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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Careworks of Ohio, Ltd.

Serial No. 75940225

Perry M. Chappano of Chappano Wood PLL for Careworks of Ohio, Ltd.

Alicia P. Collins, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

Before Quinn, Hairston and Bucher, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Careworks of Ohio, Ltd. has filed an application to register the mark CAREWORKS TECHNOLOGIES for "computer services in the insurance and financial fields, namely, computer consultation, computer programming for others, computer systems analysis, and computer network support,

namely, designing, analyzing, monitoring, programming and testing of network systems.”¹

Applicant has appealed the Trademark Examining Attorney’s requirement that applicant disclaim TECHNOLOGIES apart from the mark as shown, and her final refusal to register the mark absent compliance with the disclaimer requirement. Trademark Act Section 6(a), 15 U.S.C. 1056(a). Applicant and the Examining Attorney have filed briefs. No oral hearing was requested.

It is the Examining Attorney’s position that the word TECHNOLOGIES is merely descriptive of applicant’s services within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1).

In support of her mere descriptiveness argument, the Examining Attorney submitted a definition of the word “technology” taken from The American Heritage Dictionary of the English Language (3d ed. 1992):

- technology: 1. a. The application of science, especially to industrial or commercial objectives.
- b. The scientific method and material used to achieve a commercial or industrial objective.

The Examining Attorney maintains that the first definition is most pertinent in this case. Further, the

¹ Serial No. 75940225, filed on February 20, 2000, and based on a bona fide intention to use the mark in commerce. The application was subsequently amended to allege a date of first use anywhere and a date of first use in commerce of February 28, 2000.

Examining Attorney made of record excerpts from the Nexis database and printouts from the Internet that show use of the word "technology/technologies." The following are representative:

With the impending breakup of Microsoft, which is destined to be upheld on appeal, we are on the threshold of yet another unprecedented, if not explosive, expansion of *computer programming technology*.

(The Palm Beach Post, June 19, 2000);

But the company contends that *computer design technology* and new materials will make it far different from past models.

(The Washington Post, September 10, 2000);

Some students have made the choice to seek careers in the *computer technologies field*.

(www.hometech.com); and

The Coroillis Group is a publishing leader in the *computer technologies field*.

(www.siggraph.org).

In addition, the Examining Attorney made of record copies of third-party registrations for marks which include a disclaimer of the term "technology/technologies" for services in the computer field. Examples include Registration No. 2,477,403 for the mark SANDBOX TECHNOLOGIES for inter alia "computer consulting services;" Registration No. 2,484,835 for the mark RIGHTNOW TECHNOLOGIES for "designing, implementing and maintaining a network web site for others which will provide interactive

Ser No. 75940225

customer self help;" Registration No. 2,510,550 for LANAC TECHNOLOGY for "computer consulting services; integration of computer systems and networks; computer programming; and computer software design and development for others;" and Registration No. 2,555,267 for MILAN TECHNOLOGY for "consulting and design services in connection with computer network connectivity hardware and software; maintenance, repair and technical support in the field of network connectivity hardware and software; namely, telephone support provided to purchasers and users of computer hardware and software."

Finally, the Examining Attorney points to applicant's own description of its services at applicant's website as evidence of the mere descriptiveness of the term "technologies."

Applicant maintains that the term TECHNOLOGIES is only suggestive of its services. Relying on the Federal Circuit's decision in *In re Hutchinson Technology*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988), applicant argues that the term encompasses many different scientific fields and is simply too broad and vague to be descriptive of applicant's particular services. Applicant submitted definitions of the word "technology" taken from several

dictionaries to show that technology may relate to different scientific fields.

In determining whether TECHNOLOGIES is merely descriptive of applicant's recited services, and therefore must be disclaimed, we apply the following legal principles. A term is deemed to be merely descriptive of goods or services within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (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 purchasers of the goods or services because of the manner

of its use. In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979).

We have carefully considered the evidence of record and the arguments made by applicant and the Trademark Examining Attorney, and we conclude that TECHNOLOGIES is merely descriptive as applied to applicant's services, and that it therefore must be disclaimed. We are aware that "technology" is a very broad term which may include many categories of goods/services. Unlike in the Hutchinson case, the evidence of record establishes that TECHNOLOGIES merely describes a feature or characteristic of applicant's services, i.e., that applicant's services involve the use of computer science in the insurance and financial fields. The dictionary definition of "technology" supports this conclusion, as do the Nexis excerpts and Internet printouts which refer to computer programming technology, computer design technology, and the computer technologies field.

Further, we note that applicant describes its services at its website in the following manner:

We provide professional resources to design, analyze, program, test and support software and network systems. CareWorks IT staffing work with you to bridge **technologies** to meet your computer needs.

.....

Two solid years of research and development helped CareWorks unify all of the necessary

components for successful medical case management into one integrated system. In fact, CareWorks has created a **technology** model for Ohio's MCO Industry. (emphasis added)

Additionally, the above-referenced third-party registrations for similar services in which the registrants have disclaimed TECHNOLOGY/TECHNOLOGIES, although not conclusive evidence, are probative evidence of mere descriptiveness at least to the extent that they may suggest that TECHNOLOGY/TECHNOLOGIES has been deemed and/or acknowledged to be not inherently distinctive by the Office and/or by the prior registrants.

In view of the foregoing, we find that TECHNOLOGIES is merely descriptive of applicant's recited services and that the Examining Attorney's disclaimer requirement is proper.

Decision: The requirement for a disclaimer of TECHNOLOGIES, and the refusal of registration based on applicant's failure to submit such a disclaimer, are affirmed. However, in the event that applicant submits the required disclaimer within thirty days of the date of this decision, the refusal to register will be set aside, the disclaimer will be entered, and the application will proceed to publication.