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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Krasik

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Serial No. 77381912

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Michael J. Folise of Black, Lowe & Graham PLLC for Michael Krasik.

Sani Khouri, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

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Before Taylor, Mermelstein and Bergsman, Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Michael Krasik has filed an application to register the mark INVENTION REGISTRY, in standard character format, on the Principal Register for goods ultimately identified as "Electronic storage of archival documents related to invention conception dates, for others" in Class 35.[1] In response to a conditional request by the examining

[1] Serial No. 77381912, filed January 28, 2008, and alleging a bona fide intention to use the mark in commerce.

attorney, applicant disclaimed the exclusive right to use "Registry."[2]

The trademark examining attorney finally refused registration on the ground that applicant's mark INVENTION REGISTRY is merely descriptive of applicant's services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

Applicant appealed and both applicant and the examining attorney filed briefs. We affirm the refusal to register.

A term is merely descriptive of goods, and therefore unregistrable under Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an 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). Whether a particular term is merely descriptive is determined not in the abstract, but in relation to the goods for which registration is sought, the context in

[2] The examining attorney states in his brief that the disclaimer was "requested" only if applicant were to file an acceptable allegation of use and an amendment to seek registration on the Supplemental Register. Although applicant did neither, he submitted a disclaimer of the term "registry," which has been accepted and made of record. Applicant has not withdrawn the disclaimer.

which it is being used or is intended to be 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 or intended use. In re Tower Tech Inc., 64 USPQ2d 1314, 1316-17 (TTAB 2002) ("The question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods and services are will understand the mark to convey information about them.").

When two or more merely descriptive terms are combined, we must determine whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods, then the resulting combination is also merely descriptive. See, e.g., In re Tower Tech, Inc., 64 USPQ2d 1314 (TTAB 2002) (SMARTTOWER held merely descriptive of commercial and industrial cooling towers).

However, a mark is suggestive if, when the goods or services are encountered under the mark, a multi-stage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See, e.g., In re Abcor Development Corp., 200

USPQ at 218, and In re Mayer-Beaton Corp., 223 USPQ 1347, 1349 (TTAB 1984).

The examining attorney maintains that applicant's proposed mark "describes the purpose of the services, which is to act as a 'registry' for 'invention' conception dates." (Br. p. 3). The examining attorney particularly argues that INVENTION REGISTRY is merely descriptive of applicant's electronic storage of archival documents related to invention conception dates, for others because "both the individual components and the composite result are descriptive of appellant's [applicant] services and do not create a unique, incongruous or non-descriptive meaning in relation to the services." (Br. p. 6).

In support of the refusal, the examining attorney submitted the following definitions of "registry" and "register." Registry is defined, in relevant part, as:

> ***noun:*** an official record of names or events or transactions.[3]

Register is defined, in relevant part, as:

> 1: a written record containing regular entries of items or details
> 2a: a book or system of public records.[4]

[3] OneLook Dictionary Search, Quick definitions, www.onelook.com/?w=registry&/s=a.

[4] Merriam-Webster Online Dictionary 2008.

Additionally, we take judicial notice of the following definition of "registry":

noun: 3. an official record or list; register.[5]

Finally, the examining attorney submitted an excerpt from the www.bioinfo.com website.[6] The excerpt from this website is a story/article discussing federal technology transfer issues (i.e., federally owned inventions and licenses) and the ability of the government to track and develop the inventions. The article indicates that PHS/NIH has a mandate to transfer technology to improve public health and in so doing, "one might expect there to be an information center, public document room or an **invention registry** database maintained by the National Library of Medicine." (Emphasis added).

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[5] Webster's New World College Dictionary (2005). Retrieved at www.yourdictionary.com/registry on September 4, 2009.

[6] The examining attorney also submitted excerpts from several websites, including www.mega.nu, and findarticles.com, retrieved from a search of the Google search engine for the term "invention registry" and an excerpt from the website www.unimarkip.com, which he contends show that "an 'invention registry' appears to be an archive of information related to inventions." (Br. p 5). We find these submissions have little, if any, probative value in assessing the U.S. consuming public's perception of the term INVENTION REGISTRY as describing applicant's electronic storage of archival documents related to invention conception dates for others. Specifically, the excerpt from www.mega.nu states that the information is "grossly obsolete" and is to be replaced, the excerpt from www.unimarkip.com refers to the Trademark and Intellectual Property Office of the Republic of Yemen and the excerpt from findarticles.com is taken from the Vietnam Investment Review.

Applicant, in urging reversal of the refusal, maintains that his mark is not merely descriptive of his services, but instead, is suggestive of them. Applicant particularly argues:

> The services (as amended) associated with the proposed mark applied for are clearly not for patent registrations or invention registrations. Rather, the proposed services as amended are directed to maintenance of an electronic document repository and services associated therewith…. No "registration" … of anything is accomplished.

(Br. p. 2). Applicant further argues that "the combination of 'INVENTION' and 'REGISTRY' suggests services which potentially enhance an inventor's rights in certain limited situations. The combination in no way describes an actual or virtual register for inventions …." (Br. p. 6).

Applicant also, on the one hand, contends that the "Section 2(e)(1) refusal is traversed, particularly in light of the amended recitation of services because an electronic repository of documents related to dates of conception is clearly not an 'invention registry' as that term in commonly understood and as shown by the Examining Attorney's evidence of record." (Br. p. 2) On the other hand, applicant maintains that the evidence "fails to clearly show that there is any such thing as an 'invention registry.'"

As stated, in order to be found descriptive, the mark need only convey an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods, not the common class name. *See* In re Gyulay, 3 USPQ 1009.

We find that this record establishes that the designation INVENTION REGISTRY, as a whole, is descriptive of the identified services. When INVENTION REGISTRY is viewed in connection with the services listed in the application, there is nothing in the mark which is incongruous, nor is there anything which would require the gathering of further information, in order for the merely descriptive significance thereof to be readily apparent to prospective purchasers of the goods. See, for example, In re Abcor Development Corp., Inc., 588 F.2d 811, 200 USPQ 215 (CCPA) (Rich, J., concurring) [GASBADGE described as a shortening of the name "gas monitoring badge"]; and Cummins Engine Co., Inc. v. Continental Motors Corp., 359 F.2d 892, 149 USPQ 559 (CCPA 1966) [TUBODIESEL held generically descriptive of engines having exhaust driven turbine super-chargers]. That is, contrary to applicant's contention, the combination of the words "invention" and "registry" fails to create a new and distinct commercial impression. Applicant's own use of the term "invention" in the

identification of goods shows that INVENTION directly describes an attribute of applicant's services. Additionally, as previously indicated, the term "registry" means "an official record of names or events or transactions" and the term "register," a variation of the term "registry," means "a written record" The term "registry" thus clearly describes the purpose of applicant's electronic storage of archival documents, i.e., to provide a written record of invention conception dates. We note, too, that applicant confirms in his brief that "Applicant's services relate to an electronic repository for archival documents related to dates of conceptions for inventions." (Br. p. 3).[7]

Lastly, applicant has pointed to numerous decisions where marks were found suggestive even though they included terms that otherwise conveyed some degree of information about the goods identified thereunder (e.g., BROWN-IN-BAG not descriptive of bags used in browning meats, PLUS 30 not descriptive of creams for women over thirty, CHARRED KEG not descriptive of whiskey, IMPACT not descriptive of

[7] Indeed, applicant has disclaimed the term "registry," even though the examining attorney clearly indicated in her Office Action that such a disclaimer was not required in the absence of an amendment to seek registration on the Supplemental Register.

carbonless transfer paper, CURV not descriptive of permanent curling wave solution and SOFT SMOKE not descriptive of smoking tobacco). We note, however, that the determination of registrability of a mark in another case is of little value because each case must be determined on its own facts. In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). We are constrained to decide this appeal on the record before us.

For the reasons discussed, we conclude that when applied to applicant's services, the designation INVENTION REGISTRY immediately describes, without any kind of mental reasoning, the purpose of applicant's electronic storage of archival documents related to invention conception dates, for others is as an electronic registry, i.e., record, of invention conception dates.

Decision: The refusal to register under Section 2(e)(1) of the Trademark Act is affirmed.