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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Parasoft Corporation

Serial No. 75/599,576

LeRoy T. Rahn of Christie, Parker & Hale, LLP for Parasoft Corporation.

John Dwyer, Trademark Examining Attorney, Law Office 116 (Meryl Hershkowitz, Managing Attorney).

Before Seeherman, Quinn and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On December 4, 1998, Parasoft Corporation (a California corporation) filed an application to register the mark C++TEST! (typed drawing) on the Principal Register for goods ultimately amended to read "computer program for testing computer applications software" in International Class 9. The application is based on applicant's assertion of a bona fide intention to use the mark in commerce.

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark, when used on or in connection with applicant's goods, is merely descriptive of same.

Additionally, registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used on or in connection with its goods, so resembles the mark CTEST++ (typed drawing), which is registered for "systems software for testing and quality assurance of other computer software" in International Class 9,¹ as to be likely to cause confusion, or to cause mistake, or to deceive.

The Examining Attorney also made final his requirement under Trademark Rule 2.61(b) for further advertising or literature.

Applicant has appealed. Both applicant and the Examining Attorney have briefed the issues before us. An oral hearing was not requested.

We turn first to the refusal to register on the ground of mere descriptiveness. It is well settled that a term is merely descriptive of goods or services, and therefore

¹ Registration No. 2,109,462, issued October 28, 1997.

unregistrable pursuant to Section 2(e)(1), if it immediately conveys knowledge or information about the qualities, characteristics, purposes or features of the goods or services on or in connection with which it is used or intended to be used. See *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); and *In re Eden Foods Inc.*, 24 USPQ2d 1757 (TTAB 1992). In order to be "merely descriptive," a term need only describe a single significant quality, characteristic, purpose or feature of the goods. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

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 or is intended to be 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. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *Abcor*, supra, 200 USPQ at 218; *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).

The Examining Attorney has submitted substantial evidence showing the descriptiveness of "C++" and "TEST."² We need not list it here because applicant does not contest the descriptiveness of the individual terms. Specifically, applicant has acknowledged that "C++" is the generic name of a computer programming language (see e.g., applicant's brief, p. 5, and applicant's March 4, 2000 "request for reconsideration of suspension," p. 1); and applicant has acknowledged that "test" is descriptive for its goods (see e.g., applicant's brief, pp. 3 and 8).

However, applicant argues that its mark includes an arbitrary component, the exclamation point, which creates a different commercial impression from the words alone, and makes the mark suggestive because it requires some thought in order to determine the nature of applicant's goods.

The Examining Attorney contends that the exclamation point in applicant's mark is simply a slight alteration of

² In support of the descriptiveness refusal, the Examining Attorney submitted (i) a computer dictionary definition of "C++" and an English dictionary definition of "test"; (ii) photocopies of several representative excerpted stories retrieved from the Nexis database to demonstrate use of the descriptive term "test" in relation to applicant's goods for testing software; (iii) photocopies of several pages from an Internet search to demonstrate use of the term "C++" in relation to the involved goods; (iv) photocopies of several third-party registrations in which either "C++" or "test" was disclaimed in relation to computer software; and (v) photocopies of 18 pages from applicant's website.

an otherwise merely descriptive term; that the addition of the exclamation point in fact emphasizes the descriptive significance of "C++TEST"; and that the combination of two descriptive elements with a common punctuation mark does not create a new non-descriptive term.

On this record, we find that the Examining Attorney has established a prima facie showing that the mark C++TEST!, taken as a whole, is merely descriptive of applicant's goods.

Specifically, we disagree with applicant's argument that the presence of the exclamation point prevents its applied-for mark from being merely descriptive. Rather, this conventional punctuation mark does not, by itself, add any distinctiveness to the mark. If anything, the exclamation point emphasizes the descriptive nature of the remainder of the mark. Consumers would likely view the punctuation as an emphasis of applicant's testing function of C++ language software.³ See *In re Brock Residence Inns*,

³ Applicant cited a Board decision which was designated by the Board as nonprecedential, providing a photocopy of said decision. The Examining Attorney explained that he did not consider the cited case because it was nonprecedential. Applicant nonetheless urges that the Board consider the decision "for consistency" (applicant's brief, p. 7). Citation to nonprecedential decisions is improper. See *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, footnote 9 (TTAB 1992); and *In re American Olean Tile Company Inc.*, 1 USPQ2d 1823, 1825 (TTAB 1986). Applicant's request that we consider the case is denied. In any event, we do not find our decision herein is inconsistent with the

Inc., 222 USPQ 920 (TTAB 1984)(the slogan FOR A DAY, A WEEK, A MONTH OR MORE! held incapable of distinguishing applicant's hotel services); In re Wileswood, Inc., 201 USPQ 400 (TTAB 1978)(the slogans AMERICA'S BEST POPCORN! and AMERICA'S FAVORITE POPCORN! held merely descriptive of unpopped popcorn); and In re Burlington Industries, Inc., 196 USPQ 718 (TTAB 1977)(the term CHAMPAGNE! held merely descriptive of ladies' hosiery).

We find that the applied-for term unquestionably projects a merely descriptive connotation, and we believe that competitors have a competitive need to use this term. See In re Tekdyne Inc., 33 USPQ2d 1949, 1953 (TTAB 1994), and cases cited therein. See also, 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:18 (4th ed. 2000).

In its reply brief (in the section regarding the issue of descriptiveness, p. 3), applicant again argued that the presence of an exclamation point makes a commercial impression that distinguishes applicant's goods from those of others; and then stated that the mark has been widely used in marketing applicant's products, requesting that "if

nonprecedential case cited by applicant as the facts of that case are not even arguably the same as those in the case now before us.

the Section 2(d) refusal is reversed, therefore, Applicant respectfully requests the Board to remand the case to the Examining Attorney to permit Applicant to submit evidence of distinctiveness."

Applicant's request is denied. Once an application has been considered and decided on appeal, the Board has no authority to reopen it for further examination. See Trademark Rule 2.142(g). See also, TBMP §1218. It should be noted that after an appeal is filed, the proper procedure, if an applicant wishes to assert a claim of acquired distinctiveness in the alternative, is to file a request for remand in a separate document, rather than as a statement in its appeal brief and/or reply brief. See TBMP §1215.

Next, we turn to the refusal to register under Section 2(d), based on the registered mark CTEST++ for "systems software for testing and quality assurance of other computer software." In determining this issue we have followed the guidance of the Court in *In re E. I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See

Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to a consideration of applicant's goods vis-a-vis those of the cited registrant. We find that the goods are essentially identical, both being computer software used for testing other computer software. Applicant did not argue to the contrary.

Likewise applicant did not argue, and we do not find, any differences in the channels of trade or purchasers. We must presume, given the identifications, that the goods travel in the same channels of trade, and are purchased by the same class of purchasers. See Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Regarding the respective marks, we begin with the admonition by our primary reviewing Court that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

The Examining Attorney takes the position that applicant's mark incorporates the registered mark, but modifies it slightly by transposing the location of the

word "TEST" and adding an exclamation point; and that the marks remain similar. Applicant contends that the only common element in these marks is the word "TEST"; and that the marks are fundamentally different, with the placement of the "++" in a different part of applicant's mark, and the arbitrary punctuation "!" present in applicant's mark.

In this case, there are obvious differences between the two involved marks, specifically that only applicant's mark includes an exclamation point and that the "++" symbol appears in a different location in each of the two marks. However, we agree with the Examining Attorney that these differences do not serve to distinguish the marks.

Although registrant's mark is distinctive because of the manner in which the elements have been arranged, and applicant's mark is merely descriptive, the marks are very similar in appearance and commercial impression to that of applicant's merely descriptive mark. Both consist of the elements "C," "++" and "TEST," and rearrangement of the elements in applicant's mark does not create a mark sufficiently different from registrant's mark to avoid confusion.

Applicant strongly urges that the arbitrary exclamation point appearing at the end of its mark creates a different commercial impression, but we disagree. As

discussed previously herein, the exclamation point does not add any distinctiveness to the mark.

Upon considering the marks in their entireties, we find that applicant's mark C++TEST! and the cited registrant's mark CTEST++ are similar in sound, appearance, connotation and overall commercial impression.

Applicant, citing, inter alia, the case of *In re General Motors Corp.*, 23 USPQ2d 1465 (TTAB 1992), also contends that the cited registered mark is a weak mark entitled to a narrow scope of protection; and that because it is entitled to a narrow scope of protection, even minor differences between the marks will avoid confusion.

It is true that in the General Motors case, the Board found no likelihood of confusion between applicant's mark GRAND PRIX for "automobiles," and registrant's six registered marks, GRAND PRIX and GRAND PRIX with three different designs, for a variety of automotive products (e.g., tires, mufflers, motor oil), holding that the term GRAND PRIX was highly suggestive and entitled to a narrow scope of protection. However, in balancing all the relevant du Pont factors, the Board also considered the interesting confluence of facts including that applicant had established "relative fame of [its] mark"; that there had been coexistence of the parties' marks for over thirty

years; and that there had been no instances of actual confusion. This is to be distinguished from the case now before the Board, where there is no evidence of the nature discussed in the General Motors case.

Moreover, even weak marks remain entitled to protection against registration by a subsequent user of the same or similar mark for the same or related goods.⁴ Applicant's identified goods, as noted above, are legally identical to registrant's identified goods. See *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976).

To the extent we have any doubt on the question of likelihood of confusion, it must be resolved against the newcomer, as the newcomer has the opportunity of avoiding confusion and is obligated to do so. See *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Finally, we turn to the third issue before us, whether the Examining Attorney's requirement for further information under Trademark Rule 2.61(b) was proper.

⁴ We specifically note that the cited registered mark is on the Principal Register with no disclaimer and no claim of acquired distinctiveness under Section 2(f) of the Trademark Act; and it is, of course, entitled to the statutory presumptions under Section 7(b).

In the first Office action the Examining Attorney required advertising or literature (e.g., promotional materials) regarding the nature of applicant's goods, and if such materials were not available, then applicant was to describe the nature, purpose and channels of trade of its identified goods. In response to the first Office action, applicant submitted advertising literature in the nature of a one-page glossy brochure, which contained extensive information on how applicant's computer program for testing computer applications software works.

However, in the final Office action, the Examining Attorney reiterated the requirement, stating that the one page of literature was inadequate, and requiring more information about the goods, such as a fact sheet or advertising. (The Board notes that with this same final Office action, the Examining Attorney attached photocopies of 18 pages he had printed out from applicant's website as relevant to the issue of descriptiveness.) Applicant responded to the final Office action on this issue, and it offered photocopies of two pages from applicant's website, one titled "Products Page," and one titled "C++TEST"; and applicant stated that "Further, information can be obtained on the website.... The channels of trade would be the

Internet, and any computer storage medium product, such as CD ROMs." (Applicant's response, p. 3.)

The Examining Attorney treated the "response" to the final Office action as a request for reconsideration and denied same in an Office action dated December 19, 2000, without commenting on either the additional pages of literature or the statements of applicant regarding its goods.

Applicant filed its brief on the case addressing only the refusals to register under Sections 2(d) and (e)(1). However, the Examining Attorney made clear in his brief that whether applicant had submitted sufficient information under Trademark Rule 2.61(b) remained an issue. He specifically stated that applicant was required to provide product literature relating to how the goods operate, the salient features, and the prospective customers and/or channels of trade; and alternatively, applicant could provide a full description of the nature, purpose and channels of trade for these goods. Applicant, in its reply brief, pointed out that in the December 19, 2000 Office action, the Examining Attorney did not indicate that the additional information submitted by applicant was inadequate; and further, applicant argued that it has

complied with the Examining Attorney's requirement with all the necessary information about applicant's goods.

Certainly, the Examining Attorney's requirement under Trademark Rule 2.61(b) for additional information about the goods was appropriate. However, the record shows that applicant has made a good faith attempt to comply with the Examining Attorney's requirement; and the Examining Attorney is under a duty to be specific with regard to what is still needed from applicant. See TMEP §814 (3d ed. 2002). Here, upon receiving the denial of its request for reconsideration, applicant did not even realize that the requirement for additional information remained an issue. On this record, we find that applicant has sufficiently complied with the Examining Attorney's requirement for additional information under Trademark Rule 2.61(b). Nor do we see from the Examining Attorney's actions that applicant knew that even more information as to how the goods operate, the salient features and the prospective purchasers and channels of trade was required. Cf., *In re Babies Beat Inc.*, 13 USPQ2d 1729 (TTAB 1990).

Decision: The requirement for more information under Trademark Rule 2.61(b) is reversed. The refusals to register under both Sections 2(d) and 2(e)(1) are affirmed.