

Paper No. 21
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Platinum Technology, Inc.**

Serial No. 74/**719,023**

Matthew W. Walch of Latham & Watkins for In re Platinum
Technology, Inc.

Wanda Kay Price, Trademark Examining Attorney, Law Office **111**
(Craig Taylor, Managing Attorney).

Before **Simms**, Hairston and Holtzman, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by Platinum Technology, Inc.
to register MERGE/MODIFY as a mark for the following goods:¹

Computer software for use in database design,
implementation, administration and management; database
query and reporting, and for programming and application

¹ Serial No. 74/719,023; filed August 22, 1995 on the Principal
Register alleging dates of first use and first use in commerce in
February, 1995.

development, and instructional manuals sold as a unit therewith.

Registration has been finally refused under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark is merely descriptive of applicant's goods.²

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods or services with which it is used. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Moreover, the question of whether a particular term is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought. See In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986).

The Trademark Examining Attorney contends that the wording "MERGE/MODIFY," when considered in relation to the identified goods, describes a "feature, function, characteristic, and use" of applicant's software, namely "that is used to merge and modify data in databases." In support of her position, the Examining

² The Examining Attorney issued a second Office action refusing registration on the additional basis that MERGE/MODIFY does not function as a mark. That refusal was subsequently withdrawn.

Attorney has relied on the product literature submitted by applicant as well as listings from general and technical dictionaries. One such listing defines "merge" as follows:

...[I]n word processing, the automatic recording, printing, or sending onto one element of recording medium of selected recorded text, in correct order, from at least two other elements of recording media. *IBM Dictionary of Computing* (10th ed. 1993).

In addition, we have taken judicial notice of the following definition of "modify":³

(1) [t]o change the contents of a database. (2) To change the logical structure of a database." *IEEE Standard Computer Dictionary* (1990).

The Examining Attorney has also submitted numerous excerpts of articles from the NEXIS database in which the words "MERGE" and "MODIFY" appear. Examples of these articles are reproduced below (emphasis added):

...you'll hear a lot about 4.1's directory-management tools. For example, you'll be able to **merge** NDS trees, and you'll be able to delete, **modify**, and move inside subtrees a lot easier. All of these capabilities will be welcome,... *PC Week* (August 29, 1994).

With these database programs, you're not limited to looking up data from other data files -- you can also **modify** data in other files or even **merge** information from multiple data files. But these capabilities require a more complex design process than with flat-file-database... *MacUser* (November, 1993).

³ The Board may properly take judicial notice of dictionary definitions, including definitions in technical reference works. See, e.g., *University of Notre Dame du Lac v. J. C. Gourmet Food Imports co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

From a development perspective, this facility is helpful for rapid prototyping, given the ease with which one can **merge**, test, **modify** or delete program segments. *Industrial Management & Data Systems* (1993).

'The C code allows you to: 1. Halt a merge so that you can enter information, 2. Halt a **merge** so that you can **modify** a secondary file. 3. Cancel the merge. 4. Find the next record in the secondary file...' *MIS Quarterly* (June 1992).

...computer for which it was designed (or backup computers as appropriate) and the right to copy it for archival purposes. The government can also **modify** the restricted-rights software or **merge** it with other software,... *EDN* (March 2, 1989).

The database is limited in its capacity to **modify** the original database design. The only way to **modify** is to create a new database based on the old and then incorporate the changes. And, the database cannot perform calculations on fields. *PC Magazine* (February 10, 1987).

The different varieties of workstation software still exist: Full Notes Client offers the full capabilities of Notes with the ability to **modify** database design; Notes Desktop offers the same capabilities as the full client, except that users cannot **modify** the design of databases;.... *Network* (1997).

Applicant, on the other hand, maintains that its software does not "merge and modify data in databases." Applicant argues instead, based on its product literature, that its mark identifies a "highly specialized database software tool" which "allows database users to quickly and efficiently provide backup copies of the database without adversely impacting data availability." It is applicant's position that use of "the single words 'merge' and 'modify'...are entirely irrelevant to

whether the unitary term 'MERGE/MODIFY' is descriptive of applicant's goods."⁴

It is clear from the above evidence that the words "merge" and "modify" have well-recognized meanings in the computer industry in the context of software design and function. As the dictionary entries and NEXIS references show, software programs frequently include capabilities that allow for the merging and modification of documents or database contents as well as other aspects of the software system. The particular "merge" and "modify" features of applicant's software products can be seen from applicant's own product materials (Italics reflect emphasis in original; bold emphasis has been added):

*PLATINUM Merge/Modify...Product Description:...recovery product: it manages DB2 recovery by producing image copies while data remains accessible to users; it merges copies at record speeds; and it automates cleanup of the system recovery table....Merge/Modify provides a **change accumulation feature for use in recovery**....Benefits: Reduces downtime by speeding up image copy **merges** and **modifications** to recovery information.*

*Keep Your Data Available During Image Copy Processing...Merge/Modify's unique Log Accumulation facility **merges** full and incremental copies with information from the DB2 active and archive log datasets, creating a single, fully consistent image copy...*

⁴ Although some of applicant's product literature was made of record during the prosecution of the case, additional literature was attached to applicant's appeal brief. The Examining Attorney has treated this evidence as of record and we have done so as well.

The term "MERGE/MODIFY" immediately describes significant capabilities of applicant's software product. We observe from the literature that applicant's software performs a merge function as part of the document recovery process as well as the function of accumulating changes or modifications to the content of the recovered information. At a minimum, applicant's software speeds up the execution of these "merge" and "modify" functions, clearly a touted benefit of applicant's product. Notwithstanding the "highly specialized" nature of applicant's software products, the relevant purchasers of applicant's goods would be technologically sophisticated individuals who would understand the meaning of the term "MERGE/MODIFY" in relation to those products.

We agree with the Examining Attorney that combining the terms "merge" and "modify" does not alter the descriptive significance of the individual words. In fact, we find that the presence of the slash mark creates a separation of the two words and reinforces the descriptive meaning of each of them in connection with applicant's goods. Thus, viewed either as individual words or a combined phrase, MERGE/MODIFY immediately conveys significant information to the relevant public about applicant's products.

The third-party applications and registrations submitted by applicant are not persuasive of a different result.⁵ As the Examining Attorney points out, one mark is registered on the Supplemental Register, an acknowledgment that the term "MERGE" is descriptive, another four of the registrations contain a disclaimer of the word "merge," and at least two of the applications have not even been published for opposition. The remaining applications and registrations are for composite marks which are different from the mark involved herein, and it has not been demonstrated that they are even for the same goods as those herein. Moreover, as often noted by the Board, each case must be decided on its own facts. See *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984). Based on the facts and

⁵ Applicant attached to its appeal brief, a list of 12 third-party registrations and 8 third-party applications which include the term "merge" to "demonstrate the [registrability] of the coined term 'MERGE/MODIFY' [for applicant's goods]." Applicant has provided information only as to the application/registration numbers, the marks, and the broad statement that the registered marks "[cover] software products." Additional information about a number of the applications and registrations was disclosed by the Examining Attorney in her appeal brief. We note that the Examining Attorney has not objected to either the timeliness or the form of the third-party evidence, and in fact has treated the evidence as being properly of record. Thus, we have considered the evidence herein. Under the circumstances, applicant's alternative request to remand the application to the Examining Attorney for consideration of the additional evidence is moot. Nevertheless, we would point out that the remand request fails to include the necessary showing of good cause. See TBMP § 1207.02 and cases cited therein.

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the record before us in this case, we are convinced that applicant's mark is merely descriptive of its goods.

Decision: The refusal to register is affirmed.

R. L. Simms

P. T. Hairston

T. E. Holtzman
Administrative Trademark
Judges, Trademark Trial
and Appeal Board