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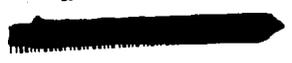
Attorney Docket No.: 1526.2002



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of: )  
)  
ADVANTEST CORPORATION )  
)  
Application Serial No: 76/235,496 )  
)  
Filed: April 5, 2001 )  
)  
Mark: SILICON FINGER )  
)

**BOX TTAB  
FEE**



01-09-2004

U.S. Patent & TMOfr/TM Mail Rcpt Dt. #22

**NOTICE OF APPEAL**

Applicant, pursuant to Trademark Rule 2.141, hereby appeals to the Trademark Trial and Appeal Board from the Examining Attorney's refusal of registration dated July 9, 2003.

Applicant has filed concurrently herewith an Amendment and Request for Reconsideration Under 37 C.F.R. § 2.64(b).

The appeal fee of \$100.00 as required in Rule 2.6(a)(18) is enclosed. The Commissioner is authorized to credit any overpayments or charge any additional fees required to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

David E. Weslow

Date: 1/9/2004

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01/14/2004 EPINA1 0000051 76235496  
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Trade Mark Application of:

ADVANTEST CORPORATION

International Class: 9

Serial No: 76/235,496

Law Office: 108

Filed: April 5, 2001

Examining Attorney: Angela Micheli

Mark: SILICON FINGER

**AMENDMENT AND REQUEST  
FOR RECONSIDERATION UNDER 37 C.F.R. § 2.64(b)**

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

**BOX: RESPONSES - NO FEE**

Sir or Madam:

This Amendment and Request for Reconsideration is filed in response to the Office Action dated July 9, 2003. Please consider the following amendments, remarks, and the attached Declaration of Robert Keith Lee.

**IN THE SPECIFICATION AND DRAWINGS:**

Please amend the identification of goods by deleting the current identification of goods and substituting therefore: --Contactors and contactor probe cards, made of Micro-Electro-Mechanical Systems (MEMS) material including mechanical elements, sensors, actuators, and electronics on a common silicon substrate, for use in testing equipment to test electronic circuits and electronic devices, namely, semiconductor wafers, integrated circuits, printed circuit boards, semiconductor chips, and packaged semiconductor devices, in international class 9--

**REMARKS**

**I. IDENTIFICATION OF GOODS**

In the Office Action dated July 9, 2003, the Examining Attorney objected to the current identification of goods and requested that Applicant amend the identification of goods to recite, "partially made of silicon." In the Office Action dated September 30, 2002, the Examining Attorney requested that the identification of goods be amended to "indicate the silicon ingredients" of the goods. As noted in the attached Declaration of Robert Keith Lee, it would be improper to state that "SILICON is the material content" of Applicant's goods.

In accordance with the Examining Attorney's request, Applicant has therefore amended the identification of goods to accurately and more specifically identify the composition of the goods. Applicant has adopted an amended goods description in accordance with the Examining Attorney's guidelines to -- Contactors and contactor probe cards, made of Micro-Electro-Mechanical Systems (MEMS) material including mechanical elements, sensors, actuators, and electronics on a common silicon substrate, for use in testing equipment to test electronic circuits and electronic devices, namely, semiconductor wafers, integrated circuits, printed circuit boards, semiconductor chips, and packaged semiconductor devices, in international class 9.--

In accordance with the Examining Attorney's request, the revised identification of goods clause accurately and specifically describes the use of silicon in Applicant's goods. The revised identification of goods is therefore believed to be definite in all respects.

**II. REFUSAL TO REGISTER**

The Examining Attorney has refused registration of Applicant's mark on the Principal Register because the mark is purportedly merely descriptive of contactors and contactor probe

cards, made of Micro-Electro-Mechanical Systems (MEMS) material including mechanical elements, sensors, actuators, and electronics on a common silicon substrate.

As discussed below, we believe that not only did the U.S. Patent and Trademark Office fail to meet its burden of showing by clear evidence that Applicant's mark is primarily merely descriptive (See In re Pennzoil Products Co., 20 USPQ2d 1753, 1758 (TTAB 1991)), but Applicant's mark is in fact not primarily merely descriptive. "There is a thin line between a suggestive and a merely descriptive designation, and where reasonable men may differ, it is the Board's practice to resolve the doubt in applicant's favor and publish the mark for opposition." In re Intelligent Medical Sys. Inc., 5 USPQ2d 1674, 1675 (TTAB 1987); In re Aid Labs. Inc., 221 USPQ 1215, 1216 (TTAB 1983); In re Gourmet Bakers, Inc., 173 USPQ 565, 565 (TTAB 1972).

In support of the merely descriptive refusal, the Examining Attorney has submitted the following:

- A. Nexis and Internet articles showing use of the term FINGER in relation to circuit boards;
- B. A dictionary definition of the term FINGER; and
- C. An assertion that "SILICON describes the material content" of Applicant's goods.

The Examining Attorney maintains that the three above referenced items demonstrate that Applicant's mark is primarily merely descriptive. However, as discussed below, the mark is susceptible to multiple connotations, and the purchasing public must engage in imagination, cogitation, or gathering of further information in order to perceive any significance in the mark as it relates Applicant's goods. In re Disc Jockeys Inc., 23 USPQ2d 1715, 1716 (TTAB 1992)(citing In re Uniroyal, Inc., 215 USPQ 716 (TTAB 1982)). Accordingly the mark is at a minimum suggestive, not descriptive, and the refusal should be withdrawn. See also In re Atavio Inc., 25

USPQ2d 1361, 1362 (TTAB 1992)(“One which is only suggestive requires some imagination, thought or perception to determine its meaning in relation to the goods.”)

**A. "Finger" Used in Relation to Circuit Boards**

As discussed at length in Applicant's Responses filed February 14, 2002 and March 31, 2003, Applicant's goods do not relate to circuit boards, but are instead directed towards testing devices. See also Declaration of Robert Keith Lee. In the Office Action dated July 9, 2003, the Examining Attorney appears to acknowledge Applicant's position that the goods are not circuit boards, yet the Examining Attorney cites additional literature showing that the "term FINGER is commonly used in reference to parts found on circuit boards."

Applicant reiterates its position that the goods are not circuit boards. Applicant's contactors and contactor probe cards, are testing equipment used to test electronic circuits and electronic devices. Assuming *arguendo* that circuit boards include "fingers," it does not follow that Applicant's testing devices include circuit board fingers. Thus, Applicant's mark should be considered at least suggestive, as imagination, thought, or perception would be required to reach a conclusion as to the nature of Applicant's goods. TMEP § 1209.01(a). Use of the term "Finger" in relation to circuit boards is not relevant to the registrability of Applicant's SILICON FINGER mark.

**B. Dictionary Definition of the Term "Finger"**

Acknowledging that Applicant's goods are not circuit boards, the Examining Attorney states "[e]ven if the finger mentioned ... is not the same type of finger of applicant's goods, the term is nonetheless descriptive. FINGER as defined is something that resembles a finger."

The Examining Attorney has cited a dictionary definition of "Finger" to show that the mark is descriptive. As shown in the definition cited by the Examining Attorney, the term has multiple

meanings, the first and foremost of which is clearly not descriptive of Applicant's goods. The primary meaning to the public would be "any of the five terminating members of the hand," as demonstrated by the number one (1) placement in the Merriam-Webster dictionary cited by the Examining Attorney. Thus, the mark is not descriptive.

Further, a dictionary definition is never conclusive on the issue of descriptiveness since it gives undue value to the perceptions of the lexicographer. Applicant in turn points to the definition of the Cambridge Dictionary, which does not support the claim that the mark is primarily merely descriptive.

"[A]ny of the long thin separate parts of the hand, especially those which are not thumbs" (available at <http://dictionary.cambridge.org/>).

Where such a conflict exists, the examining attorney should allow the application to be published for opposition. In re Sundown Tech. Inc., 1 USPQ2d 1927, 1928 (TTAB 1987); In re Men's Int'l Professional Tennis Council, 1 USPQ2d 1917, 1918 (TTAB 1987); In re Jim Crockett Promotions Inc., 5 USPQ2d 1455, 1456, n.5 (TTAB 1987).

**C. Silicon Does Not Describe "The Material Content" of Applicant's Goods**

As set forth more fully in the attached Declaration of Robert Keith Lee, it would be improper to simply state that "SILICON is the material content" of Applicant's SILICON FINGER goods. The components of Applicant's goods are Micro-Electro-Mechanical Systems (MEMS) material, fabricated using a MEMS process from a MEMS vendor. Applicant's MEMS material is comprised of a silicon-on-insulator (SOI) substrate (base) with an electroplated metal alloy composition. MEMS is the integration of mechanical elements, sensors, actuators, and electronics on a common silicon substrate through microfabrication technology.

While the electronics are fabricated using integrated circuit (IC) process sequences (e.g.,

CMOS, Bipolar, or BICMOS processes), the micromechanical components are fabricated using compatible micromachining processes that selectively etch away parts of the silicon wafer or add new structural layers to form the mechanical and electromechanical devices. Declaration of Robert Keith Lee ¶¶ 5-8.

Applicant's goods cannot be accurately described by the statement that "silicon is the material content" of the goods.

**D. Viewing the Mark in its Entirety**

When analyzing a mark to determine whether the mark is merely descriptive or suggestive, the mark must be considered in its entirety. "[T]he commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason, it should be considered in its entirety." Estate of P.D. Beckwith, Inc. v. Commissioner of Patents, 252 U.S. 538, 545-46 (1920).

Applicant's use of SILICON and FINGER with respect to "contactors and contactor probe cards, made of Micro-Electro-Mechanical Systems (MEMS) material including mechanical elements, sensors, actuators, and electronics on a common silicon substrate, for use in testing equipment to test electronic circuits and electronic devices, namely, semiconductor wafers, integrated circuits, printed circuit boards, semiconductor chips, and packaged semiconductor devices" creates ambiguity or incongruity, thus requiring customers to pause and reflect upon the significance of the combination of the two terms. Although Applicant has demonstrated that the terms "silicon" and "finger" should not be considered descriptive of Applicant's goods even when viewed separately, a mark that combines descriptive terms may be entitled to registration if the composite creates a mark with a separate, non-descriptive meaning. See e.g., Plyboo American Inc. v. Smith and Fong Co., 51 USPQ2d 1633 (TTAB 1999).

The mere combination of SILICON and FINGER does not convey the exact nature of the goods. The combination renders Applicant's mark unique or incongruous since the combination of the two words does not result in a designation that has a plain and readily understood meaning for any goods. See e.g., In re Shutts, 217 USPQ 363 (TTAB 1983)(SNO-RAKE held not merely descriptive of snow removal hand tool); In re Colonial Stores, Inc., 157 USPQ 382 (CCPA 1968)(SUGAR & SPICE held not merely descriptive of bakery products).

**III. CONCLUSIONS**

In view of the foregoing, applicant has resolved the identification of goods objection raised by the Examining Attorney. Applicant respectfully requests reconsideration of the final refusal under Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1), in light of the foregoing and the attached Declaration of Robert Keith Lee.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment and Request for Reconsideration, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 1/9/2004

By: 

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Trade Mark Application of:

**ADVANTEST CORPORATION**

International Class: 9

Serial No: 76/235,496

Law Office: 108

Filed: April 5, 2001

Examining Attorney: Angela Micireli

Mark: **SILICON FINGER**

**DECLARATION OF ROBERT KEITH LEE**

I, Robert Keith Lee, hereby state as follows:

1. I am currently the General Manager of the Custom Design Engineering Department of Advantest America, Inc., located at 1100 Busch Parkway, Buffalo Grove, IL 60089.

2. Advantest America, Inc. is a subsidiary of Applicant, Advantest Corporation (hereinafter collectively "Advantest").

3. I have worked for Advantest for over twenty years and have worked in the semiconductor industry since 1978.

4. I earned the degree of Bachelor of Science in Electrical Engineering from Auburn University and have taken graduate studies in Electrical Engineering from Lehigh University.

5. The components of Advantest's SILICON FINGER are in fact Micro-Electro-Mechanical Systems ("MEMS") material, fabricated using a MEMS process from a MEMS vendor.

6. MEMS is an industry standard acronym for Micro-Electro-Mechanical Systems.

7. MEMS is the integration of mechanical elements, sensors, actuators, and electronics on a common silicon substrate through microfabrication technology. While the electronics are fabricated using integrated circuit (IC) process sequences (e.g., CMOS, Bipolar, or BICMOS processes), the micromechanical components are fabricated using compatible "micromachining" processes that selectively etch away parts of the silicon wafer or add new structural layers to form the mechanical and electromechanical devices.

8. Advantest's MEMS material is comprised of a silicon-on-insulator (SOI) substrate (base) with an electroplated metal alloy composition. Accordingly, it would be improper to simply state that "SILICON is the material content" of Advantest's SILICON FINGER goods.

9. Advantest's application of the MEMS components is as probes attached to a probecard for testing semiconductor wafers.

10. Probecards are not circuit boards. Probecards are consumable interconnect products used to temporarily connect (probe) a semiconductor wafer under test to an automated test system (ATE) during the test process in manufacturing.

11. Industry standard terminology describes probecard probes as probing a semiconductor wafer under test. Standard commercial equipment used to transport a semiconductor wafer under test are known as "prober systems" or "probers".

12. FINGER is not an industry standard term applied to probecard probes. Standard commercial equipment used to transport a semiconductor wafer under test are not known as "finger systems" or "fingers" and would not be accurately described as such.

13. The SILICON FINGER mark should not be considered descriptive of MEMS probe components, as the description of Advantest's SILICON FINGER goods would be "Micro-Electro-Mechanical Systems material probes".

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, declares that the foregoing is true and correct under penalties of perjury.

Signed by:

  
Robert Keith Lee

Executed on:

1-8-04