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DEC. 16, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Transgo, Inc.

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Serial No. 75/055,823

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Mark P. Stone of for Transgo, Inc.

Barbara A. Gaynor, Trademark Examining Attorney, Law Office  
104 (Sidney I. Moskowitz, Managing Attorney).

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Before Seeherman, Chapman and Bucher, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Transgo, Inc. has applied to register "REPROGRAMMING  
KIT" as a trademark for the following goods:

automotive transmission valve body  
components, namely, separator plates and  
springs; automotive transmission parts,  
namely, separator plates and springs,  
sold together as a unit; automatic  
transmission valve body parts sold as a  
unit for installation in the valve  
bodies of vehicle automatic  
transmissions; and valve body kits  
comprising separator plates and springs  
for installation in the valve bodies of  
vehicle automatic transmissions.<sup>1</sup>

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<sup>1</sup> Serial No. 75/055,823, filed February 9, 1996, alleging use and  
use in commerce as early as 1970.

The Trademark Examining Attorney issued a final refusal to register based upon Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that the applied-for term is generic for such products. In response to applicant's alternative request for registration pursuant to the provisions of Section 2(f) of the Trademark Act, the Examining Attorney held that if this term is not generic, then applicant's mark is so highly descriptive that applicant's claim of acquired distinctiveness is insufficient to permit registration.

Applicant and the Examining Attorney submitted briefs, but an oral hearing was not requested.

Applicant's goods, according to the patent which the Examining Attorney has made of record, are a system used to modify factory-installed transmissions, essentially by modifying the structure and operation of the existing hydraulic circuits of the original transmission. The system produces quick application and release forces with minimum ratio sharing, or overlap, through the modification of the operation of the original transmission by enlarging or

plugging orifices in the original hydraulic circuitry to change fluid flow.<sup>2</sup>

It appears, from the evidence of record, that the purchasers of applicant's goods are auto mechanics, manufacturers of high performance automotive transmission parts, sellers of automotive transmission parts; and those interested in racing automobiles or otherwise modifying their vehicles for high performance.<sup>3</sup>

Turning first to the issue of genericness, it is the Examining Attorney's position that applicant's goods include "kits" which are used to "reprogram" vehicle transmission valve bodies. Therefore, the Examining Attorney asserts that REPROGRAMMING KIT is a generic name for applicant's goods.

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<sup>2</sup> The concurring opinion has gone into great detail about the workings of automatic transmissions and the modifications of them. The author of that opinion appears to be more knowledgeable about such products than are we in the majority. Therefore, we cannot say that the various statements in the record demonstrate as clearly to us as they do to the concurring judge the exact workings of applicant's goods or of the newer products, discussed in the concurring opinion, which are used to modify automatic transmissions. In any event, the more detailed description of such products does not affect our decision herein that the Office has failed to prove that "reprogramming kit" is a generic term for applicant's identified goods.

<sup>3</sup> Although the informational material supplied by applicant as a specimen states that it is for "professional installation," it appears from the identification of goods and the specimens that those wanting to modify their transmissions may still be purchasers of applicant's product, even though the product is professionally installed.

In support of her position the Examining Attorney has made of record excerpts of articles taken from the NEXIS database using the terms "reprogram," "reprogrammed" and "reprogramming" in connection with automotive transmissions; dictionary definitions of the terms "program" and "kit"; a copy of a patent owned by applicant's president, referred to above; and information about applicant's goods posted on one of its distributor's web sites.

The Examining Attorney has the burden of proving genericness by "clear evidence" thereof. See, **In re Merrill Lynch, Pierce, Fenner & Smith, Inc.**, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

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 ... understood by the relevant public primarily to refer to that genus of goods or services?

**H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.**, 782 F.2d. 987, 228 USPQ 528 (Fed. Cir. 1986)

The evidence of record shows that the genus of goods at issue herein are kits or automatic transmission valve body parts or components, sold as a unit, for the purpose of changing the shifting pattern of automatic transmissions of vehicles. After carefully reviewing all of the evidence submitted by applicant and the Examining Attorney, we find

that the Office has not met its burden of proving that the consuming public would refer to that genus of goods as a REPROGRAMMING KIT.

With respect to the NEXIS evidence, although words such as "reprogram" are used in articles in connection with automatic transmissions, none of these articles makes reference to a "reprogramming kit" or, indeed, to "reprogramming devices," "reprogramming systems," etc. In her brief the Examining Attorney has highlighted five NEXIS articles, which are reproduced below.<sup>4</sup>

First, B&M added a larger 30-spline input shaft, a reprogrammed valve body for crisper shifts, a Corvette servo assembly, a superior 2-4 band, a heavy-duty overdrive sprag assembly and ...  
"Hot Rod," December 1995

Reprogrammed valve-body hardware for Ford's A10 automatic trans (to shorten slippage time at the shift points) rounds out the basic Dyno Tunes package.  
"AutoWeek," May 27, 1991

Dinan reprograms the shift points on the automatic, raising the stall speed of the torque converter to match the revs where the turbos come on stream. The result is virtual elimination of lag.  
"AutoWeek," January 7, 1991

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<sup>4</sup> Rather than burdening this opinion by listing all the NEXIS excerpts which are of record we have reproduced only those included in the Examining Attorney's brief, on the assumption that the Examining Attorney chose those which best supported her position. We would add that none of the remaining NEXIS excerpts provides any better support for the claim of genericness.

[U]sing GM internal parts and a Mr. Gasket Tough Shift-3™ kit to reprogram the valve body. The kit allows you three optional programs, from slightly firm shifts to neck-snapping drag racing performance.

"Hot Rod," October 1984

In either mode, it feels like a drag racer's transmission, having been reprogrammed so that upshifts are snappier; in fact, from first to second it's a double snap--your head doesn't just snap back, it jerks forward first.

"AutoWeek," September 16, 1996.

Although these articles indicate that transmissions or transmission valves can be changed or reprogrammed to change the shifting, they do not show that the parts which are used to accomplish this purpose would be referred to as a "reprogramming kit." In fact, some of the references use the term "reprogram" only as a synonym for the word "change," e.g., B&M added a "reprogrammed valve body," Ford's transmission has "reprogrammed valve-body hardware," "Dinan reprograms the shift points."

On the other hand, applicant has submitted declarations from the president of an automotive transmission repair business; a manufacturer of high performance automotive transmission parts; and the operations manager of a distributor of automotive transmission parts, all of whom can be said to represent the views of the relevant public

for applicant's identified goods. Each of these men stated that the appropriate descriptive or generic terminology of the goods purchased from applicant is "valve body kits," "transmission kits" and "transmission modification kits." Gilbert Younger, applicant's president, has also provided a declaration stating that, in addition to the foregoing terms, "recalibration kit" is an appropriate descriptive or generic term for applicant's goods.

As for the dictionary evidence, the Examining Attorney points to definitions of "kit" as meaning "a packaged set of related materials" and of "program" as meaning "to insert, or encode specific operating instructions into (a machine or apparatus); *We'll program the bells to ring at ten-minute intervals*"<sup>5</sup> The Examining Attorney asserts that the addition of the prefix "re" to "program" simply means to program again or anew.

Relying on **In re Gould Paper Corp.**, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987), the Examining Attorney argues that REPROGRAMMING KIT is merely a combination of generic

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<sup>5</sup> Random House Unabridged Dictionary, 2d ed., © 1993. There are several definitions provided for the word "program." Although the Examining Attorney did not allude to it in her brief, and therefore we assume that she does not rely on it, in the Office action making the dictionary listing of record she also highlighted the following definition of "program": to insert (instructions) into a machine or apparatus; *An automatic release has been programmed into the lock as a safety feature.*"

terms that has no separate or distinct commercial impression apart from the meanings of the individual words. However, the Federal Circuit recently had occasion to discuss the import of Gould in **In re The American Fertility Society**, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), explaining that Gould provides assistance in determining the genericness of compound words only. The applied-for REPROGRAMMING KIT does not appear to be a compound word, as "screenwipe" in the Gould case was. Moreover, the Court stated in American Fertility that one of the requirements of Gould was that the PTO must prove "the public understands the individual terms to be generic for a genus of goods and species." The term "kit" is clearly generic for applicant's goods, as applicant has in effect conceded by identifying its goods as a kit in its application, and by the declarations of those in the trade and applicant's own president that the goods are referred to as a kit. However, we cannot say, based on the dictionary definition of "program," with or without the prefix "re," that the PTO has proven that the public understands REPROGRAMMING to be the generic term for applicant's goods.

We would also point out that Gould involved a newly created product category, screenwipes, while applicant's

product has been sold since 1970. As the Board stated in **In re Ferrero S.p.A.**, 24 USPQ2d 1155, 1157 (TTAB 1992):

Common sense leads us to conclude that if a term is generic for a type of a product that has been on the market for decades, evidence of its use by others in the marketplace should be available and should be considered.

See also, **In re Volvo White Truck Corp.**, 16 USPQ2d 1417 (TTAB 1990). However, despite the fact that applicant's REPROGRAMMING KIT product has been sold since 1970, the Examining Attorney has been unable to discover any generic uses of the term "reprogramming kit." This, in fact, is a troublesome issue even for the concurring judge: "Hence, I struggle with the fact that although this type of product has been available in the marketplace for almost thirty years, the Trademark Examining Attorney was evidently unable to find a single instance of third-party usage of this exact phraseology." p. 38.

As for the implication made in the concurring opinion that the lack of third-party usage is due to applicant's threats of legal action, the idea that applicant's enforcement efforts should cut against applicant's claim that REPROGRAMMING KIT is its trademark is contrary to the

principles of trademark law, which encourages a party to protect its mark.<sup>6</sup>

Moreover, those who write or report about automotive matters and car enthusiasts who discuss high performance transmission modifications on the World Wide Web would not have the same fear of litigation that the concurring opinion suggests may have deterred applicant's competitors.<sup>7</sup> Yet the Examining Attorney has not submitted any evidence whatsoever of a newspaper or magazine article showing the term "reprogramming kit" used at all, let alone in a generic manner. And the only evidence of cyberspace use is the web site, discussed below, of applicant's distributor. Given that an Examining Attorney who has submitted evidence from the NEXIS database and the web is presumed to have submitted the best evidence available to him or her from the searches of those media, **In re Federated Dept. Stores**, 3 USPQ2d 1541 (TTAB 1987), we must assume that such searches did not

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<sup>6</sup> In an analogous situation, the Court of Appeals for the Federal Circuit criticized this Board for treating the fame of a mark as a liability in assessing likelihood of confusion. **Kenner Parker Toys Inc. v. Rose Art Industries, Inc.**, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

<sup>7</sup> Even assuming that applicant were to write protest letters to reporters about a perceived misuse of "reprogramming kit," and thereby deter future use of the term, the Examining Attorney has not been able to show any initial uses which would even trigger such a protest.

reveal any other references to the term "reprogramming kit" per se.

The strongest evidence in support of the Examining Attorney's position is the material obtained from the web site of one of applicant's distributors. The information sheet is headed "Transgo Transmission Re-Programming Kits,"<sup>8</sup> below which is a statement, in relatively large letters, that "TRANSGO Kits instantly re-program automatic transmissions for high performance and durability," followed by the statement, "Unique kits re-calibrate the transmission to shift far more efficiently."

The informational material goes on to explain that "Factory programming achieves comfort," that "engineers have been asked to program the shifting for smoothness and comfort," but that by doing so they have lessened efficiency and durability. The advantages of applicant's product is then touted:

Trans-Go re-programming achieves durability and performance.

So if you are willing to accept a faster shift, which will subtract some comfort, you can restore full performance and durability. This is exactly what a Trans-Go Re-Programming Kit does for you. It makes each shift faster and

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<sup>8</sup> Although the applied-for mark is REPROGRAMMING KIT, the word "reprogramming" is used in the web site materials with a hyphen, i.e., "re-programming."

more efficient. As a result, durability of the transmission is immediately doubled.

Re-Programming Goal: Make the shift faster without losing precision.

The problem now becomes clear that what we need is re-programming that will precisely control the complicated chain of events that occur during every shift and do it in a far briefer span of time.

This is exactly what Trans-Go has accomplished. Trans-Go kits...

The automatic with a re-programming kit installed now shifts fast enough to take advantage of inertial energy from rotating mass...

The web site information goes on for a total of five pages. In general applicant's kits are referred to with initial capital letters--Re-Programming Kits. Some of the references capitalize only the word "Re-Programming ("installing a Trans-Go Re-Programming kit"), and there is, in the five pages, one reference in all lower case ("The automatic with a re-programming kit installed..."). The material also uses the term "re-programming" in a descriptive manner to refer to the process of changing the shifting, e.g.:

The problem now becomes clear that what we need is re-programming that will precisely control the complicated chain of events that occur during every shift...

Most kits offer Shift Command, a special feature of our re-programming that allows you to shift back to low at any speed!

...the most important improvement that can be made is to re-program the Control Assemblies.

Although many of the uses of REPROGRAMMING KIT would be frowned on by a trademark attorney, we do not think that they are sufficient, even taken in conjunction with the other evidence which is of record, to prove that REPROGRAMMING KIT is a generic term. Obviously "kit" is generic for the goods, as we have already stated, and the fact that the web site materials sometimes depict this word in lower case does not establish that the term REPROGRAMMING KIT is generic. As for the one usage of "re-programming kit" in a generic manner, we must recognize that this usage occurs in the broader context of a web site in which applicant's product is most frequently referred to in a trademark format. As a result, we think purchasers will not view RE-PROGRAMMING KIT as a generic term, despite this single lower case usage. Certainly these at-most mixed usages do not establish that REPROGRAMMING KIT is a generic term.

Accordingly, we find, based on the evidence of record, that the Office has not met its burden of establishing by

clear evidence that REPROGRAMMING KIT is generic for the identified goods. See **In re Merrill Lynch**, supra.

This brings us to the issue of whether REPROGRAMMING KIT is merely descriptive and, if so, whether applicant has shown that it has acquired distinctiveness as a trademark.

A term is merely descriptive if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods with which it is used. **In re Gyulay**, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). The evidence of record, much of which has been quoted above, clearly shows that REPROGRAMMING KIT is not only merely descriptive, but it is highly descriptive of applicant's goods. Specifically, as discussed above, KIT is a generic term for applicant's goods. The NEXIS excerpts, as well as the descriptive uses of "re-program" in applicant's distributor's web site, establish that the term "reprogram" is used and recognized to refer to modification of transmissions. When these terms are combined, the mark as a whole, REPROGRAMMING KITS, describes a primary characteristic of applicant's goods, namely, that they are kits used to "re-program automatic transmissions for high performance and durability." Web site. Consumers, viewing the mark in connection with applicant's goods, will immediately understand that these parts are sold in the form

of kits which are used to modify, or re-program, transmissions.

Having determined that REPROGRAMMING KIT is descriptive of applicant's goods, we must now consider whether applicant has met its burden of demonstrating that its mark has acquired distinctiveness. That burden is measured by the degree of descriptiveness of the mark; the greater the descriptiveness of a mark, the greater the amount of evidence necessary to prove acquired distinctiveness. See **Yamaha International Corp. v. Hoshino Gakki Co. Ltd.**, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988).

Applicant has submitted four declarations, as discussed above. Three, from those in the trade, state that their companies have purchased high performance valve body kits under the designation REPROGRAMMING KIT from applicant since 1970, in two cases, and since 1982 in the case of the third; and that they regard REPROGRAMMING KIT as a trademark of applicant's. The fourth declaration, from applicant's president, originally executed in 1996 and supplemented in July 1998, states that the mark REPROGRAMMING KIT has been used by applicant on its identified goods continuously since 1970; that as of June 30, 1998 sales of such goods have exceeded 820,000 units and \$17.2 million in gross revenues, with sales in the period between January 1, 1993 and June

30, 1998 exceeding \$6.2 million in gross revenues and 220,000 units; and that applicant uses a "TM" symbol in conjunction with the depiction of the mark on its goods.

Given the highly descriptive nature of applicant's marks, we find that applicant has not met its burden of proving that it has acquired distinctiveness. Although applicant has certainly used its mark for a substantial amount of time, mere longevity of use is not always sufficient to prove acquired distinctiveness. In this case, applicant's use of the mark is always with the trademark TRANSGO, which appears in much more prominent letters and type style. Moreover, the sale of 820,000 units over almost 30 years is not particularly significant in terms of the exposure of the mark to the consuming public. See **In re The Boston Beer Company Limited Partnership**, Case No. 99-1123, \_\_\_F.3d\_\_\_, \_\_\_USPQ2d\_\_\_ (Fed. Cir. Dec. 7, 1999), in which use since 1985, annual advertising expenditures in excess of \$10 million and annual sales of \$85 million were found insufficient to establish acquired distinctiveness of THE BEST BEER IN AMERICA.

Applicant has provided no information whatsoever about its advertising of its product, from which we might ascertain what public recognition it might have. The three declarations of purchasers of applicant's high performance

valve body kits--from the president of an automotive transmission repair business in Fort Walton Beach, FL; the president of a manufacturer of high performance automotive transmission parts in Bartlett, TN; and the operations manager of an automotive transmission parts distributor in Oklahoma City, OK--are similarly unpersuasive.

Considering the highly descriptive nature of the term REPROGRAMMING KIT, the evidence submitted by applicant is simply insufficient for us to conclude that REPROGRAMMING KIT has acquired distinctiveness among the relevant consumers.

Decision: The refusal of registration on the ground of genericness is reversed. The refusal of registration on the ground that the mark is merely descriptive, and that applicant has failed to establish acquired distinctiveness, is affirmed.<sup>9</sup>

E. J. Seeherman

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

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<sup>9</sup> Should our decision that applicant's mark is merely descriptive, and has not acquired distinctiveness, be overturned, applicant must still submit a disclaimer of the generic term KIT before a registration may issue.

Bucher, Administrative Trademark Judge, concurring:

I agree with my colleagues that based upon this record, applicant should *not* be issued a federal trademark registration. On the other hand, I disagree with that part of the majority's decision finding that the term "reprogramming kit" has not been shown to be generic for these products. This case presents the Board with a fact situation where we should merely apply common sense to the usage of these two ordinary, English-language words. Taking the plain meaning of the term "reprogramming kit" in the real-world context of applicant's after-market goods, we should readily affirm the refusal of the Trademark Examining Attorney to register this matter on the ground that the applied-for term is generic for these automotive transmission valve body components.

My colleagues in the majority conclude: "Consumers, viewing the mark in connection with applicant's goods, will immediately understand that these goods are sold in the form of kits which are used to modify, or re-program, transmissions." Indeed, they find the term to be *highly* descriptive. Yet the majority also agrees with the contention of the applicant that the Examining Attorney has failed to meet her burden of proof on the issue of

genericness. I disagree with this holding, and I would affirm the refusal to register based upon the showing of genericness contained within the file.

*Dissent only as to "Genericness" Issue*

Of the several issues on appeal in this case, the only conclusion on which I part ways with my colleagues in the majority has to do with whether the term "Reprogramming Kit" is generic for applicant's goods.

As to this critical issue, by maintaining her position that this matter is indeed a generic designation, the Trademark Examining Attorney must prove genericness with "clear evidence." See, *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). She must demonstrate that the primary significance of this term to the relevant public is as a type of product. The "primary significance" test was first enunciated by Judge Learned Hand in *Bayer Co., Inc. v. United Drug Co.*, 272 F. 505, 509 (S.D.N.Y. 1921): "The single question, as I view it, in all these cases, is merely one of fact: What do the buyers understand by the word whose use the parties are contending?" See also, *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 83 L.Ed. 73, 39 USPQ 296 (1938) ["Shredded Wheat" is generic because it "is the term by which the

biscuit in pillow-shaped form is generally known by the public].

As the Examining Attorney points out, evidence of the relevant public's perception of a term may be acquired from any competent source, including newspapers, magazines, dictionaries, catalogs and other publications. In re Leatherman Tool Group Inc., 32 USPQ2d 1443, 1449 (TTAB 1994), citing to In re Northland Aluminum Products, Inc., 777 F.2d 1566, 227 USPQ 961, 963 (Fed. Cir. 1985). Under the test articulated by our reviewing court in H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc., 782 F.2d. 987, 228 USPQ 528 (Fed. Cir. 1986):

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 ... understood by the relevant public primarily to refer to that genus of goods or services?

Evidence of Record:

Web site: The Examining Attorney submitted for the record several pages (containing pictures, drawings, and text) from a World Wide Web site. In reviewing this critical material taken from the Internet,<sup>10</sup> I have

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<sup>10</sup> Transmission Exchange Co. of Portland, OR, made this Internet site available on the World Wide Web. Transmission Exchange is a distributor of applicant's goods, and was the most authoritative source the Trademark Examining Attorney found on the Internet promoting applicant's goods. The site is found at

reproduced the text in full (with the size/style of the web page fonts but without the images):

## **TransGo Transmission Re-Programming Kits**

**TRANSGO Kits instantly re-program automatic transmissions for high performance and durability.**

**Unique kits re-calibrate the transmission to shift far more efficiently.**

**In terms of performance and durability for an automatic transmission, the most important improvement that can be made is to re-program the Control Assemblies. These assemblies regulate the functions of the entire transmission; 95% of shift performance comes from programming. Installing a Trans-Go Re-programming Kit will instantly improve the whole personality of your GM, FORD and CHRYSLER transmissions.**

**Factory programming achieves comfort.**

**The automatic transmissions coming off the assembly lines in Detroit are truly masterpieces of engineering. But engineers have been asked to program the shifting for smoothness and comfort. Also, consumer attitude surveys show that drivers believe a soft, smooth shift is easier on the transmission. *Actually, just the reverse is true.***

To add comfort, Detroit designers have had to subtract a considerable amount of efficiency and durability. They have achieved comfort by extending the time duration of every shift. Not only does power slip away during this extended shift, but all friction surfaces receive excessive wear because they are asked to work overtime.

**The stock automatic takes longer to complete each shift. [Reference to Figure 1 not shown herein]. During this period only a partial power condition exists because the friction elements are slipping.**

This extended slipping time prevents the inertial energy from being efficiently utilized. It is lost in the form of heat on the clutches and bands, instead of being utilized for forward motion. Continually operating a stock automatic at full throttle will cause early friction element failure.

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<http://www.teleport.com/~txchange/transgo.htm> , and will be discussed in more detail, *infra*.

To get high performance and improved durability in an automatic, we must improve the way it executes every shift.

**Trans-Go re-programming achieves durability and performance.**

**So if you are willing to accept a faster shift, which will subtract some comfort, you can restore full performance and durability. This is exactly what a Trans-Go Re-Programming Kit does for you. It makes each shift faster and more efficient. As a result, durability of the transmission is immediately doubled.**

**Re-Programming Goal: Make the shift faster without losing precision.**

**The problem now becomes clear that what we need is re-programming that will precisely control the complicated chain of events that occur during every shift and do it in a far briefer span of time.**

This is exactly what Trans-Go has accomplished. Trans-Go kits cut slipping time by more than 70% (even more in the Competition version) and at the same time improve the quality of the shifting action itself. [Ref to Figs 1 and 2 not shown herein]

**The automatic with a re-programming kit installed now shifts fast enough to take advantage of inertial energy from rotating mass, including the inertial energy from the transmission itself. Notice also the higher speed recorded (C) as the curve leaves the chart. In driving this conversion at full throttle a sudden forward lurch can be felt when it shifts, very similar to a power-shifted 4-speed.**

**You get better control and back to low at any speed.**

**Trans-Go kits give you more complete gear control of your transmission. Most kits offer Shift Command, a special feature of our re-programming that allows at any speed! Trans-Go kits also retain fully automatic shifting in the "D" Position.**

**As the elapsed time of shifting is decreased, the life of the transmission friction materials is increased.**

Installing a Trans-Go Re-Programming kit will at least double the life of the friction materials in the transmission. In many heavy-duty applications, a Trans-Go kit has made the difference between a few months service without repair and several years.

The shorter shift time allows the friction elements and gears far less time to wear themselves out. The useful life of the friction elements in a transmission is directly related to the amount of slipping that is allowed to occur during shifts.

Slipping converts useful energy to heat on the surface of the clutches and bands. This heat transforms the friction material to ash, which polishes its mating element, causing further slipping, heat and deterioration of the friction elements.

The gears receive less wear, too. A slow shift causes them to be partially engaged for a longer period during the gear changing process, resulting in unnecessary heat, wear and power loss.

## **ARE QUICK SHIFTS ALL THAT MATTER?**

**Not by a long way. We have seen what can be gained in durability and performance with quicker shifts. Overlap is also extremely important. Overlap is a condition caused by applying a gear before the previous gear has been released.**

**Excessive overlap as seen in the Fig. 3 converts engine horsepower into damaging heat and causes clutch wear, band wear, shift delays, short oil life, and increased gasoline usage.**

**Factory programming includes an excessive amount of overlap.**

**This is done purely for smoothness. Overlap causes delayed shifts. Overlap is the main cause of shift delay, or hesitation when shifting manually.**

Excessive Overlap is eliminated with Trans-Go Re-Programming. The difference is felt immediately and there are substantial increases in performance, durability and fuel economy.<sup>11</sup>

Applicant's patent: Given the importance to this factual determination of understanding the underlying technology, the Examining Attorney has made of record a patent supporting applicant's "Reprogramming Kit," summarized in one section of the patent as follows:

### ***DESCRIPTION OF THE BEST MODES FOR CARRYING OUT THE INVENTION***

The present invention is directed to improvements and modifications to existing "factory installed" automotive transmissions, and in particular the transmissions known as General Motors Corporation 700-2 and 700-3. The objects of the present invention include modification of the structure, hydraulic circuitry, interrelationship of structure and fluid flow patterns through the hydraulic circuitry of the original automotive transmissions for the purpose of 1). enabling driver of the vehicle to select any available ratio at any time, and 2). to control the fluid flow through the hydraulic circuitry in order to produce quick "apply and releases." The

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<sup>11</sup> Applicant has not tried to distance itself from these uses by one of its distributors. In fact, applicant has used this material in support of its own position of non-genericness.

modifications to the original operation and hydraulic circuitry of the "factory installed" automotive transmissions are made by removing structure including original valves, adding structure including new valves, adding new hydraulic circuits to the overall circuitry, discontinuing use of existing circuits by plugging; and modifying the flow through existing hydraulic circuitry by enlarging or reducing the size of fluid flow orifices and adjusting existing spring and pressure values.

U.S. Patent No. 5,540,628, issued to Gilbert Younger, Applicant's President, on July 30, 1996.<sup>12</sup>

Summary of relevant technology: One learns from the above web site, the entire text of the above referenced patent, and the specimens of record in this trademark application file, that applicant's "reprogramming kit" actually has two purposes: one is to permit the driver to control more precisely the gear ratios on a *manual* transmission, and the second is to modify the operation of an *automatic* transmission. However, much of the record emphasizes this latter function -- as applied solely to *automatic* transmissions.

Specifically, one learns from the record that automatic transmissions have transmission fluid pumped through a series of passages under pressures up to 300

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<sup>12</sup> Unlike some of the other evidentiary submissions herein, I find this patent to be most helpful in understanding the nature of applicant's improvements directed to valve body kits. Hence, it is of no moment that the patent specifications carefully avoid

psi and directed via valves and solenoids to activate various clutches and bands on planetary gear-sets. The gear-sets are engaged and disengaged to provide various ratios that multiply the input torque passed to the transmission through a torque converter, designed to turn the drive-shaft and hence to move the vehicle.

Accordingly, as seen in the claims of the patented device, which is of record, applicant's kit is designed to permit the automobile mechanic to modify the factory-installed transmission of certain automobiles using the after-market parts listed in the identification of goods.

One learns that the automatic transmission for an automobile, as originally designed and shipped from the factory, is set up to shift smoothly from one gear to the next. According to applicant's patent, this is done with excessive amounts of "overlap." Overlap refers to a design ensuring that the transmission begins to apply the new gear before the previous gear has been released. In a sense, as designed at the factory, the stock transmission has been "programmed" to shift in this manner for maximum comfort.

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usage of the terms "reprogramming" or "reprogramming kit" in a generic manner.

By eliminating excessive overlap, applicant's kit provides for a quicker shift while reducing damaging heat. The biggest concern for high performance transmissions is building up too much heat in the transmission fluid, which can considerably reduce the life of a transmission. This invention is designed to change the pre-existing hydraulic circuits by modifying the flow of transmission fluid. Hence, in the same sense that the factory transmission has been "programmed," with this shift modification kit, the stock transmission has now been "reprogrammed."

The target audience for these goods is made up of those drivers who want to improve the performance of their automotive transmissions. Hence, applicant is competing in the area of after-market components for one's automatic transmission, which components are designed to reduce the transmission's operating temperature, change shift points, reduce engine wear, and improve the performance of the vehicle when it is being used hard.

Applicant provides heavy-duty transmission parts for the person towing heavy loads.<sup>13</sup> For example, when a truck is towing a recreational vehicle up a long hill, it can cause extreme slippage in the truck transmission, which in turn causes high transmission fluid temperatures. Eventually, prolonged stress could damage the transmission. Similarly, performance enthusiasts and those driving police cars or taxicabs are willing to sacrifice smoothness by installing a kit promising a quicker, more solid shift.

Because applicant's product changes the route of transmission fluid through the transmission, it requires the services of an experienced mechanic<sup>14</sup> who must pull the "trans" apart before installing these exacting components. Since the time of the introduction of the automatic transmission until recent years, such a complicated valve body modification was the route the person towing heavy loads, the car enthusiast, or those in the taxi industry, for example, would have pursued. Certainly, when applicant

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<sup>13</sup> The specimens of record show outline designs of eight vehicles, titled "competition," "service vehicle," "police," "taxi," "muscle cars," "towing," "campers," and "rough duty."

<sup>14</sup> From the specimens of record: "This is a racing product for professional installation ONLY. It is not a "do-it-yourself" product. It's for the experienced, full-time, professional transmission mechanic who is already completely familiar with 700 trans repair."

began using this designation in 1970, automatic transmissions were not electronically controlled and shift modifications were totally mechanical. On the other hand, the record herein speaks to the mechanical complexity of automatic transmissions. In fact, automatic transmissions may be thought of as being hydraulically-activated, gear-selection "computers."

Articles of general circulation: The Trademark Examining Attorney has placed various entries from the LEXIS/NEXIS data base into the record, excerpts of which are reproduced below (emphasis supplied):

"...using GM internal parts and a Mr. Gasket Tough Shift-3™ kit to reprogram the valve body. The kit allows you three optional programs, from slightly firm shifts to neck-snapping drag racing performance." (Hot Rod, October 1984).

"Dinan reprograms the shift points on the automatic, raising the stall speed of the torque converter to match the revs where the turbos come on stream. The result is virtual elimination of lag." (AutoWeek, January 7, 1991).

"Reprogrammed valve-body hardware for Ford's A10 automatic trans (to shorten slippage time at the shift points) rounds out the basic Dyno Tunes package." (AutoWeek, May 27, 1991).

"First, B&M added a larger 30-spline input shaft, a reprogrammed valve body for crisper shifts, a Corvette servo assembly, a superior 2-4 band, a heavy-duty overdrive sprag assembly ..." (Hot Rod, December 1995).

"In either mode, it feels like a drag racer's transmission, having been reprogrammed so that upshifts are snappier; in fact, from first to second it's a double snap - your head doesn't just snap back, it jerks forward first..." (AutoWeek, p. 18, September 16, 1996).

"The transmission has been reprogrammed to upshift less readily while driving up and down mountain roads..." (The Washington Times, p. E3, October 10, 1997).

"Either a five speed manual or four-speed automatic transmission is available, with the automatic reprogrammed for smoother shifts." (Bergen County Record, p. C12, November 1, 1997).

"... The four-speed automatic gains a fluid cooler, which allows the engineers to reprogram it for quicker shifts. Average shift time has been halved from a lethargic 1.6 seconds to 0.8. Shifts are smoother too, ..." (The Toronto Star, p. G8, November 15, 1997).

Note that while the last four LEXIS/NEXIS entries above continued to use the terminology of "reprogramming" automatic transmissions in a broad (or "generic") sense, they no longer mention valve body hardware modifications. In fact, in the following LEXIS/NEXIS stories, the excerpts explicitly reflect the fact that today's automatic transmissions are at least partially electronically controlled:

"...The four speed automatic transmission optimizes the engine's power, electronically reprogramming the shift points for uphill and downhill driving." (Fresno Bee, p. D2, November 26, 1994).

"...BMW's 5-speed transmission, meanwhile, has been reprogrammed for 1996 and uses an array of electronics that ensure swift, precise shifts as the V-8 engine in the 540i accelerates or de-accelerates." (Chicago Tribune, Transportation, p. 1, April 28, 1996).

"The electronically operated, four-speed automatic transmission has been reprogrammed for cleaner, faster shifts, though I miss the old gated shifter that seemed to invite an aggressive hand on the lever." (The Spokesman-Review, p. D1, April 26, 1997).

"...Using sensors, including the lateral acceleration sensor in StabiliTrak, it can reprogram the transmission

to react like a manual gear box if the car is driven hard." (Automotive Industries, No. 9, Vol. 177, p. 82, September 1997).

In reviewing these entries from the LEXIS/NEXIS database, one may note that advances in automobile technologies have changed much of the "transmission reprogramming" scenario of the sixties and seventies, but interestingly, the same terminology has continued.

### Discussion of Genericness

The word "Reprogramming": Applicant argues that the Trademark Examining Attorney has failed to present evidence that the primary significance of the word "reprogramming" would be recognized by the relevant consuming public as the "most pertinent and individually generic" term applicable to applicant's goods. However, I agree with the Examining Attorney that the most compelling evidence that the word "reprogramming" is generic when used in conjunction with the applicant's goods comes from the applicant itself.<sup>15</sup> The information about applicant's goods posted on the Internet demonstrates generic uses of the following terminology throughout: "program," "programming," "re-program," "re-programmed" and "re-programming." The reader of this site is told right up front that TRANSGO "**Kits** instantly **re-**

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<sup>15</sup> Trademark Examining Attorney's brief, p. 6, referring to Transmission Exchange's Internet site, shown *supra*.

**program** automatic transmissions..." One is taught that "the most important improvement that can be made is to **re-program** the Control Assemblies..." inasmuch as "...95% of shift performance comes from **programming**." While "Factory **programming** achieves comfort..." because factory "...engineers have been asked to **program** the shifting for smoothness and comfort...", "Trans-Go **re-programming** achieves durability and performance." Hence, Transgo helps the car owner to achieve his "**Re-Programming** Goal." The person visiting this web site is told about the advantages of the "...automatic with a **re-programming kit** installed..." In fact, "[m]ost kits offer Shift Command, a special feature of our **re-programming**..." Later on, one learns that "[f]actory **programming** includes an excessive amount of overlap... ," but fortunately "[e]xcessive Overlap is eliminated with Trans-Go **Re-Programming**."

The majority notes correctly that at various points throughout this text, the term "re-program" seems to be used interchangeably with the terms "re-calibrate" or "modify." To the extent applicant concedes that "shift recalibration kit" or "modification kit" is generic, it seems to follow logically from this web page that "reprogramming kit" is equally generic.

I also find that the LEXIS/NEXIS entries (spanning more than a dozen years) demonstrate that the general media has indeed used the "reprogramming" term to refer to this type of modification to automatic transmissions. The earliest stories refer specifically to mechanical changes in hard parts of the valve body. By contrast, the most recent stories clearly reference electronic modifications. However, whether this is achieved through a modification to the hard parts of the transmission or through after-market changes in the electronic controls, all have much the same result for the driver -- faster shifts, longer wear, added performance and/or improved heavy-duty driving. Furthermore, any of these changes are understood by those knowledgeable about automobiles as a "reprogramming" of the transmission.

Finally, one should not be confused by the recent intersection of computer technology and automatic transmissions. Specifically, the fact that the concept of "programming" or "re-programming" may well fit another meaning (i.e., of modifying computer software generally, or even specifically modifying the computer software running the transmission electronic control

units on late model cars) reflects parallel but slightly different uses of the same terminology.<sup>16</sup>

The word "Kit": The applicant's identification of goods states that its goods include "valve body kits." The identification of goods confirms that several of its products are "sold as a unit." The web pages and the specimens of record demonstrate the prevalence of "kits" for such complex after-market items (e.g., "valve body kits," "valve Body repair kits," "transmission modification kits," "valve body rebuilding kits," "valve body calibration (or recalibration) kits," "transmission reprogramming kits," "valve body reprogramming kits"). The Trademark Examining Attorney has shown from a dictionary definition that a "Kit" is "a packaged set of related materials." Indeed, the majority seems to agree that there is no more apt, generic designation for these products than the word "kit" or "kits."

The combined term "Reprogramming Kit": Citing to *In re Gould Paper Corp.*, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987), the Trademark Examining Attorney takes the position that

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<sup>16</sup> *Viz.* applicant's request for reconsideration submitted January 13, 1997: "[T]he mark REPROGRAMMING KIT was adopted by applicant in 1970 ... to provide ... [a] general connotation and association between applicant's goods and "high tech" or "computer technology" (which was then at its early stages of development). Automotive systems, including transmissions [in 1970], were not controlled by computers..."

"reprogramming kit" is merely a combination of generic terms that has no separate or distinct commercial impression apart from what one who understands the individual meanings of the terms would expect. As such, she argues that the proposed mark is incapable of serving as a source identifier and is itself generic.<sup>17</sup> Applicant argues in turn that none of the evidence made of record by the Examining Attorney shows the use of the exact phraseology "Reprogramming Kit" in conjunction with automotive transmission valve body kits, that these excerpts do not support the conclusions the Trademark Examining Attorney derives from them, and that unlike the facts in Gould, this combination of generic terms results in a new, protectable, composite mark.

However, I agree once again with the Trademark Examining Attorney. The above uses from the web page and those excerpts from the LEXIS/NEXIS stories are highly persuasive evidence of the genericness of the matter sought to be registered. In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987). As the Trademark Examining Attorney contends:

... in Gould Paper, the Court of Appeals for the Federal Circuit held that 'the PTO has satisfied its evidentiary burden if ... it produces evidence including dictionary definitions that the separate words joined to form a compound have a meaning identical to the meaning common

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<sup>17</sup> Trademark Examining Attorney's brief, p. 4.

usage would ascribe to those words as a compound.' The evidence of record satisfies that evidentiary burden.

A "KIT" is "a packaged set of related materials." See the excerpt from *Webster's II New Riverside University Dictionary* (1994 ed.) attached to the August 5, 1996 Office action. The applicant's identification of goods affirmatively states that its goods include "valve body kits," and that several of its goods are "sold as a unit."

To "PROGRAM" something means "to insert, or encode specific operating instructions into (a machine or apparatus)." See the excerpt from the *Random House Unabridged Dictionary* (2d ed. 1993) attached to the May 22, 1997 Office action. The addition of the prefix "RE" to "PROGRAM" simply means to program again or anew.

Moreover, "REPROGRAMMING" has meaning in the applicant's industry. Attached to the August 5, 1996 and the February 10, 1998 Office actions are representative article excerpts from the examining attorney's search of the NEXIS computerized database which show the significance of "REPROGRAMMING" when used in conjunction with the applicant's goods - namely, that the applicant's goods are used to "reprogram" the valve bodies contained in a vehicle's transmission. (Trademark Examining Attorney's brief, pp. 4 - 5).

While the dictionary definitions alone would not meet the rather heavy burden placed on the Patent and Trademark Office to demonstrate genericness, I find that when they are combined with the balance of the evidence in the file, they are certainly supportive of this interpretation.

Turning to the usage by applicant on its specimens of record, I note the contention of the Trademark Examining Attorney as follows:

Moreover, the use of the proposed mark on the specimens of record is such that the relevant public would perceive "TRANSGO" as a trademark for the applicant's product and view REPROGRAMMING KIT™ as identifying what the goods are. *In re Leatherman Tool*

*Group, supra*, at 1450. The applicant's use of the trademark symbol (the "™") with REPROGRAMMING KIT cannot make an otherwise unregistrable term a trademark. (Trademark Examining Attorney's brief, p. 7).

Applicant counters with the following argument:

[T]he Examining Attorney concludes that although the term "REPROGRAMMING KIT" is designated with the informal trademark notice "™" in the specimens of use filed by Applicant in the present trademark application, the relevant public would perceive Applicant's registered trademark "TRANSGO" as the trademark for Applicant's product and view the "REPROGRAMMING KIT" as identifying what the goods are... [I]t is well established that a product can be designated with more than a single trademark, and there is no prohibition against Applicant using both of its trademarks "TRANSGO" and "REPROGRAMMING KIT" to designate the source of origin of its goods. (Applicant's reply brief, p. 8).

Applicant is correct in that a single product can bear more than one trademark (e.g., many consumer items may carry both a house mark and a product mark). However, in reviewing the specimens of record, I again find the arguments of the Trademark Examining Attorney most compelling.

In fact, the specimens reinforce the reality of the marketplace for high performance, after-market goods. I would posit the notion that automobile mechanics as well as grown boys having their grown-up toys are fairly sophisticated about their trademarks. Just as an auto enthusiast might readily disclose that the vehicle sports a Hard Dog® roll bar, that it accelerates quickly due to its Jackson Racing® supercharger and high-flow K&N® air filter,

and it corners nicely with Koni® adjustable shocks and Michelin® tires, he would refer to this particular performance product as a Transgo® reprogramming kit. The specimens, like the web page, only reinforce this usage of a manufacturer's house mark followed by the product designation, or generic name.

H. Marvin Ginn Question #1: In the language of H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc., supra, what is the precise genus of applicant's transmission components? In the course of reviewing the evidence of this file, we have seen usage of a variety of terms such as "valve body kit," "valve body rebuilding kit," "valve body repair kit," "transmission modification kit," "valve body calibration (or re-calibration) kit," and it seems, "transmission (or valve body) reprogramming kit."

As the Trademark Examining Attorney points out:

The applicant also argues that "REPROGRAMMING KIT" is not a generic name for its goods because other terminology is accepted as the generic/descriptive name(s) for the goods. "There is usually no one, single and exclusive generic name for a product. Any product may have many generic designations. Any one of those is incapable of trademark significance." 2 J. Thomas McCarthy, *Trademarks and Unfair Competition*. §12:9 (4th ed. 1996). The fact that the applicant's goods are also called "valve body kits," "transmission modification kits," and "recalibration kits" does not preclude the term "REPROGRAMMING KITS" from also being a generic name for the applicant's goods.

"All of the generic names for a product belong in the public domain." In re Sun Oil Company, 426 F.2d 401,

165 USPQ 718, 719 (CCPA 1970) [emphasis in original].  
(Trademark Examining Attorney's brief, p. 7).

H. Marvin Ginn Question #2: When reviewing the listing above of the variety of generic names for these goods, one will note that it actually answers the second H. Marvin Ginn question in the affirmative: Yes, the term sought to be registered, transmission (or valve body) "reprogramming kit," is readily understood by the relevant public primarily to refer to that genus of goods.

No evidence of third-party usage: The record shows that this product is clearly not a recent entry into the world of after-market automotive kits. Hence, I struggle with the fact that although this type of product has been available in the marketplace for almost thirty years, the Trademark Examining Attorney was evidently unable to find a single instance of third-party usage of this exact phraseology.<sup>18</sup> However, the record does reflect the fact

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<sup>18</sup> Other than the previously-noted web site (see footnote 10), the record shows no reliance on other information from the Internet. As anyone who surfs the Web must acknowledge, the Internet contains a wealth of information of varying reliability and transience. However, this information could be valuable in determining the registrability of a mark, and Examining Attorneys would be remiss in not utilizing this economical and efficient resource in appropriate ways. Especially in a case such as this one, knowing exactly how auto parts vendors, transmission specialists, car enthusiasts, *et al.*, use a term like "reprogramming kit," would be most helpful to this tribunal. Additionally, unlike the prohibitiveness of conducting a formal survey prior to an *ex parte* appeal, an Internet search in a case such as this one is certainly within the constraints imposed upon the Examining Attorneys. Hence, I anticipate we will see an

that applicant has threatened legal action against competitors who have used this generic (or according to the majority, "non-distinctive" and "highly descriptive") terminology.<sup>19</sup> The factors cited above may well explain why smaller competitors have chosen to avoid using the designation "Reprogramming Kit." Nonetheless, given that the Trademark Examining Attorney has established that applicant's "kit" is designed for the "reprogramming" of an automatic transmission, I conclude that "reprogramming kit" is one of the terms the car enthusiasts would use to refer to this product, irrespective of its source. Similarly, competitors should also be able to use this generic terminology.

As to the Trademark Examining Attorney's failure to find third-party uses, it has also long been held that a generic term may not be exclusively appropriated as a trademark, regardless of how long applicant fortuitously may

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accelerated usage of this resource. In this regard, it may be appropriate to expect future guidelines from the policy-makers within the Office, to ensure that Trademark Examining Attorneys using the Internet to support refusals during *ex parte* examination are providing applicants with adequate information to locate the documents retrieved and to show the details of the search as conducted.

<sup>19</sup> Applicant has identified for the record several past incidents in which competitors have ceased their use of this matter in response to applicant's demands that they cease and desist such usage.

have enjoyed the exclusive use thereof in trade. See Kellogg Company v. National Biscuit Co., 305 U.S. 111, 83 L.Ed. 73, 39 USPQ 296 (1938) ["Shredded Wheat" is generic]; and Schulmerich Electronics, Inc. v. J. C. Deagan, Inc., 202 F2d 772, 97 USPQ 141 (CCPA 1953) ["Carillonic Bells" is generic for "electrically-operated carillons or chimes"].

What is left of Gould after American Fertility Society?

To the extent that the majority questions the Trademark Examining Attorney's reliance on the logic of In re Gould,<sup>20</sup> I conclude that the instant case still falls within the factual parameters of In re Gould -- even though this "compound" is not one where the two words are physically joined. The Trademark Examining Attorney has demonstrated that the relevant public understands the individual terms to be generic for this type of product and that the relevant public understands the joining of the individual terms into one compound word (or term) to lend no additional meaning to the term. Hence, given the facts of this case, the Examining Attorney has demonstrated that the relevant public would understand this "compound term" to refer primarily to the genus of goods or services described by the individual terms.

I am indeed aware of the recent decision of the Court of Appeals for the Federal Circuit in the case of In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999).<sup>21</sup> The Court held that the Board (in its earlier decision affirming a disclaimer requirement for the allegedly generic phrase "SOCIETY FOR REPRODUCTIVE MEDICINE") had misapplied the "correct legal test for genericness of phrases, as set forth in H. Marvin Ginn..." The American Fertility Society Court explained that the legal test from Gould<sup>22</sup> is applicable only to marks comprised of "compound terms" such as "screenwipe." The Court in American Fertility Society stated: "Gould is limited, on its facts, language, and holding, to compound terms formed by the union of words. It is legally erroneous to attempt to apply the [Gould test] to phrases consisting of multiple

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<sup>20</sup> And of course, the Trademark Examining Attorney's brief of January 19, 1999 preceded the issuance of the Court's decision in American Fertility Society.

<sup>21</sup> The entire mark for which registration was sought in American Fertility Society was "AMERICAN SOCIETY FOR REPRODUCTIVE MEDICINE." The appeal was over whether the lesser phrase "SOCIETY FOR REPRODUCTIVE MEDICINE" must be disclaimed as generic. Although the individual terms "SOCIETY" and "REPRODUCTIVE MEDICINE" were each conceded to be generic, the Court found that the phrase "SOCIETY FOR REPRODUCTIVE MEDICINE" was *not* generic].

<sup>22</sup> That is, permitting the Office to satisfy its evidentiary burden demonstrating genericness by producing "...evidence including dictionary definitions that the separate words joined to form a compound have a meaning [to the relevant public] identical to the meaning common usage would ascribe to those words as a compound... Gould, supra, 5 USPQ2d at 1111-12.

terms, which are not 'joined' in any sense other than appearing as a phrase." In re American Fertility, 51 USPQ2d at 1837. The Court remanded the case to the Board for

...evidence of 'the genus of goods or services at issue' and the understanding by the general public that the mark refers primarily to 'that genus of goods or services.' ... The Board must now apply the Marvin Ginn test to the phrase as a whole, and not focus only on the individual terms. *Id.*

However, the phrase at issue in the case of In re American Fertility Society involved "multiple" terms - certainly more than two words. In its discussion of the proper tests to be used in determining genericness, the American Fertility Society Court distinguishes between "phrase" marks<sup>23</sup> and "compound" word (or "term") marks. Arguably, the holding and analysis of that case is not readily applicable in the context of determining the genericness of a term consisting of merely two words. Hence, my genericness finding in this case is consistent with the Court's teaching of In re American Fertility Society. As between a "phrase" mark (e.g., "Society For Reproductive Medicine") and a "compound" mark (e.g.,

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<sup>23</sup> Note that four words at issue in this case comprise the phrase "SOCIETY FOR REPRODUCTIVE MEDICINE." The admittedly generic terms "society" and "reproductive medicine" are separated by the preposition, "for." As contrasted with "SCREENWIPE" or the matter in the instant case, this distinction in syntax seems to be a significant factor in the Court's decision in American Fertility Society.

"screenwipe" or the Gould Court's hypothetical, "screen wipe" <sup>24</sup>), the term "reprogramming kit" is more akin to the "compound" mark. "Reprogramming kit" consists of two generic, constituent elements, joined to form a new term. Clearly, the Gould Court demonstrates that the results under the Lanham Act in such a case should not turn on whether this "combined" form does ("reprogramming kit," or "screen wipe") or does not ("screenwipe") have a space separating the operative terms or words. Therefore, in attempting to establish that a combination of two words into a new term is generic under the two-part test of Ginn, supra, the Office should be entitled to the "additional assistance" provided by Gould in cases involving these "compound marks," and should not be required to present evidence that the compound term, *per se*, has been used generically by others.

To the extent that In re American Fertility Society, supra, explicitly restricts the fact patterns under which the "additional assistance" of the Gould Court's logic can be invoked by a Trademark Examining Attorney, or a Judge of this Board, I find that applicant's mark should still be

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<sup>24</sup> The Gould Court explicitly states that the same result would follow if that mark had been presented as two words (e.g., "SCREEN WIPE) inasmuch as the presence or absence of a space between the words was not determinative of its status as a "compound word." See Gould, 5 USPQ2d at 1112.

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deemed to be generic under the analysis set forth in that case.

For all of these reasons, I would affirm the refusal of the Examining Attorney on the issue of genericness.

D. E. Bucher

Administrative Trademark  
Judge, Trademark Trial and  
Appeal Board