Mailed:
March 22, 2006
Walters

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Veeco Instruments, Inc.

Serial No. 76383240

John P. Fredrickson of Boyle, Fredrickson, Newholm, Stein & Gratz for Veeco Instruments, Inc.

Barbara A. Loughran, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Walters, Bucher and Zervas, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Veeco Instruments, Inc. has filed an application to register on the Principal Register the mark DIGITAL INSTRUMENTS, in standard character form, for, as amended, "scientific and technological research and development of products for others, namely, atomic force microscopes and

scanning tunneling microscopes, in the field of metrology," in International Class 42.[1]

The examining attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark is merely descriptive in connection with its services. Applicant argued against the refusal and, in the alternative, filed an amendment alleging that its mark has acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f). The examining attorney continued the refusal to register on the ground of mere descriptiveness and, further, refused applicant's claim of acquired distinctiveness on the ground that the mark is generic in connection with applicant's services and, thus, incapable of acquiring distinctiveness. Both refusals were made final.

Applicant has appealed. Both applicant and the examining attorney have filed briefs.

Mere Descriptiveness

Because applicant expressly made its claim of acquired distinctiveness pursuant to Section 2(f) of the Trademark

[1] Serial No. 76383240, filed March 12, 2002, based on use of the mark in commerce, alleging first use anywhere and use in commerce as of January 1, 1987.

Act in the alternative, we must consider, first, whether DIGITAL INSTRUMENTS is merely descriptive in connection with the identified services. The examining attorney contends that the mark merely describes the goods which are the subject of applicant's services; that such goods are "'instruments' that provide and/or process highly precise 'digital' measurements" (brief, p. 6) within the common dictionary meanings of the terms "digital" and "instruments"; and that the composite mark has the same descriptive meaning as the individual components thereof.

Applicant contends that the terms "digital" and "instruments" are so vague and variously defined, whether considered individually or in the composite, that the mark does not immediately convey the nature of applicant's services or the goods that are the subject of those services; that the record contains no evidence that the composite mark would be connected by relevant consumers to atomic force microscopes or services related thereto; and that the examining attorney has improperly dissected the mark in reaching her conclusion.

The evidence in the record includes dictionary definitions of "digital," "instruments" and "metrology," and excerpts from various Internet websites submitted by

both applicant and the examining attorney. "Metrology" is defined in *The American Heritage Dictionary of the English Language* (4th ed. 2000) as "1. The science that deals with measurement. 2. A system of measurement." The term "digital" is defined in pertinent part as follows:

> 3 – of, relating to, or using calculation by numerical methods or by discrete units, 4 – of or relating to data in the form of numerical digits, 5 – providing a readout in numerical digits …. (*Merriam-Webster Dictionary*, www.m-w.com)
>
> 4 – expressed in numerical form, especially for use by a computer, 5 – *Computer Science* – of or relating to a device that can read, write or store information that is represented in numerical form …. (*The American Heritage Dictionary of the English Language*, 4th ed. 2000, www.dictionary.reference.com)
>
> 3 – *Electronics* – of a circuit or device that represents magnitudes in digits …. (*WordNet* 1.6, 1997, Princeton University, www.dictionary.reference.com)

Additionally, applicant would have us note that the term "digital" includes the following definitions that are not at all pertinent to the services involved in this case:

> 1 – of or relating to the fingers or toes … 6 – relating to an audio recording method in which sound waves are represented digitally (as on magnetic tape) so that in the recording wow and flutter are eliminated and background noise is reduced. (*Merriam-Webster Dictionary*, www.m-w.com)

The term "instrument" is defined in pertinent part as follows:

> 4 – a device for recording, measuring, or controlling …. (*The American Heritage Dictionary of the English Language*, 4th ed. 2000, www.dictionary.reference.com)
>
> 1 – a device that requires skill for proper use …. (*WordNet* 1.6, 1997, Princeton University, www.dictionary.reference.com)

Additionally, applicant would have us note that the term "instrument" includes the following definitions that are not at all pertinent to the services involved in this case:

> (1) a means by which something is done; an agency. (2) one used by another to accomplish a purpose; a dupe. (5) *Music* – a device for playing or producing music. (6) a legal document, such as a deed, will, mortgage, or insurance policy. (*The American Heritage Dictionary of the English Language*, 4th ed. 2000, www.dictionary.reference.com)

The examining attorney submitted a product list from applicant's website; however, the use of the term DIGITAL INSTRUMENTS therein is arguably a trademark use. The examining attorney also submitted excerpts from several third-party websites wherein the phrase "digital instrument" is used. One site appears to be sponsored by a company named Quesant, which is described as a manufacturer of scanning probe microscopes and, as applicant admits, a competitor of applicant. Quesant states the following in a paragraph describing its business: "SPM [scanning probe

microscope] usage continues to grow as a wide range of digital instruments." Applicant contends that this is an infringing use of its mark and that the sentence is nonsense. We agree with applicant that this evidence is of minimal probative value due to the puzzling nature of the sentence.

The following are examples from the other excerpted websites:

> Guideline Instruments [Ontario, Canada] … can claim a track record and an outstanding reputation unparalleled in the field of electrical metrology.
>
> In 1967 two of [the company's products], the resistance and voltage comparators[,] were awarded the prestigious U.S. Industrial Research Award as one of "the most significant new products of the year." …
>
> Our presence in these laboratories is due in part to the fact that today's standards laboratories are required to make measurements well outside the precision and accuracy of conventional potentiometers and ***digital instruments***. To satisfy these requirements, Guildline manufactures a broad range of metrological instrumentation including … nanovoltmeters …. (www.guideline.ca)

> Why Calibrate Test Equipment?
>
> You're serious about your electrical test instruments. You buy top brands, and you expect them to be accurate. You know some people send their digital instruments to a metrology lab for calibration, and you wonder why. …
>
> Calibration typically requires a standard that has at least 10 times the accuracy of the instrument under test. …

> What knocks a ***digital instrument*** "out of cal?"
>
> While this article focuses on calibrating DMMs, the same reasoning applies to your other handheld test tools, including process calibrators. (www.coleparmer.com)

> New Instruments Bring Functions of Recently Released PXI Mixed-Signal Suite to Desktop PCs …
>
> "In a matter of months, we leveraged the SMC architecture that we developed for the PXI instruments to quickly deliver this complete set of analog and ***digital instruments*** for PCI," said Tim Dehne. … (www.siliconstrategies.com)

> Bowers Metrology [UK] have recently been awarded a prestigious order for supplying measuring instruments to the Bae Eurofighter Combat Aircraft project. This groundbreaking aircraft requires a completely new and innovative approach to measurement ….
>
> Bowers over the last few years has been busy extending their range to encompass every conceivable hand-held measuring instrument under the System Synergy banner.
>
> This comprehensive range of ***digital instruments*** has the advantage of a common two button operating mode, all with an RS232 output for data collection, improved ergonomics for ease of use and shop-floor ruggedness at a cost effective price. (www.manufacturingtalk.com)

The examining attorney also submitted an excerpt from *ThomasNet – Thomas Register Directory* containing a listing of companies under the heading "Metrology Instruments." The following entries are excerpted descriptors for several of the twenty-five companies listed:

- Gage calibration center, length-measuring machines, bore gages, … machinists' levels …
- complete line of pressure measurement instruments … analog and digital pressure transducers, hand-held calibrators …
- New flexible shaft measuring systems demonstrate speed, versatility, accuracy …
- Applications include mapping, industrial metrology and navigation and control …
- Full line of optical inspection instruments … a new low-cost depth-measuring microscope with miniature color viewing system …
- Products include 3D measurement hardware, software and service products to bring measurement to the factory floor…
- Complete line of electronic digital indicators available…
- Portable, non-contact, laser-based dimensional measurement and surface contour analysis instruments …
- Mfr. of automated vision and laser-based 3D measuring systems with sub-micron accuracy for surface finish and structure. Non-contact measurements include profiles, flatness, waviness, step height, contours, roughness and warpage of most materials…

Applicant submitted its informational brochure as a specimen of use and copies of its advertisements and product literature; five third-party registrations and an application for marks that include the individual terms "digital" or "instruments"; a list of four third-party registrations for marks including either the terms "electrical," "apparatus," "device" or "equipment," that applicant argues are so broad as to be non-descriptive; excerpts from third-party websites that use the individual terms "digital" or "instrument" in connection with goods

unrelated to those herein; website excerpts for companies in the fields of nanotechnology and molecular imaging to show that other companies in applicant's field do not use the term "digital instruments"; and applicant's declaration of facts in support of its alternative Section 2(f) claim.

The third-party registrations are shown below:

- DIGITAL TEST LAB for consumer research, analysis and news services relating to digital products (Reg. No. 2663250);
- LEARNING INSTRUMENTS for computer hardware and software, INSTRUMENTS disclaimed (Reg. No. 2019507);
- CONTROL INSTRUMENTS for electronic gas detection meters, INSTRUMENTS disclaimed (Reg. No. 1468036);
- DIGITAL RESEARCH TECHNOLOGIES for computer peripherals, DIGITAL and TECHNOLOGIES disclaimed (Reg. No.2254252);
- DIGITAL NATURE TOOLS for computer software, DIGITAL disclaimed (Reg. No. 2264382); and
- Pending application (No. 75909953) for DIGITOOL INSTRUMENTS for scientific measuring equipment, INSTRUMENTS disclaimed.

The fact that the terms "digital" and "instruments" are disclaimed in all but one of these registrations tends to support the examining attorney's position that the individual terms are descriptive. Applicant's list of registrations with other allegedly broad terms are of no probative value because applicant did not submit copies of those registrations and, thus, we do not know what register the marks are on or whether they include disclaimers. In any event, these registrations, for marks so different from

the mark involved herein, are of limited value because we must decide each case on its particular facts.

The information contained in applicant's material about its services and its featured goods includes the following statement:

> Scanning Probe Microscopes (SPMs) are a family of ***instruments*** that are used to measure properties of surfaces, …. In their first applications, SPMs were used solely for measuring 3D surface topography and, although they can now be used to measure many other surface properties, that is still their primary application. SPMs are the most powerful tools for surface metrology of our time, measuring surface features whose dimensions are in the range from interatomic spacing to a tenth of a millimeter. … As opposed to optical microscopes and Scanning Electron Microscopes (SEMs, TEMs), SPMs measure surfaces in all three dimensions: x, y and z. Like SEMs, SPMs image and measure the surface of the sample. (applicant's specimen – Exhibit 1 to Response received January 9, 2003. Emphasis added.)

Another excerpt from applicant's own materials entitled "Triple DAC Configuration in NanoScope Controllers, Superior Control, Resolution, and Flexibility" includes the following statements:

> The system controller is a critical component of any … SPM system. … The DAC configuration is an integral part of the ***digital*** feedback loop in any controller, and plays a major role in its level of control, accuracy, resolution, and noise.
>
> . . .
>
> A **digital**-to-analog converter (DAC) converts a ***digital*** output signal into an analog voltage.

> SPMs use DACs in their feedback loop to convert a **digital** control signal from the computer into an analog voltage, which is sent to the piezoelectric scanner for movement in x, y, and z. (Emphasis added.)

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Furthermore, when the mark involves more than a single term, we must consider whether the mark as a whole is merely descriptive and not just the individual elements. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004).

While applicant argues that the multiple different definitions for the two words comprising its mark require a multistage reasoning process to determine the nature of applicant's goods, we note that it is well-established that

the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); *see also In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985); and *In re Recovery*, 196 USPQ 830 (TTAB 1977).

The literature submitted by applicant touts its research and development and the individualized service it provides, and describes its products as leading the field. It is clear that applicant's products relating to its services are highly sophisticated scientific "instruments" that utilize "digital" technology. There is no question that the individual terms retain their ordinary dictionary meanings in the composite mark DIGITAL INSTRUMENTS. "Instruments" describes the products that are the subject of applicant's identified services. "Digital" modifies "instruments" and further describes a salient feature of

these products because, certainly, without digital technology, these highly sophisticated products would not exist. The combination of these two words into the term DIGITAL INSTRUMENTS does not create a connotation that is unique or different from the ordinary meanings of the two individual words. Further, the mere fact that the two words have broad meanings, either individually or as a composite, does not render the mark registrable. *See In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988).

It is apparent, as applicant points out, that the purchasers of its identified goods and services are highly sophisticated in this area of technology and that the question of mere descriptiveness of a mark must be determined not from the standpoint of all consumers, but rather from the standpoint of the relevant purchasing public of the goods and/or services for which registration is sought. *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552-53 (Fed. Cir. 1991); and *In re Montrachet S.A.*, 878 F.2d 375, 11 USPQ2d 1393, 1394 (Fed. Cir. 1989). However, there is no indication that the relevant sophisticated purchasers would attribute to the term DIGITAL INSTRUMENTS any unique connotation other than the common dictionary meanings of the two individual words

and, thus, they, too, would perceive of the mark as merely descriptive in connection with the identified goods and services.

In conclusion, when applied to applicant's goods and services, the term DIGITAL INSTRUMENTS immediately describes, without conjecture or speculation, a significant feature or function of applicant's goods and services, as indicated above. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's goods and services to readily perceive the merely descriptive significance of the term DIGITAL INSTRUMENTS as it pertains to applicant's goods and services.

Genericness

In view of our finding that the mark DIGITAL INSTRUMENTS is merely descriptive in connection with the identified services, we now consider, further, whether it is a generic term for such services. The examining attorney contends that, as the two individual terms are defined in the dictionary evidence, the goods which are the subject of applicant's services are "digital instruments"; and that the evidence of record shows that the term "is

used by members in the relevant field of metrology as the generic name of the class of goods into which the applicant's goods clearly fall and about which the applicant's services are concerned" (brief, p. 9); and that the mark "defines the name of a category of INSTRUMENTS that use or incorporate DIGITAL parameters or measurements" (brief, p. 11).

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 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).

As noted, *supra*, the services identified in the application are "scientific and technological research and development of products for others, namely, atomic force microscopes and scanning tunneling microscopes, in the field of metrology." Therefore, we must, first, determine the genus of these services. The examining attorney contends that the focus of applicant's services is to develop the particular noted products and, therefore, if the mark identifies the genus of the products produced by applicant in connection with its research and development services for others, then the mark is also generic in connection with these services.

Although the examining attorney makes no specific finding as to the genus of the relevant goods or services, she refers several times to "the field of metrological measurement." Her evidence encompasses the entire field of metrological measurement, which appears to include, at one

end of the spectrum, small hand-held measuring devices for use in a shop and, at the other end of the spectrum, highly sophisticated microscopes and devices for measuring aspects of sub-atomic particles. We find that this is so overly broad as to be meaningless as a genus for applicant's services. In the absence of any other evidence herein, we find that the genus of services is more appropriately narrowed to those services pertaining to the research and development of atomic force microscopes and scanning tunneling microscopes. An example, by analogy, would be if we had to determine whether a mark pertaining to tractor-trailer trucks is generic. A genus of vehicles would be over-broad because it would encompass all vehicles from tractor-trailer trucks to motor scooters; and evidence that the term is generic for motor scooters or a part for scooters would be irrelevant unless we had specific evidence also pertaining to the use of the term in connection with tractor-trailer trucks or parts therefor. Thus, the correct genus in our example would be much narrower - tractor-trailer trucks rather than vehicles. It is yet another step to determine what would be the appropriate genus for services related thereto.

In this case, we must agree with applicant that, aside from the dictionary definitions, the evidence of record primarily pertains to products that are quite different from those that are the focus of applicant's services, albeit within the broad field of metrology. However, there is insufficient evidence from which to determine whether relevant purchasers would view the composite mark "digital instruments" as the name of the class of services to which applicant's services belong, or that it would similarly name the class of goods which are the subject of applicant's services. Therefore, we must conclude that the examining attorney has fallen far short of meeting her stiff burden of establishing genericness herein.[2]

Acquired Distinctiveness

Having determined that the mark is merely descriptive in connection with the identified services, but that genericness has not been established, we now consider applicant's claim of acquired distinctiveness under Section 2(f) of the Trademark Act. Applicant specifically requested that, in the event the mark is found not to be generic, the examining attorney address whether its

[2] We note, however, that in reaching our decision we did not find applicant's arguments regarding the vagueness of the involved terms (see *In re Analog Devices Inc., supra*), or the third-party registrations for either the individual words comprising the mark or for other marks to be persuasive.

evidence establishes acquired distinctiveness. The examining attorney should have considered the sufficiency of the claim of acquired distinctiveness in the alternative during examination, regardless of applicant's request. However, other than her statements that the mark is generic and, thus, no amount of evidence of acquired distinctiveness would suffice, the examining attorney made no comment at all about applicant's evidence of acquired distinctiveness until her brief in this appeal. In her brief (p. 12), the examining attorney made the following statement: "[a]pplicant has submitted evidence of long use and substantial sales, advertising expenditures and promotional efforts related to its DIGITAL INSTRUMENTS mark. The examiner does not challenge that the applicant has indeed used its mark extensively."

We conclude that the examining attorney's statement coupled with the absence of any statements finding deficiencies in applicant's claim of acquired distinctiveness to constitute an acceptance, in the alternative, by the examining attorney of the Section 2(f) claim. We find, moreover, that the declaration submitted by applicant in support of its claim of acquired distinctiveness contains facts sufficient to support this

conclusion. The declaration attests to use of the mark in connection with the goods and services for more than fifteen years; that applicant produced the first atomic force microscope, is the leader in this field, and holds numerous patents; that applicant has won awards for its products and research; that its DIGITAL INSTRUMENTS scanning probe microscope systems range in price from $80,000 to $1,600,000 and are primarily purchased by universities; and that, in view of the pricing and limited consumer base, its annual sales and advertising are substantial.

Decision: The refusal under Section 2(e)(1) of the Act on the ground that the mark is merely descriptive is affirmed; however, the refusal on the ground that the mark is generic is reversed. Applicant's amendment to seek registration under Section 2(f) of the Act is accepted.

The registration will issue in due course on the Principal Register with a claim of acquired distinctiveness under Section 2(f) of the Trademark Act.

Bucher, Administrative Trademark Judge, concurring in part and dissenting in part:

Earlier in the digital age, a panel of this Board was most prescient in anticipating the present case. In discussing the term "analog devices," the Board identified its emerging counterpart, "digital devices," as a hypothetical term that a future applicant might argue is too "broad," "nebulous" or "vague" to be deemed generic:

> We are satisfied from the foregoing evidence that "analog devices" is a generic designation, within the guidelines set forth in the Ginn decision, *supra*, and that the term cannot be exclusively appropriated by a single entity. Applicant argues that the term is too nebulous and vague to be commercially useful for competitors of applicant to use to describe any products. However, while we readily concede that the category of products which the term "analog devices" names encompasses a wide range of products in a variety of fields, we do not believe this fact enables such a term to be exclusively appropriated by an entity for products, some of which fall within that category of goods. For example, while terms such as "***digital devices***," "computer hardware," "computer software" and "electronic devices," just to name a few, *may be broad and even nebulous terms, nevertheless, these terms may not be exclusively appropriated but must be left for all to use in their ordinary generic sense*.

In re Analog Devices Inc., 6 USPQ2d 1808 (TTAB 1988) [***emphasis*** supplied].

The word "Instruments"

According to dictionary entries of record, an "*instrument*" is 'a *device* for measuring' … 'that requires skill for proper use.' Applicant's trade name is "Veeco *Instruments*," and not surprisingly, applicant uses the term "instruments" in a generic fashion to name the devices that it allegedly researches and develops for others.

According to applicant's website, scanning probe microscopy (SPM) describes a family of *instruments* that measure the surface properties of materials to a high degree of resolution. The relevant instruments include atomic force microscopes (AFM) and scanning tunneling microscopes (STM). Consistent with the dictionary definitions, these high-tech devices certainly require a high level of skill for proper operation.

The word "Digital"

According to dictionary entries of record, "digital" is defined, *inter alia*, as 'providing a readout in numerical *digits*,' 'a device that can read, write or store information,' or 'a device that represents magnitudes in *digits*.'[3]

[3] We must look at the alleged mark in the context within which it is used. Hence, I do not take seriously applicant's

As pointed out by the majority, "without digital technology, these highly sophisticated products would not exist." Indeed, various dictionary connotations of the word "digital" keep resurfacing when one reads through the specification of applicant's named devices. For example, these instruments rely on proprietary data-acquisition and image-processing software to produce high quality *digital* images. As pictured, some SPM instruments have *digital* displays (not unlike *digital* watches) as well as analog displays. Applicant's website explains that an integral hardware component of any SPM system is a sophisticated controller. A *digital* signal processor (DSP) converts analog signals to *digital* signals and can convert *digital* output signal into an analog voltage. It appears various SPM instruments have a "*digital* feedback loop" while others discuss "analog feedback systems." As opposed to having components with mixed analog and *digital* circuitry, presumably *fully-digital* microscopes implement all the controller system functionalities in software.

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argument that this designation cannot be generic because the word "digital" could also mean, for example, "relating to the fingers or toes."

The field of metrology

In 1998, applicant acquired a company known as Digital Instruments – at that point a manufacturer and distributor of scanning probe microscopes like AFMs.[4] The affected instruments do surface metrology, and are used primarily in basic research applications at universities around the world (materials science, nanotechnology, life sciences, etc.), in national standards labs, as well as increasingly in commercial projects, such as wafer/chip testing in the semiconductor industry, aerospace and biotechnology. Applicant's highly sophisticated scientific "instruments" all fit into the broad field of "metrology," or the science of measurement.

This is relevant to the first question of *Marvin Ginn*, *supra*, which focuses on the genus of applicant's services. The Trademark Examining Attorney concluded that the genus of the relevant services encompasses activities related to the development, sale and distribution of metrological devices generally. The majority objects to this as being

[4] According to the letterhead submitted as the specimen of record – and consistent with other information in the record – this unit has now become part of the "Veeco Metrology Group" within Veeco Instruments.

overly broad. Rather, the majority holds that the genus of services should be narrowed to researching and developing scanning probe microscopes.

As gleaned from applicant's literature and the Internet sources the Trademark Examining Attorney placed into the record, there is quite a range in the scale of precision measurements within the field of metrology.

- Applicant's nanoscale metrological devices are able to create three-dimensional images on a scale of one to 100 nanometer(s) (e.g., a nanometer is one-billionth of a meter). This represents imagery and manipulation at the atomic or molecular level.
- At the other end of the spectrum of metrological instruments, one finds more conventional measuring tools like mechanical micrometers that have been available in industrial machine shops for decades.
- In between machine tools and nanotechnology, along a continuum of orders of magnitude of measurement, are increasingly precise metrological instruments.
- For example, right before getting to the twenty-first century nanoscale, one reaches twentieth-century microtechnology -- matter on the size scale of microns (expressed as 1 millionth of a meter, one

micrometer, 10^{-6} meters, or 1µm). Microelectronics, or integrated circuits, which form the basis of substantially all of our digital products, have traditionally been fabricated in the sub-micron dimension.

- Because there are not clear lines of delineation here – both in fundamental research and in commercial manufacturing, there is substantial overlap in the range of some instruments between the microscale and nanoscale.[5]

Third party uses of the term "digital instruments"

Against this background, it certainly behooves us to look more closely at the third-party uses of the term "digital instruments" within the field of metrology that the Trademark Examining Attorney has placed into the record to determine their relevance and probative value to the question of genericness.

(1) Bowers Metrology, a company in the United Kingdom, custom built high precision gauging

[5] In fact, applicant's own literature demonstrates this range from nanoscale to features that one can see with the naked eye:
> SPMs are the most powerful tools for surface metrology of our time, measuring surface features whose dimensions are in the range *from interatomic spacing to a tenth of a millimeter*. [*Emphasis* supplied].

instruments for testing the quality of construction on the Typhoon EuroFighter at BAe Systems' Samlesbury plant. These testing devices now have digital readouts as contrasted with the older analog dials. They also offer a standard computerized interface for data communications equipment [RS232 or EIA232], or a *digital* link to a computer. According to the article, in order to guarantee that the rivets are sufficiently flush with the skin of the aircraft, Bowers' "conventional equipment was rendered practically useless." Stealth technology requires a high degree of accuracy (e.g., on the order of microns).

(2) The Cole-Parmer article focuses on calibrating digital multimeters (DMMs) and process calibrators. A DMM samples electrical inputs to give very accurate readings of voltage, current, or ohms, while a process calibrator measures flows of electricity accurately to the scale of millivolts and/or milliamperes. Again, these are measurements on an extremely small scale.

(3) Guideline Instruments of Ontario, Canada manufactures a broad range of metrological instrumentation including nano-voltmeters. Guideline

provides nanoscale electric metrology for national standards laboratories, much as applicant provides nanoscale surface metrology to these same customers. According to Guideline's webpage, their state-of–the-art devices are also required to make measurements well outside the precision and accuracy of conventional potentiometers and older digital instruments.

(4) The web page from the Australian National Measurement Laboratory,[6] like the Cole-Parmer article, points out that calibration is a critical piece of characterization and metrology. In fact, these articles make reference to various specific numbered standards set by the International Standards Organization (ISO) – an International organization working with the United Nations that maintains standards for all applications of high technology for global industry.

(5) The Trademark Examining Attorney shows that ThomasNet.com, the online listing of industrial information, products and services provided by

[6] This is the Australian counterpart to the National Institute of Standards & Technology (NIST), the standards-defining agency of the US government (formerly the National Bureau of Standards).

ThomasRegister, has a category of “Digital Instruments” where the products are industrial measuring instruments, gauges, force and load indicators, precision imaging, inspection, measurement, and temperature-control instrumentation, etc. Among the entries the Trademark Examining Attorney placed into the record, are descriptors such as “complete line of *electronic digital indicators* available …,” “Mfr. of automated vision and laser-based *3D measuring systems with sub-micron accuracy for surface finish and structure*,” “*Non-contact measurements* include profiles, flatness, waviness, step height, contours, roughness and warpage of most materials …,” and “*analog and digital* pressure transducers,” etc. In fact, individual company’s listings of specific *digital instruments* are routinely paired with *analog devices* designed to measure the same metric.

(6) The *Silicon Strategies* article targeted to semiconductor professionals contains a discussion of virtual instrumentation for test, control and design. Named components include analog inputs and outputs, digital inputs and outputs, and a digital signal

processor. The author highlights the ways in which a dynamic range, flexible-resolution digitizer solves demanding applications, such as characterization of high-resolution digital-to-analog converters (DACs) – itself an integral component of applicant's goods.

In the language of *Marvin Ginn*, *supra*, what is the genus of applicant's scanning probe microscopes? Applicant's industry uses a variety of ever-broadening terms for applicant's field of endeavor, from scanning probe microscopy to advanced electronic microscopy or nanoscale metrology. Judging by the evidence of record, "digital instruments," while definitely much broader than any one of these terms, is still an overarching category of goods that would include applicant's goods and services.

In short, I would argue from the uses the Trademark Examining Attorney pulled from the Internet that the goods that are the focus of applicant's claimed services are much closer to these third-party goods and services (e.g., micron-scale gauges, calibrators, nano-voltmeters, 3D sub-micron measuring systems, virtual instrumentation digitizers, etc.) than the majority has found them to be. The incredible breadth of the term "digital instruments" is reinforced by other evidence scattered throughout the

record showing use on items such as digital cameras, electronic keyboards, weather-related instruments, audio equipment, and the like. However, this widespread usage does not detract from the usages shown in connection with goods and services in the field of nanoscale metrology.

How is "Digital Instruments" understood by the relevant public?

I turn then to the second *Marvin Ginn* question, namely, whether the term sought to be registered is understood by the relevant public primarily to refer to that genus of goods or services.

In the *Analog Devices* case, the Board dismissed that applicant's claims that the term could not be generic because it was too "nebulous" or "vague." In a footnote, the majority expressly dismisses as unpersuasive this applicant's claims of "vagueness." And "nebulous" is a synonym for "vague." However, the majority reverses the Trademark Examining Attorney because "digital instruments" is an overly broad term. Hence, it follows from their conclusion that any number of device manufacturers or merchants of high-tech instruments in a variety of fields may exclusively appropriate the term "digital instruments." I disagree. By analogy, if the category is "things one can eat," the term "Food" is hardly "nebulous" or "vague." And

while it covers a multitude of very different items, it is generic for all of them.

Similarly, we have seen that “digital instrument” is used in connection with a very wide array of goods. Yet, its usage in these various contexts carries with it consistent and specific meanings. It often tells the consumer that the product has digital readouts, that it employs state of the art electronics, and in the context of metrology, that the device is capable of processing measurements with a high degree of precision.

Accordingly, I conclude from this record that manufacturers, merchants and ultimate users of a variety of metrology devices use the term “Digital Instruments” generically for precision measuring instruments that depend upon technologies quite similar to electron microscopy, that have similar digital readouts, etc.

We have seen that applicant, Veeco Instruments, uses the term “instruments” generically for these goods. Based upon the dictionary meanings, a digital instrument is a device with digital readouts, state of the art electronics, and/or having a high degree of precision in its measurements. Even the majority concludes, in fairly compelling and straightforward language, the highly

descriptive nature of this combined term (*supra* pp. 12 – 14). In spite of an unequivocal position on descriptiveness, the majority is hesitant to conclude that the relevant purchasers would view the composite mark "digital instruments" as the name of the class of goods or services involved herein.[7]

However, based on the entire record, I find that "Digital instruments" is merely a combination of generic terms that has no separate or distinct commercial impression apart from what one who understands the individual meanings of the terms would expect. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987);

[7] As I read the majority opinion, if my colleagues in the majority had found sufficient evidence of genericness as to the involved goods, they would have had no problem taking the additional step in this case, namely that a term which is generic for a particular class of goods is also deemed to be generic for an intimately-related class of services such as designing or developing those goods. *See e.g., In re Log Cabin Homes Ltd.*, 52 USPQ2d 1206 (TTAB 1999) [LOG CABIN HOMES generic for "architectural design of buildings, especially houses, for others"]. *See also In re Candy Bouquet International Inc.*, 73 USPQ2d 1883 (TTAB 2004) [CANDY BOUQUET generic for retail, mail, and computer order services in the field of gift packages of candy]; *In re CyberFinancial.Net, Inc.*, 65 USPQ2d 1789 (TTAB 2002) [BONDS.COM generic for providing information regarding financial products and services on the Internet and providing electronic commerce services on the Internet]; *In re A La Vielle Russie Inc.*, 60 USPQ2d 1895 (TTAB 2001) [RUSSIANART generic for a particular field or type of art and also for dealership services directed to that field]; *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224 (TTAB 1987) [LA LINGERIE generic for "retail store services in the field of clothing"]; and *In re Half Price Books, Records, Magazines, Incorporated*, 225 USPQ 219 (TTAB 1984) [HALF PRICE BOOKS RECORDS MAGAZINES generic for "retail book and record store services"].

In re Leatherman Tool Group Inc., 32 USPQ2d 1443 (TTAB 1994); and *In re Lowrance Electronics, Inc.*, 14 USPQ2d 1251 (TTAB 1989).

I find that the dictionary definitions alone are compelling. Assuming *arguendo* that the terms "digital" and "instruments" are individually considered generic, admittedly, a combination of generic terms can sometimes result in composite marks that are protectable.[8] In light of the admonitions of our primary reviewing Court in *American Fertility Society*, *supra*, although we still consider the dictionary definitions of the individual words as evidence of the likely perception of the whole term, the Trademark Examining Attorney must meet the rather heavy burden placed on the United States Patent and Trademark Office to demonstrate genericness through additional evidence of generic uses of the term.

Under the standard set by *American Fertility Society*, I find that the evidence of record of media usage of the term "digital instruments" shows it used as a lower case,

[8] *See In re Chesapeake Corp. of Virginia*, 164 USPQ 395 (CCPA 1970); *Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co.*, 186 USPQ 557 (TTAB 1975), aff'd., 189 USPQ 348 (CCPA 1976); *California Cooler Inc. v. Loretto Winery Ltd.*, 227 USPQ 808 (9th Cir. 1985); *Texas Pig Stands, Inc. v. Hard Rock Cafe Int'l., Inc.*, 21 USPQ 2d 1641 (5th Cir. 1992), reh'g., en banc, denied, 23 USPQ 2d 1639 (5th Cir. 1992).

generic term for precision measuring instruments that are not analog devices.

Admittedly, there is minimal evidence establishing generic use of the term "digital instruments" by manufacturers, distributors, sellers or consumers of competitive goods. And applicant's own web pages made part of the record do not contain any self-defeating uses of "digital instruments," i.e., use in a way that would be perceived as generic. However, its use of the term in the manner of a service mark is not determinative of the ultimate issue in this case. Any business could present a generic term on its website in a technically correct trademark fashion. But such a self-serving use would not reveal the likely perception of the relevant public when the term is displayed in its normal fashion.

Scanning probe microscopes are not "a newly created product category." See *In re Ferrero S.P.A.*, 24 USPQ2d 1155 (TTAB 1992); and *American Fertility Society* at 1345. Rather, this type of product has been available in the marketplace for almost two decades. Yet, the Trademark Examining Attorney found only a single example of a competitor's use of this exact phraseology in relation to scanning probe microscopy, and less than a dozen uses in

conjunction with nanoscale (and related microscale) metrological devices.

What might be the explanations for this dearth of third-party uses in the field?

For one, “digital instruments” is, indeed, a very broad term, and may have multiple connotations. Nonetheless, I would contend that all of these uses – whether signifying the form of the readouts, the computer hardware or the precision of the measurements, each and every one of the identified uses is still a generic usage.

Applicant positioning in the field may also be relevant. Applicant noted that more than fifteen years ago “[its] predecessor in interest produced the first commercially available atomic force microscope ….” On its website, applicant touts itself as “The World Leader in Scanning Probe Miscroscopy.” The record contains claims that applicant “dominates the scanning probe microscope market” and “applicant has sold more scanning probe microscopes than all other competitive systems combined.”

All the above factors may well account for the fact that most of applicant’s competitors have avoided use of the designation “digital instruments.” Nonetheless, having established that applicant’s “instruments” are

characterized as “digital” in a variety of critical ways, I conclude that “digital instruments” is one of those generic terms that any manufacturer (e.g., including applicant’s competitors), any merchant or any user of these scanning probing microscopes should be permitted to use to refer to this item, irrespective of its source.

As to the sole third-party usage in connection with competitive goods, in a response to an Office action, applicant took the position that “[a]pplicant strongly believes that the term ‘digital instruments’ was inserted by Quesant in an attempt to divert legitimate customers of the Applicant to Quesant’s website.” Of course, this exchange puts into sharp focus a critical query, the answer to which separates me from my colleagues in the majority: Can one of applicant’s competitor -- also a leading scanning probe microscope manufacturer, make the claim that it is “supplying quality digital instruments for metrology scanning” without potentially infringing applicant’s rights?

Furthermore, while the majority finds this term to be merely descriptive, I question the logic of how others in the field of nanoscale metrology could even use the term “digital instruments” in a manner that would be merely

descriptive, but not generic? And if others can use the phrase in a descriptive (or generic) manner, why should applicant be entitled to an exclusive registration even on the Supplemental Register? When used by others in the field of metrology, I conclude that "digital instruments" could be perceived as nothing other than the name of high technology measuring devices characterized by digital readouts, digital inputs and outputs, etc.[9]

I do appreciate the harsh result that flows from a finding by this Board and/or by our reviewing Court that a term is a generic designation. However, the other side of the coin is a real public policy interest in securing for all competitors the unencumbered right to use the names of generic terms ("*what*-are-you") for goods and services. After all, I am sure that the Court in *American Fertility Society* did not change the notion that "[a]ll of the generic names for a product belong in the public domain."

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[9] *See Filipino Yellow Pages Inc. v. Asian Journal Publications Inc.*, 198 F.3d 1143, 53 USPQ2d 1001 (9th Cir. 1999) ["In light of the evidence presented by [defendant], it would seem that under the 'who-are-you/what-are-you' test, the term 'Filipino Yellow Pages' is generic. … Giving [plaintiff] exclusive rights to the term 'Filipino Yellow Pages' might be inappropriate because it would effectively" grant a monopoly]. *See also Blinded Veterans Association v. Blinded American Veterans Foundation*, 872 F.2d 1035, 10 USPQ2d 1432 (D.C. Cir. 1989) [Ginsburg, R.B., J. held "'blinded veterans' is generic when used to refer to once-sighted persons who served in the armed forces," and the BLINDED VETERANS ASSOCIATION name therefore was not entitled to trademark protection].

In re Sun Oil Company, 426 F.2d 401, 165 USPQ 718, 719 (CCPA 1970).

Is this term Merely Descriptive?

The issue has also been joined as to whether this matter should be refused as being merely descriptive and lacking in acquired distinctiveness during the relevant time period. While my reasoning may be somewhat different, I reach the same conclusion as does the majority on this question. Namely, I find that all the same evidence reviewed above to support genericness also demonstrates, *a fortiori*, that the term was merely descriptive in 1987 and continues to be merely descriptive to the present.

Applicant's showing of Acquired Distinctiveness

If applicant's proposed mark is generic, as I have concluded it is, then no amount of evidence of acquired distinctiveness can establish that the mark is registrable. *In re Northland Aluminum Products, Inc.*, *supra* at 964. Even long and successful use of a term does not automatically convert a generic term into a non-generic term. *In re Helena Rubinstein, Inc.*, 410 F.2d 438, 161 USPQ 606, 609 (CCPA 1969). However, if I were to agree with the majority that this term is not generic, for the

sake of completeness, I turn to the sufficiency of applicant's proffered showing in support of its claim of acquired distinctiveness under Section 2(f) of the Act. On this issue, it is applicant's burden to establish a *prima facie* case of acquired distinctiveness. *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) ["There is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant"]. Further, as an alleged "mark's descriptiveness increases," it is logical that the amount of proof required to demonstrate acquired distinctiveness likewise increases. *Yamaha International Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988). Even if "Digital Instruments" is not generic for applicant's services, it must be considered to be highly descriptive of them, in which case that standard is extremely difficult to meet.

The question is whether the declaration submitted by applicant in support of its claim of acquired distinctiveness contains facts sufficient to support such a finding. The declaration attests to use of the mark in connection with the goods and services for more than

fifteen years, and that its levels of annual gross sales and advertising expenditures have been substantial.

I find that applicant may well have enjoyed significant dollar sales of the involved products over a period of more than fifteen years. As a result of early entry into the field, a series of acquisitions, etc., it may well be the dominant player in this niche market. However, I find in light of this record, where the applied-for matter is so highly descriptive, that applicant has not provided persuasive evidence of acquired distinctiveness. The statement made by Mr. Don R. Kania includes annual listings of the " … approximate dollar amounts of gross sales of products bearing the DIGITAL INSTRUMENTS trademark … " Inasmuch as the statement in the declaration references *product sales*, it does not appear to be evidence of acquired distinctiveness for the *recited service*s.

Moreover, it appears as if applicant does continue to use the "Digital Instruments" *trade name* in order to retain within its "Veeco Metrology Group" some of the historic value associated with the "Digital Instruments" name. On the other hand, according to applicant's web pages made part of the record, applicant has adopted and is promoting individual product marks on each of the involved goods that

it sells (e.g., BioScope, CP-II, Dimension, EnviroScope, NanoMan, etc.). The "Digital Instruments" trade name, along with the "**di** logos" in the letterhead (footnote 5 *supra*), that serves as the specimen in this application. While this is the closest thing to service mark usage we see in this record, nonetheless, it is not at all clear just how prominently this designation is used in promoting these research and development services, or what the annual values of such service are? The most we can conclude is that applicant has experienced a relatively large dollar volume of scanning probing microscopes, but that they are evidently marketed under a variety of other product marks. Accordingly, without more detail on how "Digital Instruments" is used in promoting the recited services, or what the value of these services are in relation to the sale of products, I find applicant's gross sales to be most inadequate to support registrabilty of this highly descriptive matter for the recited services.

My Conclusions:

I would affirm the refusal to register on the ground that this alleged mark is generic. Moreover, while I concur with the majority that the term "Digital Instruments" is merely descriptive under Section 2(e)(1) of

the Act, I would also find that this highly descriptive matter should not be registered under Section 2(f) of the Act based upon applicant's claims of acquired distinctiveness. For all of these reasons, I would affirm the refusals of the Trademark Examining Attorney, and deny applicant the issuance of this registration.

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