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30 JUN 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Jacobson, Price, Holman & Stern, PLLC

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Serial No. 75470334

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Marsha G. Gentner of Jacobson, Price, Holman & Stern, PLLC.

J. Brett Golden, Trademark Examining Attorney, Law Office 102 (Thomas Shaw, Managing Attorney).

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Before Hanak, Bucher and Rogers, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Jacobson, Price, Holman & Stern, PLLC (applicant) seeks to register in typed drawing form FILEFINDER for "a computer program used as a tool in connection with electronic records management, paper records management, and three-dimensional inventory records management." The intent-to-use application was filed on April 20, 1998.

Citing Section 2(e)(1) of the Trademark Act, the Examining Attorney refused registration on the basis that applicant's mark is merely descriptive of applicant's goods. When the refusal to register was made final, applicant appealed to this Board. Applicant and the

Examining Attorney filed briefs. Applicant did not request a hearing.

A mark is merely descriptive pursuant to Section 2(e)(1) of the Trademark Act if it immediately conveys information about a significant quality or characteristic of the relevant goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986). Of course, it need hardly be said that the mere descriptiveness of a mark is judged not in the abstract, but rather is judged in relationship to the goods or services with which the mark is used. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 216 (CCPA 1978). Finally, a mark need describe only one significant quality or characteristic of the relevant goods or services in order to be held merely descriptive. In re Gyulay, 3 USPQ2d at 1010.

The word "file" is defined as follows: "2. a. A collection of papers or published materials kept or arranged in convenient order. b. Computer Science. A collection of related data or program records." The American Heritage Dictionary of The English Language (3rd ed. 1992). Of course, it need hardly be said that the words "find" and "locate" have substantially identical

meanings. The word "find" is defined as: "To get by searching." The word "locate" is defined as: "To discover the position of." Webster's New World Dictionary (1996).

Obviously, the words "file" and "find" are common, ordinary words whose meanings are known to virtually everyone. When used in connection with "a computer program used as a tool in connection with electronic records management, paper records management, and three-dimensional inventory records management," the two words combined (FILEFINDER) would immediately tell users of these computer programs that they can manage electronic records, paper records and three-dimensional records by finding them or locating them.

Indeed, applicant's own brochure FileFinder™ describes applicant's computer programs for records management in the following fashion: "To locate [find] a file, enter your file reference into a computer terminal. FileFinder™ will identify [find] where that file is, giving the last scanned location, the date, the time and the duration the file has been there." Continuing, this brochure states that: "FileFinder™ does much more than identify [find] the location of your file. It produces a snapshot of the file's history - who has worked on it, when and for how

long - providing you with a valuable tool for managing staff time and monitoring staff efficiency."

As previously noted, in order to merely descriptive a mark needs to describe only one significant quality or characteristic of the relevant goods. In re Gyulay, 3 USPQ2d at 1010. Applicant's own brochure clearly states that one of the significant qualities of applicant's FILEFINDER is that it allows one to find or locate a file. Accordingly, we find that as applied to applicant's goods, the mark FILEFINDER is merely descriptive.

One last comment is in order. At page 7 of its brief, applicant makes the following, to be charitable, unique argument as to why its mark is not merely descriptive: "A finder of files would be a person who searches for files. Applicant's FILEFINDER computer program is not a person." Obviously, it is common knowledge that any number of inanimate devices can find or locate things. Such devices include radar, sonar, and, of course, computer programs.

While we think no further comment is in order with regard to applicant's argument, we simply note that at page 6 of applicant's brief, applicant makes the following statements: "What is intended in the dictionary definition relied upon by the Examining Attorney to the reference to 'one'? Is 'one' a person or a thing? Applicant's goods are

not persons who find something." To answer applicant's question, the word "one" is defined as follows: "A single person or thing." The American Heritage Dictionary of The English Language (3rd ed. 1992). Thus, a thing or inanimate object can be a "finder."

Decision: The refusal to register is affirmed.