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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Rational AG**

Serial No. 76/122,164

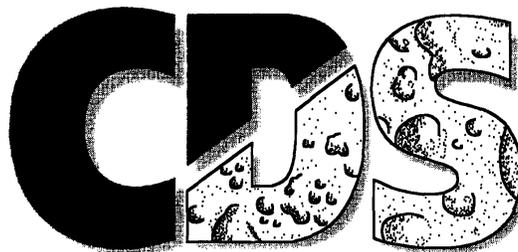
Jeanette S. Zimmer of Schiff Hardin & White for **Rational AG**.

Eugenia K. Martin, Trademark Examining Attorney, Law Office 104
(K. Margaret Le, Managing Attorney).

Before **Hohein, Bottorff** and **Rogers**, Administrative Trademark
Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

Rational AG has filed an application to register the
mark "CDS CALCDIAGNOSIS SYSTEM" and design, as shown below,



CalcDiagnosis System

for "food cookers and steamers for commercial use."¹

Registration has been finally refused under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), on the basis of applicant's refusal to comply with a requirement for a disclaimer of the wording "CALCDIAGNOSIS SYSTEM," which the Examining Attorney maintains is 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 apart from the mark as shown.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the disclaimer requirement.

Applicant, having disclaimed the word "SYSTEM," directs the focus of its initial brief to the question of whether the term "CALCDIAGNOSIS" is merely descriptive of its goods. In this regard, applicant states that it "agrees that one of the features of its food cookers and steamers is that it monitors the level of lime [i.e., calcium,] scale building up

¹ Ser. No. 76/122,164, filed on September 5, 2000, which is based upon German Reg. No. 30017210, issued on March 3, 2000. In addition to a claim of a right of priority, a "claim of color is made in the mark for the colors red and blue." Specifically, "[r]ed is claimed for the portions of the drawing shown in solid black, namely, for the letter 'C' and the upper left-hand portion of the letter 'D' and the words 'CALCDIAGNOSIS SYSTEM,'" while "[b]lue is claimed for the lower right-hand portion of the letter 'D' and for the letter 'S.'" However, "[t]he stippling ... is for the purpose of shading and is not intended to indicate color." The word "SYSTEM" is disclaimed.

inside the food cooker or steamer so that the operator will know when cleaning or service is needed." Applicant contends, however, that:²

Appellant's mark is not "Calcium Level Diagnosis," which, in Appellant's view, would be descriptive. Even if Appellant's mark was "Calcium Diagnosis," it arguably would be suggestive because the combination of the terms "Calcium" and "Diagnosis" are incongruous. How can "calcium" have a "diagnosis"? What is being "diagnosed"? Answers to questions like these may be provided by the Appellant's website, but the Appellant's mark does not provide them.

In any event, Appellant's mark is [in part] comprised of the abbreviation or prefix CALC and the word DIAGNOSIS. As discussed in Appellant's Request for

² Citing TMEP §1213.05(a), which is entitled "Compound Word Marks," applicant also argues that such section "defines a compound word mark as a mark that is 'comprised of two or more distinct words or words and syllables that are represented as one word'" and that the term "CALCDIAGNOSIS is one word comprised of two parts, namely, one syllable (the abbreviation or prefix 'calc') and one word ('diagnosis')." In view thereof, and because TMEP §1213.05(a) further provides (in part) that "[a]ll compound word marks, as defined above, are considered unitary, and [thus] a disclaimer of a component will not be required *unless* the mark is appropriately presented in the application in a typed drawing as two or more separate words" (italics in original), applicant maintains that, "[b]ased on the plain language of the TMEP, it is clear that the CALCDIAGNOSIS portion of Appellant's mark should be considered unitary and no disclaimer of CALCDIAGNOSIS should be required." Applicant's reliance on TMEP §1213.05(a), however, is misplaced inasmuch as its mark is not the compound word mark "CALCDIAGNOSIS" but rather is the compound mark "CDS CALCDIAGNOSIS SYSTEM" and design. Consequently, while the term "CALCDIAGNOSIS" may be considered unitary, applicant's mark as a whole is not; therefore, a disclaimer of the term "CALCDIAGNOSIS" may properly be required if such term is merely descriptive of applicant's goods. See, e.g., In re Uniroyal, Inc., 215 USPQ 716, 718-19 (TTAB 1982) [mark "UNIROYAL STEEL/GLAS" for vehicle tires held not unitary; requirement for disclaimer of unitary term "STEEL/GLAS" accordingly found appropriate].

Reconsideration . . . , the abbreviation CALC can have other meanings, such as calculator. As such, the purchaser could reasonably infer that CALCDIAGNOSIS means that the food cooker "calculates and diagnoses something (that also would not be descriptive because it is not immediately clear what would be "calculated" and "diagnosed"). . . .

The Examining Attorney did not cite to any third[-]party uses of the word "calcdiagnosis," let alone in a descriptive manner. The absence of third[-]party descriptive uses supports Appellant's contention that the word CALCDIAGNOSIS is a unique word, coined by Appellant. This inventive and unique combination does not immediately communicate to a prospective purchaser of Appellant's food cookers and steamers that one of the features of Appellant's products is that it monitors the lime-scale buildup in the food cooker. The purchaser or user must use imagination, thought or perception in an effort to reach a conclusion about Appellant's suggested meaning of the abbreviation CALC and its relation of the word DIAGNOSIS in connection with the goods. . . . Since a purchaser must take multiple mental steps to figure out the suggested meaning of Appellant's mark, the mark . . . is not descriptive.

Nonetheless, applicant further maintains that, even "assuming *arguendo* that both components of the [term CALCDIAGNOSIS, namely, the] word[s] CALC and DIAGNOSIS[,] are immediately and correctly understood by the purchaser, combinations of merely descriptive components have been found registrable if the juxtaposition of the words is inventive or evokes a unique commercial impression. . . . That is, the commercial impression of a composite mark may still be arbitrary

or even suggestive--even though its separate parts, individually, bear some meaning." As evidence that the term "CALCDIAGNOSIS" should likewise be regarded as arbitrary or, at the very least, no more than suggestive, and therefore should not have to be disclaimed, applicant has "attached as Exhibit F" to its main brief copies of third-party registrations³ for the following marks, each of which registrations appears to have issued without resort to a claim of acquired distinctiveness pursuant to Section 2(f) of the Trademark Act, 15 U.S.C.

§1052(f):

CALCI-COOKIE (U.S. Reg. No. 2,356,955) covering "calcium fortified cookies";
CALCIGUM (U.S. Reg. No. 2,493,348) covering "chewing gum--calcium fortified"; CALCIPORE (U.S. Reg. No. 2,606,577) covering "chemicals, namely calcium carbonated for use in the manufacture of breathable films"; and CALCITREATS (U.S. Reg. No. 2,507,884) covering "calcium fortified pastries, candy, bakery goods, chewy nougats, candy creams, candy bars, chocolate, yogurt and candy coated crackers and cookies."

Applicant, while "recognizing that such registrations are not of precedential value to the Board," indicates that it "raises these examples to demonstrate that the Trademark Office has

³ While such copies, having been submitted for the first time with applicant's main brief, are clearly untimely under Trademark Rule 2.142(d), the Examining Attorney, in her brief, has not only raised no objection thereto but has treated the evidence as if it properly formed part of the record by discussing the merits thereof. We accordingly have considered such copies. See, e.g., In re Nuclear Research Corp., 16 USPQ2d 1316, 1317 (TTAB 1990) at n. 2.

registered compound word marks ... that include an abbreviation that stands for 'calcium' in connection with goods [which] clearly relate to calcium." According to applicant, "[t]he abbreviation CALCI more clearly refers to 'calcium'--unlike Appellant's mark in which the abbreviation CALC can have other possible non-descriptive meanings."

It is well settled that a term is considered to be merely descriptive of goods, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys an immediate idea of any ingredient, quality, characteristic, feature, function, purpose or use of the goods. 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 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 for which registration is sought, the context in which it is being used on or in connection with those goods and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Thus,

"[w]hether consumers could guess what the product is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

We agree with the Examining Attorney that requiring a disclaimer of the wording "CALCDIAGNOSIS SYSTEM," which in the context of applicant's goods plainly signifies "calcium diagnosis system," is proper because such phrase is merely descriptive of a feature or function of such goods and is not an inseparable part of the mark "CDS CALCDIAGNOSIS SYSTEM" and design as a whole. In particular, as the Examining Attorney notes, the following excerpts were made of record from various websites which advertise and/or review applicant's goods and explain "what the 'CalcDiagnosis System' is with regard to the [applicant's] cookers and steamers:"

"The CalcDiagnosis System® constantly monitors limescale build-up in the steam generator, taking into account how hard or soft the local water is and how often the ClimaPlus Combi® [oven] is used.

In normal conditions, limescale deposits are removed and flushed out automatically, preventing build-up in the steam generator.

To ensure that your ClimaPlus Combi continues to operate reliably in extreme conditions, e.g. if the water is very hard, the CalcDiagnosis System warns you well in advance that the steam generator needs cleaning.

....

CalcDiagnosis System® Benefits[:]
Information on current limescale level can

be called up at the touch of a button." --
www.RATIONALusa.COM (August 22, 2002);

"CalcDiagnosis System
Say goodbye to limescale problems
The CalcDiagnosis System® constantly
monitors limescale build-up in the steam
generator Scale build-up in the steam
generator is thus substantially reduced and
the descaling intervals extended.

To ensure that your ClimaPlus Combi
continues to operate reliably in extreme
conditions, e.g. if the water is very hard,
the CalcDiagnosis System warns you well in
advance that the steam generator needs
cleaning.

....
The CalcDiagnosis System® from RATIONAL
automatically monitors limescale build-up in
the steam generator.

Your benefits:

Automatic descaling process triggered
by rising limescale levels." --
www.rational-asia.com (August 22, 2002); and

"The latest innovation on the RATIONAL
COMBI STEAMERS is the Calc-Diagnosis System.
Once you have specified how hard or soft
your local water is and how often you use
the Combi steamer, the system keeps a
constant check on lime scale levels inside
the boiler and displays the current status
at the touch of a button. The intelligent
Calc-Diagnosis System lets you know when a
service is due in ample time. This
guarantees maximum operational reliability,
and saves a lot of money in repairs and
inconvenience when the oven is down." --
www.malta-hotels.com (February 13, 2001).

The above evidence, the Examining Attorney accurately asserts,
shows that "the CalcDiagnosis System identifies the limescale
levels in the [applicant's] steamers and cookers, it provides
the relevant information on limescale levels to the user of the

goods, and it informs the user when they need cleaning" inasmuch as "analysis of the limescale levels triggers a 'descaling,' or cleaning, process in the goods. Such evidence, according to the Examining Attorney, also properly demonstrates that "the CalcDiagnosis System is an important feature of the goods."

In addition, the evidence of record includes definitions of several terms. Excerpts from The American Heritage Dictionary of the English Language (3rd ed. 1992) define "**calci-** or **calc-**" as a prefix meaning "[c]alcium; calcium salt; lime: *calciferous*"; list "**diagnosis**" in relevant part as a noun signifying "**2. a.** A critical analysis of the nature of something. **b.** The conclusion reached by such analysis"; and set forth "**lime**" in pertinent part as a noun connoting "**1. a.** See calcium oxide. **b.** Any of various mineral and industrial forms of calcium oxide differing chiefly in water content and percentage of constituents such as silica, alumina, and iron. Also called *quicklime*." Excerpts from the The American Heritage Dictionary of the English Language (4th ed. 2000) likewise define "**calci-** or **calc-**" as a prefix connoting "[c]alcium; calcium salt; lime" and list "**calc.**" as an abbreviation for "calculate," while "**calc-**" is set forth as a prefix meaning "[v]ariant of calci-." "**Calc**" is also defined by an excerpt from The Free On-line Dictionary of Computing (1993-2001) as

signifying "[a]n extensible, advanced desk calculator and mathematical tool written in Emacs Lisp by Dave Gillespie."

Applicant, in view of the above, states in its reply brief that it "readily admits that CALC is one of the recognized abbreviations for 'calcium.'" Applicant argues, however, that the evidence establishes that such abbreviation "has other meanings" and that:

Therefore, when considered by purchasers in association with Appellant's goods, "calcium" is not the immediate--or even most likely--connotation deduced by a purchaser; other, more readily understood connotations for the abbreviation (e.g. calculate) would come to mind. The Examining Attorney provides no evidence that either in general, in the relevant industry, or on the goods, the abbreviation CALC is substantially synonymous with the word "calcium."

We concur with the Examining Attorney, however, that when used in the context of applicant's food cookers and steamers for commercial use, the term "CALC" would be immediately understood by purchasers and users of its goods to refer to the calcium or lime which accumulates in such goods through use, especially since applicant's goods are designed to monitor the build up of calcium or lime deposits and issue a warning as to when a cleaning or descaling is needed. None of the other meanings of the term "CALC," such as "calculate," would as readily come to mind with respect to commercial food cookers and steamers, which

require periodic cleaning or descaling of the calcium or lime left by the water used therein in order to continue to properly function.

Consequently, as contended by the Examining Attorney, the phrase "CALCDIAGNOSIS SYSTEM" merely describes, without the need for speculation or conjecture, "the exact function [or feature] of the system, namely[,] to provide a diagnosis, or analysis, of the calcium levels which have built up in the cookers and steamers." Although applicant's advertising, as the Examining Attorney also notes, "discusses 'lime' as opposed to calcium," because lime is an oxide of calcium, the knowledgeable and sophisticated commercial purchasers and users of applicant's goods would immediately understand that, "when the applicant discusses 'lime' which has built up in the cookers and steamers," applicant is "referring to calcium which has built up" in such goods and which must be removed after intervals of operation if the goods are to continue to function. Thus, rather than it being the case that, as argued by applicant, customers and prospective purchasers must gather further information by consulting its website advertising in order to understand the meaning of the term "CALCDIAGNOSIS," such advertising simply confirms that the term, which appears in applicant's mark as "CalcDiagnosis," would immediately be

perceived in relation to applicant's goods as meaning only calcium diagnosis.

Moreover, as the Examining Attorney persuasively points out, no new, nondescriptive meaning is created by the combination of the descriptive terms "CALC" and "DIAGNOSIS." The combined term "CALCDIAGNOSIS" does not result, for example, in a composite which is so incongruous, unusual or otherwise different in meaning from its constituent terms as to possess no definitive connotation or significance other than that of an indication of source for applicant's goods. Instead, there is simply nothing in such combined term which, when used in connection with applicant's commercial food cookers and steamers, requires the exercise of imagination, cogitation or mental processing or necessitates the gathering of further information in order for the merely descriptive significance thereof to be immediately apparent. Plainly, to customers for and users of applicant's goods, the term "CALCDIAGNOSIS" conveys forthwith that a significant feature or function thereof is the calcium diagnosis capability which indicates when the goods need to be cleaned or descaled of built-up lime. Likewise, because a system for diagnosis or critical analysis of calcium or lime deposits is merely described by the phrase "CALCDIAGNOSIS SYSTEM," a disclaimer thereof is proper. Furthermore, as the Examining Attorney additionally notes, it is settled that even

if applicant is or intends to be the first to use such phrase or the term "CALCDIAGNOSIS" in connection with its products, registration thereof is not warranted where, as here, those designations have been shown to be merely descriptive. See, e.g., In re Quik-Print Copy Shop, Inc., 616 F.2d 523, 205 USPQ 505, 507 n. 8 (CCPA 1980); and In re National Shooting Sports Foundation, Inc., 219 USPQ 1018, 1020 (TTAB 1983).

Finally, with respect to the third-party registrations relied upon by applicant, the Examining Attorney correctly observes that they are not conclusive as to the question of mere descriptiveness. Specifically, as the Examining Attorney properly points out, a phrase or term which is merely descriptive is not made registrable simply because other similar marks appear on the register. See, e.g., In re Scholastic Testing Service, Inc., 196 USPQ 517 (TTAB 1977). Each case, instead, 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 Furniture Industries Inc., 60 USPQ2d 1511, 1514 (TTAB 2001); and In re Pennzoil Products Co., 20 USQP2d 1753, 1758 (TTAB 1991).

Accordingly, we agree with the Examining Attorney's conclusion that because "[t]he wording CALCDIAGNOSIS SYSTEM in the applicant's mark [merely] describes a [feature or] function of the [applicant's commercial] food cookers and steamers, namely, to diagnose ... the limescale, or calcium, levels on the goods in order to optimize the performance of the goods," the mark is not registrable in the absence of a disclaimer of such wording.

Decision: The requirement for a disclaimer under Section 6(a) is affirmed. Nevertheless, in accordance with Trademark Rule 2.142(g), this decision will be set aside and applicant's mark will be published for opposition if applicant, no later than thirty days from the mailing date hereof, submits an appropriate disclaimer of the merely descriptive phrase "CALCDIAGNOSIS SYSTEM".⁴

⁴ See In re Interco Inc., 29 USPQ2d 2037, 2039 (TTAB 1993). For the proper format for a disclaimer, attention is directed to TMEP §§1213.08(a) and (b).