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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Parametric Technology Corporation

Serial No. 78040702

Thomas V. Smurzynski of Lahive & Cockfield for Parametric Technology Corporation.

Priscilla Milton, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Walters, Rogers and Cataldo, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Parametric Technology Corporation filed an application to register on the Principal Register the mark THE PRODUCT DEVELOPMENT COMPANY for, as amended, the following goods and services¹:

"computer software for computer aided design (CAD), computer aided manufacturing (CAM) and computer aided engineering (CAE), computer

¹ Serial No. 78040702, filed December 27, 2000, based on an allegation of a bona fide intention to use the mark in commerce as to each class of goods and services. On April 11, 2002, applicant filed an amendment to allege use, alleging first use and use in commerce as of June 2001. The amendment to allege use was approved on June 14, 2002.

software for workflow, process and production automation, computer software for visualization and digital mockup, computer software for information management of business, organizational, supplier, engineering, component, product, production and maintenance information, computer software for use in software development and accompanying user guides sold with such software as a unit," in International Class 9;

"computer education training services, namely, training and education services in the field of computer software," in International Class 41; and

"technical support services, namely, troubleshooting of computer software problems via telephone; updating of computer software; maintenance of computer software, namely, maintenance and error correction services for computer software; computer consultation; product development for others; Repair of computer software," in International Class 42.²

The examining attorney refused registration on the ground that the mark is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). After filing its amendment to allege use, applicant amended its application to the Supplemental Register. The examining attorney refused registration, under Section 23 of the Trademark Act, 15 U.S.C. §1091, on the ground that applicant's mark is incapable of identifying applicant's goods and services and distinguishing them from those of others. The examining attorney subsequently withdrew the refusal as to the services in International Class 41 and issued a final refusal to register on the Supplemental

Register with respect to the goods and services in International Classes 9 and 42.

Applicant has appealed and filed a brief, but did not request an oral hearing. The examining attorney's brief was due on April 23, 2005, but was not submitted until June 8, 2005. Applicant's motion to reject the late-filed brief was granted by the Board and, thus, the examining attorney's brief has been given no consideration.

In the office actions, including the final refusal, the examining attorney contends that the mark is generic in connection with the identified goods and services because "applicant clearly indicates in the recitation of services that applicant develops products for others [and] applicant provides product development tools in the nature of product development software" (office action of June 10, 2004, p. 1). The examining attorney asserts that the addition of the words THE and COMPANY to the generic term PRODUCT DEVELOPMENT do not create a non-generic composite.

The evidence submitted by the examining attorney includes a definition from *The American Heritage Dictionary of the English Language* (3rd ed. 1992) of "product development" as "something produced by human or mechanical effort or by a natural process"; copies of the results of

² Applicant originally classified "computer repair services" in International Class 37. In response to a requirement by the examining attorney, these goods were reclassified in International Class 42.

Internet searches using the Google search engine, for the term "product development"; and excerpts from various Internet websites and excerpts of articles retrieved from the Lexis/Nexis database that show use of the term "product development."

The evidence submitted by the examining attorney includes an excerpt from "EDTN Network," also known as "The Electronic, Design, Technology and News Network." The site contains a section under the heading "Product Development" that provides summaries of relevant articles and includes the following briefs of, *inter alia*, three different articles:

Find out how **product development** organizations like yours are using the latest advances in product data management to bring better products to market faster, boost productivity across the board, and streamline the product design process.

. . .
This document discusses what the future holds for the collaborative **product development** (CPD) software market.

. . .
This paper offers insight into the consequences of poor information management and suggests some specific advances that dramatically improve the **product development** process.

Additionally, the examining attorney submitted the results of a Google search for "product development software," which returned many pages of results, although the record includes only two pages of these results. Each entry includes the term "product development," and several of the entries include the unitary phrase "product development software."

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Of these results, she excerpted two of the websites listed, which include the following statements:

www.formationsystems.com:

Formation Systems has added a key module to Optiva[®], its **product development software**: Experiment Design Management.

. . .
Nation's largest family-owned food company [Rich], has chosen Optiva[®], from Formation Systems, and will implement the **product development software** at its facilities worldwide.

www.soe.stevens-tech.edu:

Automated Concurrent Engineering Software (ACES) is an advanced **product development software** system that allows product developers to optimize a product's design by concurrently integrating numerous critical non-geometric factors, such as materials, manufacturing processes, tooling, machine availability, field maintenance, and associated costs that affect the performance and profitability of a product.

The examining attorney submitted the results of several other Google searches of the Internet, all clearly showing use of the term "product development" in connection with the development and design of products.

Of the excerpted articles from the Lexis/Nexis database submitted by the examining attorney, the following are several examples:

Workgroup, based in Lexington, Mass., makes **product development software**. Clients include Whirlpool Corp., Honeywell International Inc. and Goodrich Corp. [*Mergers and Acquisitions Report*, May 6, 2002.]

Needham, Mass.-based collaborative **product development software** vendor PTC announces that TRW

Automotive, Livonia, Mich., has successfully implemented three of PTC's Windchill applications ... [MSI, May 1, 2002 - referring to applicant.]

HEADLINE: Common Knowledge: **product developers** are finding competitive advantage through the use of knowledge-based software; solid modeling.
BODY: EDS' PLM Solutions is one developer of collaborative **product development software** and services that is working to these new criteria, and has introduced several different knowledge-based tools into the most recent releases of the CAD/CAM/... [Engineering, March 1, 2002.]

The largest seller of computer services and hardware is expanding its 20-year partnership with Dassault to integrate Dassault's Enovia **product-development software** with IBM's primary electronic commerce software, WebSphere, the companies said. [The Miami Herald, February 19, 2002.]

Electronic Data Systems Corp of Plano is expected to announce Thursday that Jaguar Racing will use its **product development software** to design its Formula One race cars. [The Dallas Morning News, February 14, 2002.]

With her final office action, the examining attorney submitted substantial additional evidence excerpted from Internet websites. Rather than reproduce it here, suffice it to say that it exemplifies and corroborates the use as shown above of the terms "product development" and "product development software" by numerous third parties.

The examining attorney also included extensive excerpts from applicant's own website, www.ptc.com, including the following examples:

We eat, drink and sleep **product development**.
We've worked hard to ensure that you'll find

everything you need in our products and services area.

. . .
PTC **product development software** takes good to best. ... That's because our software gets involved with your team, all of them - the developer, the designer, the engineer, the manufacture, the marketing group, procurement people and the management team. ... By using our **product development software**, manufacturers are finding that rapid **product development** and lower costs can actually go hand in hand.

. . .
At PTC, we specialize in **product development** and product lifecycle management (PLM). Our software solutions have been helping engineers and manufacturers do their jobs with a level of excellence that is unmatched in the industry. Since 1985, our customers have enjoyed highly personalized tech support, consulting services and comprehensive training programs.

Applicant's argument that its mark is not generic in connection with the goods and services in International Classes 9 and 42 is repeated below (brief, pp. 4-5):

Applicant asserts that the mark THE PRODUCT DEVELOPMENT COMPANY is not generic for applicant's software and software support services, because applicant does not perform or provide product development for anyone. Applicant's software and related technical support and implementation services provide tools to its customers that help to streamline and automate their product development activities, among other things, but applicant itself does not use its products for these purposes.

. . . There do appear to be businesses that are known for developing products for themselves or for others, and these are referred to as engaging in "product development."

However, applicant does not engage in "product development" as a distinct business activity. To the contrary, applicant provides software products and software support services that allow customers

to better design and manufacture their products and therefore engage in their own product development. Since "product development" is a laudatory phrase in a business context, suggesting a business that does not have a static product line, applicant has attempted to capitalize on a popular use for its design and manufacture software, and to use the phrase THE PRODUCT DEVELOPMENT COMPANY as a mark for the software.

Furthermore, it should be noted that applicant's mark is not PRODUCT DEVELOPMENT. It is THE PRODUCT DEVELOPMENT COMPANY. The difference is that the full four-word mark indicates an entity, making the full phrase non-generic. Other businesses have created trademarks in the same style.

In support of its position, applicant, in addition to its specimens of use, submitted a copy of its brochure. On the cover of the brochure is the following statement: "Product development means business.™" The following statements also appear in the brochure:

According to Deloitte Research, over 67 percent of high-technology companies foresee M&A as the key factor impacting their **product development** strategies.

Opening up the **product development** process to your value chain of suppliers, manufacturing partners, and customers creates new opportunities to build market share ...

To deliver category-killer products, manufacturers must break through the four walls of traditional **product development** and work collaboratively - across departments and across enterprises. PTC solutions empower manufacturers to develop products in real time from multiple locations and control the process at every step.

In addition to the concession of descriptiveness implied by its amendment to the Supplemental Register,

applicant has expressly conceded that its mark is merely descriptive in connection with the goods and services identified. Therefore, the only issue before us is whether THE PRODUCT DEVELOPMENT COMPANY is a generic term that is incapable of registration on the Supplemental Register for the identified goods and services in International Classes 9 and 42.

A mark is a generic name if it refers to the class, genus or category of goods and/or services on or in connection with which it is used. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The test for determining whether a mark is generic is its primary significance to the relevant public. Section 14(3) of the Act; *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, *supra*; and *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, *supra*. The examining attorney has the burden of establishing by clear evidence that a mark is generic and thus unregistrable. *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Evidence of the relevant public's understanding of a term may be obtained from any competent source, including

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testimony, surveys, dictionaries, trade journals, newspapers, and other publications. *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

In the case of *In re American Fertility Society, supra*, the court reversed the Board's decision that SOCIETY FOR REPRODUCTIVE MEDICINE within the mark AMERICAN SOCIETY FOR REPRODUCTIVE MEDICINE is generic in connection with association services and, thus, a disclaimer would be required in order to register that mark on the Supplemental Register. The court remanded the case, stating that the Board applied an improper legal test by finding the disputed phrase of the mark generic as a whole based solely on evidence that its constituent elements, "society" and "reproductive medicine," were generic. The court stated that to find a mark generic, the PTO must prove "(1) the public understands the individual terms to be generic for a genus of goods and species; and (2) the public understands the joining of the individual terms into one [phrase] to lend no additional meaning to the term, then the PTO has proven that the general public would understand the [phrase] to refer primarily to the genus of goods or services described by the individual terms." (*id.* at 1837.)

In the case of *In re Dial-A-Mattress Operating Corp.*, *supra*, 1-888-M-A-T-R-E-S-S for "telephone shop-at-home

retail services in the field of mattresses," the court distinguished the *American Fertility* and *Gould* cases as follows (*id.* at 1810):

Where a term is a "compound word" (such as "Screenwipe"), the Director may satisfy his burden of proving it generic by producing evidence that each of the constituent words is generic, and that "the separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to those words as a compound." *In re Gould Paper Corp.*, 834 F.2d 1017, 1018, 5 USPQ2d 1110, 1110 (Fed. Cir. 1987). However, where the proposed mark is a phrase (such as "Society for Reproductive Medicine"), the board "cannot simply cite definitions and generic uses of the constituent terms of a mark"; it must conduct an inquiry into "the meaning of the disputed phrase as a whole." *In re The Am. Fertility Soc'y*, 188 F.3d at 1347, 51 USPQ2d at 1836. The *In re Gould* test is applicable only to "compound terms formed by the union of words" where the public understands the individual terms to be generic for a genus of goods or services, and the joining of the individual terms into one compound word lends "no additional meaning to the term." *Id.* at 1348-49, 51 USPQ2d at 1837.

The court concluded that "1-888-M-A-T-R-E-S-S," as a mnemonic formed by the union of a series of numbers and a word, bears closer conceptual resemblance to a phrase than a compound word, and the court reiterated that the PTO must produce evidence of the meaning the relevant purchasing public accords to the proposed mnemonic mark "as a whole." In concluding that there was not substantial evidence that the term is generic, the court added that the term is not literally a genus or class name nor does it "immediately and unequivocally" describe the service at issue.

We find that, in this case, the mark THE PRODUCT DEVELOPMENT COMPANY is more analogous to the phrase considered by the court in *American Fertility* than it is to the compound word considered in *Gould*. Thus, dictionary definitions alone cannot support a refusal to register the proposed mark. It is clear that the constituent term "product development" is the name of a class of services, as established by the substantial amount of evidence herein, and that "product development software" is also a generic name of a class of goods. The term "the" is of no consequence, see *In re The Computer Store, Inc.*, 211 USPQ 72, 74-75 (TTAB 1981) and the term "company," although not defined in the record, is merely a generic term for a business entity. While the record is clear, indeed, applicant has conceded, that it sells product development software, it is not applying to register either that phrase or THE PRODUCT DEVELOPMENT SOFTWARE COMPANY. Thus, the record does not show that the relevant public would view THE PRODUCT DEVELOPMENT COMPANY as the name of a class of products known as product development software.

On the other hand, the record is sufficient to establish that the relevant public would find THE PRODUCT DEVELOPMENT COMPANY a generic term indicating a company that provides product development services. See, *In re The Computer Store, Inc.*, *supra*. Indeed, applicant acknowledges that

there are product development businesses providing product development services and A PRODUCT DEVELOPMENT COMPANY would be a generic name for any such business. Applicant's use of THE instead of A cannot render the composite non-generic.

Therefore, we conclude that the examining attorney has met the substantial burden of establishing that THE PRODUCT DEVELOPMENT COMPANY is incapable of identifying and distinguishing the source of the identified services in International Class 42. However, for the reasons noted above, the examining attorney has not established that THE PRODUCT DEVELOPMENT COMPANY is generic in connection with the identified goods in International Class 9.

Decision: The refusal to register under Section 23 of the Act is affirmed as to the services in International Class 42 and reversed as to the goods in International Class 9. The application will proceed to registration in due course in two of the three International Classes (Classes 9 and 41) contained therein.