

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

August 30, 2002
Paper No. 16

GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Institute of Electrical and Electronics Engineers, Inc.

Serial No. 75/437,901

Sandra Edelman of Dorsey & Whitney LLP for Institute of
Electrical and Electronics Engineers, Inc.

Dominic J. Ferraiuolo, Trademark Examining Attorney, Law Office
102 (Thomas V. Shaw, Managing Attorney).

Before Seeherman, Hohein and Hairston, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Institute of Electrical and Electronics Engineers,
Inc., doing business as IEEE, has filed an application to
register the term "1394" for a "publication, namely, standard
for a high performance serial bus."¹

Registration has been finally refused on several
grounds. First, that under Sections 1, 2 and 45 of the
Trademark Act, 15 U.S.C. §§1051, 1052 and 1127, the term "1394"

¹ Ser. No. 75/437,901, filed on February 20, 1998, which alleges a date
of first use anywhere of December 31, 1991 and a date of first use in
commerce of December 31, 1995.

"merely identifies a designated industry standard, as used on the specimen of record," and that, "as [so] used, [it] would not be perceived as a trademark."² Second, that under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), the term "1394" is merely descriptive, when used in connection with applicant's product, "of the subject matter contained in and addressed by the applicant's ... serial bus standard."³ Third, and lastly, that under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), "[t]he drawing displays the mark as 1394," but because "this differs from the display of the mark on the specimen, where it appears as IEEE Std 1394-1995," applicant must "submit a substitute specimen that shows use of the mark shown in the drawing" and "verify, with an affidavit or declaration ..., that the substitute specimen was in use in commerce at least as early as the filing date of the application."⁴

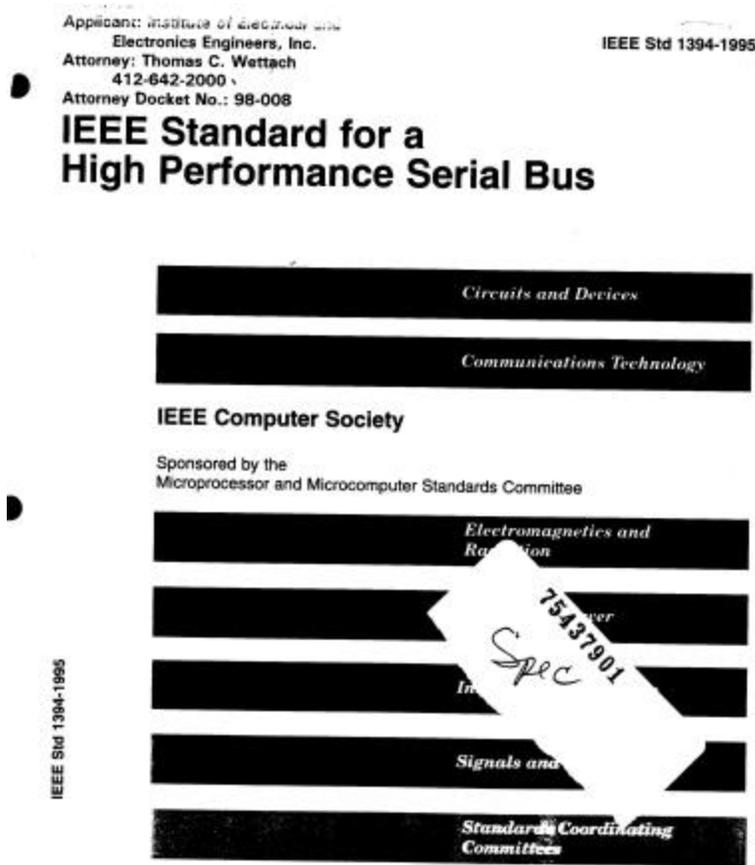
² Such refusal is alternatively expressed by the Examining Attorney as a failure of such term to function as a trademark for applicant's product.

³ Although not so indicated in either the final refusal or any prior Office Action, the Examining Attorney asserts in his brief that the mere descriptiveness refusal "is made in the alternative should this Board not agree with the above determination by the trademark-examining attorney" regarding the refusal on the ground of failure of the term "1394" to function as a mark as used on the specimen.

⁴ While the final refusal also required that applicant, in the alternative, must "submit a new drawing of the mark that agrees with the specimen," such refusal nevertheless further indicated that "applicant may not amend the drawing if the amendment would materially alter the character of the mark." Inasmuch as it is obvious, however, that addition of the term "IEEE" to the term "1394" materially alters the character of the latter (see, e.g., In re Vienna Sausage Mfg. Co.,

Applicant has appealed. Briefs have been filed, but an oral hearing was not held.⁵ We affirm the mere descriptiveness refusal, but reverse the other refusals to register.

Turning to the first ground of refusal, the specimen of record shows the following manner of use of the term "1394":



16 USPQ2d 2044, USPQ2d 1882, 18 Life-Code System the Examining Applicant "has consequently is silent with respect to the alternative requirement made in the final refusal, no further consideration will be given thereto.

⁵ Although applicant timely requested an oral hearing, it subsequently withdrew such request.

Inc., 6 v. since n that

Applicant, noting in its initial brief that the product in connection with which it uses the term "1394" is "a specific technical publication distributed by Applicant that contains a standard for a high performance serial bus," argues that:

The primary question in determining whether a mark functions as a trademark is "whether the designation in question, as used, will be recognized in and of itself as an indication of origin for the particular product." Procter & Gamble Co. v. Keystone Automotive Warehouse, Inc., 191 USPQ 468, 474 (TTAB 1976). In this case, Applicant's mark (the number "1394") meets this test since it has been used in interstate commerce to identify Applicant's goods, i.e., its technical publication containing a standard for a high performance serial bus.

By way of background, applicant further asserts in its initial brief that:⁶

⁶ Applicant additionally contends therein that:

Significant to note is that Applicant has received a trademark registration for a solely numeric designation of another standard it publishes, i.e., the mark "802" for "[p]ublications, namely, pamphlets of standards and specifications for local and metropolitan area networks." (See U.S. Trademark Registration No. 2,342,235 for IEEE Standard No. 802.) Since the test for trademark protection has already been met by such a numeric designation under similar circumstances, it is also met in this case.

We observe, however, that applicant never made of record a copy of the file history for such registration and, thus, there is no basis for a comparison of the determination of registrability therein with the factual situation presented by this appeal. Moreover, even if such evidentiary information had been provided, it is settled that each case must be determined on its own merits. See, e.g., In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to [applicant's] application, the ... allowance of such prior registrations does not bind the Board or this court."]; In re Broyhill

Applicant is the world's largest technical professional society with members spanning the globe. Applicant is known in the industry to publish nearly 30% of the world's literature in the electrical, electronics and computer engineering and science fields. Applicant's publications are the most cited publications in its field, and Applicant's standards are a recognized leader in the development of global standards in electrical and computer engineering.

Applicant publishes an annual catalog identifying the Mark with the subject matter of the publication it designates, and Applicant also displays the Mark on its website as an identifier of this publication. Thus, the Mark meets the test of being recognized in and of itself as an indication of origin for the product it designates--in this case, Applicant's publication for a high performance serial bus standard.

However, as the Examining Attorney accurately points out in his brief, applicant "did not provide any documentation, exhibits, [printed] information or other evidence in support of its arguments." Noting, furthermore, that "Section 45 of the Trademark Act ... defines a 'trademark' as a 'word, name, symbol, or device, or any combination thereof that is used ... in commerce to *identify and distinguish his or her goods* (emphasis added)" and that, "[b]efore rights in a term as a trademark can be established, the subject matter to which the

Furniture Industries Inc., 60 USPQ2d 1511, 1514 (TTAB 2001); and In re Pennzoil Products Co., 20 USQP2d 1753, 1758 (TTAB 1991).

term is applied must be 'goods in trade,'" the Examining Attorney maintains that:

The proposed numerical designation "1394" is identified in the record as a publication, namely a "standard." A "standard" is a type of publication or report in the field of electrical engineering that consists of a body of information agreed upon by the Applicant, The Institute of Electrical and Electronic[s] Engineers, Inc., (IEEE), [which is] disseminated and designated for use by others in the particular relevant and related fields. The purposes of the standard include, for example, providing for uniformity of or for a particular application or device in the field of electrical engineering. In this case, the "1394" standard is an external bus standard that embodies and supports particular transfer protocols and transfer rates of speed. Its application is typically for external buses on personal computers.

According to the Examining Attorney, such "information is supported by ... [a] definition [he] made of record" of the term "IEEE 1394" from the "Webopedia," which touts itself as "[t]he #1 online encyclopedia dedicated to computer technology," and by "56 Nexis stories [he] made of record," which include reference to the term "1394." The former defines "IEEE 1394" as follows (underlining and italics in original):

A new, very fast external bus standard that supports data transfer rates of up to 400 Mbps (400 million bits per second). Products supporting the 1394 standard go under different names, depending on the company. Apple, which originally developed the technology, uses the trademarked name

FireWire. Other companies use other names, such as *I-link* and *Lynx*, to describe their 1394 products.

A single 1394 port can be used to connect up to 63 devices. In addition to its high speed, 1394 also supports isochronous data--delivering data at a guaranteed rate. This makes it ideal for devices that need to transfer high levels of data in real-time, such as video devices.

Although extremely fast and flexible, 1394 is also expensive. Like USB, 1394 supports both Plug-and-Play and hot-plugging, and also provides power to peripheral devices. The main difference between 1394 and USB is that 1394 supports faster data transfer rates and is more expensive. For this reason, it is expected to be used mostly for devices that require large throughputs, such as video cameras, whereas USB will be used to connect most other peripheral devices.

Representative examples of the relevant "NEXIS" excerpts are set forth below (**emphasis added**):⁷

"[A]nother new device, the PowerFile C200 from Escient Digital Storage Group, provides more than one terabyte of digital storage space Billed as the 'world's

⁷ Because 34 of the 56 excerpts made of record by the Examining Attorney are from the wire services "Business Wire" and "PR Newswire," they are of limited probative value inasmuch as there is no evidence that the stories set forth therein have appeared in publications of general circulation in the United States. It therefore cannot be assumed that the excerpts therefrom have had any material impact on consumer perception or attitude as to the meaning of the term "1394." See, e.g., *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1555 (TTAB 1987) at n. 6 and *In re Men's Int'l Professional Tennis Council*, 1 USPQ2d 1917, 1918-19 (TTAB 1986). Moreover, of the remaining 22 excerpts, many are duplicative in content and thus their probative value, in terms of the range of publications in which stories referring to the term "1394" have appeared, is limited.

first IEEE-**1394** based CD/DVD changer,' the C200 runs on Windows 98

The IEEE **1394** serial bus provides a non-proprietary high-speed method of interconnecting digital devices." -- National Underwriter; December 13, 1999;

"Cirrus Logic announced an agreement to license IEEE **1394** serial bus firmware from Digital Harmony Technologies for system-on-chip designs" -- TechWeb News, September 27, 1999;

"The Model 2345 delivers full VME memory and control from any host equipped with an IEEE **1394** serial bus port." -- Albuquerque Tribune, August 2, 1999;

Skipstone Inc. ... developed the first-ever products for a digital interface known as **1394** serial bus and used to connect computers with telephones, radios or videocassette recorders." -- Austin Business Journal, April 4, 1997;

"With Pentium II, Intel will offer a new level [of] performance augmented by systems sporting an advanced graphics port, high-performance **1394** serial bus, and Synchronous DRAM" -- TechWire, March 24, 1997;

"Texas Instruments Inc. intends to provide the building blocks for a new generation of technology with a series of controllers that better implements the 32-bit PC Card and the **1394** serial bus specifications." -- InfoWorld, October 28, 1996;

"It also means supporting new, high-speed external buses such as Universal Serial Bus and the International Electrical and Electronics Engineers' **1394** serial bus standard." -- InternetWeek, April 1, 1996; and

"Apple wants to showcase its own implementation of the **1394** serial bus, called FireWire, and doesn't want Microsoft to get all the credit." -- InfoWorld, March 11, 1996.

Based on the above evidence, the Examining Attorney maintains that:

[T]he company Apple uses the trademark "Firewire" to identify the external bus on its computers that conform to the 1394 standard. Other companies use their own trademarks as well to identify the external buses on their computers that comply with this standard. Generally, the use of such standards allows a certain necessary uniformity that, for example, all manufacturers of personal computers comply with in order for end users and computer network service providers to freely and efficiently communicate with each other. Without such standards ... it would be nearly impossible for users of computers manufactured by different companies to transmit and receive data with each other.

In the instant application the Applicant does not show use of "1394" as a trademark. It is shown in the record used and provided by the [A]pplicant as a published standard for others to use. It does not identify a single source of goods in commerce but rather its use [is] in the goods and/or services provided by sources other than the Applicant that comply with this agreed upon external bus standard. The record establishes and the Applicant does not provide any evidence to the contrary that this standard is solely provided for use by others as an electrical engineering standard for use in the manufacture of goods and provision of services by others.

The record as a whole does not show that the Applicant uses the proposed mark on

its own goods in trade. Rather, the record as a whole establishes that the Applicant only publishes a standard or report that provides the technical specifications of the standard for use by others to provide goods and/or services that conform, comply, meet and fulfill this standard for the purposes of industry.

We disagree with the Examining Attorney, however, that the specimen does not evidence use of the term "1394" in the manner of a mark in connection with applicant's product. As persuasively pointed out in its reply brief, applicant's product is its published standard, which the specimen shows is designated by the term "1394" and is entitled "IEEE Standard for a High Performance Serial Bus" (bold in original):

The specimen of record shows that Appellant uses the **1394** mark on and in connection with the goods identified in the application, i.e., a "publication, namely, standard for a high performance serial bus." Indeed, the specimen is the cover page of the publication. Thus, contrary to the Examining Attorney's argument that Appellant does not use the proposed mark on its own goods in trade, the standard publication is the good in trade and the mark is used on the good.

The Examining Attorney also points out, correctly, that others in the industry use or refer to the **1394** standard in connection with the sale of their goods to indicate that their goods or services conform to the standard. But this third[-]party use does not render Appellant's use on the standard a non-trademark use. These are downstream users who have purchased Appellant's standard publication product for use in the manufacture of their goods, and these users

are indicating to the consuming public the application of the **1394** standard in the manufacture of their goods.

This downstream use is analogous to a manufacturer who purchases a third party's trademarked ingredient or component of a product and then labels that product as made with or containing that ingredient or component. As the McCarthy treatise explains, a product may "have multiple marks owned by different firms Such multiple marking is entirely appropriate so long as the separate identifying function of both marks is apparent to the customer, either explicitly or implicitly." McCarthy on Trademarks and Unfair Competition § 7:8 (4th ed. 2002) (citing, e.g., Safe-T Pacific Co. v. Nabisco, Inc., 204 U.S.P.Q. 307 (T.T.A.B. [1979]); Yard-Man, Inc. v. Getz Exterminators, Inc., 157 U.S.P.Q. 100 (T.T.A.B. 1968)).

Accordingly, that manufacturers and other users of applicant's publication for its "1394" standard may label or promote their goods or services as conforming to such standard does not, per se, make applicant's use of the term "1394" on its publication a non-trademark use or otherwise mean, in the absence of the term's being merely descriptive, that it fails to function as a mark for applicant's standard for a high performance serial bus.

Turning next, therefore, to the refusal on the ground 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 argues that the term "1394" does not describe any purpose, function, characteristic or feature of its standard for a high performance serial bus. In particular, as

stated in its initial brief, applicant asserts that (bold in original):

The Mark is not a general term describing all standards published by the Applicant, but instead identifies a unique standard for a high performance serial bus. Moreover, the Mark describes no quality or function of the publication. Use of the Mark "**1394**" refers to a specific standard published by Applicant in much the same way that the registered trademark "**KLEENEX**"® refers to a specific brand of facial tissue. Thus, rejection of the Mark "**1394**" for descriptiveness would be analogous to rejection of the Mark "**KLEENEX**"® as merely descriptive of all brands of facial tissue, which would clearly be improper.

In addition, as set forth in its reply brief, applicant contends that (bold in original):

Here ... **1394** does not have any descriptive significance when used in connection with a high performance serial bus standard. The designation **1394** is arbitrary, and the Examining Attorney does not offer any evidence that the mark is descriptive of any aspect of the goods. The Examining Attorney does refer to an explanation [from "Webopedia"] of the **1394** standard made of record ... and the Nexis stories made of record ..., but these references almost uniformly point to Appellant IEEE as the source of the standard and in no way support any nexus between the numerical **1394** trademark and the nature, quality or any other aspect of the high performance serial bus standard Under the circumstances, the Examining Attorney has failed to establish that the **1394** mark has any descriptive significance.

The Examining Attorney, on the other hand, maintains in light of the previously noted evidence of record that "[t]he proposed numerical designation '1394' merely describes the subject matter of the identified goods" in that it generically designates a "particular industrial standard." Specifically, he insists that such evidence "establishes *prima facie* that the numerical designation '1394' identifies the subject matter of ... a standard for a high performance serial bus known widely throughout the relevant fields and industries as 'IEEE Standard 1394' and '1394', in reference to the IEEE Standard."

We agree with the Examining Attorney. Contrary to applicant's arguments, the record establishes that the only name by which applicant's publication of a standard for a high performance serial bus is known is "1394." While such term--on this limited record--does not in and of itself appear to describe any significant ingredient, quality, characteristic, feature, function, purpose or use of applicant's goods, it is the sole designation for (other than the acronym or abbreviation "IEEE," by which applicant is often referred), and thus serves to generically name, applicant's standard for a high performance serial bus. As such, the term "1394" merely describes the subject matter of applicant's publication. Consequently, unlike applicant's example of the mark "KLEENEX" for a brand of facial tissue, or the terms "FireWire" or "IEEE" for a brand of high

performance serial bus which conforms to applicant's published standard, the record herein contains clear evidence which shows that the only term which those in the industries or fields served by applicant's publication utilize to designate the particular standard for a high performance serial bus is "1394." Applicant, we further note, has offered no evidence to rebut the Examining Attorney's *prima facie* showing.

Turning to the third and last ground for refusal, applicant asserts in its initial brief that, rather than the designation "IEEE Std 1394-1995" (as shown on the specimen of record) being its mark, as claimed by the Examining Attorney, "[t]he wording 'IEEE Std' simply indicates what '1394' already identifies--that '1394' is an IEEE standard." According to applicant, "[t]he number '1995' is the year of the standard, which will change to reflect the year of any update(s)." Applicant consequently insists that (bold in original) "[t]he number '**1394**' is thus the only trademark within this display, and therefore, the only trademark to be shown in the drawing," so that a verified substitute specimen is not required.

The Examining Attorney, however, urges that the specimen of record does not illustrate use of the term "1394" as a mark for applicant's product. Specifically, the Examining Attorney contends that:

The Applicant's specimen of record consists of the cover or front page of a publication titled "IEEE Standard for a High Performance Serial Bus." This type of publication is known in the relevant industries and trades as a standard. It shows use of the proposed mark as part of a phrase, namely "IEEE Std 1394-1995." The applicant explains in the record that the "-1995" portion identifies a year. However, the focus of this requirement for an acceptable specimen is that the proposed numerical designation "1394" does not appear on the specimen of record in and of itself as a trademark. It appears only as a non-separable part of the wording "IEEE Std 1394." The numerical designation "1394" does not appear anywhere else on the specimen of record. It is highly unlikely that users of the goods will perceive "1394" separate and apart from the wording "IEEE Std 1394" as a trademark for the identified goods based upon this specimen.

The specimen of record does not show unique, separate or distinct use of the numerical designation "1394" but only shows it used as part of the wording "IEEE Std 1394." Therefore, the specimen in question does not show trademark use of "1394" on the identified goods and the ... refusal to register on the grounds that the Applicant has not provided an acceptable specimen of use in the record should be upheld.

Assuming, for purposes of this ground of refusal, that the term "1394" is not merely descriptive of applicant's product and thus could function as a mark therefor if so used, we concur with applicant that, given both the nature of its product and the sophistication of the purchasers and users thereof, the term "1394" as used on the specimen of record would be regarded as a

mark for applicant's publication, namely, a standard for a high performance bus, even though such term appears as part of the phrase "IEEE Std 1394-1995." The Examining Attorney, we note, appears to accept applicant's argument that in such phrase, the element "-1995" would be regarded as the year of issuance of applicant's standard and, therefore, is of no trademark significance. Specifically, as reiterated in its reply brief, applicant asserts that:

[T]he designation "1995" denotes the year of Appellant's standard, and would be viewed as distinct from the mark itself. Appellant would not want to register the year as part of the mark, since the year could be subject to change. See TMEP [Section] 1214 (noting that marks incorporating a date (usually a year) should not be included in registered marks as "phantom" elements).

The Examining Attorney, however, simply maintains that, as previously indicated, "the focus of this requirement for an acceptable specimen is that the proposed numerical designation '1394' does not appear on the specimen of record in and of itself as a trademark" and, thus (emphasis added): *"It is highly unlikely that users of the goods will perceive '1394' separate and apart from the wording 'IEEE Std 1394' as a trademark for the identified goods based upon this specimen."*

Contrary to the Examining Attorney's position, we find persuasive applicant's argument, as more extensively set forth in its reply brief, that as shown in the specimen of record the

term "1394" independently functions as a mark for applicant's product (bold in original)"

[W]hen evaluating the nature of Appellant's use of the **1394** mark on the standard publication, it is important to keep in mind that this is not a conventional consumer brand used on a household product; rather it is a technical publication used by a specialized category of professionals. Thus, the Board should not judge Appellant's use of the **1394** mark as if the mark were **COCA-COLA** on a soda bottle or **CLAIROL** on a hair care product. It won't appear in fancy type or in an interesting graphic display to entice consumers.

[T]he designation **1394** will be viewed by the professional audience that uses this standard as the trademark identifying the standard. Indeed, contrary to the Examining Attorney's argument ...[,] the Nexis stories made of record by the Examining Attorney ... demonstrate that the relevant audience in fact identifies the high performance serial bus standard by the trademark **1394**, emanating from Appellant IEEE.

....

Here, the designation "IEEE" is Appellant's house mark, and it is entirely appropriate to use it in connection with the **1394** mark It is also entirely appropriate for Appellant to use the designation "Std" next to the mark **1394** since that is the generic term which the mark identifies

Thus, Appellant's specimen of record properly shows a house mark (IEEE), a generic descriptor (Std), the mark applied for (**1394**) and the year (1995). While the entire designation "IEEE Std 1394-1995" may not look like the typical or conventional brand identification on a consumer product,

given the nature of the product at issue, a technical standard, the mark's use on the specimen is proper trademark use.

In essence, this case is analogous to *In re Raychem Corp.*, 12 USPQ2d 1399 (TTAB 1989), in which registration of the term "TINEL-LOCK" for "metal rings for attaching a cable shield to an adapter" was sought based upon specimens showing the following manner of use of such term in context:

DESC.	DATE.
TR06AI-TINEL-LOCK-RING	07/22/87
PCN 546679 MOD()	QTY.1
LOT#	DEPT.6246

Although the Examining Attorney in such case required new specimens because the mark sought to be registered did not agree with the asserted mark "TR06AI-TINEL-LOCK-RING" used on the specimens, the Board reversed such requirement, reasoning that:

The generic name of the product is plainly "RING." Both applicant and the Examining Attorney use this word as the name for applicant's goods. Ordinarily, even if it is used with a trademark, the generic name of a product need not be included as part of the words applicant seeks to register unless it forms part of a unitary mark. The issue, therefore, is whether the combination of the trademark (source-identifying) matter and the generic term form a unitary expression with a single commercial impression.

As to whether "TR06AI" must be included in the drawing of the mark [sought to be registered], the record establishes that this alpha-numeric designation is in fact a part or stock number. The Examining Attorney concedes ... that the "TR06AI"

designation shown on the specimens is a part number.

The issue [thus becomes] whether ... the matter sought to be registered creates a commercial impression separate and apart from the model number and generic term in association with which it is used.

A part or stock number does not usually function as a source identifier. Even when a part number is joined by a hyphen to other matter which does serve a trademark function, the trademark is registerable [sic] without showing the part number as well in the drawing. In re Sansui Electric Co., Ltd., 194 USPQ 202 (TTAB 1977).

In the case at hand the alpha-numeric designation appearing on the specimen in front of "TINEL-LOCK" is not essential to the commercial impression of "TINEL-LOCK" as a trademark for applicant's metal rings. In a similar sense, the generic term "RING," although connected to the model number and the source-identifying term, "TINEL-LOCK," by a hyphen, nonetheless plays no integral role in forming the portion of applicant's mark which distinguishes applicant's goods from those of others. Applicant therefore need not include either the part number or the generic term in the drawing, because neither is essential to the commercial impression created by the mark as shown in the specimens. Prospective purchasers of these highly technical goods would readily recognize both the part number and the name of the goods as such, and would therefore look only to the trademark "TINEL-LOCK" for source identification. The fact that hyphens connect both the part number and the generic term to the mark does not, under the circumstances presented by this case, create a unitary expression such that "TINEL-LOCK" has no significance by itself as a trademark. Such independent significance is in fact supported by applicant's use of the

mark without the part number or generic designation in its advertising materials. Accordingly, the requirement for different specimens showing "TINEL-LOCK" used alone is reversed.

Id. at 1400.

Although, in this appeal, the Examining Attorney is correct that there is no evidence that applicant advertises its product under the term "1394" alone, applicant is correct in observing that the "NEXIS" excerpts of record plainly reveal that its "IEEE 1394" standard is commonly referred to in the relevant trades and industries for its product as simply "1394." In consequence thereof, and given the fact that the customers and users of applicant's standard for a high performance serial bus are highly trained and sophisticated consumers who are accustomed to dealing with publications like that of applicant, it is clear that they would readily recognize "Std" as an abbreviation for the generic term "standard," the substance of which forms the subject matter of applicant's publication. Such purchasers and users, moreover, would be expected to be familiar with applicant, as the world's largest technical professional society and publisher of nearly 30% of the world's literature in their respective electrical, electronics and computer engineering and science fields, and would identify its publications by its house mark "IEEE" and would recognize its

convention of designating its particular standards by the year in which such issued or were updated.

In view thereof, we find that as used on the specimen of record, the term "1394" creates a separate and distinct source-identifying commercial impression for applicant's publication. Neither the abbreviation "Std" for the generic name "standard," nor applicant's house mark "IEEE" or the year "1995" in which it issued its standard for a high performance serial bus, are essential to the commercial impression readily conveyed by the term "1394." A verified substitute specimen showing use of "1394" by itself is accordingly not necessary.

Decision: The refusal on the ground that, under Section 2(e)(1), the term "1394" is merely descriptive of applicant's product is affirmed, but the refusal on the ground that, under Sections 1051, 1052 and 1127, such term would not be perceived and hence does not function as a mark for its product, and the refusal on the ground that, under Section 1(a), applicant must submit a substitute specimen which shows use of "1394" as a mark, are reversed.