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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re MicroStrategy Incorporated

Serial Nos. 75/666,992 and 75/666,993

Michael J. Bevilacqua and Barbara A. Barakat of Hale and Dorr for MicroStrategy Incorporated.

Stacy B. Wahlberg, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Hohein, Walters and Rogers, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

MicroStrategy Incorporated has filed two applications to register on the Principal Register the mark THE INTELLIGENCE COMPANY for "computer programs for use in online analytical processing and data analysis"[1] in the first application, and, in the second application, for

[1] Serial No. 75/666,992, in International Class 9, filed March 24, 1999, based on an allegation of a bona fide intention to use the mark in commerce.

"computer education training services" and "computer services, namely, providing computer consulting services, computer support services, namely troubleshooting of computer hardware and software problems via telephone and email, computer software design for others."[2]

The trademark examining attorney has issued a final refusal to register in each case, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive if used in connection with its goods and services.[3]

Applicant has appealed in each case. Both applicant and the examining attorney have filed briefs, but oral hearings were not requested. Because the issues and facts are substantially the same in these two applications, we have considered the appeals together and issue, herein, this single decision.

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[2] Serial No. 75/666,993, in, respectively, International Classes 41 and 42, filed March 24, 1999, based on an allegation of a bona fide intention to use the mark in commerce.

[3] In the office actions of July 3, 2000, the examining attorney noted applicant's entry of a disclaimer; stated "the disclaimer requirement [is] withdrawn"; and stated a Section 2(e)(1) refusal. In its responses, applicant stated that it "assumes the previously entered disclaimer [of COMPANY] has been removed." The examining attorney did not respond to this statement and the disclaimers remain of record in the two applications.

The final refusal to register in each application included a ground of likelihood of confusion. Applicant, in its brief, notified the examining attorney that the cited registration had been cancelled. In her brief in each application, the examining attorney withdrew that ground of refusal.

The examining attorney contends that THE INTELLIGENCE COMPANY merely describes “a company that is the source of goods with computer processing capabilities” and services using such goods; that the term “intelligence” is used in the computer industry to describe a function or feature of computer programs; that, in the context of applicant’s computer software, “intelligence” describes the processing and data analysis capabilities of the software; and that, in the context of applicant’s services, “intelligence” describes “a field in which computer education, support, consulting and software design services are offered.”

In support of her position, the examining attorney submitted dictionary definitions of “intelligence”; excerpts of articles from the LEXIS/NEXIS database; and copies of third-party registrations for marks that include the disclaimed term “intelligence” for computer software and related products and services.

Except for four excerpts referring, respectively, to “artificial intelligence software,” “intelligence software at Idefense” (pertaining to computer viruses), “intelligence software,” and “e-customer intelligence software and consulting services,” the remaining LEXIS/NEXIS article excerpts submitted use the term “business intelligence” or “business-intelligence” to refer to software of the type

identified in application serial no. 75/666,992. The following are two examples:

> Informix joins a growing list of business-intelligence software vendors selling prepackaged data-analysis software to specific vertical markets. [*TechWeb News*, June 14, 2000.]

> You don't need to be a statistician at the Census Department or a researcher at the Centers for Disease Control and Prevention to need statistical or data analysis software. Once used primarily for scientific research, the functions offered in these packages have now permeated the business and government arenas, providing what is called business intelligence. [*Government Computer News*, June 1, 2000.]

Applicant contends that THE INTELLIGENCE COMPANY, considered as a whole, is not merely descriptive because it does not "enable potential purchasers to immediately understand the precise nature of the goods which it identifies"; that "[e]ven informing a potential purchaser that computers have processing capability provides no information to a consumer, even an educated consumer aware of the nature of the goods … [because] all computers have processing capability"; that there is no evidence of third-party use of the term "the intelligence company" in a descriptive manner; and that numerous registered marks for software-related products include the term "intelligence" without a disclaimer thereof.[4]

[4] With its brief, applicant submitted copies of third-party registrations. The record must be complete prior to appeal, and the examining attorney has properly objected to consideration of this evidence. Because this evidence is untimely, we have not considered it in reaching our decision. Trademark Rule 2.142(d).

Applicant also argues that “intelligence” has additional meanings unrelated to computer processing capability; that one such meaning is “the ability to learn or understand or to deal with new or trying situations”; that applicant’s mark “is intended to evoke that image of products [and the provision of services] that will grow for the user, to become more efficient, more adaptable, and provide more benefit to the user as use continues and new and trying situations or factors arise”; that applicant’s “employees are able to deal with new or trying situations faced by its clients”; and that, as such, THE INTELLIGENCE COMPANY is a double entendre that is not merely descriptive in connection with applicant’s goods or services.

In support of their respective positions, the examining attorney and applicant submitted the following definitions of intelligence:

> From *Techencyclopedia*, www.techweb.com, March 21, 2001 “intelligence” is “processing capability.”
>
> From *Merriam-Webster’s Collegiate Dictionary*, www.yourdictionary.com, 2001, “intelligence” includes “1. the ability to learn or understand or to deal with new or trying situations; 5. the ability to perform computer functions.”

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re*

Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd*., 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

We find that, considering the mark in its entirety, it is not merely descriptive. Clearly, the terms “The” and “Company” have little or no trademark significance alone. However, THE INTELLIGENCE COMPANY, when considered in connection with applicant’s identified goods and services, connotes a company with intelligence, i.e., defined as “the ability to learn or understand or to deal with new or trying situations.” At most, it is suggestive of the purported qualities of its employees or the skill with which applicant renders its services, or suggestive of the quality of applicant’s software.

Even if prospective customers of applicant were to understand the term “intelligence” in THE INTELLIGENCE COMPANY as referring to “computer processing ability,” it is too general a concept to be merely descriptive in connection with the identified goods and services. Thus, while there may be a double entendre quality to the mark, both meanings are, at most, suggestive. To consider the term “intelligence” to be descriptive of the nature of applicant’s goods and services is a significant mental leap.[5]

Decision: The refusal under Section 2(e)(1) of the Act is reversed.

[5] Further, the examining attorney has not established whether the term “intelligence” is likely to be understood as none, one or all of the terms “business intelligence,” “artificial intelligence,” or “surveillance intelligence.”