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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Faculdades Catolicas

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Serial No. 77423725

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Laurence P. Colton of Smith, Gambrell & Russell, LLP for Faculdades Catolicas.

Sara N. Benjamin, Trademark Examining Attorney, Law Office 110 (Chris A. F. Pedersen, Managing Attorney).

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Before Grendel, Taylor and Ritchie, Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Faculdades Catolicas has filed an application to register the mark LUA, in standard character format, on the Principal Register for goods ultimately identified as "Computer operating programs; downloadable computer programs and computer programs recorded on data media for computer software development and for implementing computer programming languages" in Class 9.[1] At the request of the

[1] Serial No. 77423725, filed March 17, 2008, and alleging a bona fide intention to use the mark in commerce.

examining attorney, applicant included the following translation statement: "The foreign wording in the mark translates into English as moon."

The trademark examining attorney finally 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 LUA merely describes a feature of the identified goods.[2]

Applicant appealed and requested reconsideration of the final refusal. On September 10, 2009, the examining attorney denied the request for reconsideration and this appeal was resumed. Both applicant and the examining attorney have filed briefs. For the reasons discussed below, we reverse the refusal to register.

Before addressing the merits of this appeal, we consider the examining attorney's objection to certain statements made by applicant for the first time in its appeal brief.[3] Citing to 37 C.F.R. § 2.142(d) which states,

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[2] Applicant initially also sought registration of its mark for services identified as "development, conception, updating and maintenance for computer software and language computer programs including software and software projects" in International Class 42. Registration of these services was finally refused pursuant to both Trademark Act Sections 2(d) and 2(e)(1). However, in its request for reconsideration, applicant deleted the Class 42 services and the examining attorney withdrew the Section 2(d) refusal. Also withdrawn was the requirement for a more definite identification of the Class 9 goods, after applicant proffered an acceptable identification in its request for reconsideration.

[3] The statements are as follows:

in part, that "[t]he record in the application should be complete prior to the filing of an appeal," the examining attorney argues that "[b]ecause these statements have not been substantiated by actual evidence, and because they were untimely submitted, the 'evidence' should not be considered." (Br. p. 3).

We agree with the examining attorney that the record in any application must be complete prior to trial. However, applicant is not foreclosed from making additional arguments in support of its position in its brief. Accordingly, we will consider these statements, but point out that they are of little probative value given their lack of substantiation.

We also note that applicant extensively argued in its brief as if the examining attorney had refused registration based on genericness with respect to the identified goods. Although the examining attorney opined in her office

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(1) "… a search of the USPTO TESS database reveals that no one except Applicant has even attempted to register LUA for goods related to computer operating programs, indicating that it is not a common or commonly used term";
(2) "[i]n the present case, as no one has even attempted to register a mark comprising 'lua' in connection with computer operating programs…"; and
(3) "…no one has ever used the term 'lua' in the identification of goods services [sic] of a mark submitted for registration with the USPTO for use in connection with computer operating programs."

actions that the term "lua" appears to be generic for the identified goods, as made clear in those actions, as well as the examining attorney's brief, the refusal that was issued and made final is that applicant's applied-for mark LUA merely describes the identified goods. Accordingly, we have given no consideration to those arguments pertaining solely to the issue of genericness.

Turning now to the merits of the appeal, the examining attorney maintains that the proposed mark LUA "immediately, and without conjecture or speculation, describes a feature or purpose of the identified computer programs, namely, that the computer programs are written in or run on the LUA programming language, are for the development of software written in the LUA programming language and are for implementation of the LUA programming language." (Examining Attorney's Br. p. 4).

In support of her position, the examining attorney submitted the following evidence.

1. Definitions of Lua

a. *Language type:*
C – Command or Scripting
Description:
Lua is an interpreted structured language designed for embedding into other applications. It is intended for use as an extension and scripting language, especially for applications with requirements for structured data storage. Because it is

> intended for use as an application extension language, Lua does not have the notion of a 'main' program or initial entry point; instead, all code is assumed to be invoked from the host application. …
> ***
> Origin:
> W. Celes, R. Ierusalimschy, L.H. de Figueiredo, PUC-Rio, 1994.
> ***
> Remarks:
> … Lua has gone through several major expansions in its fairly short career so far, but new versions have maintained back-compatibility with older ones. …[4]

b. 1. A programming language.[5]

2. Internet Evidence

a. a copy of the web page (www.tiobe.com/index.php/paperinfor/tpc/Lua.html/) from the website of Tiobe Software wherein "Lua" identifies a programming language.

b. results from searches of the Google search engine for the term "lua" (pertinent web pages provided with emphasis in original):[6]

> 1) The homepage for the website www.lua.org showing a logo including the text "the programming language Lua" and a reference to PUC Rio;
>
> 2) an article from the IBM website (www.ibm.com/developerworks...) entitled Embed Lua

[4] Dictionary of Programming Languages, retrieved on June 30, 2008 at http://cgibin.erols.com/ziring/cbi-bin/cep/cep.pl?_alpha=l.

[5] *Wiktionary*, retrieved June 30, 2008 at http://en.wiktionary.org/wiki/Lua.

[6] The information was retrieved on February 14, 2009 (1-5) and September 10, 2009 (6-9).

for scriptable apps by Peter Seebach, freelance writer, Wind River Systems, discussing "the Lua programming language";

3) an article from the Computerworld website (www.computerworld.com …) entitled the A-Z of Programming Languages: Lua. The article is based on a chat with the developer of the language – Prof. Roberto Ierusalimschy;

4) an article on the FreEPOC website (www.freepoc.org) entitled Lua 5 by Reuben Thomas *** A lovely little language and stating, in part, that more information about Lua is available from its homepage and that Lua is available under the "MIT License";[7]

5) a web page from the website www.dmoz.org listing top computer programming languages of which Lua appears to rank 33rd and including references to a manual written by Roberto Ierusalimschy, et al, as well as Lua reference works written by other third parties;

6) additional web pages from the website www.lua.org stating that the "official definition of the Lua language is its reference manual, which describes the syntax and the semantics of Lua, the standard libraries, and the C API. The web pages also reference numerous books, including the Reference Manual, Programming in Lua (in multiple languages) and other books and papers written about Lua by other authors;

7) an article published on the website http://onlamp.com entitled "Introducing Lua." It reads in part: … Roberto Ierusalimschy of the Pontifical Catholic University of Rio de Janeiro in Brazil leads the development of **Lua**. The most recent version (5.0.2; version 5.1 should be out soon) is made available under the MIT license. **Lua** is written in 99 percent ANSI C;

[7] The MIT License is a generally-known method of distributing free software.

8) a book review (published on the website http://books.slashdot.org) by Andre Carregal of Programming in Lua 2d Edition – written by Roberto Ierusalimschy. The review states in part: "The Lua programming language has been around for more than 10 years, but only recently has it started to appear on the mainstream radar screens.
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Lua is free software and can be obtained from its site (www.lua.org). There you will also find the reference manual of the language and the full contents of the first edition of Programming in Lua; and

9) an article published on the website www.allexperts.com discussing the Lua programming language, in pertinent part (emphasis in original): The Lua (pronounced LOO-ah, or in IPA) programming language is a lightweight, reflective, imperative and procedural language, designed as a scripting language with extensible semantics as a primary goal….
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History
Lua was created in 1993 by Roberto Ierusalimschy, Luiz Henrique de Figueiredo, and Waldemar Celes, members of the Computer Graphics Technology Group at PUC-Rio, the Pontifical University of Rio de Janeiro, in Brazil. Versions of Lua prior to version 5.0 were released under a license similar to the BSD license. From version 5.0 onwards, Lua has been licensed under the MIT License.

Applicant, in urging reversal of the refusal, maintains that its mark is not descriptive of the identified goods because (emphasis supplied):

A. The initial hits on the Yahoo!®, Google® and Altavisa® search engines for "lua" for goods in the computer programming field are **Applicant's goods**; and

B. No one has attempted to register Applicant's Mark in connection with any related products [i.e., not using the mark descriptively].

Applicant's Br. p. 7.

Applicant argues that it is "trying to register the brand name of its own computer operating programs to which others also are referring. In other words, others are not using their own 'LUA' computer operating programs – they are using Applicant's LUA computing operating programs. … In fact, the mark, when it appears in searches, **already refers to Applicant's goods.**" Applicant's Br. p. 8 (emphasis in original).

Applicant also argues that the examining attorney's evidence is deficient in that it does not show that a single competitor promotes its goods as a "lua"; that no one has attempted to register a mark comprising "lua" in connection with computer operating programs; and that the examining attorney's evidence all refers to Applicant's computer operating program.

Lastly, applicant argues that any doubts should be resolved in favor of applicant as to whether a mark is "generic."[8] Because it "has used the LUA mark consistently

[8] We consider this argument because it is also applicable to a descriptiveness refusal.

and exclusively worldwide, and all references to the mark LUA in connection with computer operating programs refer to Applicant's goods, [applicant maintains] there is inherently significant doubt as to whether the LUA mark is generic." Applicant's Br. p. 13.

The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product in connection with which it is used, or intended to be used. See, e.g., in re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Whether a particular term is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the term is used, or is intended to be 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 USPQ 1222, 1224 (TTAB 2002). In other words, the issue is whether someone who knows what the goods are will understand the mark to convey information about them. *In re Tower Tech, Inc.,* 64 USPQ 1314, 1316-1317 (TTAB 2002); and *In re Patent & Trademark Services Inc.,* 49 USPQ2d 1537, 1539 (TTAB 1998). It is

well settled, however, that where there is doubt on the issue, the doubt must be resolved in applicant's behalf and the mark should be published for opposition. *See In re Rank Organization Ltd.*, 222 USPQ 324, 326 (TTAB 1984) and the cases cited therein.

In this case, we have doubts concerning the quantity and character of the evidence submitted by the examining attorney in support of her position that "LUA" is merely descriptive of the identified goods. The examining attorney's evidence seemingly shows that the term "lua" is used in a descriptive manner to refer to a computer programming language. Closer scrutiny of these materials, however, reveal that the uses predominantly refer to a single discrete computer programming language developed by Roberto Ierusalimschy, Luiz Henrique de Figueiredo, and Waldemar Celes, members of the Computer Graphics Technology Group at PUC-Rio, the Pontifical University of Rio de Janeiro, and currently made available to the public via the MIT License. Of those remaining, it is unclear whether such examples display the term descriptively or as a source indicator. Moreover, applicant has responded to the

examining attorney's evidence and argues that that all uses of LUA refer to applicant's computer programming language.[9]

Since the evidence does not support third-party use of the term "lua" generically as the name of a computer programming language, we find unavailing the examining attorney's argument that a computer language is neither "goods in trade" nor a "service" for which a mark may be registered. That is, the examining attorney's reliance on Loglan Inst., Inc. v. Logical Language Group, Inc., 962 F.2d 1038, 1041, 22 USPQ2d 1531, 1533 (Fed. Cir. 1992), is misplaced. In that case, the record supported a finding that the term "Loglan" was used generically to designate a language, and thus, was unregistrable. Here, no such finding is, nor can be, made.

We also find unavailing the examining attorney's claim that because third-parties incorporate the "Lua programming language" into their software applications, they should be free to use the name of the language in describing their software. The record does not support the examining attorney's claim that LUA describes a feature of a programming language. As noted, applicant states that all

[9] Notably, the record reflects that applicant is a non-profit association that supports the Pontificia Universidade Catolica de Rio De Janeiro.

uses of "Lua programming language" refer to its goods and applicant is not foreclosed from using the same mark to identify more than a single good.

We simply are not persuaded, on this record, that persons in the relevant computer fields understand the term "Lua" to refer to a type of programming language as opposed to a particular proprietary programming language. Thus, we are unable to conclude that applicant's mark LUA merely describes an immediate idea about any characteristic or feature of applicant's computer operating programs; downloadable computer programs and computer programs recorded on data media for computer software development and for implementing computer programming languages. That is not to say that, on a different record, such as might be adduced in an opposition proceeding, we might reach a different conclusion.

Decision: The refusal to register under Section 2(e)(1) is reversed.