Oral Hearing: Paper No. 2
August 16, 2001
GDH/gdh

10/17/01

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SICAN Gesselschaft für Silizium-Anwendungen und CAD/CAT Niedersachsen mbH

Serial No. 75/188,281
Serial No. 75/188,288

Richard E. Backus of Flehr, Hohbach, Test, Albritton & Herbert for SICAN Gesselschaft für Silizium-Anwendungen und CAD/CAT Niedersachsen mbH.

Kathy M. Vanston, Trademark Examining Attorney, Law Office 103 (Dan Vavonese, Acting Managing Attorney).

Before Hanak, Hohein and Wendel, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

SICAN Gesselschaft für Silizium-Anwendungen und CAD/CAT Niedersachsen mbH has filed applications to register the term "DesignObjects" for "computer programs for the recording,

processing, transmission or reproduction of sound or images; data processing equipment, namely, audio decoders; semiconductors; data processing computer programs; [and] computer program library modules for digital signal processing, digital image processing and broad band communication" in International Class 9[1] and "computer software design services, namely designing computer program library modules; [and] design of electronic devices for use in conjunction with computer program library modules" in International Class 42.[2]

Registration in each instance has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that, when used in connection with applicant's goods and services, the term "DesignObjects" is merely descriptive of them. In addition, in the case of applicant's service mark application, registration has been finally refused under Sections 1(a)(1) and 45 of the Trademark Act, 15 U.S.C. §§1051(a)(1) and 1127, on the ground that the

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[1] Ser. No. 75/188,281, filed on October 28, 1996, based upon an allegation of a bona fide intention to use such term in commerce. By an amendment to allege use, filed on January 23, 1998, the application was amended to claim dates of first use anywhere and in commerce of December 1996.

[2] Ser. No. 75/188,288, filed on October 28, 1996, based upon an allegation of a bona fide intention to use such term in commerce. By an amendment to allege use, filed on January 23, 1998, the application was amended to claim dates of first use anywhere and in commerce of December 1996.

specimens are unacceptable because they do not show use of the term "DesignObjects" as a service mark for the recited services.

Applicant, in each instance, has appealed. Briefs have been filed and an oral hearing was held. Because the issue of mere descriptiveness in each case is substantially the same, the appeals are being treated in a single opinion. We affirm the refusals to register.

Turning first to the refusals on the basis of mere descriptiveness, it is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection

with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of such use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

Applicant maintains that the term "DesignObjects" is at most suggestive rather than merely descriptive of its goods and services. Among other things, applicant insists that none of excerpts retrieved by the Examining Attorney from her search of the "LEXIS/NEXIS" database are relevant to or otherwise support her contention that, as characterized by applicant, "the word 'objects' is an independent program module written in object-oriented programming languages and that 'design objects' is a name given to these independent program modules." According to applicant, the Examining Attorney erroneously "then contends that Applicant is using its mark in connection with [both] software which contains pre-developed pre-defined program modules" and "computer programming and design services pertaining to the development use of [the same] design objects such that the term 'describes a significant attribute of the services.'"

Applicant further asserts that its "search of dictionary and other technical resources to determine the prevalence of usage of 'design objects'" either "found no entries for the phrase 'design objects'" or none which would be pertinent to either applicant's goods or its services. Noting, moreover, that "[t]he rule for determining whether a mark is merely descriptive is that the term must describe <u>with some particularity</u> a quality or ingredient of the product or service" (underlining in original), applicant submits that, due to the "variety of different meanings" for the constituent words "design" and "objects," the composite term "DesignObjects contains nothing which describes with particularity any of the features of" either its goods or its services. Lastly, applicant insists that even if the individual words which comprise the term "DesignObjects" were to be considered descriptive of its goods and services, it is nonetheless well settled that a combination of descriptive elements can result in a composite mark which, as is the case in each instance herein, is not merely descriptive as a whole. Thus, rather than infringe its mark, applicant urges that competitors "are perfectly free to use any of the other commonly available terms in the English language that they wish to suggest to consumers that computer programs, for example, can be used to 'design'

some plan or other structure, or that icons or the like that may appear on a display screen are 'objects.'"

The Examining Attorney, on the other hand, maintains that as shown by the evidence which she has made of record:

> "Objects" are independent program modules written in object-oriented programming languages. They are software components designed to work together at runtime. *See* http://www.techweb.com. .... "Design objects" are, in effect, software building blocks used by computer software programmers and designers.

The Examining Attorney, in light thereof, insists that the following excerpts in particular, taken from her search of the "LEXIS/NEXIS" database, "demonstrate descriptive use of 'design objects'" as a term "used to describe software components used in computer programming and design of computer programs" (**emphasis added**):

> "It also enables cycle-accurate simulation and employs object-oriented programming to reuse **design objects**." -- Electronic Design, October 4, 1999 (article headlined in part: "Looking For A Way To Make Hardware Design Easier Using C++");

> "These functions, known as access or ACC/acc routines, focused PLI attention to cover a variety of **design objects** while keeping the user interface as simple as possible" -- Electronic Design News, September 2, 1999 (article headlined: "A Verilog programming-language-interface primer; If you design in Verilog, using the HDL's programming-language-interface is valuable for invoking a C function from Verilog. This article provides the

> information you need to start writing useful PLI routines");
>
> "Naming Standards: Users can enforce naming standards for all **design objects** with the Naming Standards Specification Language." -- PR Newswire, March 23, 1999 (article headlined in part: "Sterling Software Releases Powerful Software Solution That Uniquely Combines Data Modeling and Database Design"); and
>
> "Teams can track and correlate defects and design-application notes with revisions and releases of **design objects**." -- Electronic Design, January 25, 1999 (article headlined: "Find Out If IC Data Management Is Right For You").

In addition, the following excerpt appears to be relevant (**emphasis added**):

> "[The] tool promotes a managed process of releasing designs for interim storage, and archiving released products for safekeeping . He said the release process seeks to create a read-only, self-contained **design object** comprising all CAD and library data referenced by the design, such as schematic symbols and geometries" -- Electronic Engineering Times, September 5, 1999 (article headlined: "Product development tools roll").

The Examining Attorney further points out that applicant's advertising brochure, which is of record in each of its applications, states among other things that:

> SICAN's DesignObjects™ give design teams a new alternative. Now it is possible to buy pre-developed, pre-defined soft cores to quickly integrate standards-based functionality required in a design.

The Examining Attorney also observes that, in the case of the specimens of use for applicant's trademark application, the language "STANDARD DESIGN OBJECTS" appears directly beneath the term "DESIGN OBJECTS," with such wording being used in connection with what is stated to be a "MPEG AUDIO DECODING ENGINE." According to the Examining Attorney, "[t]his is additional evidence that the software, in fact, embodies 'design objects.'"

In view of the above, the Examining Attorney maintains that because applicant's "'pre-developed, pre-defined soft cores' are 'design objects," the term "DesignObjects" is therefore merely descriptive of applicant's goods. Moreover, because applicant's "design services involve the use of design objects," the term "DesignObjects" therefore merely describes "a significant attribute of the services." The Examining Attorney also contends that, inasmuch as "design objects" has been shown to have "a specific meaning in the computer field," the fact that the individual words "design" and "objects" in the abstract "may have other shades of meaning is irrelevant."

With respect to applicant's remaining contentions, the Examining Attorney properly notes that the assertion by applicant that the "LEXIS/NEXIS" articles constitute infringing uses, and hence are without probative value, because "its use predates the use of the articles ... is equally irrelevant." As

the Examining Attorney, citing In re National Shooting Sports Foundation, Inc., 219 USPQ 1081, 1020 (TTAB 1983), correctly points out, the fact that applicant may be the first user of a merely descriptive term does not entitle it to registration thereof if the term projects only a merely descriptive significance. The Examining Attorney, citing In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987), is also correct in asserting that "[t]he fact that a term is not found in the dictionary is not controlling on the question of registrability." See, e.g., In re Orleans Wines, Ltd., 196 USPQ 516, 517 (TTAB 1977).

Before turning to a discussion of the merits of the issue of mere descriptiveness, we note from the "COMPANY PROFILE" set forth in applicant's advertising brochure that "SICAN ... is a microelectronics design and technology licensing company specializing in communications, multimedia and networking applications" so as "to meet the rapidly changing design needs of its customers"; that "SICAN began as an ASIC design house"; that "SICAN now focuses its design projects around the integration of its reusable core technology into customer-specific solutions to improve the quality of their designs as well as reduce their time to market"; and that applicant's "mission is to provide ... leading edge design solutions ...."

In particular, under the heading "SOFT CORES FOR SYSTEMS ON SILICON," applicant's brochure states with respect to the topic of "WHY USE DESIGNOBJECTS™" that:

> Purchasing ... technology as soft cores gives the design team the freedom to optimize the functionality that will set their design apart from its competition.
>
> DesignObjects™ from SICAN encompass a broad spectrum of technologies, including ... video and audio coding techniques, and broadband modem technologies. .... A detailed list and description of the DesignObjects™ can be obtained from SICAN's website.
>
> DesignObjects™ are not targeted to a specific technology, foundry or EDA tool. By maintaining core "softness", the power, size and performance can be optimized by the design team for the technology, foundry or tool of their choice.
>
> DesignObjects™ are delivered as an all-inclusive assembly of RTL source code, ... design specifications ... and application support. Some DesignObjects™ also include reference designs, application notes and behavioral models. By providing the most comprehensive documentation support available ..., SICAN realizes the knowledge transfer design teams need to successfully implement the cores.

Applicant's brochure also indicates that: "Licensing DesignObjects™ give the Design Team the Freedom to Optimize the Functionality that will set the Design Apart from its competition."

In addition, by way of further pertinent background, we judicially notice that Webster's New World Dictionary of Computer Terms (7th ed. 1999) at 372 defines "object" as meaning, "[i]n object-oriented programming, (OOP), a self-contained program module that contains the data as well as the procedures needed to make the data useful. By following established rules for communicating with the object, other programs can make use of it." Likewise, The Computer Glossary (9th ed. 2001) at 273 defines "object" as signifying "[a] self-contained module of data and its associated processing. Objects are the software building blocks of object technology." The same dictionary, at 273, also lists "object-oriented design" as "[t]ransforming an object-oriented model into the specifications required to create the system"; and, at 274, sets forth "object technology" as "[t]he use of objects as the building blocks for applications. Objects are independent program modules written in object-oriented programming languages. Just as hardware components are routinely designed as modules to plug into and work with each other, objects are software components designed to work together at runtime without any prior linking."

In the same vein, the excerpt made of record by the Examining Attorney from the on-line reference TechEncyclopedia discusses "object technology" in relevant part as:

> The use of objects as the building blocks for applications. Objects are independent program modules written in object-oriented programming languages. Just as hardware components are routinely designed as modules to plug into and work with each other, objects are software components designed to work together at runtime without any prior linking or precompilation as a group.
>
> The ultimate goal of objects is that it should not matter which source language they were programmed in or which computer on the network they are running in. They are designed to interoperate strictly through the messages passed between them.
>
> Objects as building blocks are an evolutionary architecture, being a more formalized approach to modular programming, which has been around for years. What is revolutionary about objects is that they provide a new way of modeling applications, and this is expected to have a significant impact on application development. With objects, a system can be designed as familiar business functions, and the design can be carried all the way down to the programming level. ....

Upon careful consideration of all of the above evidence and arguments, we agree with the Examining Attorney that, when used in connection with applicant's goods and services, the term "DesignObjects" immediately describes, without conjecture or speculation, both significant information concerning the purpose, function or use of applicant's goods, namely, that they are objects, in the sense that such word is utilized in object-oriented programming, which are used in the

design of software applications, and a significant attribute of applicant's services, which involve the design of such design objects. Plainly, when viewed in the context of applicant's goods and services, rather than in the abstract as applicant essentially urges, there is nothing in the term "DesignObjects" which, to the software engineers, computer programmers and other members of application design teams who would purchase and/or utilize such goods and services, would be ambiguous, incongruous or otherwise require the need for the exercise of any imagination, cogitation or mental processing or the gathering of further information in order to readily perceive the merely descriptive significance of the term.

Specifically, applicant's computer programs for the recording, processing, transmission or reproduction of sound or images; its data processing equipment, namely, audio decoders; its semiconductors; its data processing computer programs; and its computer program library modules for digital signal processing, digital image processing and broad band communication are all design objects in that they are objects, in the technical sense of software building blocks or modular program components which are utilized in whatever application design is being developed or modeled. Whether such goods, as referred to on the specimens in applicant's trademark application, are regarded as "STANDARD DESIGN OBJECTS" or are

customized or specialized design objects produced by applicant's computer software design services, its modular programs are products which have the functionality of being able to interface or operate with other such goods so as to create a new software application design. Applicant's goods, in short, are objects, namely, self-contained, pre-developed and pre-defined program modules which are used by its customers as design building blocks for software applications and, thus, are merely described by the term "DesignObjects." Such term likewise merely describes a significant aspect of applicant's "computer software design services, namely designing computer program library modules; [and] design of electronic devices for use in conjunction with computer program library modules," since it forthwith conveys information as to the nature of the products the services produce. See, e.g., In re Wickerware, Inc., 227 USPQ 970, 971 (TTAB 1985) ["WICKERWARE" for "mail order and distributorship services in the field of wicker furniture and accessories" designates "a central characteristic of appellant's services" and thus is not registrable].

Turning now to the refusal on the ground that, in the case of applicant's service mark application, the specimens are unacceptable because they do not show use of the term "DesignObjects" as a service mark for the recited services, applicant notes that the second page of the advertising

brochures which it furnished as specimens specifically references the following as "Design Services": "High Complexity High Speed Digital Design"; "Mixed Signal Design"; "A/D and D/A Converters and Filters"; "Smart Power Design"; and "High Speed Digital Communications Design." In view thereof, applicant contends that the specimens evidence service mark usage of the term "DesignObjects" in connection with the services recited in the subject application, notwithstanding the fact that such specimens admittedly also "refer to 'soft cores' for use by a consumer."

We concur with the Examining Attorney, however, that while the specimens of record indicate that applicant is providing various design services, the term "DesignObjects" is not used as a mark to identify such services. In particular, the advertising brochures, which on the first page thereof are entitled "DESIGNOBJECTS™ at SICAN" and solely refer to "SOFT CORES FOR SYSTEMS ON SILICON," utilize the term "DesignObjects" to identify applicant's goods, which are the software components which can be purchased by its customers' design teams or licensed for use in their design projects. The specific reference to applicant's "Design Services" and the list of such services on page 2 of the brochures appear as part of applicant's "COMPANY PROFILE" and are prefaced, under the heading "TECHNOLOGY LINE-UP," by the language "[a]s a natural

expansion of its experience with integrated circuits and systems design, SICAN offers independently developed core technology and know-how in the following technology fields:"; there is, however, no reference or other association of the term "DesignObjects" with such services. Instead, the term "DesignObjects" is discussed only on page 3 of the brochures, which like page one thereof contains the heading "SOFT CORES FOR SYSTEMS ON SILICON." Plainly, as used in applicant's brochures, the term "DesignObjects" refers to applicant's goods, the various types of which are set forth on pages four through seven, and not to any of applicant's services. Accordingly, such specimens fail to evidence service mark use of the term "DesignObjects." See, e.g., In re Walker Research, Inc., 228 USPQ 691, 692 (TTAB 1986) [specimens failed to evidence service mark use since, while such reflected that applicant was rendering the services which were recited in the application, the mark "SegMentor" as used in the specimens identified and distinguished the software or computer program used in the performance of the services and not the services themselves]; and In re Information Builders Inc., 213 USPQ 593 (TTAB 1982) [specimens failed to evidence service mark use of mark "FIDEL" inasmuch as demonstrated use thereof only to refer to a computer program].

Decision: The refusals under Section 2(e)(1) and under Sections 1(a)(1) and 45 are affirmed.