

This Opinion is Not a
Precedent of the TTAB

Mailed: March 5, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re DMG Mori Co., Ltd.

Serial No. 79317839

Jeffrey H. Handelsman of Greenblum & Bernstein, PLC, for DMG Mori Co., Ltd.

Akeela Makshood,¹ Trademark Examining Attorney, Law Office 122, Kristin
Dahling, Managing Attorney.

Before Goodman, Pologeorgis and Thurmon, Administrative Trademark Judges.

Opinion by Thurmon, Administrative Trademark Judge:

DMG Mori Co., Ltd. (“Applicant”) filed a Request for Extension of Protection, pursuant to Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), of an international registration for the standard character mark GEAR PROFILER on the Principal Register for the following goods:

Metalworking machines and machine tools, and their
structural parts, in International Class 7; and

Computers; downloadable and recorded computer
software for controlling and monitoring tools of

¹ The Application was originally examined by Examining Attorney Christina Calloway. The Application was assigned to the identified Examining Attorney after this appeal was instituted.

metalworking machine tools for use in connection with metalworking machine tools; computer peripheral devices; laser measuring systems; scanners, in International Class 9.²

The Examining Attorney refused registration of the mark for being merely descriptive of the goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). Applicant appealed and requested reconsideration, which was denied. The Applicant and Examining Attorney have filed briefs and this case is ready for decision. We affirm the refusal.

I. Section 2(e)(1) – Merely Descriptive – Analysis

Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), precludes registration of a mark on the Principal Register which, when used in connection with the applicant's goods, is merely descriptive of them. "A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services." *In re Zuma Array Ltd.*, 2022 USPQ2d 736, at *5 (TTAB 2022) (internal quotations and citations omitted). "A mark need not immediately convey an idea of each and every specific feature of the goods in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the goods." *Id.* (quoting *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016) (citing *In re Gyulay*, 820

² Application Serial No. 79317839, filed June 8, 2021, seeking an extension of protection of International Registration No. 1607202, pursuant to Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a).

F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987)). In addition, “a mark need not be merely descriptive of all recited goods or services in an application. A descriptiveness refusal is proper ‘if the mark is descriptive of any of the [goods or] services for which registration is sought.’” *Id.*, at *5-6 (quoting *In re Chamber of Commerce of the United States*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005))).

“Whether a mark is merely descriptive is evaluated in relation to the particular goods for which registration is sought, the context in which it is being used, 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 Fallon*, 2020 USPQ2d 11249, at *7 (TTAB 2020) (quoting *Chamber of Commerce*, 102 USPQ2d at 1219), and “not in the abstract or on the basis of guesswork.” *Id.* (quoting *Fat Boys*, 118 USPQ2d at 1513) (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)). “We ask whether someone who knows what the goods and services are will understand the mark to convey information about them.” *Id.* (quoting *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1374 (Fed. Cir. 2018) (quoting *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012))).

“Whether a mark is merely descriptive or not is determined from the viewpoint of the relevant purchasing public.” *Zuma Array*, 2022 USPQ2d 736, at *8 (quoting *In re Omniome, Inc.*, 2020 USPQ2d 3222, at *5 (TTAB 2020) (quoting *Stereotaxis*,

77 USPQ2d at 1090)). The relevant purchasers of the goods identified in the application are consumers of metalworking machines (the International Class 7 goods) and the computers and software used to control metalworking machines (the International Class 9 goods).³

“Evidence of the public’s understanding of [a] term . . . may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers[,] and other publications.” *Id.* (quoting *Fallon*, 2020 USPQ2d 11249, at *7 (quoting *Real Foods*, 128 USPQ2d at 1374)). “These sources may include [w]ebsites, publications and use in labels, packages, or in advertising materials directed to the goods.” *Id.* (quoting *Fallon*, 2020 USPQ2d 11249, at *7-8 (quoting *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017) (internal quotation omitted))).

“It is the Examining Attorney’s burden to show, prima facie, that a mark is merely descriptive of an applicant’s goods or services.” *Id.* (internal quotation and quotation marks omitted). “If such a showing is made, the burden of rebuttal shifts

³ We have not attempted to include in this consumer group all the consumers of the different goods identified in the Application. Rather, we focus on metalworking machines and the computers and software that control those machines. The evidence of record establishes that such machines, and the computers and software that control the machines, constitutes a market segment. *See, e.g.*, Final Office Action dated July 11, 2022, at 8-11. For this reason, we define the relevant consumers based on the record evidence, while noting that the Application also identifies goods that may be sold to different consumer groups. The definition of the relevant consumers provided above is appropriate here, because if the GEAR PROFILER mark is merely descriptive of any of the goods within the identification, registration must be refused under Section 2(e)(1). *In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219 (a term that is merely descriptive or generic as to certain of the goods or services in a class renders the mark unregistrable as to the entire class of goods or services).

to the applicant.” *Id.* (internal quotation and quotation marks omitted). “The Board resolves doubts as to the mere descriptiveness of a mark in favor of the applicant.” *Id.* (internal quotation and quotation marks omitted).

The issue before us is a straightforward one. Applicant argues the proposed mark GEAR PROFILER is suggestive of the goods, while the Examining Attorney contends the mark is merely descriptive. The Examining Attorney bears the burden of making a prima facie showing that the mark is merely descriptive, and Applicant is fully within its rights to challenge that showing. The Examining Attorney submitted dictionary definitions and other evidence to support the refusal. Applicant submitted no evidence, but argued against the refusal.

We begin with the dictionary entries in the record. Evidence that a term is merely descriptive to the relevant purchasing public may be obtained from any competent source, *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001), such as dictionaries, newspapers, or surveys. *In re Bayer*, 82 USPQ2d at 1831. It also may be obtained from websites and publications. *In re N.C. Lottery*, 123 USPQ2d at 1710. In short, “the [US]PTO has satisfied its evidentiary burden if ... it produces evidence including dictionary definitions that the separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to those words as a compound.” *In re Gould Paper Corp.*, 834 F.2d 1017, 1018, 5 USPQ2d 1110, 1111-12 (Fed. Cir. 1987).

The following dictionary definitions are established by the evidence:

- a “gear” is “a toothed machine part, such as a wheel or cylinder, that meshes with another toothed part to transmit motion or to change speed or direction;”⁴
- a “profile” can be “a representation of an object or structure seen from the side,” or “an outline of an object.”⁵

We have a Wikipedia entry that refers to the profile of a gear, which we construe to be the outline or side view of a gear.⁶ The following excerpt, taken from the Wikipedia page, shows portions of the profiles of two gears engaged with each other:




We also have evidence showing a gear profile, with a technical discussion of a particular type of gear profile, an excerpt of which is provided below.

⁴ Office Action dated November 1, 2021, at 6 (from the American Heritage dictionary of the English Language (online version)).

⁵ *Id.* at 7 (from same dictionary).

⁶ Final Office Action dated July 11, 2022, at 11.


⁷ *Id.*



HomeAbout UsServicesBlogContact

Gear Tooth Profile

Home / Construction / Gear Tooth Profile



Categories

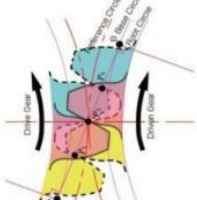
- Construction
- General Knowledge
- Government/Military
- Uncategorized

Gear Tooth Profile:

One of the fundamental s of gear design is the profile of the gear tooth. Gears generally have an involute curve tooth profile. There are other types of gear profiles, but they are mainly utilized in specialty applications such as cycloidal gears in clocks and watches.

This involute curve helps the gears transmit power smoothly during the rolling action. The curve is produced by wrapping a string around a cylinder; the base circle, and as it is unwrapped from this cylinder traces the involute curve. The base circle of the involute curve is also important because it helps to determine the pressure angle of the gear, another fundamental of gear design.

The contact point of the gear and pinion goes along the involute curves of the gears. The involute gear tooth profile also helps with smooth rotation even with variations in

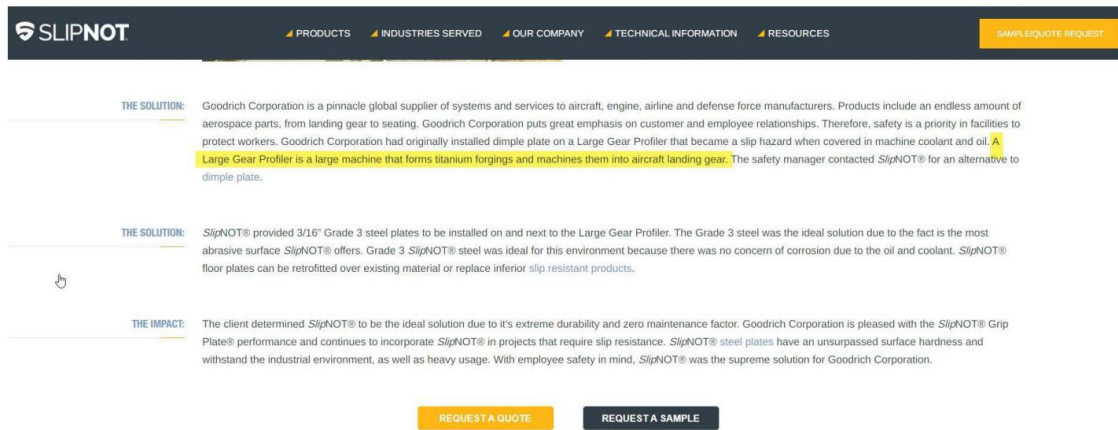


8

Finally, and most to the point, there is evidence that a “gear profiler” is a particular type of metalworking machine or is a function carried out by some metalworking machines. The excerpt below includes the following statement (highlighted in yellow): “A Large Gear Profiler is a large machine that forms titanium forgings and machines them into aircraft landing gear.”⁹

⁸ *Id.* at 9.

⁹ *Id.* at 7.



Other evidence identifies a particular machine tool known as a “Wera Profilator gear profiler,” which is described as part of a “fully automated production of ring gears.”¹¹ Finally, there is evidence with a reference to an “Automatic Gear Profile Machine,” which is described as being capable of producing “cylindrical parts with special profile”¹²

Applicant submitted no evidence, but argues the evidence just reviewed fails to establish a prima facie showing that the mark GEAR PROFILER is merely descriptive. We strongly disagree. The evidence of record shows, at a minimum, descriptive uses of “gear profiler,” and this evidence shows at least some segments of the metalworking machine industry understand what a “gear profiler” is. The evidence shows that relevant consumers—those use purchase metalworking machines and the computers and software that control metalworking machines—

¹⁰ *Id.* This excerpt is from a section of a website that appears to provide “Case Studies” showing how certain problems were solved. The reference to a Large Gear Profiler is made in that context.

¹¹ *Id.* at 8.

¹² *Id.* at 13.

will understand the GEAR PROFILER mark as at least merely descriptive of the goods.

Applicant tries to distinguish the evidence of record by arguing that the machines referenced above are not the same as the goods in the Application. In doing so, Applicant distorts the evidentiary record and misconstrues the Section 2(e)(1) inquiry. First, Applicant disputes the probative value of the evidence that describes a Large Gear Profiler, because Applicant argues, its goods “are not the same or similar to [such a machine].”¹³ The Application, however, identifies “metalworking machines” and the evidence just referenced identifies a metalworking machine. Applicant provides no explanation for why this particular metalworking machine would not fall within the identification of goods in the Application. The same is true of the other evidence. The evidence shows machines within the scope of the International Class 7 goods.

Applicant amended its International Class 9 goods, but even as amended, the evidence shows uses of the phrase “Gear Profiler” in connection with goods closely related to those identified in the Application. The International Class 9 goods include computers and software for controlling and monitoring metalworking machines. The evidence cited above includes a description of a gear profiler being controlled by a large computer system, as seen below.

¹³ 6 TTABVue 7 (emphasis in original).

Throughout the metalcutting process here, mostly in the gear and spline forming, hobbing, grinding and finishing, CNC technology is onboard dozens of machine tools. Most of the machines here are controlled by Sinumerik® 840D, the highest-level CNC offered by Siemens. The control not only processes the particular part dimensions in the cutting theater of the machine, it also coordinates all motion control and movements into and out of the machine. Working in tandem with the other hardware and communication network software in the line, for example, ring gears cut on a Wera Profiator machine are indexed from one station to the next, in timed sequences, to coordinate with predetermined production requirements. This operation occurs in a fully automated mode, requiring no operator intervention, except for maintenance and planned inspections.

Likewise, in the machining of valve bodies and transmission cases, each step of the process is controlled by the Siemens CNC to produce the required components in the proper sequence for subsequent assembly and testing operations. During those subsequent operations, other motion control devices and software solutions provided by Siemens execute, monitor and control the assembly process, through the SIFACS solution set.

PROFINET TALKS THE TALK

Through a decentralized and cabinet-less design, GM achieves highly integrated RFID control with easy access and true out-of-the-box solutions for the control architecture installed on this line. A Profinet solution provides GM with a high-performance, reliable network with minimum bandwidth impact or additional network load achieved at this plant, all with no special hardware required, a further cost savings for GM.

SAFETY FIRST — AND LAST

Safety features are numerous here, resulting in a complete failsafe



Wera Profiator gear profiler run by a Sinumerik 840D, the highest level CNC in the Siemens line, used for fully automated production of ring gears.

14

This evidence appears to show both a metalworking machine—the “Wera Profiator gear profiler”—and computer and software controlling the machine—the Siemens Sinumerik 840D. This machine and the computer and software that control it appear to be within the scope of the goods identified in the Application. Mere attorney argument that contradicts the record is not persuasive. *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005) (“Attorney argument is no substitute for evidence.”); *Cf. Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1725 n.7 (TTAB 2010) (assertions in brief carry no weight unless supported by evidence introduced at trial or except as admission against interest).

¹⁴ Final Office Action dated July 11, 2022, at 8.

Applicant misconstrues the Section 2(e)(1) inquiry when it argues the mark does not directly describe “metalworking machines and machines tools, computers, laser measuring systems, or scanners, much less with the requisite level of particularity required to support a ‘merely descriptive’ refusal.”¹⁵ A Section 2(e)(1) refusal is appropriate if the mark merely describes any goods, or features of any goods, that fall within the scope of the goods identified in the Application. *In re Chamber of Commerce of the United States*, 102 USPQ2d at 1219. In other words, if the mark merely describes a product that falls within the identification, the mark is merely descriptive under Section 2(e)(1). To argue otherwise is to miss the trees for the forest, so to speak.

This appeal provides a good example of why this rule is needed. Applicant’s goods include metalworking machines, a broad category of goods. The Examining Attorney has established, through the evidence of record, that a “gear profiler” is a type of metalworking machine, or a function performed by metalworking machines. The evidence also shows such machines are often controlled using computers and software. We do not have an extensive record concerning these tools, but the evidence of record is probative, and Applicant provides no evidence to refute or undermine that submitted by the Examining Attorney. As previously noted, Attorney argument only goes so far and is not a substitute for evidence. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 76 USPQ2d at 1622; *Martahus v.*

¹⁵ 6 TTABVue 6.

Video Duplication Servs. Inc., 3 F.3d 417, 27 USPQ2d 1846, 1849 (Fed. Cir. 1993) (“[M]ere attorney arguments unsubstantiated by record evidence are suspect at best.”).

Because the GEAR PROFILER mark merely describes a type of product within the identification of goods, allowing registration of this mark could facilitate efforts by Applicant to block third parties from using the words “gear profiler” in connection with metalworking machines that reproduce gears by using a profiling process. In short, Applicant could use a registration in an anti-competitive manner if the mark is merely descriptive of any goods that fall within the identification.¹⁶ And in this case, that is exactly what the evidence establishes.

We find the Examining Attorney has made a prima facie showing that the GEAR PROFILER mark is merely descriptive of a product, or a feature of a product, that falls within the identification of both classes of goods in the Application. For this reason, we affirm the Section 2(e)(1) refusal to register.

Decision: The Section 2(e)(1) refusal is **affirmed**.

¹⁶ We do not mean to suggest that Applicant had improper motives in seeking registration of the GEAR PROFILER mark. Our point is a general one. When merely descriptive marks are protected under trademark law, there is a risk of anticompetitive consequences.