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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 15
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lenore E. Perry

Serial No. 75/382,570

Gerald S. Schur of Welsh & Katz, Ltd. for Lenore E. Perry.

Angela Lykos, Senior Examining Attorney, Law Office 115
(Tomas Vlcek, Managing Attorney).

Before Quinn, Hairston and Bottorff, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark MINIBORE.COM, in typed form, for services recited in the application as "providing general information concerning products and their selection and use in the field of boring tools for use with machine tools via a computer global network," in Class 42.¹

¹ Serial No. 75/380,570, filed October 31, 1997. The application is based on applicant's asserted bona-fide intention to use the mark in commerce, under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

The Senior Examining Attorney refused registration of applicant's mark under Trademark Act Section 2(e)(1), on the ground that the mark is merely descriptive of the recited services. When the refusal was made final, applicant filed this appeal. Applicant and the Senior Examining Attorney filed main briefs, and applicant filed a reply brief. No oral hearing was requested.

The evidence of record on appeal includes:

(1) a printout (submitted by the Senior Examining Attorney) of applicant's Principal Register Registration No. 2,108,615, issued October 28, 1997, of the mark MINIBORE and design for goods identified as "boring tools, namely, boring bars and inserts therefor for use with turning machines for boring holes, recesses and shoulders in metal," in Class 7.² In the registration, applicant has disclaimed MINIBORE apart from the mark as shown.

(2) a printout (submitted by the Senior Examining Attorney) of a page from <http://www.dns.net> which identifies ".com" as a top level domain name.

(3) a printout (submitted by the Senior Examining Attorney) from the electronic version of The American Heritage® Dictionary of the English Language, (3d Ed. 1992) containing the following entry for "mini-":

mini- *prefix*
Small; miniature: *minicar*.
[From miniature and minimum.]

² In compliance with the Senior Examining Attorney's requirement, applicant has claimed ownership of this registration in its present application.

(4) a printout (submitted by the Senior Examining Attorney) from the same dictionary containing the following entry for "bore":

bore *verb*

bored, boring, bores *verb, transitive*

1. To make a hole in or through, with or as if with a drill.
2. To form (a tunnel, for example) by drilling, digging, or burrowing.

verb, intransitive

1. To make a hole in or through something with or as if with a drill.
2. To proceed or advance steadily or laboriously: *a destroyer boring through heavy seas.*

noun

1. A hole or passage made by or as if by use of a drill.
2. A hollow, usually cylindrical chamber or barrel, as of a firearm.
3. The interior diameter of a hole, tube, or cylinder.
4. The caliber of a firearm.
5. A drilling tool.

(5) a photocopied excerpt (submitted by applicant) from the Random House Webster's Unabridged Dictionary (2d Ed. 1998), which includes the following entries for "bore," "borer," "boring" and "boring bar":

bore *v.*, **bored**, **boring**, *n.* -*v.t.* **1.** To pierce (a solid substance) with some rotary cutting instrument. **2.** To make (a hole) by drilling with such an instrument. **3.** To form, make, or construct a tunnel, mine, well, passage, etc.) by hollowing out, cutting through, or removing a core of material: *to bore a tunnel through the Alps; to bore an oil well 3000 feet deep.* **4. Mach.** To enlarge (a hole) to a precise diameter with a cutting tool within the hole, by rotating either the tool or the work. **5.** To force (an opening), as through a crowd, by persistent forward

thrusting (usually fol. by through or into); force or make (a passage). -v.i. **6.** To make a hole in a solid substance with a rotary cutting instrument. **7. Mach.** To enlarge a hole to a precise diameter. **8.** (of a substance) to admit of being bored: *Certain types of steel do not bore well.* -n. **9.** A hole made or enlarged by boring. **10.** The inside diameter of a hole, tube, or hollow cylindrical object or device, such as a bushing or bearing, engine cylinder, or the barrel of a gun.

borer n. **1.** A person or thing that bores or pierces. **2. Mach.** A tool used for boring; auger.

boring n. **1. Mach. a.** the act or process of making or enlarging a hole. **b.** the hole so made.

boring bar, *Metalworking.* A bar holding a tool for boring a cylinder or the like.

(6) a printout of applicant's web page³ (submitted by the Senior Examining Attorney), which includes the following excerpts:

Welcome to the Kaiser Tool Company Home Page. Kaiser Tool Company was founded in 1964 with the purpose of supplying small cutting tools that, at the time, were not available as standard, in-stock items. ... Today, we're a leading producer of precision cutting tools with more than 11,000 tools for grooving, threading, parting, boring and turning. ...

MINI-BORE® is our line of indexable boring bars and inserts. From ground chipbreakers to 0° lead angle bars to step boring bars, the MINI-BORE® line is designed to meet any boring need. ...

³ <http://www.kaisertool.com/>

The web page also sets out certain specifications of applicant's boring bars, including a specification for "Minimum Bores."

(7) A copy of applicant's September 1998 catalog of its "MINI-BORE® Indexable Boring Bars and Inserts" (submitted by applicant in response to the Senior Examining Attorney's requirement for information under Trademark Rule 2.61(b)), which contains informational statements essentially identical to the web site excerpts quoted above at item (6), including an introductory statement regarding applicant's founding in 1964 as a supplier of "small groove cutting tools," as well as product specifications in categories such as "bar diameter," "minimum bore," "lead angle" and "overall length."

(8) Five letters (submitted by applicant), addressed to the Assistant Commissioner for Trademarks, from five of applicant's manufacturer's representatives who assert that they have represented applicant since 1996 (or, in one case, since 1997) and who claim, respectively, fifteen, twenty-four, thirty, thirty-two and thirty-seven years' experience in the machine tools industry. The letters are printed on the respective company's letterheads. Aside from the differences in each writer's number of years' experience in the field and in the starting date of each company's representation of applicant, the letters are identical in content. One of the letters reads as follows:

We are a manufacturer's representative of Kaiser Tool Company, Inc., and market certain MINIBORE™ indexable boring bars, inserts and tool holders for that company. We have been marketing MINIBORE™ bars, inserts and tool holders since 1996.

It is our understanding that Kaiser Tool Company, Inc. is licensed by Lenore E. Perry

to distribute MINIBORE™ boring bars, inserts and tool holders using the MINIBORE mark.

In my 30 years of experience with machine tools and specifically boring tools and related products, I have never heard customers or anyone else in the industry refer to such products as "mini-bores." These products are referred to and ordered as boring bars, inserts and holders for boring bars or inserts for machine tools and almost always by their precise dimension specifications. As a technically oriented field, it is unimaginable that one would order such a tool by terms such as "mini" and/or "bore." As far as I am aware, the mark MINIBORE is novel and original with Kaiser Tool Company, Inc.

A term is merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. 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, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a term is

merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

Applying these principles to the present case, we find that there is no reasonable dispute that the .COM portion of applicant's mark is merely descriptive of applicant's information services, which are provided via the Internet. Likewise, applicant does not seriously dispute that the term MINI is merely descriptive of the boring tools which are the subject of applicant's information services. Those tools, as they are broadly identified in the recitation of services and as is evidenced by applicant's own promotional literature (see evidentiary items nos. 6 and 7, at pages 4-5, *supra*), would include tools which are miniature or small in size and which are used for miniature- or small-scale, precision cutting and boring.

We also find that the term BORE is merely descriptive of the products, i.e., boring tools, with which applicant's information services are concerned. The dictionary

evidence submitted by applicant herself (listed above as item no. 5) establishes that "bore" is a verb defined as "to pierce (a solid substance) with some rotary cutting instrument," and as "to make (a hole) by drilling with such an instrument." Moreover, this dictionary gives a specialized definition of the verb "bore" as it relates to applicant's own field, i.e., machining: "to enlarge (a hole) to a precise diameter with a cutting tool within the hole, by rotating either the tool or the work." Finally, applicant's dictionary evidence establishes that "bore" is a noun defined as "a hole made or enlarged by boring." Thus, the term "bore," viewed as a verb and/or a noun, immediately and directly describes a feature, function or characteristic of the products with which applicant's information services are concerned, i.e., boring tools. Boring tools bore. A boring tool makes a bore.⁴

⁴ The Senior Examining Attorney and the applicant devote considerable argument to the issue of whether "bore" is a generic product name for applicant's goods. The Senior Examining Attorney argues that it is a generic term, citing one of the noun definitions of "bore" found in her dictionary, i.e. "a drilling tool." Applicant argues that it is not a generic term for applicant's products, citing the absence of the "drilling tool" definition from the other dictionaries in the record, the industry practice as evidenced by the letters from her distributors, and the existence of other generic names for the products, e.g., "boring bars" or "boring tools."

This dispute as to whether "bore" is a generic term for applicant's products appears to have arisen because the Senior Examining Attorney has cited and relied on two cases, i.e., **In re Occidental Petroleum Corp.**, 193 USPQ 732 (TTAB 1977)(MINI PELLETS held to be merely descriptive of pellet fertilizer) and **General**

The combination, in applicant's mark, of the merely descriptive terms MINI and BORE creates a composite term, MINIBORE, which is equally merely descriptive. MINIBORE immediately and directly describes a feature, function or characteristic of applicant's products, which are small-sized or miniature boring tools used to bore small-bore bores. This composite term merely describes the products to which applicant's information services pertain, and ".COM" merely describes the manner or medium, i.e., the Internet, by which the information services are provided. The entire composite term MINIBORE.COM, viewed in its entirety, is as merely descriptive of applicant's services

Mills, Inc. v. K-Mar Foods, Inc., 207 USPQ 510 (TTAB 1980) (MINI MEAL held to be merely descriptive of miniature food bars), for the proposition that a composite mark is merely descriptive if it consists of the term "MINI" plus the generic name of the product. Applicant, in turn, argues that the two cited "MINI" cases are distinguishable from the present case because "bore" is not the generic name for applicant's products, and concludes therefrom that her "MINI" mark, unlike the marks involved in the cited cases, is not merely descriptive.

However, the cited "MINI" cases do not constitute the "rule" or the sole analytical framework and standard for determining whether a mark which includes "MINI" is merely descriptive. Rather, the standards for determining whether any mark is merely descriptive are those which are set out earlier in this opinion. Applicant's mark may be merely descriptive under those principles and standards even if it does not fit squarely within the fact pattern of the two cited cases. Thus, it is not dispositive in this case whether "bore" is or would be perceived as a generic name for applicant's product. The other dictionary definitions of the term "bore," both as a verb and a noun, clearly establish that the term is merely descriptive of a feature, function or characteristic of applicant's goods. Genericness need not be proven.

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as are each of the components of the term viewed separately.

Decision: the refusal to register is affirmed.