1212.02(c).

Accordingly, the only issues before the Board are (i) whether applicant's designation "isp" is generic for applicant's products and, if so, (ii) whether the designation is nevertheless capable of distinguishing applicant's goods, and therefore registrable on the Supplemental Register, because of the style in which it is displayed.²

Turning to the first issue, the Office has the burden of proving genericness by "clear evidence" thereof. *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567,

² Even if we considered applicant's alternative claims on the Principal Register, we would reach the same result in this case.

1571, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be registered to refer to the genus (category or class) of goods in question. *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992). Our primary reviewing court has set forth a two-step inquiry to determine whether a mark is generic: First, what is the genus (category or class) of goods at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that genus (category or class) of goods? *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986). Evidence of the relevant public's understanding of a term may be obtained from any competent source, including dictionaries, magazines, trade journals and other publications. *See In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 1559, 227 USPQ 961, 963 (Fed. Cir. 1985).

The Examining Attorney contends that "isp" is an acronym for "in-system programmable," a generic term in the computer chip and semiconductor fields as applied to integrated circuits. Although applicant has disclaimed the acronym, the Examining Attorney asserts that the commercial impression of the designation is simply the generic acronym

"isp" in lowercase typeface. According to the Examining Attorney, applicant's designation is devoid of any stylization or uniqueness which would render the mark capable of registration. Rather, the Examining Attorney characterizes applicant's designation as "ordinary and non-distinctive, of the kind with which the average consumer is confronted everyday." (Examining Attorney's Br. at 5).

In support of his refusal, the Examining Attorney relies upon case law citations and approximately eleven articles from the DIALOG database containing the acronym "ISP." These articles were made of record via a Letter of Protest granted by the Office on August 23, 1995, and incorporated by reference by both applicant and the Examining Attorney during prosecution.

Applicant, on the other hand, argues on appeal that the Examining Attorney has not presented any evidence that the applied-for mark is generic for applicant's products. At most, applicant submits, the acronym "ISP" refers to "in-system programmable," a feature of integrated circuits. Applicant maintains that this designation has no meaning with respect to the computer programs listed in applicant's identification of goods. Applicant also argues, among other things, that consumers would not immediately recognize applicant's lowercase, italicized presentation of "isp" as

an acronym for "in-system programmable." According to applicant, competitors do not use the style of lettering shown in applicant's mark. At a minimum, applicant concludes that its unique presentation of "isp" warrants registration on the Supplemental Register.

In support of its position, applicant has relied upon case law and third-party registrations to support its position that marks have routinely been granted registration based upon stylized lettering. During prosecution, applicant also submitted articles from the World Wide Web and the LEXIS/NEXIS database which contain the acronym "ISP."

As noted above, applicant entered a disclaimer of "ISP" apart from the mark as shown, and repeatedly stated during prosecution that it only claims rights in the "stylized 'isp' in lower case letters." See e.g. (Applicant's Response dated Feb. 5, 1998, pp. 2 & 4, Applicant's Amendment dated March 7, 1996, p. 2, Applicant's Response dated Nov. 13, 1996, p. 1). Applicant also acknowledged during prosecution that the semiconductor industry uses "ISP" in uppercase typeface as an acronym for the term "in-system programmable." (Applicant's Response dated Feb. 5, 1998, p. 2). We view applicant's statements and disclaimer during prosecution as a concession that the

acronym "ISP" is generic for the identified goods.³ See *In re The Wella Corp.*, 565 F.2d 143, 144, 196 USPQ 7, 8 (CCPA 1977).

Even if we were to consider the issue of genericness on the merits, the evidence of record supports the conclusion that the acronym "ISP" is generic (in either uppercase or lowercase typeface) as applied to applicant's products and would be so regarded by purchasers. The articles made of record via the Letter of Protest, and those offered by applicant itself, define "ISP" as "in-system programmable." According to the evidence, "ISP" is a specific type or subset of integrated circuits (applicant's genus or class of goods).⁴ The following articles of record indicate that others in the industry have recently begun to use "ISP" (in

³ We reject applicant's argument that the acronym is not generic because it allegedly does not refer to each and every item listed in the identification of goods. It is well settled that if a term is generic for some of the goods or services listed in an application, "registration is properly refused." *In re Analog Devices Inc.*, 6 USPQ2d 1808, 1810 (TTAB 1988), *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989).

⁴ The term "integrated circuit" is defined as "the formal name for chip." *The Computer Glossary*, 199 (7th ed. 1995). According to the specimens of record, applicant's "integrated circuits" include programmable logic devices (PLDs). A "PLD" is defined as a type of logic chip used to reconfigure the sequence of operations performed by hardware or software. *Id.* at 227 & 303; see also *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983)(The Board may take judicial notice of dictionary definitions).

either uppercase or lowercase typeface) to refer to their own integrated circuits.

"**In-system programmability** PLD vendors - including Altera, Lattice Semiconductor Corp., Vantis, and Xilinx - are taking advantage of a growing **ISP market**." Jim Evans, *Fast and Flexible*, Electronic Buyers' News, April 21, 1997.

"Altera claims Jam will allow **in-system-programmable (ISP) PLDs** to be programmed faster, more easily, and with smaller file sizes than manufacturer-specific languages." Mark Hachman, *Altera in a 'Jam' Over Language*, Electronic Buyers' News, July 14, 1997. (emphasis added).

"In terms of specific openings, Altera offers **in-system programmable, or ISP, PLDs**." Brian Santo, *Spotlight: Devices -- Logic Vendors Scrounge for Talented Engineers*, Electronic Engineering Times, May 5, 1997. (emphasis added).

". . . . complex programmable logic device (CPLD) industry by introducing a family of flash-based **in-system programmable (ISP) CPLDs**. The move is an attempt to gain a leadership position in the CPLD market - currently dominated by Altera - the company said." *Xilinx Making Challenge For CPLD Leadership Role*, Electronic News, Jan. 20, 1997. (emphasis added).

Atmel has expanded its line of **in-system programmable (isp)**, downloadable flash microcontrollers, to include a device that provides an expanded on-chip programmable memory." *MCU has In-system Programmability*, *What's New in Electronics*, July 1997, at 44. (emphasis added).

In fact, several articles authored by or about applicant show the designation "ISP" (in both

uppercase and lowercase typeface) used in a generic sense.

"**ISP devices**, on the other hand, are treated as any other standard component from incoming inventory through board assembly, with patterning occurring at final test after board assembly. . . . As a result, **non-ISP devices** must be programmed by hand using a standard logic programmer." Stan Kopec, *In-system Tuning Expands Horizon*, Electronic Engineering Times, April 11, 1994, at S26. (emphasis added).

"The simplest, and the most important to Lattice today, is that **ISP chips** don't have to go through a mechanical programmer before they are placed on the chip. With the fragile fine-pitch lead frames used on most PLDs today, eliminating a parts-handling step by programming the chips after insertion can dramatically improve loss from mechanical damage. . . . The boards can be inventoried, unprogrammed, and then the **ISP PLDs** configured at shipment time, cutting back on inventory headaches." Ron Wilson and Brian Fuller, *Lattice Rebound Maps Unconventional Course*, Electronic Engineering Times, Oct. 10, 1994, at 31. (emphasis added).

"Silicon Concepts can supply two of Lattice Semiconductor's latest **isp (in-system programmable) super i/o high density cplds.**" *Silicon Concepts Supply Latest isp*, What's New in Electronics, March 1997, at 68. (emphasis added).

"**isp PLDs** can provide benefits to systems tested using boundary-scan. Along with inherent reprogrammability, **isp PLDs** can be programmed while soldered to the board. Individual devices or entire chains of devices can be programmed concurrently." Dave Thompson, *In-system programs Link to Testing*, Electronic Engineering Times, January 26, 1998. (emphasis added).

Having concluded that the acronym "ISP" (in either uppercase or lowercase typeface) is generic for applicant's goods, we come to the question of whether the designation is nevertheless capable of distinguishing applicant's goods because of the manner in which it is displayed.

As a general rule, an entire mark cannot be disclaimed and also registered. See TMEP Section 1213.07. An exception to this rule is when the unregistrable components of a mark are combined in a design or display which is so "distinctive" as to create a commercial impression separate and apart from the unregistrable components. *In re Carolyn's Candies, Inc.*, 206 USPQ 356 (TTAB 1980), citing *Wella, surpa*; see also 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 12:40, p. 12-81 (4th Ed. 1999).

In the leading case of *Wella, supra*, the Court of Customs and Patent Appeals held the designation shown below,

balsam

with the word "balsam" disclaimed apart from the mark as shown, to be capable of distinguishing applicant's hair conditioner and hair shampoo, and hence registrable on the Supplemental Register because of the style of lettering in

which the word "balsam" was displayed. The court also noted that "balsam" did not appear in third-party marks in the "unique style of the applicant's mark." *Wella*, 565 F.2d at 144, 196 USPQ at 8.

Thereafter, the Board, in *Carolyn's Candies, supra*, found the designation shown below to be registrable on the Supplemental Register for candy bars, with a disclaimer of the words "yogurt bar" apart from the mark as shown.

YOGURT BAR

The Board noted that in order for a generic term to be capable of registration, the presentation must be so striking, unique or "distinctive" in character as to overcome its inherent incapacity. *Id.* at 361. The Board held that the style and display of "yogurt bar" was more "distinctive" than that of the word "balsam" in *Wella, supra*.

On the other hand, in *In re Anchor Hocking Corp.*, 223 USPQ 85 (TTAB 1984), the Board affirmed a refusal to register the designation shown below on the Supplemental Register, with a disclaimer of "microwave" and "turntable,"

for "ovenware, namely, a plastic dish for supporting foodstuffs while being cooked in microwave oven."

MICROWAVE TURNTABLE

The Board found that the words "microwave turntable" were "displayed in a plain block style of lettering" which was characterized as "ordinary and nondistinctive" and "obviously not unique." *Id.* at 87; *see also In re Cosmetic Factory Inc.*, 220 USPQ 1103 (TTAB 1983)(style of lettering of "body soap" found ordinary and nondistinctive).

The determination of whether the display of a mark is striking, unique or "distinctive" is naturally a subjective one. In this case, applicant's acronym "isp" is shown in an ordinary lowercase, slightly italicized typeface. We agree with the Examining Attorney that there is nothing unique or unusual about the presentation of applicant's designation to create a commercial impression separate and apart from the generic acronym "ISP." In this regard, applicant's designation differs from the highly stylized, curlicue lettering of "balsam" in *Wella, supra*, and the unique letter style and placement of "yogurt bar" in *Carolyn's Candies, supra*. In fact, applicant's designation is even less

Ser No. 74/638,085

"distinctive" than the presentation of the words "microwave turntable" in *Anchor Hocking, supra*.

Decision: The refusal to register on the Supplemental Register is affirmed.

J. E. Rice

E. J. Seeherman

L. K. McLeod
Administrative Trademark
Judges, Trademark
Trial and Appeal Board