

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

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Paper No. 19
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re RG Delaware, Inc.

Serial No. 75/525,634

James J. Merek of Merek & Voorhees for RG Delaware, Inc.

Kathleen M. Vanston, Trademark Examining Attorney, Law
Office 103 (Michael Hamilton, Managing Attorney).

Before Bottorff, Rogers and Drost, Administrative Trademark
Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Supplemental
Register of the mark DYNAMIC PROBE (in typed form) for
goods identified in the application as "pressure monitor

with pressure sensors for use in connection with filtration beds."¹

The Trademark Examining Attorney has made final her refusal to register the mark on the Supplemental Register, on the ground that the mark is generic and therefore incapable of distinguishing applicant's goods. See Trademark Act Section 23, 15 U.S.C. §1091. Applicant has appealed that final refusal.

The appeal is fully briefed, and an oral hearing was held at which applicant's attorney and the Trademark Examining Attorney presented argument. We affirm the refusal, but only to the extent that the generic word PROBE

¹ Serial No. 75/525,634, filed on July 27, 1998 as an intent-to-use application seeking registration on the Principal Register. After the Trademark Examining Attorney issued a final refusal to register the mark on the Principal Register on the ground of mere descriptiveness, applicant filed a Notice of Appeal and a request to amend the application to one seeking registration on the Supplemental Register. The Board instituted the appeal and remanded the application to the Trademark Examining Attorney for consideration of the amendment to the Supplemental Register. The Trademark Examining Attorney initially rejected the proposed amendment to the Supplemental Register on the ground that the application remained an intent-to-use application. Applicant subsequently filed an Amendment to Allege Use (alleging August 1, 1998 as the date of first use and the date of first use in commerce), and renewed its request for amendment to the Supplemental Register. It does not appear that the Trademark Examining Attorney ever expressly accepted the Amendment to Allege use or the amendment to the Supplemental Register, but it appears that the amendments were entered, and the application thereafter has been prosecuted as a Supplemental Register application. When the Trademark Examining Attorney made her refusal to register the mark on the Supplemental Register final, the application was returned to the Board and the appeal was resumed.

must be disclaimed apart from the mark DYNAMIC PROBE before the mark may be registered on the Supplemental Register.

Trademark Act Section 23 provides for registration on the Supplemental Register of marks "capable of distinguishing applicant's goods or services and not registrable on the Principal Register." Generic terms, i.e., terms that the relevant purchasing public understands primarily to refer to the genus of goods or services in question, are by definition incapable of indicating a particular source of the goods or services, and they therefore are not registrable on either the Principal Register or the Supplemental Register. See *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001); *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987); and *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

The determination of whether the term sought to be registered is generic involves a two-part inquiry: "First, what is the genus of the 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., supra*, 228 USPQ

at 530. Evidence of the relevant public's understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers, and other publications. *In re Merrill Lynch, supra.* The Office bears the burden of proving, with clear evidence, that the term sought to be registered is generic. *In re Merrill Lynch, supra; In re Dial-A-Mattress Operating Corp., supra.*

For purposes of the first prong of the *Ginn* genericness test, we find that the genus of goods at issue in this case is that which is set forth in the application's identification of goods, i.e., "pressure monitor with pressure sensors for use in connection with filtration beds." It appears from applicant's brochure that the product is part of a filtration system used for water and wastewater treatment. The product consists of a slender cylindrical "dynamic sensor" unit which is inserted vertically into the filtration bed, and a "dynamic filter control" unit which displays the data collected by the sensor and/or transmits it electronically to the filtration system operator's computer. The product "reads the dynamic pressure in a filter directly during service," "measures available dynamic head," "monitors level of cleaning at multiple filter points," and allows the operator to

"anticipate and manage variable operating conditions during service and backwash," *inter alia*.

As for the second prong of the *Ginn* genericness test, we find that the evidence of record fails to establish that the relevant purchasing public understands the composite term DYNAMIC PROBE to primarily refer to the above-referenced genus of goods. There is no evidence that applicant, or anyone else, has used "dynamic probe" to refer to the genus of applicant's goods. Indeed, the only evidence of record (besides applicant's brochure) which appears to relate at all to applicant's genus of goods is the following excerpt from Water Technology News (May 1999), obtained from the NEXIS database and submitted by the Trademark Examining Attorney: "One of the more important features of the system, granted U.S. Patent 5,895,565, Steinberger points out, is a dynamic probe failure detection system, along with in-line computation of water saturation index that handles sensor and panel keyboard inputs." However, the word "dynamic" in the quoted excerpt reasonably might be construed as modifying "probe failure detection system," rather than "probe." That is, what is "dynamic" is the "probe failure detection system," not the "probe" itself or the "operational conditions" the probe is monitoring. Thus, we cannot

conclude that this excerpt is clear evidence of use of "dynamic probe" as a generic term in connection with the genus of applicant's goods.

It appears that the word "dynamic" has some descriptive significance as applied to applicant's goods; applicant's brochure indicates that the product's purpose or function is to monitor "dynamic pressure" and/or "dynamic head" within the filtration system.² It also appears (as discussed more fully, *infra*) that the "dynamic sensor" component of applicant's goods essentially is a "probe." Thus, "dynamic probe" might be an apt name for the product, which appears essentially to be a probe used to measure "dynamic pressure." However, in cases involving multiple-word marks, "[a]ptness is insufficient to prove genericness." *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999). Absent evidence of generic use of the term by applicant or others in connection with the genus of applicant's goods, we cannot conclude that the term is generic.

The Trademark Examining Attorney's genericness refusal is based on her theory that the genus of goods in this case

² We shall discuss, *infra*, the Trademark Examining Attorney's contention that "dynamic" in applicant's mark refers to the fact that the unit allows for monitoring "during service" (as opposed to "static" monitoring which would occur when the system is not in operation).

is a general class of probes, called "dynamic probes," which monitor operational conditions. Specifically, she argues that a "dynamic probe" is a type of probe (of which applicant's product is an example) which is used for testing during operational or "dynamic" conditions. It can be contrasted to a "static probe," which is a type of probe used for testing during non-operational or "static" conditions. She argues that "dynamic probe" is a generic term for any probe which allows for testing during operational conditions, whatever the specific industry or field, and that it therefore is a generic term for applicant's goods notwithstanding that applicant might be the first and only user of the term in applicant's particular industry. We are not persuaded.

A term which the evidence of record shows to be the name of a general category of goods may be found to be generic as well for goods within that general category, even in the absence of evidence of generic use of the term in connection with those particular goods *per se*. See, e.g., *In re Medical Disposables Co.*, 25 USPQ2d 1801 (TTAB 1992); *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd* 10 USPQ2d 1879 (Fed. Cir. 1989). In the present case, however, the evidence of record does not clearly prove that "probes which monitor operational

conditions" is a recognized commercial class or category of goods, much less that the name of such class or category of goods is "dynamic probes."

Specifically, the dictionary evidence of record does not include any entry for the composite term "dynamic probe." Compare *In re Analog Devices Inc.*, *supra*, in which there was dictionary evidence of entries not only for the words "analog" and "device" but also for the composite term "analog device." The Trademark Examining Attorney's cobbling together (in her brief) of definitions of the words "probe" ("a testing device inserted into something to test conditions at a given point") and "static" ("pertaining to tests and measurements made without subjecting the unit or device to regular operation, as opposed to DYNAMIC") is not evidence that "dynamic probe" is the generic name for any recognized commercial category of goods. Again, that these words are merely descriptive of the goods, or that considered together they might be an "apt" name for the goods, is not a sufficient basis for finding "dynamic probe" to be generic and unregistrable on the Supplemental Register. *In re American Fertility Society*, *supra*.

Likewise, the NEXIS and Internet evidence submitted by the Trademark Examining Attorney does not establish that

"dynamic probe" names a general class or category of probes used to monitor operational conditions (as opposed to "static probes" which monitor non-operational conditions). Indeed, most of the references to "static probes" in fact are references to "pitot-static probes," which appear to be sensors which are mounted on aircraft to gather air data (e.g., Mach number, altitude) during flight. In other of the references to "static probes," it is the probe itself, not the conditions being probed, that is "static" or non-moving: "The scanner may move the sample relative to a static probe ("sample scanning"), or the sample may be held steady while the scanner moves the probe ("probe scanning"). The latter is the more common..."

Similarly, in many of the NEXIS and Internet excerpts, "dynamic" appears to refer to the action of the probe itself rather than to the fact that the probe is used during "operational conditions": "the machine features a dynamic probe head"; "all terrain, fully hydraulic MRZB heavy and super heavy weight probe incorporating caterpillar tracks, hydraulic jack and additional hydraulic percussion hammer drive system ... combines the ability to penetrate to increased depths and recover larger diameter soil samples and represents a significant advance in dynamic probe technology." And, like the "dynamic probe

failure detection system" referred to in the Water Technology News excerpt discussed above, other of the excerpts do not refer to an instrument called a "dynamic probe." They refer instead to "dynamic probe correcting software," and to "dynamic probe calibration," in which "dynamic" modifies the "software" and the "calibration," not the probe itself or the "operational conditions" the probe is monitoring.

In short, we find that the NEXIS and Internet evidence relied on by the Trademark Examining Attorney does not support her theory that "dynamic probes" and "static probes" are two general classes of probes, nor does it clearly establish that "dynamic probe" is a generic term for applicant's goods.

However, we find that the evidence of record clearly establishes that the relevant purchasing public understands the term "probe" to refer primarily to the genus of applicant's goods, i.e., that applicant's product is, or includes as a key component, a probe. The pertinent definition of "probe," in the context of applicant's goods, is "any of various testing devices or substances: as ...a usually small object that is inserted into something so as

to test conditions at a given point.”³ (yourdictionary.com, attached to February 5, 2002 final refusal.) We also take judicial notice of the similar definition of “probe” set forth in Webster’s Third New International Dictionary (1993) at 1807:⁴ “**2 a** one of several testing devices used in electronics or other physical sciences: as ...(2) a slender wire or some other small slender object that is inserted into something (as a flame, a discharge tube) so as to test conditions (as potential differences) at a given point.”

These dictionary definitions clearly apply to a key component of applicant’s product, i.e., the slender, cylindrical sensor unit which is inserted into the filtration bed to provide “continuous bi-directional differential pressure measurement across multiple layers of the bed in one instrument” (quoted from applicant’s brochure, second page). Moreover, the NEXIS excerpt from Water Technology News, quoted *supra*, which refers to a dynamic “probe failure detection system,” shows that the

³ That the term might have other meanings in different contexts is immaterial, since our genericness determination must be made with respect to applicant’s goods, not in the abstract.

⁴ The Board may take judicial notice of dictionary definitions. See, e.g., *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); see also TBMP §712.01.

term "probe" has been used generically in applicant's industry in connection with similar goods. We find that this evidence suffices to establish that "probe" is a generic term as applied to applicant's goods, that it is incapable of distinguishing those goods, and that it therefore is not registrable on the Supplemental Register and must be disclaimed.⁵

Decision: The refusal to register the mark on the Supplemental Register is affirmed, but only to the extent that the generic term PROBE must be disclaimed apart from the mark as shown. In accordance with Trademark Rule 2.142(g), this decision will be set aside and applicant's DYNAMIC PROBE mark will be forwarded to issuance of registration on the Supplemental Register if applicant, no later than **thirty days** from the mailing date of this decision, submits an appropriate disclaimer of the term PROBE.⁶

⁵ See TMEP §1213.03(b) regarding disclaimers of unregistrable components of marks sought to be registered on the Supplemental Register.

⁶ The proper format for the disclaimer statement is: "No claim is made to the exclusive right to use PROBE apart from the mark as shown." See TMEP §1213.08(a)(i).