

This Opinion is Not a
Precedent of the TTAB

Oral Hearing: December 18, 2019

Mailed: March 17, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re ZF Friedrichshafen AG
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Serial No. 79231720
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Brewster Taylor and Marie-Elise Paul of Stites & Harbison PLLC,
for ZF Friedrichshafen AG.

Scott Bibb, Trademark Examining Attorney, Law Office 109,
Michael Kazazian, Managing Attorney.

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Before Lykos, Greenbaum and Lynch,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

ZF Friedrichshafen AG (“Applicant”) seeks to register the mark SOUND.AI in standard characters¹ on the Principal Register for goods identified as:

¹ Applicant’s mark appears on the drawing page as “Sound.AI” but retains a claim as to standard characters and not special form. The presentation of the mark on the drawing page does not change the nature of the mark from a standard character mark to a special form mark. *See* Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a) (setting forth requirements for standard character mark). *See also In re Calphalon Corp.*, 122 USPQ2d 1153, 1158-61 (TTAB 2017) (applicant’s amendment of mark from SHARPIN to SharpIn did not transform mark from standard character to special form). Our references to Applicant’s mark in this opinion in all uppercase letters reflects the fact that a term registered as a mark in standard character format is not limited to any particular font style, size, or color. *See In re Calphalon Corp.*, 122 USPQ2d at 1153 n.1. *See also Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011) and *Cunningham v. Laser Golf Corp.*, 222

Sensors for detecting sound waves; electronic control and regulating apparatus for operating motor vehicles; driver assistance systems for motor vehicles, based on the detection of sound waves; computer hardware and software for operating motor vehicles in International Class 9.²

The Trademark Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the mark is merely descriptive of Applicant's identified goods. When the refusal was made final, Applicant filed a request for reconsideration, which was denied,³ and then a notice of appeal. The appeal is fully briefed and an oral hearing was held on December 18, 2019. For the reasons set forth below, we affirm the refusal to register.

In the absence of acquired distinctiveness, Section 2(e)(1) of the Trademark Act prohibits registration of a mark on the Principal Register that, when used in connection with an applicant's goods, is merely descriptive of them. 15 U.S.C. § 1052(e)(1).⁴ "A term is merely descriptive if it immediately conveys knowledge of a

F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000) ("Registrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce."); *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1284 (TTAB 2009) ("rights associated with a word mark in standard character (or typed) form reside in the wording and not in any particular display of the word.").

² Application Serial No. 79231720, filed March 9, 2018, under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f ("Madrid Protocol"), requesting extension of protection for International Registration No. 1400927.

³ Applicant filed a single request for reconsideration on February 28, 2019. The Examining Attorney issued the same denial on May 11, 2019 and June 29, 2019.

⁴ "No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . (e) Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive . . ." A mark in an application filed under Trademark Act Section 66(a) is ineligible for registration on the Supplemental Register. Trademark Rules 2.47(c), 2.75(c); 37 C.F.R. §§ 2.47(c), 2.75(c).

quality, feature, function, or characteristic of the goods or services with which it is used.” *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). See also *In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015). By contrast, a mark is suggestive if it “requires imagination, thought, and perception to arrive at the qualities or characteristics of the goods.” *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Suggestive marks, unlike merely descriptive terms, are registrable on the Principal Register without proof of acquired distinctiveness. See *Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004).

The determination of whether a mark is merely descriptive must be made in relation to the goods for which registration is sought, not in the abstract. *In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Bayer*, 82 USPQ2d at 1831. 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. *In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Bayer*, 82 USPQ2d at 1831; *In re Omaha Nat’l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987). In other words, the question is not whether someone presented only with the mark could guess the goods listed in the identification. Rather, the question is whether someone who knows what the goods are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757

(Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)).

Evidence that a term is merely descriptive to the relevant purchasing public “may be obtained from any competent source, such as dictionaries, newspapers, or surveys,” *In re Bayer*, 82 USPQ2d at 1831, as well as “labels, packages, or in advertising material directed to the goods.” *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). It may also be obtained from websites and publications, and, in the case of a use-based application, an applicant’s own specimen of use and any explanatory text included therein. *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017); *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1565 (Fed. Cir. 2001). In this particular case, the involved application has been filed under the Madrid Protocol provisions set forth in Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f, meaning that Applicant claims no use in the United States. Nonetheless, the Examining Attorney is not precluded from introducing excerpts from Applicant’s own materials, website, or news articles as evidence of public perception of the mark. *Cf. In re Promo Ink*, 78 USPQ2d 1301, 1303 (TTAB 2006) (examining attorney may introduce evidence that applicant’s own literature supports descriptiveness of term despite the fact that application based on intent-to-use under Trademark Act Section 1(b); fact that applicant has filed an intent-to-use application does not limit the examining attorney’s evidentiary options or shield an applicant from producing evidence that it may have in its possession).

In support of the refusal, the Examining Attorney made of record the following dictionary definitions:

sound

noun

1. a. Vibrations transmitted through an elastic solid or liquid gas, with frequencies in approximate range of 20 to 20,000 hertz, capable of being detected by human organs of hearing.
b. Transmitted vibrations of any frequency.
c. The sensation stimulated in the organs of hearing by such vibrations in the air or other medium.
d. Such sensations considered as a group
2. A distinctive noise: a hollow sound.
3. The distance over which something can be heard: within sound of my voice.⁵

AI abbr.

5. artificial intelligence⁶

artificial intelligence

1. The ability of a computer or another machine to perform those activities that are normally thought to require intelligence.
2. The branch of computer science concerned with the development of machines having this ability.⁷

⁵ THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (www.ahdictionary.com) attached to June 21, 2018 Office Action, p. 7. Citations to the prosecution history in the USPTO's TSDR database are to the downloadable .pdf version. See, e.g., *In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1402 n.4 (TTAB 2018).

⁶ *Id.* at 10.

⁷ *Id.* at 12.

As noted above, “AI” is a commonly recognized abbreviation for “artificial intelligence.” WIKIPEDIA explains “artificial intelligence” generally and in the computer science field as

...intelligence demonstrated by machines, in contrast to the natural intelligence displayed by humans and other animals. In computer science, AI research is defined as the study of “intelligent agents”; any device that perceives its environment and takes actions that maximize its chance of successfully achieving its goals.⁸

The WIKIPEDIA excerpt also notes the application of AI in various sectors, including the automotive industry.⁹ Consistent therewith, Applicant, in an article written by one of its engineers who is an “expert for autonomous driving and artificial intelligence,” explains the concept of AI or artificial intelligence as follows:

At its core, artificial intelligence it[sic] is about equipping machines with cognitive abilities so that they can perform certain tasks better than humans. This is precisely the essence of innovation – and it represents a revolution, because in the course of history, the ability to analyze and plan, as well as draw logical conclusions, has been something reserved for humankind to this point. ... Thanks to AI, can computers handle the most complex problems better than humans.

...

The key difference from the traditional software world is that AI systems can make decisions and answer questions that are not already thematically stored in their code.¹⁰

⁸ November 20, 2018 Office Action p. 24.

⁹ *Id.* at 36.

¹⁰ “Artificial Intelligence: Smarter Than Man” Arnold Schlegel, June 14, 2018 (<https://vision.zf.com/site/magazine>) attached to June 21, 2018 Office Action, pp. 16-18.

Another article published in Applicant's corporate magazine describes the innovation process for Applicant's new Class 9 automotive products, touting the features and advantages of sensors incorporating AI to detect sound:

Who would have thought just a few years ago that cars would listen to the outside world, draw conclusions thanks to artificial intelligence and then be able to perform an evasive maneuver automatically? ... After all hearing is an important factor when it comes to road traffic safety. ZF's Sound.AI enhances vehicle sensors, giving cars a sense of hearing. Last year the two economists began thinking about how they could enhance the radar and lidar technology for the car's seeing capability to also include sound recognition. In the process, the vehicle's hearing capability was to be developed based on artificial intelligence. Ade and Fieres therefore included this technology in the name of their product: "Sound.AI." The system detects signals issued by sirens from approaching police, fire or emergency medical service vehicles ("siren detection"). Using a display screen, "Sound.AI" informs the driver which direction the emergency vehicle is coming from and suggests what to do. If it comes from behind, it recommends the driver to pull over to the right, or – on freeways – to form an emergency lane. However, "Sound.AI" can do more than just detect sirens, it is also suitable for other purposes.¹¹

This excerpt from a trade journal further explains how Applicant's AI goods work to sense sound in vehicles as a safety feature:

In the future, the supplier wants to teach cars to listen with its new development "Sound.AI" – so that they can perceive non visible sources of danger prematurely. An Artificial Intelligence (AI) module detects sounds from the environment, such as the siren of an approaching police or ambulance. The system then warns drivers via the display

¹¹ "Safely on the Road With Your Ears Open" by Michael Schiebe, May 2, 2018 attached to June 21, 2018 Office Action, pp. 23-27.

where the emergency vehicle comes from and gives a recommendation on how they should behave.¹²

Based on the foregoing evidence, purchasers will immediately perceive Applicant's mark SOUND.AI as merely describing a feature and purpose of its goods, which use AI (a commonly recognized acronym for artificial intelligence) to detect "sound" in order to enhance the safety of automotive vehicles. The period, a punctuation mark between the two terms, does not negate their descriptive nature. *Cf. Duopross Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757-58 (Fed. Cir. 2012) (finding SNAP! with a broken exclamation point, merely descriptive of medical syringes using snap-off plungers). Taken together, this evidence shows that Applicant's mark SOUND.AI, when considered as a whole, immediately conveys a feature and purpose of the identified goods which utilize artificial intelligence to detect the sound of emergency vehicles and guide the driver to a safe road position.

Applicant refers to third-party registrations for marks registered on the Principal Register incorporating the word "sound" (SOUNDMAX, SOUNDPRINT, SOUNDRAIL, SOUNDBADGE, SOUNDCOVER and Design; SOUNDBRIDGE, SOUNDCLEAN, SOUNDSOCKS) and marks incorporating the term AI (RISC.AI, DEEPCHAT.AI, PEOPLE.AI, ACCESSAI, and AI FOR THE COMMON GOOD),¹³ as

¹² Excerpts from <https://translate.google.com/translate?hl=en&sl=de&u=https://www.automobil-industrie.vogel.de/soundai-zf-will-fahrzeuge-hoeren-lassen-a-699800/&prev=search> attached to November 20, 2018 Final Office Action, p. 7.

¹³ See February 28, 2019 Request for Reconsideration, pp. 13-32.

evidence that Applicant's mark is not merely descriptive. Third-party registrations featuring the same or similar services as Applicant's services are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on a showing of acquired distinctiveness, or registered on the Supplemental Register. *See Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987); *In re Box Sol'ns Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006). Insofar as the marks are distinct and are for goods or services different than those in the involved application, we find the prior registrations to be of little, if any, probative value. In addition, the registrations of marks that include SOUND as part of a compound word do not support Applicant's contention that SOUND has not been treated as a descriptive term, because SOUND would not be subject to a disclaimer requirement even if descriptive. Established examination disclaimer practice for compound marks, as set forth in the TRADEMARK MANUAL OF EXAMINING PROCEDURE ("TMEP") § 1213.05(a) (Oct. 2018) provides that:

If a compound word mark consists of an unregistrable component and a registrable component combined into a single word, no disclaimer of the unregistrable component of the compound word will be required. *See In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981) (finding that "[a] disclaimer of a descriptive portion of a composite mark is unnecessary . . . if the elements are so merged together that they cannot be regarded as separable elements . . . for example, . . . by combining two words or terms, one of which would be unregistrable by itself . . .").

Similarly, the registrations of marks that include AI do not support Applicant's position that the term is not descriptive, either because it was disclaimed, or because

it was subject to special disclaimer rules. *See* TMEP § 1215.07 (no disclaimer of .COM required for the mark ABC.COM).

Applicant urges the Board to draw a negative inference based on the lack of evidence of third-party use of “sound” and “AI” together to describe any goods or services. As Applicant contends, the terms “sound” and “AI” when used together are “too generalized and vague to instantaneously convey to purchasers” any characteristics of the goods.¹⁴ The Examining Attorney is not required to prove that others have used the mark at issue or that they need to use it. The correct test is whether the mark conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1514 (TTAB 2016). *See also In re Walker Mfg. Co.*, 359 F.2d 474, 149 USPQ 528, 530 (CCPA 1966) (“The question . . . is not whether the Board or others may or would utilize ‘CHAMBERED PIPE’ to describe applicant’s goods, but whether this designation does, in fact, describe such goods.”). Even if Applicant were the first and only entity in this industry to use the terms “sound” and “AI” together this would not obviate the descriptive nature of the proposed mark. *See KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 122 (2004) (trademark law does not countenance someone obtaining “a complete monopoly on use of a descriptive term simply by grabbing it first”) (citation omitted); *Clairol, Inc. v. Roux Distrib. Co.*, 280 F.2d 863, 126 USPQ 397, 398 (CCPA 1960) (“Even novel ways of referring to a product may nonetheless be merely descriptive.”); *In re Bailey Meter Co.*, 102 F. 2d 843, 41

¹⁴ Applicant’s Appeal Brief, p. 13; 5 TTABVUE 18.

USPQ 275, 276 (CCPA 1939) (“The fact that appellant may have been the first and only one to adopt and use the mark sought to be registered does not prove that the mark is not descriptive . . .”). Vocabulary in the computer science field evolves rapidly. *Cf. In re Styleclick.com Inc.*, 57 USPQ2d 1445, 1448 (TTAB 2000) (noting “a year or two is an eternity in ‘Internet time,’ given the rapid advancement of the Internet into every facet of daily life”). The logic of Applicant’s argument fails because the record shows that “sound” and “AI” have specific meanings when considered in relation to the goods. This significance is not lost when the two terms are joined together to form the mark SOUND.AI. Competitors in this field should be able to use this descriptive term when advertising to the public their own similar goods. As explained in the seminal case of *In re Abcor Dev. Corp.*, 200 USPQ at 217:

The major reasons for not protecting such marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.

Applicant argues that its mark is “inarguably unique and new” and “incongruous because ‘sound’ cannot be used to modify ‘AI.’”¹⁵ Pointing to the dictionary definition of “sound,” Applicant asserts that when used as a noun, “sound” or “vibrations capable of being detected by human organs of hearing are not a function or quality of artificial intelligence and therefore cannot modify AI.”¹⁶ Applicant also argues that SOUND.AI

¹⁵ Applicant’s Brief, p. 6; 5 TTABVUE 10.

¹⁶ *Id.*

engenders an incongruity by juxtaposing the discordant element of “sound” used as an adjective to modify “AI” thereby creating a pun that Applicant’s goods are free from sound. In support thereof, Applicant cites to a myriad of cases where the Board found various marks to be incongruous and not merely descriptive. *See, e.g., In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382, 385 (CCPA 1968) (SUGAR & SPICE double entendre for bakery products). Applicant’s arguments are unpersuasive. As noted above, determination of whether a mark is merely descriptive is considered in relation to the identified goods, not in the abstract. *See In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Bayer*, 82 USPQ2d at 1831; *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). For example, in the case of *In re Polo Int’l Inc.*, 51 USPQ2d 1061, 1063 (TTAB 1999), the Board found the term DOC in the mark DOC-CONTROL would be understood to refer to the “documents” managed by applicant’s software, not “doctor,” as shown in a dictionary definition. Likewise, in *In re Digital Research Inc.*, 4 USPQ2d 1242, 1244 (TTAB 1987), the Board found the mark CONCURRENT PC-DOS merely descriptive of “computer programs recorded on disk” where the evidence showed that the computer industry used the denomination “concurrent” as a descriptor of a particular type of operating system. In other words, the issue is whether someone who knows what the goods and services are will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); *In re Patent & Trademark Serv. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998). We fail to see any incongruous meaning in

the juxtaposition of the two terms “sound” and “AI” in Applicant’s mark when considered in relation to the goods.

Applicant also counters that its proposed mark SOUND.AI is suggestive of a desired result in relation to the identified goods because the juxtaposition of the two words requires the consumer to engage in multistep reasoning.

consumers must – at a minimum – use multistage reasoning to understand the mark’s significance with relation to products in which there is a complex relationship between an ambient sound, sensors, processing signals and the use of artificial intelligence to transform the electric signals into intelligible directions on a display screen in a vehicle so that a driver can take appropriate action.¹⁷

This, however, is precisely why the mark is merely descriptive. Given the technical nature of the goods, we are skeptical that prospective consumers would attribute any other meanings. Again, the question of whether a proposed mark is merely descriptive is not determined by asking whether one can guess, from the mark itself, what the goods are, but rather by asking, when the mark is seen on or in connection with the goods, whether it immediately conveys information about their nature. *In re MBNA Am. Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003); *In re Tower Tech*, 64 USPQ2d at 1316-17; *In re Patent & Trademark Serv. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998). No imagination or thought is required by prospective consumers to discern the nature of Applicant’s goods. To the contrary, to purchasers encountering Applicant’s Class 9 goods, Applicant’s proposed mark immediately

¹⁷ Applicant’s Brief, p. 11; 5 TTABVUE 16.

conveys, without conjecture or speculation, an attribute of Applicant's goods. Thus, when considered as a whole, the mark does not have a separate non-descriptive meaning.

In sum, we find Applicant's standard character mark SOUND.AI to be merely descriptive of the identified goods in International Class 9 and therefore ineligible for registration on the Principal Register in the absence of a showing of acquired distinctiveness.

Decision: The refusal to register is affirmed.