Mailed: April 12, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Nanochip ID, Inc.

Serial No. 86694656

Travis D. Wilson of The Law Office of Travis Wilson,
for Nanochip ID, Inc.

Sophia S. Kim, Trademark Examining Attorney, Law Office 106,
Mary I. Sparrow, Managing Attorney.

Before Zervas, Bergsman and Pologeorgis,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Nanochip ID, Inc. ("Applicant") seeks registration on the Principal Register of the mark NANOCHIP (in standard characters) for "radio frequency identification (RFID) tags," in Class 9.[1]

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground

[1] Application Serial No. 86694656 was filed on July 16, 2015, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant's claim of first use anywhere and use in commerce since at least as early as June 17, 2013.

that Applicant's mark is merely descriptive because it immediately describes a feature or characteristic of the goods, namely, that the products "feature a very small microchip."[2]

After the Trademark Examining Attorney made the refusal final, Applicant appealed to this Board. We affirm the refusal to register.

Section 2(e)(1) of the Trademark Act prohibits registration on the Principal Register of "a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive . . . of them." 15 U.S.C. § 1052(e)(1). A term is "merely descriptive" within the meaning of Section 2(e)(1) if it "immediately conveys knowledge of a 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)). "On the other hand, if 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 363, 364-65 (TTAB 1983); *In re Universal Water Systems, Inc.*, 209 USPQ 165, 166 (TTAB 1980).

Whether a mark is merely descriptive is determined in relation to the goods for which registration is sought, not in the abstract or on the basis of guesswork.

[2] Trademark Examining Attorney's Brief at 6 TTABVUE 9; *see also* 6 TTABVUE 4 ("The proposed mark conveys the impression that the identified goods [radio frequency identification tags] are comprised of a very small integrated circuit or microchip.").

Descriptiveness must be 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 Chamber of Commerce of the U.S.,* 102 USPQ2d at 1219 (quoting *In re Bayer AG*, 82 USPQ2d at 1831). 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); *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)).

When two or more merely descriptive terms are combined, the determination of whether the combined mark also has a merely descriptive significance turns on whether the combination of terms evokes a non-descriptive commercial impression. If each component retains its merely descriptive significance in relation to the goods, the combination results in a composite that is itself merely descriptive. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004) (quoting *Estate of P.D. Beckwith, Inc. v. Commr.*, 252 U.S. 538, 543 (1920)); *see also In re Tower Tech, Inc.*, 64 USPQ2d at 1318 (SMARTTOWER merely descriptive of commercial and industrial cooling towers); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENTBEANS merely descriptive of computer programs for use in developing and deploying application programs); *In re Putman Publ'g. Co.*, 39 USPQ2d 2021 (TTAB 1996) (FOOD & BEVERAGE ONLINE merely descriptive of news and information services in the food processing industry).

On the other hand, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a non-descriptive meaning, or if the composite has an incongruous meaning as applied to the goods or services. *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE for "bakery products"); *In re Shutts*, 217 USPQ 363 (SNO-RAKE for "a snow removal hand tool having a handle with a snow-removing head at one end, the head being of solid uninterrupted construction without prongs"). 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). Thus, we must consider the issue of descriptiveness by looking at the mark in its entirety.

"It is the Examining Attorney's burden to show, *prima facie*, that a mark is merely descriptive of an applicant's goods or services." *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1513 (TTAB 2016) (citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987)). If the Examining Attorney establishes a *prima facie* case, the burden shifts to the applicant to rebut that case. *Id.* "The Board resolves doubts as to the mere descriptiveness of a mark in favor of the applicant." *Fat Boys,* 118 USPQ2d at 1512 (citing *In re Stroh Brewery Co.*, 34 USPQ2d 1796, 1797 (TTAB 1994)).

We start our analysis of whether NANOCHIP is merely descriptive by defining the terms that comprise the mark. The word "nano" is defined, *inter alia*, as "denoting a very small item."[3] The word "chip" is defined, *inter alia*, as set forth below:

> Also a microchip. *Electronics.* A tiny slice of semiconducting material, generally in the shape of a few millimeters long, cut from a larger wafer of the material, on which a transistor or an entire integrated circuit is formed.[4]

Applicant's website identifies the "radio frequency identification (RFID) tags" as microchips.[5]

Applicant's mark NANOCHIP retains the dictionary definitions of its component parts when used in connection with "radio frequency identification (RFID) tags" engendering the commercial impression that Applicant's product is or is comprised of a very small microchip that functions as an identification tag. The combined term NANOCHIP does not form a unitary mark with a non-descriptive meaning. Excerpts from Applicant's website (nanochipid.com) touting the small size of the product support this finding of fact.

---

[3] *Oxford Dictionaries* (oxforddictionaries.com) attached to the November 5, 2015 Office Action, TSDR p. 4. References to TSDR pages are in the .pdf format.

[4] Dictionary.com based on the *Random House Dictionary* (2017). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd,* 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1038 n.14 (TTAB 2010). *See also MacMillan Dictionary* (macmillandictionary.org) attached to the November 5, 2015 Office Action, TSDR pp. 6-7 ("a very small piece of silicon marked with electronic connections"); *Free On-Line Dictionary of Computing* (foldoc.org) ("integrated circuit" or "microelectronic semiconductor device") attached the November 5 2015 Office Action, TSDR p. 10.

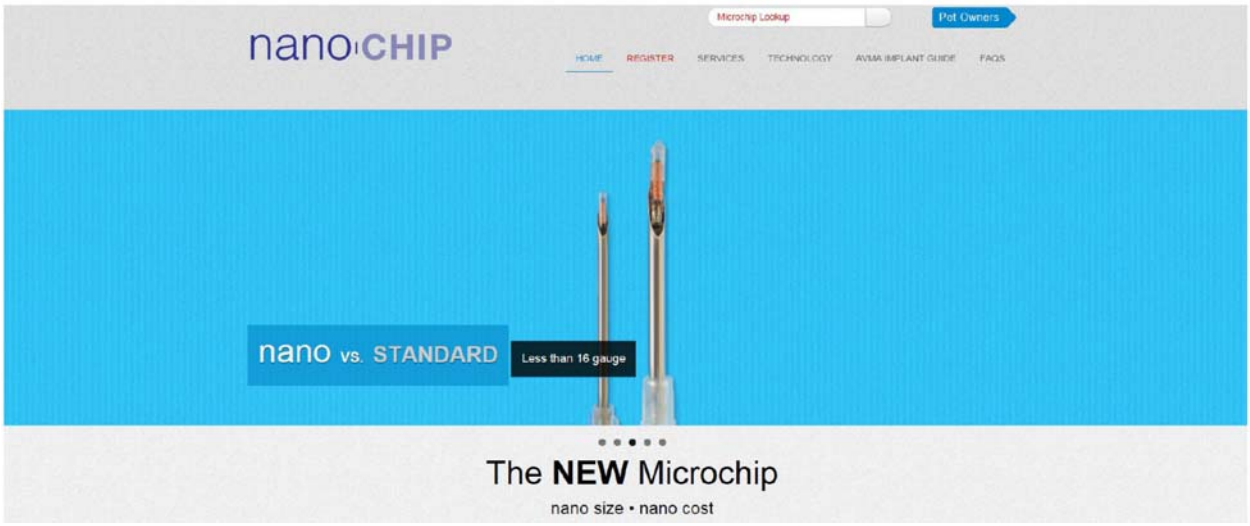
[5] Nanochipid.com attached to the November 5, 2015 Office Action, TSDR pp. 12-15 ("The NEW Microchip," "Advanced microchip technology available for only $3.99 per chip," "nano/chip Carton (10 microchips)").

6

Why should I use nanoCHIPs?

A nanoCHIP occupies only 16% of the volume of a typical microchip. nanoCHIP's fine gauge needle makes it easier for you to implant and for the pet to receive.

7



Applicant argues that NANOCHIP is suggestive because "it fails to convey the use or purpose of that microchip, in the instant application as a part of a RFID tag."[8] However, as indicated above, a mark may be merely descriptive it "immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used." In this case, when NANOCHIP is used in connection with a RFID tag, the mark directly conveys to consumers a feature of Applicant's product, namely, an RFID that is or is comprised of a very small microchip.

[6] Applicant's February 18, 2016 Response to an Office Action, TSDR p. 15.

[7] November 5, 2015 Office Action, TSDR p. 15.

[8] Applicant's Brief, p. 4 (4 TTABVUE 8).

Applicant also contends that the use of NANOCHIP in connection with RFID tags creates a double entendre.

> In relation to Applicant's NANOCHIP mark, the second meaning is in the word "NANO." While it usually denotes the size of the product, it can also refer to the cost. Nano in cost equates to a smaller and therefor [sic] less expensive cost to the consumer. This second meaning is used by the Applicant in regard to their goods.[9]

However, Applicant's contention is based solely on the word "nano" when the mark at issue is NANOCHIP. While the word "nano" may have multiple meanings in the abstract, when Applicant uses NANOCHIP in connection with RFID tags, it clearly conveys the message that its product is or is comprised of a very small microchip.

In view of the foregoing, we find that NANOCHIP is merely descriptive under Section 2(e)(1) of the Trademark Act of a characteristic of Applicant's goods when used in connection with "radio frequency identification (RFID) tags."

Decision: The refusal to register Applicant's mark NANOCHIP is affirmed.

[9] Applicant's Brief, p. 6 (4 TTABVUE 10).