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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 Mentor Graphics Corporation

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Serial No. 78325604

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Douglas Hancock of Hancock Hughey for Mentor Graphics Corporation.

David E. Tooley, Jr.,[1] Trademark Examining Attorney, Law Office 112 (Angela Wilson, Managing Attorney).

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Before Seeherman, Walters and Grendel, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Mentor Graphics Corporation seeks registration on the Principal Register of the mark VIRTUALWIRES, in standard character form, for "computer hardware and software for electronic design automation," in International Class 9.[2]

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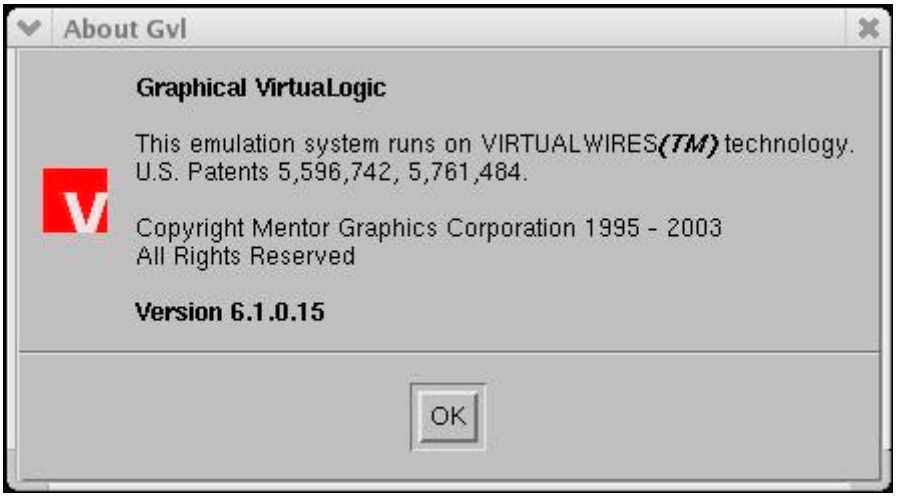
[1] The examining attorney on the brief in this appeal is different from the examining attorney who examined the application.

[2] Serial No. 78325604, filed November 10, 2003, based on an allegation of bona fide intent to use the mark, under Trademark

At issue in this appeal is the Trademark Examining Attorney's final refusal to register applicant's mark on the ground that the subject matter does not function as a mark in connection with the identified goods as it is shown on the specimen and, thus, the specimen is not acceptable evidence of use of the mark as a trademark. See Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§ 1051, 1052 and 1127. The appeal is fully briefed.

After careful consideration of the evidence and arguments of record, we reverse the refusal to register.

The specimen of record is shown below:



The statement of use contains the following description of the specimen: "The specimen is a splash screen displayed

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Act Section 1(b), 15 U.S.C. §1051(b). On August 22, 2006, applicant submitted a statement of use, alleging first use and first use in commerce as of August 16, 2006, and a specimen of use.

on computer monitors associated with computers on which the subject software is running."

As a preliminary matter, we dismiss the examining attorney's objection in his brief to "evidence" introduced by applicant in its brief. The text in the brief to which the examining attorney refers is merely further explanation as to the nature of the identified goods, not documentary "evidence"; and this information was previously stated for the most part in applicant's response of November 28, 2006.

In the following paragraphs, applicant describes its identified goods:

> The goods described in the application are "computer hardware and software for electronic design automation." Electronic design automation [EDA] is a field of electronics that deals with the development and engineering of complex circuits …. EDA engineers that use EDA software tend to be highly trained and educated – they typically are electrical engineers who specialize in circuit design. The software is just as sophisticated as the users.
> (response of November 28, 2006)
>
> . . .
>
> VIRTUALWIRES is software. VIRTUALWIRES software enables a technology that is used in several different kinds of software and hardware sold by applicant. In a variety of marketing materials, and on the specimen, applicant uses the word "technology" to describe its VIRTUALWIRES product, in part because it is a background software system that is used in numerous other, separately branded products. It is appropriate therefore from a product marketing viewpoint to identify the VIRTUALWIRES product as a technology.

> In the case of the specimen submitted with the statement of use, VIRTUALWIRES is software that is used in another software tool called GVL. GVL is an emulation system that helps users to emulate complex circuits. VIRTUALWIRES is software used in GVL that enables certain scaling technologies used in electronic design automation emulation.
> (appeal brief, p. 2-3)

Does the subject matter function as a mark as used on the specimen?

The examining attorney makes essentially two arguments in this regard. First, the examining attorney contends that "the specimen is unacceptable as evidence of actual trademark use because as used on the specimen of record, [the mark] is being used to describe a technology and not 'computer hardware and software for electronic design automation,'" (Office Action, November 18, 2006). In other words, as shown on the specimen, the examining attorney contends that the mark does not identify the goods recited in the application. The examining attorney submitted definitions from *The American Heritage Dictionary of the English Language*, 3rd ed. 1992, of "software" as "the programs, routines, and symbolic languages that control the functioning of the hardware and direct its operation" and of "technology" as "b. the scientific method and material used to achieve a commercial or industrial objective."

The examining attorney's definition of "technology" is from a dictionary published in 1992, which is a long time in the past for computer-related products. Therefore, additionally, we take judicial notice of the definition in *Merriam-Webster's Collegiate Dictionary*, 11th ed. 2003, of "technology" as "a manner of accomplishing a task esp. using technical processes, methods, or knowledge <new *technologies* for information storage>."

In view of these definitions, we disagree with the examining attorney and find that the term "technology" encompasses EDA computer hardware and software. This is particularly true in this case due to the complex nature of the field in which this hardware and software is used and the multiple layers of programs running, i.e., the identified software operates in the background in a complex system of hardware and software. Thus, the use of the term "technology" as the noun or type of goods identified by the mark VIRTUALWIRES does not render the specimen unacceptable for the purpose of showing that VIRTUALWIRES functions as a mark in connection with "computer hardware and software for electronic design automation."[3]

[3] *Cf. In re Hutchinson Technology Inc.*, 7 USPQ2d 1490 (Fed. Cir. 1988). The court found HUTCHINSON TECHNOLOGY not to be primarily merely a surname, and stated "the fact that the term 'technology' is used in connection with computer products does not mean that the term is descriptive of them[;] many other goods possibly may

In his second argument in support of his position that the subject matter does not function as a mark, the examining attorney contends that VIRTUALWIRES "is embedded in a descriptive sentence, specifically, 'this emulation system runs on VIRTUALWIRES(TM) technology,' in small text in the middle of a specimen containing other more prominently placed text and graphic elements"; that "use of the TM symbol beside the otherwise defective use of a mark will not obviate a failure to function refusal"; and he makes the following statement (brief, p. 4):

> In fact, the terms VIRTUAL and WIRES are both highly descriptive terms that, when used together, create a phrase that consumers are likely to mistake for a generic technology when not displayed in a separated and prominent manner. The descriptive nature of applicant's mark is reinforced by its insertion into the informational sentence "[t]his emulation system runs on VIRTUALWIRES(TM) technology."

Again, we disagree with the examining attorney. First, we note that the examining attorney has not refused registration on the ground that the mark VIRTUALWIRES is merely descriptive. Further, if the examining attorney's

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be included within the broad term 'technology,' but that does not make the term descriptive of all of those goods" (1492). The court also remanded the case for entry of a disclaimer of TECHNOLOGY. In today's marketplace, the term "technology" is clearly a broad term with several different meanings and, in the computer field, encompasses a number of different products and services. As the term is used in the specimen of record in this case, it functions as a category of goods in the computer field encompassing EDA hardware and software.

position is that the mark as a whole is inherently distinctive, but the individual words "virtual" and "wires" are merely descriptive in connection with the identified goods, he has submitted no evidence in this regard. Thus, on this record, we presume that, if properly used, VIRTUALWIRES is a distinctive mark.

Second, we find the manner of use of the subject matter to be as a mark, not merely informational. While the sentence in which the mark appears provides information, the information is that the system being used is powered by a software technology identified by the mark VIRTUALWIRES. This is evidenced by the nature of the sentence itself; by the representation of the term VIRTUALWIRES in all capital letters followed by the "TM" symbol in all bolded capital letters; and by the mark's distinctive use to modify the descriptive terminology for the goods as broadly characterized, i.e., "technology." This finding is not negated by the fact that the sentence provides information that the system uses the goods identified by the mark, or by the fact that there may be additional matter on the screen that is also prominent. Therefore, we conclude that VIRTUALWIRES does function as a trademark in reference to the identified goods as used on the specimen of record.

As a final matter, we note that, in its brief, applicant stated that the specimen of record "is a screen that is displayed on the monitor when the computer user requests 'About' information from the software's Help menu" (p. 1). In his brief, the examining attorney asked the Board to take judicial notice of several definitions, including of the terms "About screen" and "splash screen." Applicant originally described its specimen as a splash screen and, in view of applicant's statement in its brief, the examining attorney argues that, because of the nature of an About screen, applicant's subsequent statement is further evidence that relevant consumers will not perceive of the subject matter as a trademark.

To address the examining attorney's argument, we take judicial notice of the following two definitions:

> **Splash screen** – "Initial screen that is displayed for a few seconds when you start a program. The splash screen normally displays the product logo and gives basic copyright information." *The Dictionary of Personal Computing and the Internet*, Peter Coffin Publishing, 2000.
>
> **About** – "A menu selection that tells you who developed the program and gives copyright information." *Dictionary of Computing*, Bloomsbury Publishing, 5th ed. 2004.

Although a splash screen and an About screen appear to be different types of screens that are viewed by computer users at different points, that does not change the fact

that VIRTUALWIRES, as it is used on the About screen, functions as a mark to identify the recited goods. Further, as the issue has been framed in this appeal, the question of whether a specimen of use consisting of an About screen is acceptable to show use of the subject matter as a mark is not before us. Therefore, we have given this question no consideration.

Decision: The refusal to register is reversed on the ground that the subject matter does not function as a mark in connection with the identified goods as it is shown on the specimen.