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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Matsushita Electric Corporation of America

Serial Nos. 76328037 and 76328039

Morton Amster and Holly Pekowsky of Amster, Rothstein & Ebenstein for Matsushita Electric Corporation of America.

Carolyn Pendleton Cataldo, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Simms, Hohein and Walters, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Matsushita Electric Corporation of America has filed two applications to register on the Principal Register the marks shown below for "digital camcorders having the capability of functioning as a digital still camera and/or as a camera providing connection to the Internet or web," in International Class 9.

[1]

[2]

Following publication and issuance of a notice of allowance, applicant filed a statement of use and specimens of use in each application. The Examining Attorney then required a disclaimer of "3 IN 1" and "2 IN 1," respectively. She also stated that the specimens showing wording around the rim of each design mark (as in the

[1] Serial No. 76328037 ("'037 application"), filed October 22, 2001, based on an allegation of a bona fide intention to use the mark in commerce. In its statement of use, applicant alleged dates of first use and use in commerce as of January 25, 2002. Subsequent to filing the specimens, applicant amended its mark as shown above and entered a disclaimer of DIGITAL CAMCORDER, DIGITAL STILL CAMERA and WEB CAM apart from the mark as a whole.

[2] Serial No. 76328039 ("'039 application"), filed October 22, 2001, based on an allegation of a bona fide intention to use the mark in commerce. In its statement of use, applicant alleged dates of first use and use in commerce as of January 25, 2002. Subsequent to filing the specimens, applicant amended its mark as shown above and entered a disclaimer of DIGITAL CAMCORDER and DIGITAL STILL CAMERA apart from the mark as a whole.

pictures above) are materially different from the marks shown in the applications as filed, wherein each design mark has an outer black ring without any wording contained thereon; and that, thus, an amendment to the drawing would be inappropriate. She required substitute specimens showing use of the mark as originally filed.

Applicant responded by submitting substitute drawings of the two marks (as shown above) and entering disclaimers of the wording contained in the outer black ring of each mark. Applicant argued that a disclaimer of "3 IN 1" and "2 IN 1," respectively, is unnecessary as neither term is merely descriptive.

The Trademark Examining Attorney issued a final requirement, under Section 6 of the Trademark Act, 15 U.S.C. 1056, for a disclaimer in each application of "3 IN 1" or "2 in 1," respectively, apart from the respective mark as a whole on the ground that this portion of each of applicant's marks is merely descriptive in connection with the identified goods.[3]

[3] The Examining Attorney also issued a final requirement, under C.F.R. 2.72(b), for substitute specimens that show use of the mark shown in the original drawing, concluding that the mark shown on the specimens and in the amended drawing is a material alteration of the mark in the original drawing. However, in her brief in Application Serial No. 76328037 and following remand after applicant's submission of its reply brief in Application Serial No. 76328039, the Examining Attorney withdrew the requirement for substitute specimens and accepted the amended drawing and disclaimer in each application. Therefore, this issue is no longer before us in these appeals.

In each case, applicant has appealed. Both applicant and the Examining Attorney have filed briefs but an oral hearing was not requested. The Board will consider the appeals in these two applications in a single consolidated decision because the issues on appeal are essentially the same in each application.

The Examining Attorney contends that the wording "3 IN 1" and "2 IN 1" are commonly used in the electronics industry to refer to products, such as camcorders, that contain three (or two) features in one product, *i.e.*, in both of these applications the product is a camcorder and a digital still camera and, in the '037 application, it is also a web camera. In support of her position, the Examining Attorney submitted excerpts of articles retrieved from the Lexis/Nexis database. The following are several examples from the excerpted articles:

"3 IN 1":

> "Argus Camera is demonstrating an array of digital cameras with features for a variety of photographic needs …. The DC-1540 is a **3-in-1** device that can be used as a digital camera, a PC cam, or a video camera, and when not in use, can be folded up to fit in a pocket or purse." [*Twice*, March 24, 2003.]
>
> "Micro 'Cool-Cam' **3-in-1** digital camera; $49.99 at JCPenney.com." [*Los Angeles Magazine*, December 1, 2002.]
>
> "TV/DVD/VCR combo: One of this season's hottest video items is the entertainment combo. Combining a television set, DVD player and videocassette recorder in one compact tabletop cabinet model has

marketing appeal. This **three-in-one** concept made its debut last Christmas when Panasonic introduced a 20-inch TV combo." [*The Oregonian*, November 29, 2002.]

"If size is not an issue, try Brookstone's 3-in-1 Digital Camera, which goes for $99." [*The Daily Record (Baltimore, MD.)*, November 21, 2002.]

Three-In-One – Imagine a digital camera, digital camcorder and PC camera combined into one feature-packed, high-tech, palm-size package. The PenCamII does it all …." [*Popular Mechanics*, June 1, 2001.]

Panasonic is taking those wishes to the proverbial next level with its e-wear line of products, all built around the tiny Secure Digital removable memory card. There's a digital audio player ($350), a photo printer ($220) and a **three-in-one** digital camera/camcorder/audio recorder ($450) – each weighing less than four ounces. We took the **three-in-one** device for a spin and found it to be a thoughtfully designed, pocket-friendly gadget." [*Newsweek*, July 8, 2002.]

"2 IN 1":

"If you can't decide between a new digital camcorder and a digital still camera, consider getting both gadgets with Panasonic's PV-VM202 MultiCam. What distinguishes this $2,200 model from other digital camcorders that can record both video and still images is a detachable 1-megapixel digital camera that can capture still pictures and MPEG-4 video and sound on its own. If all that this **2-in-1** camera had going for it were a clever design, it would be easy to write it off as just another tech gimmick." [*Des Moines Register*, May 14, 2002.]

"Electric Fuel's new batteries initially support Sony and JVC camcorders and Nikon and Sony digital cameras, but additional brand support will be added soon. The company also introduced a **2-in-1** Instant Power package for cell phones and PDAs. This features an Instant Power cell plus a car adapter …." [*Twice*, January 8, 2002.]

> This trend toward true higher-resolution sensors … means you can have a camera that's literally a **two-in-one** product. You no longer have to carry around a camcorder AND a digital still camera. These new Combo-Cam models feature the best features of both, and they're actually less expensive than buying both." [*Camcorder and Computer Video*, June 1, 2001.]
>
> "For consumers with limited shelf space and TV input jacks, integrated boxes combining a DVD player with a VHS VCR have proven a big hit. Now makers are building these **two-in-one** video players into HtiBs. [*Philadelphia Daily News*, February 5, 2003.]

Applicant contends that the "3 IN 1" and "2 IN 1" portions of its marks are not merely descriptive because "these elements could be construed as suggesting any number of goods"; that a term is not merely descriptive if it "could be used suggestively as to a number of different goods"; that "there is no evidence of others using the[se] term[s] in connection with applicant's consumer electronics products…"; and that "there are numerous third-party registrations for various goods in which [these terms are] not disclaimed."

Both the Examining Attorney and applicant submitted third-party registrations in support of their positions. Applicant's submission is from search reports taken from a private company's databases, which is not acceptable evidence of those registrations. *See In re Carolina Apparel*, 48 USPQ2d 1542, footnote 2 (TTAB 1998); and *In re Smith & Mehaffey*, 31 USPQ2d 1531, footnote 3 (TTAB 1994).

However, since the Examining Attorney addressed the evidence on its merits, we have considered applicant's submission for whatever probative value it may have. In this regard, this Board has stated that "third-party registrations simply are not conclusive on the question of descriptiveness, and a mark which is merely descriptive cannot be made registrable merely because other similar marks appear on the register." *In re Scholastic Testing Service, Inc*., 196 USPQ 517, 519 (1977). Moreover, applicant's submitted registrations, coupled with the ones submitted by the Examining Attorney, indicate that the register is mixed. While uniform treatment under the Trademark Act is an administrative goal, our task in this appeal is to determine, based on the record before us, whether these terms in *applicant's marks* are merely descriptive. As often noted by the Board, each case must be decided on its own merits. Moreover, as stated in *In re Nett Designs, Inc*., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001), "[e]ven if some prior registrations had some characteristics similar to [applicant's] application, the … allowance of such prior registrations does not bind the Board or this court."

The test for determining whether a mark (or a portion thereof) is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or

service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark (or a portion thereof) is merely descriptive, that it describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

We conclude that, notwithstanding applicant's arguments to the contrary, the "3 IN 1" and "2 IN 1" portions of applicant's marks are merely descriptive of the fact that the electronic device identified in each application has 3 (or 2) functions combined in one device, i.e., in the '037 application the product is a digital camcorder, a digital still camera and a camera providing connection to the Internet or web; and in the '039 application the product is a digital camera as well as a camera providing connection to the Internet or web. Thus, three (or two) functions are

combined in one electronic device. The excerpted articles clearly show descriptive use of these two terms in describing several different types of electronic products and, with respect to cameras, several different brands. Applicant notes that the references to Panasonic are references to applicant and, thus, those excerpts are inapposite. We disagree. Even those excerpts referring to Panasonic use the terms "3 IN 1" and "2 IN 1" in a descriptive, rather than trademark, manner.

In conclusion, we find that when applied to applicant's respective goods, the terms "3 IN 1" and "2 IN 1" immediately describe, without conjecture or speculation, a significant feature or function of applicant's respective goods, namely that the identified goods are three (or 2) devices combined in a single electronic device. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's services to readily perceive the merely descriptive significance of the terms as they pertain to applicant's respectively identified goods.

Decision: The requirement, under Section 6 of the Trademark Act, 15 U.S.C. 1056, for a disclaimer of "3 IN 1" (or "2 IN 1") apart from each mark as a whole, is affirmed.

However, if applicant, no later than thirty days from the mailing date hereof, submits an appropriate disclaimer of "3 IN 1" (or "2 IN 1") in each of the applications, registrations will be allowed with these disclaimers. *See*, Trademark Rule 2.142(g).