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Paper No. 20
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Advent Networks, Inc.

Serial No. 75/906,114

Rochelle D. Albert of Brobeck, Phleger & Harrison LLP for
Advent Networks, Inc.

Fred Mandir, Trademark Examining Attorney, Law Office 105,
(Thomas G. Howell, Managing Attorney).

Before Cissel, Quinn and Walters, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On January 31, 2000, applicant filed the above-
referenced application to register the mark "ULTRABAND" on
the Principal Register for goods in Class 9 and services in
Class 38. The application was subsequently amended to
strike reference to the services and to identify the goods
as follows: "computer software for telecommunications
purposes, namely, for a digital interface for connecting
home content accessing devices with a global computer

network over a hybrid fiber coaxial network for the delivery of additional information in a high-speed electronic format including video, text, and audio content; computer hardware for telecommunications purposes, namely, a digital interface connecting home content accessing devices with a global computer network over a hybrid fiber coaxial network; electronic hardware and software computer interfaces for connecting home content accessing devices with a global computer network over a hybrid fiber coaxial network; fiber-optic network equipment, namely optical switches, optical transceivers, wavelength division multiplexing (WDM) combiners, WDM splitters, and WDM selectors for using rf signals in the television bandwidth; computer hardware, namely, optical transmitters, receivers, coaxial fibers, rf amplifiers, quadrature amplitude/phase modulation modems, and amplitude/phase modulators for enabling telecommunications over a hybrid fiber coaxial network," in Class 9. The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in interstate commerce in connection with these goods.

The Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. Section 1052(e)(1), on the ground that the mark applicant seeks to

register is merely descriptive of the goods set forth in the application. Submitted in support of the refusal to register were excerpts retrieved from the Nexis database of published articles. One of the excerpts is from the February 29, 1996 edition of the Minneapolis Star Tribune, and the other is from the April 4, 1995 edition of the Roanoke Times & World News. Both appear to be from the same article, written by David Butler, who is identified in the Minneapolis newspaper as a freelance writer from Charlotte, North Carolina, "who specializes in home automation and advanced consumer products." The language in each excerpt is identical: "Tech Talk: Cable television channels are divided into four bands: midband (channels 14-22), superband (23-36), hyperband (37-64) and ultraband (65-120). UHF channels 14-69 are located in the same spectrum as ultraband. That's why cable-ready TV's must have a cable/antenna switch." The Examining Attorney contended that this evidence establishes that the term sought to be registered is generic in connection with the goods specified in the application, so applicant was advised that amending the application to seek registration on the Supplemental Register or under the provisions of Section 2(f) of the Act would not be appropriate.

Applicant responded to the refusal to register by arguing that "ULTRABAND" is not merely descriptive of the goods identified in the application, much less generic as applied to them. Applicant submitted a copy of a company information paper explaining its products. In relevant part, this advertisement states as follows: "Advent Networks' Ultraband™ cable modem termination system will enable upgraded cable operators to differentiate themselves with new premium services, increased market share and additional revenue opportunities... The Ultraband™ system features the company's patent-pending Packet over Hybrid Fiber Coax (PoHFC) network... As an example of the speed of the Ultraband™ system, viewers could download an entire software program or a CD album to their PC in only two minutes. ...The Ultraband™ system includes a modem termination system residing at the cable head--and an s subscriber modem that resides at the subscriber premises. This platform opens a new world of revenue-generating content delivery applications to cable network operators currently limited by today's cable modem systems." Applicant argued that in view of the information provided in this advertisement, it is clear that the mark

"ULTRABAND" is neither generic nor merely descriptive of the goods identified in the application.

With his second Office Action, the Examining Attorney made the refusal to register based on mere descriptiveness under Section 2(e)(1) final. Submitted with that action were a number of excerpts from a wire service, as well as several from periodical publications. Examples from the latter group include the following: "... digital radio-frequency exciter, each occupying a single board in the 6U VME form factor; and an ultra-band microwave power module" (International Defense Review, March 1, 2000); "... to lobby on legislation and regulations affecting the company's development of its geoposition, radar and ultra-band technologies" (Political Finance & Lobby Reporter, July 28, 1999); "... and Northrop Grumman for its ultra-band microwave power module..." (Flight International, June 23, 1999); and "The new fusion beamformer and our exclusive HP ultra band transducers, combined with the multidimensional processing capability of this system, create a powerful diagnostic tool." (Medical Industry Today, June 4, 1997).

Applicant requested reconsideration of the refusal to register, arguing that none of the excerpts submitted by the Examining Attorney refers to the products with which applicant intends to use the mark it seeks to register.

Applicant timely filed a Notice of Appeal thereafter. The Board instituted the appeal, but suspended action on it and remanded the application to the Trademark Examining Attorney to consider a request for reconsideration, but the Examining Attorney adhered to the refusal. As additional support therefor, he submitted a news story and information obtained from a Google search. The story refers to "wireless ultra-band" as the subject to be discussed at a conference. Several additional excerpts retrieved from the Nexis database were also attached, but each is from a wire service, rather than an actual publication. Additionally, the Examining Attorney attached pages from applicant's WebSite wherein the "Ultraband System" is promoted, including a notice that applicant claims "Ultraband" as its trademark.

Applicant timely filed a Notice of Appeal, followed by an appeal brief. The Examining Attorney filed his brief in response. Then applicant revoked its previous power of attorney and appointed the above-identified legal counsel, who filed a reply brief along with a declaration in support of additional evidence she sought to have considered by the Board. Included with this evidence were copies of third-party registrations, and the results of a fruitless search of the official Federal Communications Commission's WebSite

for the terms "ultraband" and "ultra-band." Counsel for applicant requested suspension and remand under Trademark Rule 2.142(d) so that the Examining Attorney could consider these materials, as well as a copy of a letter from the Deputy Chief, Office of Engineering & Technology, Federal Communications Commission, who responded to an inquiry from applicant's congressman with a statement that "the term 'ultraband' is not used or defined in the [FCC] rules and there is no frequency location associated with this term." The Board granted applicant's request to suspend and remand, but the Examining Attorney did not find the additional evidence of record persuasive, and returned the application to the Board for resumption of action on the appeal. Applicant did not request an oral hearing.

The test for determining whether a mark is merely descriptive under Section 2(e)(1) of Lanham Act is not seriously disputed in the case at hand. A mark is merely descriptive under this section of the Act if it immediately and forthwith conveys information concerning a significant quality, characteristic, feature, function, purpose or use of the goods. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the

goods in order for it to be considered to be merely descriptive of them; rather, it is sufficient if the term describes any significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods for which registration is sought, the context in which it is used (or is intended to be used) in connection with those goods and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use. In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). A mark is suggestive, rather than merely descriptive, if, when the goods are encountered under the mark, a multi-stage reasoning process, or the use of imagination, thought or perception is required in order to determine what attributes of the goods the mark indicates. In re Mayer-Beaton Corp., 223 USPQ 1347 (TTAB 1984). As we have stated previously, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category the mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See, e.g., In re Atavio, 25 USPQ2d 1361 (TTAB 1992), and In re TMS Corp. of the Americas, 200 USPQ 57 (TTAB 1978).

Additional legal principles which are particularly relevant to the case at hand are that the burden of establishing that a mark is merely descriptive is on the Examining Attorney, and that if, after considering the evidence and arguments, this Board is left with any doubt on the issue of descriptiveness, such doubt must be resolved in favor of the applicant, allowing the mark to be published so that if competitors have a need to use the term asserted by the Examining Attorney to be merely descriptive, they may oppose registration of it to applicant. See: In re Gyulay, supra; In re Warren Petroleum Corp., 192 USPQ 405 (TTAB 1976); In re Pennwalt Corp., 173 USPQ 317 (TTAB 1972).

After carefully considering the record before us in this appeal in the context of the arguments presented by both applicant and the Examining Attorney, we find that the Examining Attorney has not established that "ULTRABAND" would immediately and forthwith convey significant information about applicant's goods with any specificity to prospective purchasers of them. While the term applicant seeks to register does apparently have some meaning with respect to some electronic devices, it is just not clear to us what, if any, meaning would be attributed to it in connection with any of the products in connection with

which applicant intends to use it, as recited in the amended application.

To begin with, we note that we do not attach any probative value to the excerpts submitted by the Examining Attorney from wire services. The record does not establish that this information was ever published or otherwise made available to perspective purchasers of these products, so we have no basis upon which to conclude that such people have been exposed to the uses of the term shown in the wire service excerpts.

With respect to the other evidence listed above, none of it constitutes a clear demonstration that the term has descriptive significance in connection with any of the products listed in the amended application. The Examining Attorney puts significant emphasis on the excerpt from the Butler article, wherein the consumer product and home automation writer states that cable television channels are divided into four bands, one of which is the "ultraband." The letter from the Federal Communications Commission's engineering and technology deputy chief, however, makes it clear that Mr. Butler's statement is either erroneous or made in a context different from the FCC response.

The Examining Attorney argues that because applicant conceded that particular equipment may be programmed to

operate using the "ultraband cable channels," in view of the fact that applicant's goods operate over hybrid fiber coaxial cable networks and fiber-optic network cables, the term is merely descriptive of the goods. Applicant acknowledges that the term it seeks to register has meaning in the telecommunications field relating to wireless technology, but argues that its goods are not in that field, but instead relate to hybrid fiber coaxial networks and fiber-optic network cables. While we are certainly not experts in the technology embodied in the computer software and hardware and fiber optic network equipment used in the telecommunications industry, after the exercise of considerable effort to relate the Examining Attorney's arguments to the materials of record in connection with this appeal, we are not convinced without any doubt that the distinction applicant draws between cable and wireless technologies is invalid. To the contrary, the evidence to which the Examining Attorney points seems to relate to other areas of technology, especially the references to "display radio frequency exciters," "microwave power modules" and "transducers" as "diagnostic tools," and this technology appears to be distinct from the fiber optic and hybrid fiber coaxial networks in which applicant's products are used.

As noted above, the Examining Attorney has the burden of proof on this issue, and doubts must be resolved in favor of the applicant. In that the evidence submitted by the Examining Attorney leaves us unsure that this term describes a feature, function, characteristic or purpose of the goods with which applicant intends to use it, we cannot affirm the refusal to register under Section 2(e)(1) of the Act. If applicant's competitors need to use this term to describe their own products in this field, they will of course be free to oppose registration to applicant. If they could create a record which clearly establishes, beyond doubt, that this term has descriptive significance in connection with these goods, such an opposition would be sustained.

DECISION: The refusal to register is reversed.