

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB NOV. 19,99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Siemens Stromberg-Carlson**

Serial No. 75/048,293

Lawrence E. Abelman of Abelman, Frayne & Schwab for
applicant.

Kathleen M. Vanston, Trademark Examining Attorney, Law
Office 103 (Michael A. Szoke, Managing Attorney).

Before Quinn, **Chapman** and Rogers, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Siemens Stromberg-
Carlson to register the mark FAST FEATURE PLATFORM for
"computer software and hardware used in the
telecommunications field to deploy features of a switch."¹

¹ Application Serial No. 75/048,293, filed January 25, 1996,
alleging a bona fide intention to use the mark in commerce.
Applicant's briefs indicate that the applicant is now Siemens
Information and Communication Networks, Inc. A check of the
Assignment Branch records of the Office show that no assignment
or name change document has been recorded in connection with this

The Trademark Examining Attorney has refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark, if used in connection with applicant's goods, would be merely descriptive thereof.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney have filed briefs.² An oral hearing was not requested.

Applicant contends, in urging that the refusal be reversed, that the applied-for mark is, at worst, just suggestive of the goods. Applicant argues that the mark is subject to a variety of meanings and, in this connection, points to the different interpretations of the mark set forth by the Examining Attorney during prosecution as

application. In order to ensure that a registration issues in the correct name, the appropriate documents should be filed with the Office.

² Applicant, in its brief, objected to the evidence accompanying the Office action dated March 20, 1998 wherein the Examining Attorney denied applicant's request for reconsideration which was filed with the notice of appeal. Applicant contends that the evidence is untimely, citing Trademark Rule 2.142(d).

Although the record in an application should be complete prior to the filing of an appeal, an applicant filing a request for reconsideration runs the risk that the Examining Attorney, on remand, will supplement the record. Section 1204 of the *Trademark Trial and Appeal Board Manual of Procedure (TBMP)* states, in pertinent part, the following: "If the Examining Attorney, upon consideration of a request for reconsideration (made with or without new evidence), does not find the request persuasive, and issues a new final or nonfinal action, the Examining Attorney may submit therewith new evidence directed to the issue(s) for which reconsideration is sought." Accordingly,

evidence that the significance of the mark is deduced only through a multi-stage reasoning process. In sum, according to applicant, the word combination FAST FEATURE PLATFORM is inventive, and the alliteration in the mark reinforces the likely perception of the wording as a trademark.

The Examining Attorney maintains that the mark is merely descriptive. The Examining Attorney, relying on dictionary definitions, asserts that the terms "feature" and "platform" have specific meanings in the telecommunications field, and that the mark describes computer hardware and software (i.e., a "platform") capable of deploying switch features in a fast manner. In denying a request for reconsideration (Office action dated March 20, 1998), the Examining Attorney articulated the refusal as follows:

"Fast feature platform is descriptive given the context of its use. As was noted in an earlier office action, "platform" is a generic term describing a computer hardware and software operating system. Applicant intends to use the mark on computer software and hardware.

"Feature" is a term often used in conjunction with switches. Telecommunication switches typically have different features. (See material from the Lexis/Nexis Research

applicant's objection is overruled, and the evidence has been considered in reaching a final decision.

Database). "AIN" capability involves use of signal and packet switches. Applicant's product will bring AIN capability to smaller carriers through use of the fast feature platform. This computer operating system will deploy features of AIN switches. Presumably, the deployment will be swift.

Also of record are dictionary definitions of the term "fast," "switch" and "AIN (Advanced Intelligent Network)," as well as excerpts retrieved from the NEXIS database. One of the excerpts is about applicant's goods, and the other excerpts show uses of "feature(s) of the switch" or "feature(s) to the switch."

The Examining Attorney bears the burden of showing that a mark is merely descriptive of the relevant goods. In re Merrill, Lynch, Pierce, Fenner, and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). A mark is descriptive if it "forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods." *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976) (emphasis added). See also: *In re Abcor Development Corp.*, 616 F.2d 525, 200 USPQ 215 (CCPA 1978). Moreover, in order to be descriptive, the mark must immediately convey information as to the ingredients, qualities or characteristics of the goods with a "degree of particularity." *Plus Products v.*

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Medical Modalities Associates, Inc., 211 USPQ 1199, 1204-1205 (TTAB 1981). See also: In re Diet Tabs, Inc., 231 USPQ 587, 588 (TTAB 1986); Holiday Inns, Inc. v. Monolith Enterprises, 212 USPQ 949, 952 (TTAB 1981); and In re TMS Corp. of the Americas, 200 USPQ 57, 59 (TTAB 1978).

Applicant's goods would appear to be highly technical telecommunications software and hardware. In the one NEXIS article specifically about applicant's goods, the goods are described as "essentially an intelligent peripheral networked to multiple [Digital Central Offices]."

Applicant has described its goods as "hardware and software [which] enable[s] carriers to provide added telecommunication services to their clientele, such as call forwarding options, call screening options, and rerouting of incoming calls" and that the "hardware and software deploy, operate and manage these applications." (brief, p. 6)

Given the dictionary definitions of record, the individual words comprising applicant's mark have commonly understood meanings. We do not believe, however, that the specific combination of these words results in a designation which, when considered in its entirety, is merely descriptive of applicant's goods. That is to say, applicant's mark, as proposed to be used in connection with

applicant's telecommunications software and hardware, does not convey an immediate idea about the goods with any degree of particularity. As pointed out by applicant, this is borne out by the slightly different interpretations of the meaning of applicant's mark which have been offered by the Examining Attorney. We tend to agree with applicant that its mark is capable of different meanings, and that one seeing the mark on the goods would not be sure which word "fast" is meant to modify. In sum, the significance of the mark as a whole, when applied to the goods, is vague and unclear, and we find that the mark is suggestive of the goods.

The prohibition against registration of merely descriptive designations is intended to prevent one party from precluding all others from fair use of descriptive terminology in connection with goods which are described thereby. Nothing in the record suggests that others in the telecommunications field have used or would need to use the three-word combination FAST FEATURE PLATFORM to describe their goods.

The Board has noted on a number of prior occasions that there is a thin line of demarcation between a suggestive and a merely descriptive designation. The present case is a close one, and we have doubts about the

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"merely descriptive" character of applicant's mark. In such cases, doubts are to be resolved in applicant's favor and the mark should be published, thus allowing a third party to file an opposition and develop a more comprehensive record. See, e.g., In re Atavio, 25 USPQ2d 1361 (TTAB 1992); In re Morton-Norwich Products, Inc., 209 USPQ 791 (TTAB 1981); and In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972).

Decision: The refusal to register is reversed.

T. J. Quinn

B. A. Chapman

G. F. Rogers
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

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