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Paper No. 16
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re JVC Americas Corp.

Serial No. 75/474,474

Morton Amster of Amster, Rothstein & Ebenstein for JVC Americas Corp.

Gary R. Thayer, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Cissel, Chapman and Wendel, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

JVC Americas Corp. has filed an application to register on the Principal Register the mark shown below

for "automatic set-up feature of video cassette recorder which provides automatic clock setting and automatic channel setting and scanning" in International Class 9.¹

¹ Application Serial No. 75/474,474, filed April 27, 1998, based on applicant's claimed first use and first use in commerce date of January 1997.

Registration has been refused under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a) on the basis of applicant's failure to comply with a requirement to disclaim the words "PLUG & PLAY." Such words, according to the Examining Attorney, are merely descriptive of applicant's goods within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), and therefore must be disclaimed.

When the refusal to register was made final, applicant appealed to this Board. Both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

Applicant contends that the word portion of its mark is suggestive of the goods as it does not immediately convey an idea about the automatic set-up feature for VCRs which provides automatic clock setting and automatic channel setting and scanning; that the words "plug & play" could suggest any number of other goods and features of other goods, as shown by the Examining Attorney's evidence relating to computers; that several of the articles retrieved from the Nexis database refer to applicant's products when discussing the "Plug & Play" feature; that the limited number of Nexis articles including allegedly descriptive uses of the phrase "plug and play" is an

insufficient basis to conclude that the phrase is widely understood as descriptive; that the word portion of the mark together with the plug and cord design create a unitary expression thus negating the need for a disclaimer; that "under the doctrine of fair use, third parties will still be able to use the elements PLUG and PLAY in connection with VCRs. See 15 U.S.C. § 33(b)(4)...)" (Supplemental Brief, p. 3); and that any doubt on the issue of descriptiveness resulting in a disclaimer should be resolved in favor of applicant.

It is the Examining Attorney's position that "plug & play" (or "plug and play") "is a common phrase used in the computer and home electronics field to refer to an automatic set-up feature of an electronic product such as a home computer or a VCR" (brief, p. 3); that in a VCR containing such a capability, the correct clock and timer-recording settings, available channel settings and the like, can be automatically set up merely by plugging in the unit; that when such a VCR unit is "plugged" in, it is ready to "play" because it has a capability or feature known as "plug and play"; that when the mark is viewed in its entirety, the phrase "plug & play" is an unregistrable component of applicant's composite mark; and that the words

"plug & play" are not so integrated into the design that they need not be disclaimed.

As evidence in support of his position, the Examining Attorney submitted, inter alia, a definition of "plug and play" from the techweb.com online encyclopedia, and several excerpted stories from the Nexis database.

The techweb.com online encyclopedia defines "plug and play" as follows (underlining in original):

1. The ability to add a new component and have it work without having to perform any technical analysis or procedure. 2. (Plug and Play) Also known as PnP, it is an Intel standard for the design of PC expansion boards. Plug and Play is supported directly in Windows 95/98. It eliminates the frustration of configuring the system when adding new peripherals. ...

While the second definition relates to computers, there is no such limitation to the meaning given in the first definition. In addition, the following examples (emphasis added) of the excerpted Nexis stories specifically relate "plug and play" to VCRs:

Headline: VIDEOCASSETTE RECORDERS.
TEST. How to buy a VCR (Expect good picture quality. But some useful features aren't widespread.); which features do you need?
...In our tests, some models drew low standby power.
Movie advance. Enables viewers of video movies to skip through the previews and get quickly to the feature

film. It's not common; in our tests, only 1 and 10 had this feature.

Plug and play. Does away with setup preliminaries. Automatically sets the clock and channels when the VCR is attached to a cable or antenna and plugged in. Not common; found on 8 and 14 in our tests.

Universal remote control. Controls not only the VCR, but also cable boxes and TV sets of a large number of brands..., "Consumer Reports," November 1998;

Headline: VCRs learn new tricks; While the cost of VCRs continues to fall, the machines keep getting smarter and adding features

...If you're drawn to special features, you can find VCRs that will: ...

*Movie advance: It skips through the movie trailers at the beginning of a video and returns to regular play when the real movie begins.

***Plug and play:** Need to setup your new VCR? Just connect the antenna and plug in the VCR. Everything from setting the clock to recording the available channels is registered automatically.

*SmartFile: Can't remember which show you recorded on which tape? Sony VCRs with SmartFile register programming information on a small chip embedded in special labels. Just...it displays the information on-screen. The chips can be rewritten up to 100,000 times. SmartFile is available on the 450 SLV-M10HF model released this month.

*SpeakEZ voice prompts: Available on all Zeniths, this feature talks you through VCR setup and programming..., "The Des Moines Register," June 23, 1998;

Headline: Programming the VCR gets easier

...If you're drawn to special features, you can find VCRs that will:

...

***Plug and play:** Need to setup your new VCR? Connect the antenna, plug in the VCR, and consider it done, with this handy feature. Everything from setting the clock to recording the available channels is registered automatically. Various manufacturers may call this feature by different names, such as easy setup or smart setup.
..., "The Detroit News," June 19, 1998;

Headline: New Mac Blazes Technology Trails

...the Quadra 840AV also has four video I/O ports: in and out ports for both composite video and S-video. With the right software, video capture to a QuickTime movie is practically **plug-and-play**. I connected a portable VCR's output to the Mac's composite video input, fired up a video-capture application from VideoFusion (a demo version of the program comes bundled with the Mac), watched the incoming live video in a ..., "Byte," January 1994;

Headline: Video machine: True Desktop Video

...VM can drive the VCRs using Control-L/Control-S or five-pin Syncro Edit control protocols. ... A significant plus for VM is its two on-board frame synchronizers, which function as TBCs (timebase correctors). As owners of NewTek's Toaster discovered, the toaster is not **plug-and-play** unless you plug in the TBCs, too...., "Byte," September 1993; and

Headline: VIDEO PLAYERS. TEST. Getting the picture (A guide to your options for playback, taping, and programmed recording.); Which features do you need?

...
Helpful VCR features

Plug and play. You connect the VCR to the cable system or an antenna, then plug it in. It reads signals from broadcasters to automatically program the channels and the clock. Auto clock set. A VCR with this feature can read broadcast signals to automatically set the time and date. No more blinking "12:00."

VCR features for programming and editing
Cable-channel changer. ...
Power backup. ...
VCR plus. ...
Search. ...
Auto speed-switching. ...
Editing features. ...
Front audio-video jacks. ...

Features at a glance

VCRs

Key no.

Plug and play

..., "Consumer Reports," December 1999.

The test for determining whether a mark is merely descriptive under Section 2(e)(1) of the Trademark Act is whether the term or phrase immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Associates*, 226 USPQ 285 (TTAB 1985); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). The determination of mere descriptiveness must be made in relation to the goods or services for which registration is

sought, the context in which the term or phrase is being used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991). That is, the question is not whether someone presented with only the mark could guess what the goods or services are.

Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

The Examining Attorney has established a prima facie case that the phrase "plug & play" is merely descriptive of applicant's goods, "automatic set-up feature of video cassette recorder which provides automatic clock setting and automatic channel setting and scanning." The above quoted Nexis stories clearly establish that "plug and play"² will immediately be understood by purchasers and prospective purchasers for its common meaning which is that the VCR has a "plug and play" feature or capability.

² We find no distinction between "plug and play" and "plug & play."

Several of the stories specifically refer to automatic clock setting and automatic channel setting for VCRs, and applicant's goods are precisely that automatic set-up feature for VCRs.

Applicant's argument that the stories relating to computers do not establish the meaning with regard to VCRs may have merit. However, there is sufficient evidence specifically relating "plug & play" to VCRs to establish the descriptive meaning with relation thereto.

While applicant argues that some of the excerpted stories from the Nexis database refer to applicant's products, applicant did not cite to any specific excerpted story referring to applicant's products. In fact, several of the stories refer to certain VCR features in relation to a particular manufacturer (e.g., SmartFile on Sony VCRs, SpeakEZ voice prompts on Zenith VCRs), but there is no such reference to applicant with regard to the "plug and play" feature. In addition, some of the Nexis stories refer to "plug and play" in a general descriptive sense. We find the phrase "plug & play" is merely descriptive of applicant's identified goods.

Next, we must determine whether the words and design form a unitary mark negating the need for a disclaimer. In order to decide that question, we must consider whether the

mark as a whole creates a commercial impression separate and apart from any unregistrable component. See TMEP §1213.06. In this case, we agree with the Examining Attorney that the design feature is not so integrated with the words as to be unitary. The mark, as displayed on the specimens of record, (photographs on which the relevant wording is somewhat difficult to read), would be perceived by purchasers as essentially the terms "plug & play," in the descriptive context established in this case. That is, the depiction of a plug and a cord does not negate the descriptive significance of the words "plug & play" as applied to automatic clock and channel setting set-up features for VCRs. The slightly elongated line coming down from the ampersand appears to be merely a fanciful ampersand font. The plug design on the tail of the "Y" in the word "PLAY" is also not of such significance that the composite mark creates a commercial impression that is wholly separate and distinct from the words "plug & play." Inasmuch as the visual presentation of the mark does not form a unitary whole, the phrase "plug & play" must be disclaimed. See *Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991); *In re Lean Line, Inc.*, 229 USPQ 781 (TTAB 1986); *In re IBP, Inc.*, 228 USPQ 304 (TTAB 1985); and *In re Truckwriters Inc.*, 219

USPQ 1227 (TTAB 1983), aff'd unpubl'd Appeal No. 84-689 (Fed. Cir., November 1, 1984). Cf. *In re Texsun Tire and Battery Stores, Inc.*, 229 USPQ 227 (TTAB 1986).

Finally, applicant's argument that third parties would still be able to use the words "plug" and "play" is of little merit. There is sufficient evidence of record to show that purchasers will understand "plug & play" to refer to a certain set-up feature of a VCR, namely, one which automatically sets the clock and the channel settings. That is, the phrase unquestionably projects a merely descriptive connotation, and we believe competitors would have a competitive need to use this phrase, not the words separately as argued by applicant. See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:18 (4th ed. 2000).

Decision: The requirement under Section 6 for a disclaimer of the words "plug & play" is proper. In the absence of a disclaimer of "plug & play," the refusal to register is affirmed. If a disclaimer is entered within thirty days from the mailing date hereof, this decision will be vacated and the mark will then be published for opposition. See Trademark Rule 2.142(g).