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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Siemens Aktiengesellschaft

Serial No. 79100971

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Aktiengesellschaft.

April K. Roach, Trademark Examining Attorney, Law Office 115 (John T. Lincoski,
Managing Attorney).

Before Bucher, Mermelstein and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Siemens Aktiengesellschaft filed an application on the Principal Register for
the mark ISCM, in standard character form, for the services ultimately identified
below:

Business management services, namely, business
management of the monitoring and analysis of the
condition of assets that are components of electric energy
supply networks to maximize performance and
component life and reduce costs and downtimes of those
components, namely, business management of programs
for monitoring and analyzing the condition of individual
pieces of equipment used in electrical power supply

plants to determine if the equipment requires repair or replacement, in Class 35.

The application is based on a request for extension of protection filed under Section 66(a) of the Trademark Act of 1946, 15 U.S.C. § 1144f(a).

The Trademark Examining Attorney refused to register applicant's mark on the ground that it is merely descriptive. Section 2(e)(1) of the Trademark Act of 1946, 15 U.S.C. § 1052(e)(1). According to the Trademark Examining Attorney, ISCM is an "acronym" for the term "Integrated Supply Chain Management," that "Integrated Supply Chain Management" "is the coordinated management of the entire supply chain of an entity to improve efficiency and decrease costs,"¹ and that because applicant's services include the management of parts of the supply chain, applicant's mark is merely descriptive.²

In presenting the issue on appeal, both applicant's counsel and the Trademark Examining Attorney are commended for their precise arguments and direct references to the evidence in the record.

Preliminary Issue

Applicant referenced an inapplicable recitation of services in its brief. During the prosecution of the application, applicant went through several iterations of its recitation of services. In its September 4, 2012 petition to revive and response to Office action, applicant amended its recitation of services to read as follows:

Business management services, namely, business management of the monitoring and analysis of the

¹ Examining Attorney's Brief, p. 2 (unnumbered).

² Examining Attorney's Brief, pp. 3-5 (unnumbered).

condition of assets that are components of electric energy supply networks to maximize performance and component life and reduce costs and downtimes of those components; professional business consultancy, namely, ensuring cost effectiveness and quality of electric energy supply networks through consultation regarding the management of assets, namely, the management of the components of electrical supply networks; statistics and professional business expertise, namely, statistical and business efficiency expert services in connection with improving the effectiveness and efficiency of electric energy supply networks through monitoring and analysis of the condition of network components; organizational project management, in particular analysis, optimization and implementation of asset management processes in the nature of managing assets in the form of components of electrical supply networks.

The Trademark Examining Attorney accepted that recitation of services in her October 2, 2012 Office action.

In its April 4, 2013 response to an Office action, applicant amended its recitation to read as follows:

Business management services, namely, business management of the monitoring and analysis of the condition of assets that are components of electric energy supply networks to maximize performance and component life and reduce costs and downtimes of those components, namely, business management of programs for monitoring and analyzing the condition of individual pieces of equipment used in electrical power supply plants to determine if the equipment requires repair or replacement.

The Trademark Examining Attorney accepted that recitation of services in her May 13, 2013 Office action.

In its brief, applicant referenced the recitation of services from its September 4, 2012 response to an Office action, not the subsequently amended recitation of services. The April 4, 2012 recitation of services does not include the following:

professional business consultancy, namely, ensuring cost effectiveness and quality of electric energy supply networks through consultation regarding the management of assets, namely, the management of the components of electrical supply networks; statistics and professional business expertise, namely, statistical and business efficiency expert services in connection with improving the effectiveness and efficiency of electric energy supply networks through monitoring and analysis of the condition of network components; organizational project management, in particular analysis, optimization and implementation of asset management processes in the nature of managing assets in the form of components of electrical supply networks.

“[O]nce the applicant has expressly amended the identification of good and services to delete an item, it may not be reinserted in a later amendment.” TMEP § 1402.06(a) (October 2013).

In view thereof, the recitation of services as amended by applicant in its April 4, 2013 response to an Office action is the operative recitation of services.

Whether the mark ISCM is merely descriptive?

A term is merely descriptive if it “immediately conveys ... knowledge of the ingredients, qualities, or characteristics of the goods ... with which it is used.” *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the goods or services for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Development Corp.*, 588

F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). This requires consideration of the context in which the mark is used or intended to be used in connection with those goods, and the possible significance that the mark would have to the average purchaser of the goods in the marketplace. *See In re Chamber of Commerce*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Bayer*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Assocs.*, 226 USPQ 285 (TTAB 1985). The question is not whether someone presented only with the mark could guess the products listed in the description of goods. Rather, the question is whether someone who knows what the products are will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002); *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

“[I]f one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive.” *In re Tennis in the Round, Inc.*, 199 USPQ 496, 498 (TTAB 1978). *See also, In re Shutts*, 217 USPQ at 364-65; *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980). In this regard, “incongruity is one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive from the descriptive mark.” *In re*

Shutts, 217 USPQ at 365. *See also In re Tennis in the Round, Inc.*, 199 USPQ at 498 (the association of applicant's mark TENNIS IN THE ROUND with the phrase "theater-in-the-round" creates an incongruity because applicant's services do not involve a tennis court in the middle of an auditorium).

A series of letters that are a recognized abbreviation for a significant characteristic of the services in the application is merely descriptive. *Foremost Dairies, Inc. v. The Borden Company*, 156 USPQ 153, 154 (TTAB 1967); *Calgon Corporation v. Hooker Chemical Corporation*, 151 USPQ 359, 360 (TTAB 1966).

However, not all abbreviations are necessarily merely descriptive.

While each case must be decided on the basis of the particular facts involved, it would seem that, as a general rule, initials cannot be considered descriptive unless they have become so generally understood as representing descriptive words as to be accepted as substantially synonymous therewith.

Modern Optics, Inc. v. Univis Lens Co., 234 F.2d 504, 110 USPQ 293, 295 (CCPA 1956). *See also Southwire Co. v. Kaiser Aluminum & Chemical Corp.*, 196 USPQ 566, 573 (TTAB 1977).

Accordingly, for ISCM to be merely descriptive of applicant's services, we have to find the following:

1. ISCM is an abbreviation for "Integrated Supply Chain Management";
2. "Integrated Supply Chain Management" is merely descriptive of applicant's services; and

3. A relevant consumer viewing ISCM in connection with applicant's services would recognize it as an abbreviation of the term "Integrated Supply Chain Management."

See In re Harco Corp., 220 USPQ 1075, 1076 (TTAB 1984).

The factual issue in this appeal is whether applicant's recitation of services comprises "Integrated Supply Chain Management." The Trademark Examining Attorney submitted evidence showing that the letters "ISCM" is the abbreviation of the term "Integrated Supply Chain Management," and applicant did not challenge the evidence or the conclusion.³ Thus, there is no question that ISCM is an abbreviation for the term Integrated Supply Chain Management. Also, there is no question regarding the meaning of the term Integrated Supply Chain Management. For example, the examining attorney placed screen prints into the record of the following websites:

Integrated supply chain management is the act of ensuring that your supplier provides the right items on schedule, built to the correct specifications, at the proper cost. This means that you, as the purchaser of the materials required to make your product, are the pivotal station within your supply chain.⁴

Integrated supply chain management includes every part of the supply chain under the direction of one person. ... The supply chain starts at the supplier's production line and ends at the customer's point of use. It includes every function or department that can have a direct effect on

³ September 21, 2011 Office action.

⁴ "What is Integrated Supply Chain Management?" TML Business Services LLC website (tml-business-services.com) attached to the October 2, 2012 Office action.

raw materials, work-in-process and finished goods; this includes storage, transportation, purchasing, production and distribution.⁵

Cat Logistics specializes in providing integrated supply chain solutions that ensure the right product is in the right place at the right time so customers get what they need when they need it.⁶

Applicant's services are the monitoring and analysis of the condition of components of electric energy supply networks.⁷ The evidence shows that applicant's services are ensuring that the components in an energy supply system are in good working condition, not the coordination of the supply of goods or raw materials for electrical supply networks. In other words, applicant's services do not involve insuring that suppliers provide the right goods on schedule, built to the correct specifications, at the proper cost. Accordingly, we find that when the initialism ISCM when used in connection with applicant's services is not merely descriptive.

Decision: The refusal to register is reversed.

⁵ "What Is Integrated Supply Chain Management?" eHow Money (ehow.com) attached to the September 21, 2011 Office action.

⁶ Cat Logistics website (logistics.cat.com) attached to the September 21, 2011 Office action.

⁷ Applicant argues that its use of ISCM is an abbreviation of the term "Integrated Substation Condition Monitoring." (January 12, 2012 response to Office action).