

THIS DISPOSITION IS NOT
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11/1/99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re CIBER, Inc.

Serial No. 74/643,553

Christopher M. Brock and George T. Schooff
of Harness, Dickey & Pierce, P.L.C. for CIBER, Inc.

Heather D. Thompson, Trademark Examining Attorney, Law
Office 103 (Michael A. Szoke, Managing Attorney).

Before Hanak, Hohein and Wendel, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

CIBER, Inc. has filed an application to register the
mark CIBRCASE for "computer software development and
support services for manufacturing and service companies
namely, development of customized application software and
programming, loading, and updating software."¹

¹ Serial No. 74/643,553, filed March 8, 1995, based on an
allegation of a bona fide intention to use the mark in commerce.
The statement of use filed July 22, 1996 sets forth first use
dates of August 1995.

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After the initial examination of this intent-to-use application was completed, the mark was published for opposition on November 28, 1995. No opposition having been filed, a notice of allowance was issued on February 20, 1996. Applicant filed its statement of use on July 22, 1996. In the subsequent examination the Examining Attorney refused to accept the specimens of use submitted by the applicant on the ground that the specimens failed to show use of the mark sought to be registered, CIBRCASE, in connection with the services identified in the application. The requirement for acceptable specimens was made final and this appeal followed. Applicant and the Examining Attorney have filed briefs but no oral hearing was requested.

The Examining Attorney has set forth the issue on appeal as whether the specimens of record demonstrate use of the mark CIBRCASE in connection with the computer software development services identified in the application. We believe the issue may equally well be stated as whether the designation CIBRCASE, as used on the specimens of record, functions as a service mark for the identified services.

To be registrable as a service mark, there must be a direct association between the mark and the services named in the application. In re Universal Oil Products Co., 476

F.2d 653, 177 USPQ 456 (CCPA 1973). The Examining Attorney has taken the position that applicant uses the designation CIBRCASE in its advertisements, which have been submitted as specimens, to identify a software tool used in the performance by applicant of its services and not as a mark for the services per se.

As noted by the Examining Attorney, in the specimens applicant describes the performance of its "outsourcing projects" by means of the "processes, methods and tools prescribed in CIBRScope." CIBRScope, in turn, is said to include CIBRMethods and CIBRWorks ("a suite of design, construction and re-engineering tools"). The tools of CIBRWorks are listed as:

- CIBRCASE - an integrated CASE tool
- CIBRView - a code analysis tool, and
- CIBRTools - an evolving set of construction tools.

In a second specimen the CIBRCASE tool is identified in terms of the particular software program which is used.

In order to clarify the recognized meanings of the terms CASE and "tool" in the trade, the previous Examining Attorney made of record the definition of CASE as an acronym for "computer aided software engineering" and of "CASE tools" as tools which "provide automated methods for

designing and documenting software programming.”² The present Examining Attorney attached to her brief the definition of “tool” alone as “a program used for software development or system maintenance.”³ Thus, the Examining Attorney argues that CIBRCASE in the specimens of record refers only to the software being used by applicant in the process of developing customized software for others. She likens the present circumstances to those in *In re Walker Research, Inc.*, 228 USPQ 691 (TTAB 1986), in which the Board found that the mark SegMentor, as used in the advertising sheets submitted as specimens, only identified software used in the performance of the applicant’s market segment analysis services and not the services themselves.

Applicant argues that the specimens of record unequivocally show use of CIBRCASE in the advertising of its recited services, and that this is all that is required to support registration of CIBRCASE as a service mark. Applicant contends that the prospective purchasers for its computer software development and support services are aware that applicant does not sell goods, such as software,

² H. Newton, *Newton’s Telecom Dictionary* 196 (8th ed. 1994).

³ A. Freedman, *The Computer Glossary* 428 (8th ed. 1998). In view of the fact that the Board may take judicial notice of dictionary definitions, we have considered this definition even though only introduced by the Examining Attorney with her brief. See *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852 (TTAB 1981).

and would view applicant's use of the mark CIBRCASE in its specimens as being used in association with its services.

As we stated in *Walker Research*, "whether or not a term functions as a service mark necessarily depends on how that term is used and how it is perceived by potential recipients of the services." Here, as in the *Walker* case, we must base our determination of public perception of applicant's mark on the manner of use of CIBRCASE in the advertising which has been submitted as specimens.

In doing so, we find applicant's usage in the text of its advertising parallels the manner of use found in the *Walker* case. In both instances, the designation sought to be registered as a service mark is used to describe a "tool" which is utilized to perform the service being offered to the prospective purchasers. Although applicant here, similar to the applicant in the *Walker* case, does not sell the software so designated, and accordingly may not intend to use the designation in a trademark sense with the software, as we pointed out in *Walker*, this does not warrant finding that the designation must therefore function as a service mark for the services as a whole. The mark CIBRCASE, as used in the specimens of record, refers only to the software used by applicant in the

performance of its software development and support services, and does not identify the services themselves.

While applicant argues that prospective purchasers for its particular services would be aware that applicant does not sell software and thus would not perceive CIBRCASE as other than a mark being used to identify the services, the present specimens provide no support for this contention. CIBRCASE is used solely to identify a specific "tool" used by applicant in performing the service, in the same manner that CIBRVIEW and CIBRTOOLS identify other tools. The evidence of record shows that the term "tool" is widely used in the computer industry to refer to a computer program or software. Thus, we see no reason to view CIBRCASE, as well as the other two designations, as other than applicant's internal names for the software "tools" it uses in performing its services.

Despite applicant's arguments to the contrary, this is not a situation comparable to that in *In re Holiday Inns, Inc.*, 223 USPQ 149 (TTAB 1984). There the manner of use of the designation KING LEISURE was found to be likely to be perceived by the relevant public as referring to a type of lodging offered by the applicant, rather than any specific goods or physical items. Accordingly, KING LEISURE functioned as a service mark. Here the specimens provide

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no basis for CIBRCASE to be viewed as a type or variation of the basic services offered by applicant; CIBRCASE refers only to specific goods used by applicant in performing these services. Furthermore, although applicant attempts to distinguish the present circumstances from the *Walker* case by arguing that CASE connotes the provision of software development services, while SegMentor has no such connotation, we cannot accept this distinction. The mark at issue is not CASE, but rather CIBRCASE, which applicant describes as "an integrated CASE tool." The reference in the designation is to a program which implements this CASE or computer aided software engineering, not to the engineering per se.

Accordingly, we find that the designation CIBRCASE, as used on the specimens of record, does not function as a service mark.

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Decision: The refusal of registration on the basis that the specimens of record are not acceptable in that they fail to show use of CIBRCASE as a mark for the services identified in the application is affirmed.

E. W. Hanak

G. D. Hohein

H. R. Wendel
Trademark Administrative Judges,
Trademark Trial and Appeal Board

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