

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
October 28, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
In re Neato Robotics, Inc.

—
Serial No. 85751529
Serial No. 85751546
Serial No. 85757665
Serial No. 85757674

—
James E. Rosini and Jonathan W. Thomas of Kenyon & Kenyon LLP for Neato Robotics, Inc.

Priscilla Milton, Trademark Examining Attorney, Law Office 110 (Chris A. F. Pedersen, Managing Attorney).

—
Before Kuhlke, Shaw and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Neato Robotics, Inc. (“Applicant”) filed four applications for registration of standard character trademarks on the Principal Register, as follows:

Serial Nos. 85751529; 85751546; 85757665; and 85757674

| <u>Serial No.</u> | <u>Mark</u> | <u>Goods</u> |
|-------------------|--------------|---|
| 85751529 | NEATO BOTVAC | Vacuum cleaners, robotic vacuum cleaners and parts thereof, in International Class 7. |
| 85751546 | NEATO BOTVAC | Robotic appliances for household purposes and maintenance and parts thereof, namely, robotic vacuum cleaners and parts thereof, in International Class 9. |
| 85757665 | BOTVAC | Vacuum cleaners, robotic vacuum cleaners and parts thereof, in International Class 7. |
| 85757674 | BOTVAC | Robotic appliances for household purposes and maintenance and parts thereof, namely, robotic vacuum cleaners and parts thereof, in International Class 9. |

The two NEATO BOTVAC applications were filed on October 11, 2012. The two BOTVAC applications were filed on October 18, 2012. All were filed on the basis of Applicant's asserted *bona fide* intent to use the mark in commerce, under Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

In the case of the two applications to register BOTVAC, the Trademark Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant's mark is merely descriptive of the identified goods. In the case of the two applications to register NEATO BOTVAC, the Examining Attorney required Applicant, under Trademark Act Section 6(a), 15 U.S.C. § 1056(a), to disclaim the exclusive right to use BOT VAC (as two words) on the ground that it is an unregistrable component of Applicant's mark, because it is merely descriptive of Applicant's goods. Applicant

Serial Nos. 85751529; 85751546; 85757665; and 85757674

declined to enter the required disclaimer. When the respective refusals and requirements were made final, Applicant appealed with respect to all four applications and requested reconsideration with respect to the two NEATO BOTVAC applications. The Examining Attorney denied the requests for reconsideration, and Applicant's four appeals proceeded. Applicant filed a separate appeal brief for each application. The Examining Attorney then moved to consolidate the four appeals, and the Board granted the motion.¹ The Examining Attorney in turn filed a single brief relating to all four appeals; and Applicant filed a single reply brief. The evidentiary records of all four applications are nearly identical. In our discussion, all references to the record refer to the record of Application Serial No. 85751529, unless we note otherwise.

1. The refusals under Section 2(e)(1).

We will first address the applications to register BOTVAC, Serial Nos. 85757665 and 85757674, which raise the question of whether BOTVAC is merely descriptive of Applicant's goods within the meaning of Section 2(e)(1) of the Trademark Act. Section 2(e)(1) provides for the refusal of registration of "a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them." 15 U.S.C. § 1052(e)(1). A term is merely descriptive of goods 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. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102

¹ See 20 and 21 TTABVue of the record for 85751529.

Serial Nos. 85751529; 85751546; 85757665; and 85757674

USPQ2d 1217, 1219 (Fed. Cir. 2012); *see also*, *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). 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. *See In re Gyulay*, 3 USPQ2d at 1010; *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Moreover, the mark need not describe all of the identified goods. Rather, a descriptiveness refusal is proper with respect to all of the identified goods in an International Class if the mark is descriptive of any of the goods in that class. *In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005).

It is the Examining Attorney's burden to show, *prima facie*, that a term is merely descriptive of an applicant's goods or services. *In re Gyulay*, 3 USPQ2d at 1010; *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2052 (TTAB 2012). If such a showing is made, the burden of rebuttal shifts to Applicant. The Board resolves doubts as to the mere descriptiveness of a mark in favor of Applicant. *In re The Stroh Brewery Co.*, 34 USPQ2d 1796, 1797 (TTAB 1994).

The Examining Attorney has shown that "robot vacuum cleaners" or "robotic vacuum cleaners" are a known product in the marketplace. They are electronic devices that, when set in motion, will move about a space at their own direction, vacuuming up dust and dirt. *See, e.g.*, web pages from <appliancist.com>, <broadwayfurniture.net>, <blog.espow.com>, and <robotreviews.info>, describing

Serial Nos. 85751529; 85751546; 85757665; and 85757674

“robot vacuum cleaners” offered under brands such as LG, iROBOT ROOMBA, ELECTROLUX TRILOBITE, SAMSUNG NAVIBOT, and NEATO XV-12, among others.² Such goods are within the scope of the goods identified in each of the four applications.

The Examining Attorney argues that in the term BOTVAC, “[A]pplicant has combined two highly descriptive and/or generic designations for [A]pplicant’s goods,” and that “if the individual components of a mark retain their descriptive meaning in relation to the goods and/or services, the combination results in a composite mark that is itself descriptive and not registrable.”³

The Examining Attorney has shown that the term VAC is a recognized informal expression meaning “A vacuum cleaner.” See definition of “vac” from <education.yahoo.com>.⁴ She also refers in her brief to a definition of “bot” from <abbreviations.com>;⁵ but no such definition is present in the record of any of the four applications. However, she made of record numerous excerpts from internet web sites, showing use of the term “bot” to mean “robot.” We note the following:

| | |
|---------------|---|
| <cnet.com> | “Neato’s vac-bot sucks it up” ... Neato Robotics showed off its XV-11 vacuum bot after launching it last year. ⁶ |
| <gizmodo.com> | “The Best Robot Floor Cleaners” ... But which floor-bot is dominant? ⁷ |

² Office Action of February 13, 2013 at 17-18, 20, 23, 28-29, 40-42.

³ Examining Attorney’s brief, 22 TTABVUE 7, 11-12.

⁴ *Id.*, 22 TTABVUE 7.

⁵ *Id.*, 22 TTABVUE 7, fn.1.

⁶ Office Action of September 4, 2013 at 13-14.

⁷ *Id.* at 43.

<trustedreviews.com> Neato XV-25 Features ... Unlike so-called ‘bump bots’ which seem to take an almost random approach to cleaning, SLAM robot vacuums calculate their every move.⁸

<singularityhub.com> Neato has a bot that sees better, works smarter, and sucks harder ... Why Do We Need a Better Vacuum Bot? ... Because iRobot is spending their time making some cool army and healthcare bots, not innovating the Roomba.⁹

<singularityhub.com> The bot uses advanced mapping software and a killer laser range to find its way through a room with a single pass. ... Worry not, bot-junkies, the next generation of vacuum bots is making its way stateside as we speak ... The market for these household bots is expanding ...¹⁰

<mashable.com> Windoro cleans windows small to large. With adjustable magnets, you can fit the window cleaner bot to single or double pane windows.¹¹

<positivefuturist.com> Design tricks like these, along with soft “nanoskin” will make tomorrow’s ‘bots seem uncannily human ... [A] timetable for robot development: ... **2020:** ‘Bots prepare meals, set tables, clean house, provide interface to communication ...¹²

Mail Online

“Plant bot: The world’s first robot that can turn your household plants into light-seeking ‘triffid’ drones” ...The world’s first robot that can carry plants around a room making sure they stay in sunlight all day has been developed by a team of researchers from Rutgers University.¹³

<forbes.com> “Household Robots” Science fiction writers have long envisioned ... surveillance robots ... Little could they have

⁸ *Id.* at 60.

⁹ *Id.* at 64.

¹⁰ *Id.* at 86-87.

¹¹ *Id.* at 94.

¹² *Id.* at 98.

¹³ *Id.* at 99.

imagined that when those spybots became a reality, we would invite them into our homes. ... Connect the bot to your home wi-fi network and you can control it through a Web browser from anywhere in the world. ... You can even set the bug-like bot to follow a pre-programmed patrol through the house.¹⁴

NBC NEWS

“Dawn of the bot” New era nears, experts say” ... Using voice commands and hand gestures, humans will control robots in the cold vacuum of space, while bots deep underwater and high in the air will collaborate to protect the U.S. from natural disasters and military threats.¹⁵

Digital Trends

“BOTS BEHIND THE WHEEL: FORD TURNS TO HIGH-TECH ROBOTS FOR TRACK TESTING DUTIES”¹⁶

<technology.inquirer.net>

Matthew Rossow tests the lettuce bot in Salinas, Calif. ... [E]ntrepreneurs ... are testing the Lettuce Bot, a boxy robotic machine that can thin fields of lettuce...¹⁷

<venturebeat.com>

“Robotic pet care: While you’re at work, this bot takes care of your best friend.”¹⁸

<bostonglobe.com>

The sleek, 4-foot-tall bot, which costs about \$6,000, is equipped with a video screen, speaker, and microphone so a doctor in a distant location can communicate with--and see -- members of the NAU Lumberjacks. ... The VGo bots are also being used in several Boston-area hospitals and in some schools ...¹⁹

<minnesota.cbslocal.com>

“Bright Minds Battle Their ‘Bots At Minnesota State Fair.”²⁰

¹⁴ *Id.* at 117,

¹⁵ *Id.* at 128-129.

¹⁶ *Id.* at 136.

¹⁷ *Id.* at 142.

¹⁸ *Id.* at 148.

¹⁹ *Id.* at 154-155.

²⁰ *Id.* at 158.

We find this evidence sufficient to show that in the context of automated machines, including automated vacuum cleaners, the term “bot” is used and understood to mean “robot.”

Applicant argues that “a composite mark must be considered in its entirety and the question then is whether the entirety is merely descriptive.”²¹ Applicant criticizes the Examining Attorney’s evidence because she “did not proffer a single definition for “botvac”; and because she “failed to proffer evidence regarding consumer understanding and meaning of the composite mark BOTVAC altogether.”²² However, the news articles quoted above are evidence of the public’s understanding of the term “bot,” and the dictionary entry for “vac” is valid evidence to show that “vac” is a recognized term. We must, of course, determine the question of mere descriptiveness with respect to Applicant’s mark as a whole. However, it is not improper to consider the meanings of the individual components of a mark:

In considering a mark as a whole, the Board may weigh the individual components of the mark to determine the overall impression or the descriptiveness of the mark and its various components. *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058 [224 USPQ 749] (Fed. Cir. 1985). ... However, if those two portions individually are merely descriptive of an aspect of appellant's goods, the PTO must also determine whether the mark as a whole, i.e., the combination of the individual parts, conveys any distinctive source-identifying impression contrary to the descriptiveness of the individual parts.

²¹ Applicant’s brief at 12, 18 TTABVUE 13, quoting *In re Wisconsin Tissue Mills*, 173 USPQ 319 (TTAB 1972).

²² *Id.* at 8, 7, 18 TTABVUE 9, 8.

Serial Nos. 85751529; 85751546; 85757665; and 85757674

In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004). The Examining Attorney need not demonstrate that “botvac” is a known word that is defined in dictionaries or other reference works. The actual test is whether relevant customers would perceive the mark as conveying “an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods.” *In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219.²³ Under this standard, descriptiveness may be found not only as to individual words, but also as to combinations of words or compound terms like Applicant’s mark. Even a combination of words or compound term that has never been used before may be found merely descriptive. Being “the first and only one to adopt and use the mark sought to be registered does not prove that the mark is not descriptive.” *In re Bailey Meter Co.*, 102 F.2d 843, 41 USPQ 275, 276 (CCPA 1939); *In re Swatch Grp. Mgmt. Servs. AG*, 110 USPQ2d 1751 (TTAB 2014).

The evidence discussed above shows that each of the terms BOT and VAC is merely descriptive with respect to Applicant’s goods. BOT describes the robotic feature of the goods and indicates that the goods are, themselves, robots. VAC describes their fundamental nature, in that the goods are vacuum cleaners. Considering the two terms together, we note that in standard English usage it is commonplace to see two nouns combined, such that the first noun modifies the

²³ Applicant’s contention, supported primarily by nonprecedential decisions of the Board, that a determination of mere descriptiveness must be based upon a four-factor test is not an authoritative statement of the legal standards at issue in this case. The Board’s primary reviewing court has, on a number of occasions in recent years, restated the applicable test. *See, e.g., In re Chamber of Commerce of the U.S.*, 102 USPQ2d 1217; *DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). We are guided in our decision by these and similar authorities.

Serial Nos. 85751529; 85751546; 85757665; and 85757674

second. Examples abound in the portions of the record quoted above, *e.g.*, “Floor Cleaners,” “robot vacuums,” “window cleaner,” “healthcare bots,” “bot-junkies,” “design tricks.” When Applicant’s mark is viewed as two nouns, the first of which modifies the second, relevant customers would readily perceive it to mean a vacuum cleaner that is a robot or is robotic. The fact that, in Applicant’s mark, there is no space between the terms BOT and VAC does not render the combined term nondescriptive: we see no persuasive evidence or argument of record to suggest that combining BOT and VAC into a single term alters the commercial impression created by the two terms. *See, e.g., In re Carlson*, 91 USPQ2d 1198, 1200 (TTAB 2009) (URBANHOUSING merely descriptive of real estate brokerage); *In re A La Vieille Russie Inc.*, 60 USPQ2d 1895, 1897 n. 2 (TTAB 2001) (“the compound term RUSSIANART is as merely descriptive as its constituent words, ‘Russian Art’”).

Applicant argues that “the Examining Attorney’s adopted definitions of ‘bot’ and ‘botvac’ are arbitrary and ignore the numerous definitions and meanings of the same. Applicant points to its own evidence showing that “bot” means “the larva of a botfly,” “a person who cadges” or a type of computer software, and that “bot” may be considered an abbreviation for words including “botanical” and “botany.”²⁴ Applicant further argues that “arriving at a single definition or meaning of ‘bot’ is impossible,” and that, accordingly, “a precise definition or meaning of BOTVAC cannot be established on this record.”²⁵ The possibility that a term may have different meanings in a variety of contexts is not the controlling question. Rather,

²⁴ Dictionary definitions filed with Applicant’s response of August 13, 2013 at 16-21.

²⁵ Applicant’s brief at 13, 18 TTABVUE 14.

Serial Nos. 85751529; 85751546; 85757665; and 85757674

we determine the question of descriptiveness in relation to the goods 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). In other words, we evaluate 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). When considered in the relevant commercial context by a person who knows that the goods are robotic vacuum cleaners, the alternative meanings of “bot” proposed by Applicant would not likely interfere with the customer’s understanding of the mark as meaning “robotic vacuum cleaner.”

Applicant argues that its mark is suggestive rather than merely descriptive:

[E]ven if consumers are familiar with Applicant’s products, when they encounter “bot” combined with “vac” in the marketplace, they are just as likely to assume that BOTVAC suggests goods related to vacuums and botfly larvae, or vacuums and automated shopping assistants, as they are to assume it suggests Applicant’s goods. It is also possible that consumers do not see the mark as “bot-vac,” but as “boat-vac” or “bo-t-vac.” Thus, upon encountering BOTVAC in the marketplace, consumers must momentarily pause, work through the numerous potential definitions and meanings of BOTVAC, and then take a mental leap in order to correctly determine the nature and characteristics [of] Applicant’s products.²⁶

These arguments do not persuade us. Relevant customers for a robotic vacuum cleaner would be at least somewhat familiar with the concept of a robot, but would

²⁶ *Id.* at 10, 18 TTABVUE 11.

Serial Nos. 85751529; 85751546; 85757665; and 85757674

be relatively unlikely to know what a botfly is. It is also unlikely that they would interpret the mark as meaning something that combines a vacuum cleaner and an automated shopping assistant; what such a product might be is difficult to imagine. Finally, while it is true that a trademark might be subjected to all kinds of pronunciations, the context in which robotic vacuum cleaners are sold would be unlikely to put customers in mind of a boat; and there is no reason, on this record, to believe that customers would perceive the mark as the meaningless “bo-t-vac,” when the highly relevant words “bot” and “vac” are so directly meaningful in the context of the goods. Overall, in view of the evidence showing how the terms “bot” and “vac” are understood in the context of robotic vacuum cleaners, no multi-stage reasoning process or resort to imagination would be required of relevant customers in order to determine the attributes of Applicant’s goods.

Applicant’s alternative contentions that its mark is either fanciful or arbitrary are without merit. Although BOTVAC may, technically, be a “coinage,” it is not a *fanciful* coinage, being composed of two words that have descriptive meaning in the relevant field of goods. Moreover, the fact that the words “bot” and “vac” have specific meaning in the field of robotic vacuum cleaners causes the mark to be the opposite of arbitrary, as that term is contemplated by *Abercrombie & Fitch Company v. Hunting World, Incorporated*, 537 F2d 4, 189 USPQ 759, 766 fn.12 (2d Cir. 1976).

Having considered all of the relevant evidence and arguments, we find that BOTVAC is merely descriptive of Applicant’s goods within the meaning of

Serial Nos. 85751529; 85751546; 85757665; and 85757674

Trademark Act Section 2(e)(1). Accordingly, we affirm the refusal to register the marks in applications Serial Nos. 85757665 and 85757674.

2. Requirement of a disclaimer under Trademark Act Section 6.

We turn next to the Examining Attorney's requirement that Applicant disclaim the exclusive right to use BOT VAC, apart from the mark NEATO BOTVAC as a whole. The Examining Attorney issued this requirement with respect to applications Serial Nos. 85751529 and 85751546.

The Director of the USPTO "may require the applicant to disclaim an unregistrable component of a mark otherwise registrable." Trademark Act Section 6(a), 15 U.S.C. § 1056(a). The USPTO may require a disclaimer as a condition of registration if the term at issue is merely descriptive of any of the identified goods or services. *In re Stereotaxis Inc.*, 77 USPQ2d at 1089.

Our analysis in part 1 of this decision found that BOTVAC is merely descriptive of Applicant's goods within the meaning of Section 2(e)(1) and is therefore an unregistrable component of Applicant's mark within the meaning of Section 6(a). Applicant has not contended, and we see no reason to find, that in Applicant's mark the terms NEATO and BOTVAC are so integrated that they cannot be regarded as separable, giving rise to a distinct meaning independent of the meanings of the mark's constituent terms. *See Dena Corp v. Belvedere Int'l Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991). Therefore, the Examining Attorney's requirement of a disclaimer is warranted. Inasmuch as the compound term BOTVAC consists of two distinct words that are not usually rendered as a single

Serial Nos. 85751529; 85751546; 85757665; and 85757674

term, the disclaimed matter should be rendered as two words, BOT VAC. Accordingly, we affirm the Examining Attorney's requirement of a disclaimer of the exclusive right to use BOT VAC apart from the mark as shown.

Decision: With respect to applications Serial Nos. 85757665 and 85757674, the refusal to register the mark BOTVAC under Trademark Act Section 2(e)(1) is AFFIRMED.

With respect to applications Serial Nos. 85751529 and 85751546, the refusal to register the mark NEATO BOTVAC is AFFIRMED on the ground of Applicant's failure to comply with the requirement of a disclaimer. With respect to these two applications, Applicant is allowed until thirty (30) days from the date of this decision to submit to the Board a disclaimer (in proper form) of the designation BOT VAC, in which case this decision will be set aside with respect to applications Serial Nos. 85751529 and 85751546. *See* Trademark Rule 2.142(g).