

This Opinion is Not a
Precedent of the TTAB

Mailed: March 1, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Silhouette America, Inc.
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Serial No. 86228926
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Shunsuke S. Sumitani of Stetina Brunda Garred & Brucker,
for Silhouette America, Inc.

Natalie Polzer, Trademark Examining Attorney, Law Office 108,
Andrew Lawrence, Managing Attorney.

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Before Kuhlke, Shaw and Greenbaum,
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

Silhouette America, Inc. (“Applicant”) seeks registration on the Principal
Register of the mark PIXSCAN (in standard characters) for

Computer software for use in capturing images and
operating cutting machines, cutters, and plotters for
cutting textile, paper, and cardstock in sheet or roll form
in the field of crafts in International Class 9, and

Cutting mats for capturing images from which designs for cutting machines for textile, paper and cardstock are generated in International Class 16.¹

The Trademark Examining Attorney has 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 that Applicant's mark is merely descriptive of the identified goods in each class.

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

I. Evidentiary Issue

Before proceeding to the merits of the refusal, we address an evidentiary matter. With its appeal, Applicant submitted for the first time screenshots from third-party websites discussing the terms "pixel scan," "pick and scan," "pick-to-scan," and "scan pick." The Examining Attorney has objected on grounds of timeliness.

Trademark Rule 2.142(d) provides that the record in the application should be complete prior to the filing of an appeal. The Board ordinarily will not consider additional evidence submitted by an applicant or examining attorney after the appeal is filed. Thus, exhibits attached to a brief that were not made of record during examination are untimely, and generally will not be considered. *See, e.g., In re Fiat Grp. Mkt'g & Corporate Commc'ns S.p.A.*, 109 USPQ2d 1593, 1596 (TTAB 2014) (examining attorney's objection to applicant's submission of registrations with appeal brief sustained); *In re MC MC S.r.l.*, 88 USPQ2d 1378, 1379 n.3 (TTAB 2008)

¹ Application Serial No. 86228926 was filed on March 21, 2014, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

(previously unsubmitted materials attached to applicant's brief not considered); *In re Tea and Sympathy Inc.*, 88 USPQ2d 1062, 1063 n.2 (TTAB 2008) (exhibits submitted for first time with applicant's appeal brief and declaration attached to reply brief not considered). On the same point, evidentiary references made in briefs but not supported by timely submissions may not be considered. *See In re Procter & Gamble Co.*, 105 USPQ2d 1119, 1120 (TTAB 2012). Accordingly, the objection is sustained, and we have not considered the evidence attached to Applicant's reply brief or any remarks relating thereto in the reply brief.

II. Applicable Law

Section 2(e)(1) of the Trademark Act 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 or services 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 Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). *See also In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (quoting *Estate of P.D. Beckwith, Inc. v. Comm'r*, 252 U.S. 538, 543 (1920) ("A mark is merely descriptive if it 'consist[s] merely of words descriptive of the qualities, ingredients or characteristics of the goods or services related to the

mark.”)), *cited with approval in In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015).

The determination of whether a mark is merely descriptive must be made “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.” *Bayer Aktiengesellschaft*, 82 USPQ2d at 1831 (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978)). In other words, the question is not whether someone presented only with the mark could guess the goods listed in the identification of goods. Rather, the question is 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); *Abcor*, 200 USPQ at 218. In addition, it is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods, only that it describe a single, significant ingredient, quality, characteristic, function, feature, purpose or use of the goods. *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219 (quoting *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005)); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

Where a mark consists of multiple words, the mere combination of descriptive words does not necessarily create a nondescriptive word or phrase. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012); *In re Associated Theatre Clubs*

Co., 9 USPQ2d 1660, 1662 (TTAB 1988). If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. *Oppedahl & Larson*, 71 USPQ2d at 1371. However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a nondescriptive meaning, or a double entendre with one meaning being non-descriptive, 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 (TTAB 1983) (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”).

Last, as Applicant correctly points out, a mark comprising more than one element must be considered as a whole and should not be dissected; however, as the Examining Attorney aptly notes, we may consider the significance of each element separately in the course of evaluating the mark as a whole. *See DuoProSS*, 103 USPQ2d at 1756-57 (reversing the Board's denial of cancellation for **Snap!** for medical devices as not merely descriptive, but noting that “[t]he Board to be sure, can ascertain the meaning and weight of each of the components that makes up the mark.”).

III. Analysis

The Examining Attorney relies on definitions for “pix” as meaning “pictures,” and for “scan” as meaning “to use a piece of equipment to read and store information in digital form.”² When these terms are taken together, as PIXSCAN, the Examining Attorney contends that the mark describes a function or purpose of the goods, namely, that Applicant’s cutting mats and computer software are used in connection with capturing and storing pictures or images in digital form.

In further support of her position, the Examining Attorney points out that Applicant’s own identification specifies that the purpose of the goods is to capture images. She also points out that Applicant’s marketing materials indicate that the identified computer software and cutting mats are used with equipment to read and store pictures in digital form. Applicant’s website states that “PixScan technology” allows users “to cut precisely around a printed design using a scanner or camera, including smartphones and tablets” and “convert printed images of all varieties into custom craft projects and art pieces.”³ Similarly, Applicant’s website indicates that “PixScan is ideal for ... [i]ncorporating any printed image or pattern into your custom craft projects ... [and] [s]aving any scanned or photographed image into your personal digital library.”⁴ Consequently, according to the Examining Attorney, when used in connection with Applicant’s identified computer software and cutting mats for use in capturing images, the proposed mark PIXSCAN merely indicates

² Submitted with July 1, 2014 Office Action.

³ Submitted with January 2, 2015 Response to Office Action.

⁴ *Id.*

that Applicant's goods are used in connection with reading and storing pictures in digital form.

The Examining Attorney also has submitted copies of third-party registrations that include the words PIX used in connection with images or pictures (e.g., 2863149 and 3270435), or SCAN for software and other goods used in connection with scanning, capturing or working with images (e.g., Reg. Nos. 3566514 and 4299080).⁵ In each instance, the word PIX or the word SCAN has been disclaimed. Third-party registrations featuring goods that are the same as or similar to an applicant's goods are probative evidence on the issue of descriptiveness of a word or term in the mark, where the relevant word or term is disclaimed. *See Institut National des Appellations D'Origine v. Vintners Int'l Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006), *aff'd per curiam*, 223 Fed. App'x 984 (Fed. Cir. 2007).

The Examining Attorney further made of record screenshots from several commercial websites showing the term PIX used in connection with capturing and storing images and pictures. For example, the www.emc.com website describes the "EMC Captiva PixTools Toolkit" as "a software development kit specifically built for imaging capture, including scanning, viewing, and image processing[.]" and the article *What Is Verizon Pix Place* on the www.ehow.com website explains that "It is designed to work with Verizon's camera devices, and allows users to do more with

⁵ Submitted with the July 1, 2014 and January 24, 2015 Office Actions, respectively.

the pictures and videos captured with cell phones. You can utilize Pix Place to edit, store and print your favorite shots.”⁶

Based on the foregoing, we have no doubt that consumers who see the proposed mark PIXSCAN used on the computer software and cutting mats for capturing images identified in the application, immediately would understand that the goods are used in connection with capturing and storing pictures and images in digital form. Accordingly, the mark is merely descriptive of the identified goods.

We are not persuaded by Applicant’s arguments that the mark is suggestive. For example, Applicant offers several definitions of “picture scan.” However, in light of the evidentiary ruling above, this argument lacks evidentiary support. Moreover, as stated above, the meaning of a term must be considered in relation to the identified goods (described as being used for “capturing images”), and when used in connection with Applicant’s identified goods, it is clear that the definitions referenced by the Examining Attorney would apply.

Applicant argues that the identifications of goods are quite broad, implying that the proposed mark would not immediately tell a consumer what the goods are. However, this is not a correct application of the test. As explained above, the determination of whether or not a mark is merely descriptive must be made in relation to the goods for which registration is sought and the question is whether someone who knows what the goods are will understand the mark to convey

⁶ Submitted with the January 24, 2015 Office Action.

information about them. *See DuoProSS*, 103 USPQ2d at 1757; *Abcor*, 200 USPQ at 218.

Finally, contrary to Applicant's contention, the fact that the descriptive term PIXSCAN is not itself found in the dictionary is not controlling on the question of registrability. *In re Planalytics, Inc.*, 70 USPQ2d 1453, 1456 (TTAB 2004) (GASBUYER is merely descriptive of providing online risk management services in the field of pricing and purchasing decisions for natural gas); *In re Orleans Wines, Ltd.*, 196 USPQ 516, 517 (TTAB 1977) (BREADSPRED for jellies and jams is merely descriptive). The test is whether the merely descriptive components retain their merely descriptive significance in relation to the goods when the mark is considered as a whole; if they do, the resulting combination is also merely descriptive. *See, e.g., Oppedahl & Larson*, 71 USPQ2d at 1371-72; *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs, and pillows where the evidence showed that the term "breathable" retained its ordinary dictionary meaning when combined with the term "mattress" and the resulting combination was used in the relevant industry in a descriptive sense). In this case, the terms "pix" and "scan" individually have descriptive meanings when used in connection with the identified goods; together, the term "pixscan" retains this descriptive meaning.

IV. Conclusion

For the reasons discussed, we conclude that when used on or in connection with Applicant's identified goods, the proposed mark PIXSCAN immediately describes, without any kind of mental reasoning, that Applicant's computer software and cutting mats for capturing images is used on or in connection with capturing and storing pictures and images in digital form.

Decision: The refusal to register Applicant's mark PIXSCAN on the ground that it is merely descriptive of Applicant's identified goods is affirmed in each class.