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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re Transgo, Inc.

Serial No. 76/031,676

Mark P. Stone for Transgo, Inc.

Barbara A. Gaynor, Trademark Examining Attorney, Law Office  
104 (Michael Hamilton, Managing Attorney).

Before Simms, Bucher and Rogers, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Transgo, Inc. seeks registration of the term  
REPROGRAMMING KIT on the Principal Register as used in  
connection with:

automotive transmission valve body components; namely,  
separator plates and springs; automotive transmission  
parts; namely, separator plates and springs, sold  
together as a unit; automatic transmission valve body  
parts sold as a unit for installation in the valve  
bodies of vehicle automatic transmissions; and valve  
body kits comprising separator plates and springs for  
installation in the valve bodies of vehicle automatic  
transmissions, in International Class 12.<sup>1</sup>

<sup>1</sup> Application Serial No. 76/031,676 was filed on April 2,  
2000 based upon applicant's allegation of use in commerce at  
least as early as 1970.

As filed, the initial application papers claimed acquired distinctiveness under Section 2(f) of the Act. During the course of prosecution, applicant agreed to disclaim the generic word KIT apart from the mark as shown.

This case is now before the Board on appeal from the final refusal to register based upon the grounds that this term is generic for these goods based upon Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), or alternatively, that applicant's showing of acquired distinctiveness is insufficient to overcome the highly descriptive nature of this designation.

This is applicant's second attempt to secure a registration of this term for the listed goods. In this context, we note that the instant record is similar to, but somewhat different from, the record in a prior application by applicant to register the same term for identical goods.<sup>2</sup>

The earlier application was abandoned after an *ex parte* appeal and subsequent administrative petitions. In deciding that appeal, the majority of another panel of the Board found that the record in the prior application did not contain sufficient evidence of the genericness of the term:

Applicant's goods, according to the patent which the Examining Attorney has made of record, are a system used to modify factory-installed transmissions, essentially by modifying the structure and operation of the existing hydraulic circuits of the original transmission. The system produces quick application and release forces with minimum ratio sharing, or overlap, through the modification of the operation of the original transmission by enlarging or plugging orifices in the original hydraulic circuitry to change fluid flow.

It appears, from the evidence of record, that the purchasers of applicant's goods are auto mechanics, manufacturers of high performance automotive transmission parts, sellers of automotive transmission parts; and those interested in racing automobiles or otherwise modifying their vehicles for high performance.

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... [However] we find, based on the evidence of record, that the Office has not met its burden of establishing by clear evidence that REPROGRAMMING KIT is generic for the identified goods.

(In re Transgo, pp. 2 - 3, 13 - 14 (TTAB December 16, 1999), hereinafter Transgo I).

On the other hand, all three members of the prior panel affirmed the Trademark Examining Attorney's alternate ground for refusal of registration, inasmuch as the showing of acquired distinctiveness in that application record was deemed insufficient to overcome the highly descriptive nature of the mark:

Given the highly descriptive nature of applicant's mark, we find that applicant has not met its burden of proving that it has acquired distinctiveness. Although applicant has certainly used its mark for a substantial amount of time, mere longevity of use is

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<sup>2</sup> Application Serial No. 75/055,823 was filed on February 9, 1996, also based upon applicant's allegation of use in commerce at least as early as 1970.

not always sufficient to prove acquired distinctiveness. In this case, applicant's use of the mark is always with the trademark TRANSGO, which appears in much more prominent letters and type style. Moreover, the sale of 820,000 units over almost 30 years is not particularly significant in terms of the exposure of the mark to the consuming public...

Applicant has provided no information whatsoever about its advertising of its product, from which we might ascertain what public recognition it might have. The three declarations of purchasers of applicant's high performance valve body kits ... are similarly unpersuasive.

Considering the highly descriptive nature of the term REPROGRAMMING KIT, the evidence submitted by applicant is simply insufficient for us to conclude that REPROGRAMMING KIT has acquired distinctiveness among the relevant consumers.

(Transgo I, pp. 16 - 17).

As to the current application, the same Trademark Examining Attorney assigned to the application in Transgo I issued and made final the same two grounds for refusal, namely, that the term "Reprogramming Kit" is generic for these goods, and that even if on appeal it should be found not to be generic, applicant's showing of acquired distinctiveness is insufficient to overcome the highly descriptive nature of the term.

In the instant record, the Trademark Examining Attorney has added examples of third parties' usage of the term "reprogramming kit" for their own packages (or kits)

for modifying or recalibrating the operation of automatic transmissions.<sup>3</sup>

Similarly, while continuing to argue vehemently that REPROGRAMMING KIT is not generic, in response to the second alternative ground for refusal, applicant has provided additional evidence as to promotion of its products in the form of its annual catalog, advertisements in two national magazines and product updates for its distributors. All these materials are supported by another declaration of applicant's president,<sup>4</sup> this one citing specifically to applicant's distribution of annual catalogs and reciting the seminars and trade shows in which applicant has participated in recent years.

### **I. The Genericness Refusal**

The Trademark Examining Attorney has the burden of proving that a term is generic by clear evidence. In re

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<sup>3</sup> The Trademark Examining Attorney had failed to include such examples in Transgo I, see pp 10 - 11:

"... the only evidence of cyberspace use is the web site ... of applicant's distributor. Given that an Examining Attorney who has submitted evidence from the NEXIS database and the web is presumed to have submitted the best evidence available to him or her from the searches of those media [citation omitted], we must assume that such searches did not reveal any other references to the term "reprogramming kit" *per se*.

<sup>4</sup> In addition to a photocopy of Mr. Younger's declaration dated August 29, 1996 and a supplemental declaration dated July 6, 1998, both of which were included in the record of Transgo I, this application contains a third and more extensive declaration dated April 12, 2000.

American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832, 1835-36 (Fed. Cir. 1999); and In re Merrill Lynch, Pierce, Fenner & Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Evidence of the public's understanding of a term can be obtained from any competent source, including dictionary definitions, research databases, trade journals, newspapers and other publications. Merrill Lynch, supra; See also In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985). With this standard in mind, we turn to the record.

The record in this *ex parte* appeal suggests the existence of, but cannot completely catalogue, the wide technical variations in kits available for fixing and improving automobile transmissions. The record also reveals an additional source of confusion, namely, the fact that within the industry, various vendors employ inconsistent nomenclature for their respective kits. In fact, applicant itself does not always apply exactly the same generic naming phraseology to the same package of components. Nonetheless, in order to appreciate the *arguments* of applicant and of the Trademark Examining Attorney on the question of genericness posed by this appeal, it is necessary that one understand the basic functions of these various kits. Hence, the discussion

that follows seeks to maintain a focus on the exact question of genericness posed by this appeal without oversimplifying the relative complexity of automatic transmissions and their components.

For those having no general familiarity with auto mechanics, or those having no specific interest in automatic transmission components, we consider herein the real world choices facing Harold Lee ("Hal Lee") Shelby, a hypothetical consumer of applicant's affected products. Hal Lee has just purchased a used 1994 Ford Mustang GT convertible having a 5.0-liter engine and an automatic transmission. The stock Ford transmission installed by the manufacturer is a popular model known to tranny mechanics as the "AODE." While reveling in the results of several engine (and other power train) modifications made by his local, high performance auto shop, Hal Lee has identified several shifting problems that he considers to be design shortcomings of the stock automatic transmission. His local professional transmission mechanic<sup>5</sup> shows him applicant's (hereinafter, also "Transgo's") annual catalogs

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<sup>5</sup> Each of applicant's catalogs emphasizes on the front cover that these Transgo products are "For the Professional Transmission Mechanic." While a few daring shade tree mechanics may attempt to repair or overhaul an automatic transmission, applicant clearly directs the installation of all the relevant kits herein to transmission specialists who are comfortable with the complexities of an automatic transmission.

from 1999, 2000 and 2001 (made of record herein). Hal Lee is in luck. When flipping through the 2001 catalog, he notes that the majority of Transgo's transmission components are designed for automatic transmissions turned out by the "Big Three" automobile manufacturers since the mid-1960's. All of applicant's kits are very specific packages having components designed to work with particular transmissions. Hal Lee notes that applicant sells transmission repair and modification "kits" having two somewhat different goals.

**A. Applicant's "Valve Body Kits" are "fixes"**

On pages 3 to 5 of the Transgo 2001 catalog, under the heading "Ford Transmission - Valve Body<sup>6</sup> Kits," Hal Lee discovers two dozen kits containing "fixes" for design shortcomings of stock Ford transmissions.<sup>7</sup> Each catalog listing of a kit contains a "Features" section. This section often introduces a particular kit with language like "Corrects/Prevents/Reduces," followed by a list of

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<sup>6</sup> The transmission valve body is the brain of the transmission. It is clear from the record that the valve body is located above the pan on the bottom of the transmission. It appears from this record that any fixes limited to the valve body should not make it necessary to drop the entire transmission out of the automobile (e.g., as would be necessary to do a complete overhaul of the transmission).

<sup>7</sup> Many of these packages of components are identified by applicant's unique part numbers (usually containing the model

problems remedied by the kit. For example, if Hal Lee wants merely to provide for greater durability and crisper performance, he would likely settle on the following catalog entry for a valve body kit for his pony:

<b>Kit #</b>	<b>Application</b>	<b>Features</b>
<b>SK® AODE (4R70W)</b> Update	AODE 1991-2001 Ford/Mercury: Lincoln, 1994-up Mustang, T-Bird, Bronco, Light Trucks	Calibration and Assembly Upgrade, Installs in 10 minutes during your repair Corrects/Reduces/Prevents: 4 <sup>th</sup> band failure; 2 <sup>nd</sup> roller failure; long soft 1-2 and 2-3 shifts; soft lockup; reduces accidental high-pressure parts breakage. Includes special forward clutch rings, SOL regulator valve and EPC relief valve.

From the entire record, then, it appears the Board can make the following conclusions:

- Applicant's "valve body kits" comprise "fixes"
- Applicant uses "shift kit" as a synonym for "valve body kit" <sup>8</sup>
- All the half dozen photographs showing boxes of "shift kits" depict small, robin's egg blue boxes, with each display of the boxed contents showing a dozen or more small valve body parts, such as springs, plugs and balls.<sup>9</sup>

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number of the original equipment manufacturer) combined with applicant's SK@\_\_\_\_ or SK@\_\_\_\_Jr. marks.

<sup>8</sup> The record herein shows that not everyone manufacturing, selling and installing transmission kits uses the same nomenclature for substantially the same assortment of items. We acknowledge some confusing usage of various terms within the transmission parts industry. For example, in spite of applicant's long proprietary claims to the term SHIFT KIT for "automatic transmission valve body components," applicant, in its catalogs, uses "valve body kit" interchangeably with "Shift Kit," while third-party competitors across the board use the term "shift kit" generically for shift correction packages. In fact, industry-wide, it seems that the term "shift kit" is sometimes used even more broadly to name any component package that repairs, rebuilds or modifies a transmission, including superficial changes to the shifter on the console.

<sup>9</sup> Although the catalog provides no picture of Hal Lee's AODE transmission kit, a similar fix kit is featured on the back cover of applicant's 2000 catalog. Beneath the title "RE4R01A Shift

**B. What is Transgo's "High Performance Reprogramming Kit"?**

Upon reviewing the kits in Transgo's catalogs, Hal Lee - who prefers that his ponies be small but wild - is intrigued by the additional possibility (i.e., not simply fixing inherent deficiencies in the transmission valve body) of actually modifying his automotive transmission using after-market components to enhance the performance of his vehicle when it is being used hard.

Happily for Hal Lee, he quickly locates Transgo's second large category of Ford transmission kits. These kits appear under the general heading of "High Performance Reprogramming Kit" (in the 1999 and 2000 catalogs), and under "High Performance Reprogramming Kits™" (in the 2001 catalog).

**C. Reprogramming Kits: Transgo and its competitors**

In the event the reader has not had the benefit of the Board's decision in Transgo I, we review the summary of the technology underlying applicant's "High Performance Reprogramming Kits" contained in the concurring opinion:

Specifically, one learns from the record that automatic transmissions have transmission fluid pumped

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Kit for Nissan, Mazda, and Subaru" is a photograph of thirty small transmission parts (e.g., springs, plugs, balls, gaskets and seals). On page 12 of the same catalog, this item is identified as "SK® RE4R01A," and located under the catalog heading of "Import Transmission Valve Body Kits."

through a series of passages under pressures up to 300 psi and directed via valves and solenoids to activate various clutches and bands on planetary gear-sets. The gear-sets are engaged and disengaged to provide various ratios that multiply the input torque passed to the transmission through a torque converter, designed to turn the drive-shaft and hence to move the vehicle.

Accordingly, as seen in the claims of the patented device ... applicant's kit is designed to permit the automobile mechanic to modify the factory-installed transmission of certain automobiles using the after-market parts listed in the identification of goods.

One learns that the automatic transmission for an automobile, as originally designed and shipped from the factory, is set up to shift smoothly from one gear to the next. ... .

By eliminating excessive overlap, applicant's kit provides for a quicker shift while reducing damaging heat. The biggest concern for high performance transmissions is building up too much heat in the transmission fluid, which can considerably reduce the life of a transmission. This invention is designed to change the pre-existing hydraulic circuits by modifying the flow of transmission fluid... .

(Transgo I, pp. 24 - 27).

Hence, we see that, as contrasted with the shift correction packages described earlier, these performance enhancement kits are designed not just to fix inherent shortcomings of the stock transmission, but are actually designed to convert the transmission in more fundamental ways. The ultimate goal is to realize a performance upgrade - to improve the design of the transmission in a way that will result in significantly changed performance

by the automobile in heavy duty, racing and other high performance situations.<sup>10</sup>

On page 2 of Transgo's 2001 catalog, Hal Lee finds the appropriate "Reprogramming Kit" for the stock transmission in his 1994 Mustang:

<b>Kit #</b>	<b>Application</b>	<b>Features</b>
<b>AODE-HD2 (4R70W)</b>	<i>AODE 1991-2001</i>	Short, firm, full throttle shifts that have "class", performance and durability. Back shifts to any gear at your command. Holds the gear you select to any rpm. Includes EPC bypass to prevent parts breakage.

As touted in applicant's advertisements, catalogs and other literature of record, installation of this kit will create a noticeably more aggressive feel for Hal Lee's pony. He can then treat his automatic transmission as if it were a manual transmission absent the need for a clutch pedal (i.e., he can shift through five gears simply by moving the shifter on his console). Even if he should choose merely to put the car in "Drive," so that the gears

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<sup>10</sup> The pictures of the high performance kits on the front of applicant's 2000 and 2001 catalogs show a much larger, dark blue box (the type of box from which the specimens of record are cut) than those shown containing the simpler shift correction kits (i.e., applicant's valve body kits/shift kits in the much smaller, robin's egg blue boxes). For the same type of automatic transmission, the high performance kit contains many more "hard" parts, including large separator plates (viz. identification of goods herein), performance bands, frictions, clutches and/or servo assemblies, all used in modifying and significantly strengthening the transmission.

Applicant's large, dark blue TRANSGO® Reprogramming Kit boxes show outline designs of eight vehicles, titled "competition," "service vehicle," "police," "taxi," "muscle cars," "towing," "campers," and "rough duty."

will be automatically shifted (with acceleration and deceleration), the modified automatic transmission will feel as if a high performance driver is physically shifting a manual, five-speed transmission.

Applicant's president has declared that to the best of his knowledge and belief, "none of Applicant's competitors use the term 'REPROGRAMMING KIT' to describe competitive goods which are the same or substantially similar to the goods identified in the pending trademark application."<sup>11</sup> (Gil W. Younger declaration of August 29, 1996, p. 3).

It is against this backdrop that we consider the evidence placed into this record by the Trademark Examining Attorney - most of it drawn from three Internet searches.

According to the Internet evidence of record, applicant's competitors produce "valve body reprogramming kits" that differ as to the complexity of their installation (i.e., by novice or by transmission expert) and the resulting level of performance ("first stage" or "second stage"). Unlike applicant's approach (as shown

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<sup>11</sup> While this declaration seems to imply that competitors' products that are the same or substantially similar to the "goods identified in the pending trademark application" consist of transmission performance enhancement kits, applicant's identification of goods herein is not limited to kits of a particular type, but is broad enough to include all types of kits - those for fixing shortcomings as well as those designed for enhancing automotive performance.

consistently throughout this record), some vendors of valve body reprogramming kits target their webpage marketing directly to the shade tree mechanic. This is the consumer who wants his automatic transmission to perform well under the stress of heavy-duty usage (e.g., towing a heavy load, impressive acceleration off the light, etc.).<sup>12</sup> These "first stage" kits go well beyond correcting noticeable design defects. When installed, these components actually recalibrate the transmission for higher performance than is available with a stock transmission, although these first stage valve body reprogramming kits do not purport to be capable of handling the stresses of competitive racing:



**Modify Control System** – It is desirable to increase clutch apply pressure, furnish more complete converter front oil exhaust (for improved holding ability), and provide full time converter feed to prevent clutch drag/glazing. We at Transmission Connection recommend that you install a valve body reprogramming kit. These products install very easily, and safely achieves (sic) the converter control system modifications recalibration that are (sic) so beneficial.

<http://www.atra-gears.com/tcra/e4od.html>

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<sup>12</sup> By contrast, as noted earlier, each of applicant's catalogs and packaging boxes emphasize that applicant's products are "For the Professional Transmission Mechanic."

**Transmission Kits  
Valve Body Reprogramming Kit**



Hughes Performance recommends this kit for the person who wants a little 'snap' in their street machine. This kit was not designed for full competition, but it will give you a positive competitive feel on the street. Easy to install and comes complete with instructions and all parts and gaskets necessary to get you on the road to your first stage in performance. Works great for street, towing, and off road applications.

<http://www.hughesperformance.com/perfkits/index.html>

This text tracks very closely the benefits that applicant claims for its "Reprogramming Kits." Moreover, the Hughes kit pictured above contains an array of parts similar to the kit shown on the picture of applicant's "reprogramming kit." Below, we compare the Hughes kit and the photo on the front of applicant's 2000 catalog.



**Hughes Performance  
Valve Body Reprogramming Kit**



**Transgo  
High Performance Reprogramming Kit**

If Hal Lee were to locate all the same "hits" from his Internet search as did the Trademark Examining Attorney

herein, he would learn that some vendors sell the entire transmission as a unit, rebuilt for heavy-duty applications, as shown in the following example:

## **Racing Transmissions by The Tranny Doctor**

<b>Customized/Heavy Duty</b>		These transmissions are for everyday use. Each unit comes with a reprogramming kit, heavy duty clutches and bands. All new internal soft parts and a chrome pan with drain plug and brass filter
P/G	529.00	
TH-350	559.00	
TH-400	599.00	
C-4	559.00	
C-6	599.00	
Chy 727	559.00	
700R4	889.00	
AOD <sup>13</sup>	889.00	

<http://www.trannydr.qpg.com/index.html>

Should Hal Lee decide he wants to begin racing competitively, he would also find, within the Trademark Examining Attorney's Internet "hits," transmission kits designed for even higher performance uses than stage one modification kits:<sup>14</sup>

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<sup>13</sup> This example does not have the AODE, which unlike the older AOD listed by Tranny Doctor, has electronic controls (indicated by the terminal letter "E").

<sup>14</sup> The record shows that these kits are described as "Stage Two" kits, "high end" kits, or kits for "full competition," etc. They are designed for use with police cars, autos for drag racing, etc.

While the components in one vendor's kit may vary from those of another vendor, these kits are the most complex kits available for reprogramming an automatic transmission, and often involve making programming changes by drilling holes in separator



TRANSMISSION PRODUCTS

## The 4L60 3-4 Clutch Pack

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8. For police and high rpm applications, 1) a top end reprogramming kit is recommended. 2) Art Carr has a pump slide spring to prevent loss of oil volume at high rpm's. 3) also, an exhaust hole can be drilled in the aluminum bell so 3-4 oil does not drag the clutches thru centrifugal forces...

<http://www.raybestosclutch.com/Info/3-4clutch.html>

## *Art Carr* Performance Products

OEM automatic transmissions are more closely matched to their use through valves and varying clutch capacity, with the intent to provide an inoffensive "softer" shift. This soft shift is achieved through a certain degree of "slippage," which can lead to overheating, a measurable loss of efficiency and a premature transmission failure... To create a transmission that is better suited to meet the needs of our customer, Art Carr offers everything from completely rebuilt transmissions to various component kits. Our valve body and reprogramming kits offer more positive shifting, performance oriented automatic shift points and full manual control when desired... You can also make a significant improvement in the performance and reliability by incorporating such Art Carr products as a deep-finned aluminum transmission pan and a valve body "reprogramming kit". Art Carr overhaul kits give you all the gaskets, seals, bushings, metal sealing rings, clutch friction plates and steels, needed to assemble a heavy duty street/strip transmission...

<http://www.artcarr.com/>

In the event that Hal Lee wants to prepare his car for drag racing, he could buy a rebuilt automatic transmission as a unit, having already had a high-end performance "reprogramming kit" included:

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plates, etc., as is the case with applicant's "Reprogramming Kits."

## Racing Transmissions by The Tranny Doctor

Street Fighter/Street Strip		The street fighter/streep (sic) strip transmission is for vehicles that are powered by engines producing 475 horsepower without superchargers.  All units come with a 12,000 GVW transmission cooler, an inline filter, and a reprogramming kit. Both automatic and manual mode, where applicable...
P/G	629.00	
TH-350	759.00	
TH-400	810.00	
C-4	759.00	
C-6	810.00	
Chy 727	759.00	
700R4	1199.00	
AOD	1199.00	

[http://www.trannydr.qpg.com/RACING\\_8716.html](http://www.trannydr.qpg.com/RACING_8716.html)

In some of the third-party excerpts placed in the record by the Trademark Examining Attorney, it is not clear whether the kit is designed for heavy duty/stage one performance, more extreme stage two performance, or is programmable for either stage at the time of installation, as are applicant's kits:



### Performance Transmissions

Item #	Description	Price
4510	VALVE BODY REPROGRAMMING KIT	\$70.00

[http://www.transmission-specialties.com/performance\\_transmissions/gm\\_200\\_4R.html](http://www.transmission-specialties.com/performance_transmissions/gm_200_4R.html)

In spite of this evidence showing third-party usage of the term "reprogramming kit" in a generic manner as applied to packages of transmission parts for modifying an

automatic transmission, applicant dismissed the value of these Internet excerpts. First, applicant variously characterizes the Internet evidence as *de minimis* and ambiguous. Also, applicant argues that the Trademark Examining Attorney has failed to show "the exposure of the website(s) to the relevant consuming public ... ."

We disagree with this conclusion. In response to our criticism of the record in Transgo I, the Trademark Examining Attorney herein has shown critical third-party usage on the Internet. Repeated usage of the term "reprogramming kit" in a generic fashion by applicant's competitors to promote their shift modification kits does reflect consumers' likely understanding when encountering that term. As to applicant's argument that the Trademark Examining Attorney has failed to document the level of public exposure to this use by competitors on the Internet, this type of showing has not been required for similar indications drawn from trade journals, dictionaries, newspapers, etc. Regardless of the level of exposure received by the Internet webpages, we find that these websites reflect current public understandings and are likely to continue to influence relevant consumer perceptions in the future. While applicant has tried to avoid a conclusion of genericness by splitting hairs (viz.

text surrounding footnotes 11 and 19), applicant has not argued herein that these competitors are misusing its alleged trademark. Cf. E. I. du Pont de Nemours & Co. v. Hoshida International, Inc., 393 F.Supp. 502, 185 USPQ 597 (E.D.N.Y. 1975).

Moreover, applicant argues, in effect, that there is only one generic name for its "Reprogramming Kits," and that the term 'valve body kit' is the proper generic expression" for its "Reprogramming Kits." (Applicant's appeal brief, p. 6). Yet as seen in applicant's own catalogs, the term "valve body kits" is used by applicant to identify shift correction kits and does not appear at all in the sections on "High Performance Reprogramming Kits." In fact, the evidence of record (drawn primarily from applicant's parts catalogs) demonstrates that applicant uses these two terms in a mutually exclusive manner.<sup>15</sup> Moreover, even if applicant were using the lexicon as carefully as it claims, this would not change

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<sup>15</sup> This gets confusing because most of the fixes (discussed earlier) as well as the modification, recalibration, or reprogramming of older (non-electronic) automatic transmissions take place in the valve body of the transmission. Moreover, even a cursory review of applicant's rather broad identification of goods herein shows that in crafting its various identifications of goods in trademark applications prosecuted over the years, applicant has made no distinction between kits designed to function as mere "fixes" and those designed for performance enhancement.

the fact that applicant's competitors use the same terminology for a variety of automatic transmission kits, all of which are contained within the broad identification of goods as listed in Transgo's instant application.

Some of the other Internet examples placed in the record by the Trademark Examining Attorney (and not reproduced above) are in the form of Internet postings from do-it-yourself mechanics that refer in detail to their experience with transmission "reprogramming kits." (See <http://www.d-p-g.com/corvette/CurrentIssue/eC.htm> attached to the Trademark Examining Attorney's final refusal). While we may view this as an Internet analogue to a trade journal, applicant dismisses this kind of usage as without foundation, and as suffering from all the alleged defects noted above in the websites of applicant's competitors.

It is clear that for any given automobile transmission, there is no limit to the permutations of component parts that a vendor might include in a single kit or package. Certainly, some modification packages, like applicant's, involve novel approaches receiving temporary, proprietary protection under our nation's patent law system. Nonetheless, for purposes of deciding the genericness of the term "reprogramming kit" for applicant's goods as identified, we have focused on any kits that

fundamentally modify automatic transmissions, since all such kits would fall within the relatively broad scope of applicant's identification of goods herein. When the goal is to redesign the basic operation of the transmission, the generic name of the kit usually includes a word like "modification," "recalibration," or "reprogramming."

Applicant argues that the use of an expression like "valve body reprogramming kit" or "shift reprogramming kit" is of no avail in demonstrating the genericness of the term "reprogramming kit" when used alone. In response to this creative argument, the Trademark Examining Attorney argues correctly that:

Whether the goods are called "VALVE BODY REPROGRAMMING KITS," "SHIFT REPROGRAMMING KITS," or "REPROGRAMMING KITS," the one constant is the generic wording "REPROGRAMMING KITS."

(Trademark Examining Attorney's appeal brief, p. 6).

As noted by Professor McCarthy:

There is usually no one, single and exclusive generic name for a product. Any product may have many generic designations. Any one of those is incapable of trademark significance...

In one case the proponent of trademark status for the word "Mart" argued that the word is quaint and not generally used. But the court replied that the test is not whether a term is more frequently used colloquially than its synonyms (such as "store" or "market"), but whether it still retains its generic meaning. "Mart" was held to have no other meaning among the consuming public than as a synonym for "store" or "market" and hence was generic. [Footnote omitted] Similarly another court said that the

fact that there are other generic names than "Super Glue," such as "Instant Glue" or "Ten Second Glue," does not preclude generic status: "[T]he existence of synonyms for a term does not mean the term is not generic. There may be more than one term which the consuming public understands as designating a category of goods." [footnote omitted]. Thus, while prerecorded audio tape cassettes of books may be generically called "audio books," "talking books," "book cassettes," "cassette books," or "taped books," the designation "recorded books" was held to be a generic name by the Trademark Board, noting that a product can have more than one generic name. [footnote omitted]

In another example, the Fourth Circuit found that "ale house" was a generic name and one of several generic names for places that serve beer, with or without food. "[Plaintiff] has no protectable interest in the words 'ale house.' They are generic words for a facility that serves beer and ale, with or without food, just as are other similar terms such as 'bar,' 'lounge,' 'pub,' 'saloon,' or 'tavern.' All serve alcohol alone or both food and alcohol." [footnote omitted]

While the Lanham Act uses the singular article "the," referring to "the generic name," the author does not believe that this is the result of any considered judgment by Congress and should not be read as changing the rule of the case law that there can be more than one generic name of a thing. [footnote omitted]

2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition §12:9 (4<sup>th</sup> ed. July 2002).

Under the Trademark Act, the fact that applicant's identified kits may be called by a variety of different names does not preclude any one of those terms from being a generic name for the applicant's goods. While we have acknowledged a degree of inconsistency in terminology in this field, it must be clear that muddled naming practices are neither a basis in logic nor in trademark law for the conclusion that one of the terms used rather broadly by

one's competitors as a generic designation for a particular genus of products can nonetheless be removed from the language and serve as a proprietary source indicator for a single vendor of those very goods.

As noted throughout this opinion, applicant's own usage corroborates the conclusions to be drawn from the third-party usage found on the Internet by the Trademark Examining Attorney. The prior panel noted that " ... many of [applicant's] uses of REPROGRAMMING KIT would be frowned on by a trademark attorney..." (Transgo I, p. 13). Proper usage of a source indicator is important in any setting, but especially so when many prospective customers are already prone to see the claimed trademark as a generic designation among competitors. In reviewing this entire record, nowhere has applicant ever used its alleged trademark as an adjective modifying a noun. Specifically, while applicant uses "a Reprogramming Kit" or "Reprogramming Kits" (the noun form, and often pluralized), applicant has never employed the formulation "Reprogramming Kit(s) valve body kits," or any other similar combination. Moreover, this hypothetical formulation uses the word "kit" in a redundant fashion, and as noted earlier, would seem to contradict the logic and layout of applicant's entire parts catalogs.

Accordingly, based on the totality of the instant record, we find that the term "Reprogramming Kit" is a generic designation for applicant's listed goods.

**II. Alternative Refusal: Inadequate showing of Acquired Distinctiveness under Section 2(f)**

Should our decision on the question of genericness be reversed on appeal, in the interest of judicial economy, we now consider at length the evidence of acquired distinctiveness placed into the record by applicant.

Applicant has resubmitted the same three declarations of its customers that were part of the application record before the Board in Transgo I, the earlier *ex parte* appeal. The Board panel that decided that appeal found these declarations to be "unpersuasive." Similarly, even though applicant claims that these three statements are merely representative of a larger population of potential declarants, in light of all the countervailing evidence in this record, three now-dated (from 1996), form declarations from customers do not appear significant.

In regard to the current record, this application contains a third and more extensive declaration of Mr. Gil Younger, applicant's president, dated April 12, 2000:

3). As of December 31, 1999, the trademark "REPROGRAMMING KIT" has been used continuously in commerce in the United States for nearly thirty (30) consecutive years, and in excess of 875,000 number of

units of goods (kits) have been sold under the trademark "REPROGRAMMING KIT" generating gross revenues of in excess of \$19,000,000;

4). Attached as Exhibits C and D respectively, are true copies of Applicant's product catalogs for the years 2000 and 1999. Each of these catalogs prominently displays Applicant's goods marketed under the "REPROGRAMMING KIT" trademark. Applicant's catalogs are distributed annually as follows:

a). Between 10 - 25 catalogs are automatically sent by Applicant to each of its distributors. Applicant currently has over 130 distributors for the goods it markets under the "REPROGRAMMING KIT" trademark.

b). Between 2500 - 4000 catalogs are distributed at trade shows at which Applicant exhibits its products, as will be discussed below;

c). A current catalog is distributed to each attendee at each seminar at which Applicant's products are discussed, as will be discussed below; and

d). Catalogs are mailed on an ongoing basis in response to consumer requests generated by advertisements of Applicant published in trade journals, as will be discussed below;

5). Valve body kits marketed by Applicant under the "REPROGRAMMING KIT" trademark are advertised primarily in two trade journals - Gears and Transmission Digest. Attached as Exhibits E and F are true copies of sample advertisements of Applicant's for goods marketed under the trademark "REPROGRAMMING KIT" which have appeared in these two trade publications. Each of these publications is distributed primarily to the automotive transmission trade including transmission repair shops, transmission rebuilders, transmission warehouse and parts facilities, and retail speed and performance sales outlet[s]. Upon information and belief, the Gears trade publication is distributed throughout the United States and has a monthly circulation of about 25,000, and the Transmission Digest trade publication is distributed both throughout the United States and internationally, and has a monthly circulation of about 25,000.

6). Applicant's goods, including the goods which Applicant markets under its "REPROGRAMMING KIT" trademark, are shown at seminars throughout the United States attended primarily by transmission repair mechanics and automatic transmission rebuilders for the purpose of furthering their education with regard to the technical aspects of the transmission industry including new automotive transmissions and related products. Between the years 1995 - 1999, Applicant's

goods marketed under the "REPROGRAMMING KIT" trademark were shown at over 350 different seminars attended by over 30,000 people conducted throughout the United States including the following cities: Seattle, WA; Wichita, KS; Phoenix, AZ; Portland, OR; Pittsburgh, PA; Charlotte, NC; Nashville, TN; St. Louis, MO; Denver, CO; Manchester, NH; Dallas, TX; Sarasota, FL; Salt Lake City, UT; Mobile, AL; Bloomington, MN; Atlanta, GA; Jericho, NY, et al. As noted above, each attendee at each seminar is provided with a current catalog of Applicant featuring Applicant's goods marketed under the "REPROGRAMMING KIT" trademark (See Exhibits C and D attached hereto);

7). Applicant currently exhibits its products, including the goods it markets under the "REPROGRAMMING KIT" trademark, at two national trade shows annually. Each show has between 250 - 400 exhibitors, and between 5000 - 7500 attendees. The attendees are primarily individuals employed in the automotive transmission trade including owners and employees of transmission repair and rebuilding shops, transmission parts warehouses and distributors, buyers for distributors and warehouse facilities, and jobbers. At each trade show it attends, Applicant demonstrates and describes its product line, including the goods marketed under the "REPROGRAMMING KIT" trademark, to interested trade show attendees. Applicant also distributes between 2500 - 4000 of its current product catalogs at each trade show at which it exhibits its products;

8). Applicant provides its distributors with product releases on a regular ongoing basis to update its distributors with information regarding new product models being marketed by Applicant. Attached hereto as Exhibit G are samples of product releases from Applicant to its distributors describing new product models marketed by Applicant under the "REPROGRAMMING KIT" trademark.

...

10). In view of the extensive sales of goods in commerce by Applicant under the "REPROGRAMMING KIT" trademark for nearly thirty continuous years, and in further view of the wide exposure of the term "REPROGRAMMING KIT" as Applicant's trademark through advertising, seminars, product releases, and national trade shows attended by Applicant, the term "REPROGRAMMING KIT" is recognized as Applicant's trademark throughout the United States by the relevant consuming public, trade and industry.

As noted earlier in this decision, the record contains copies of applicant's product listings (or catalogs) from 1999, 2000 and 2001. Although nowhere does applicant provide a clear bottom-line number of parts catalogs distributed during each of these years, the above declaration makes it clear that applicant is diligent in getting thousands of its parts catalogs distributed to those individuals most likely to be interested in purchasing its transmission repair and modification kits. In addition to thirty years of Transgo's marketing these kits, the enumerated efforts of recent years demonstrate applicant's continued presence in the marketplace. For example, in comparing Gil Younger's declarations of July 1998 and early 2000, it appears as if applicant has sold an average of three-thousand such kits per month between July 1998 and January 2000, each of which generated around \$21 in gross revenue for applicant.

Nonetheless, as noted in the discussion above, the catalogs use the term "Reprogramming Kit" as the name of a thing, not as a source indicator. The ads appearing in Gear and Transmission Digest use the term "Reprogramming Kit(s)" as the name of the item, failing to provide an alternative generic designation anywhere. The advertising copy in the Gear ad says, "Transgo Reprogramming Kits™"

extend the life of the friction materials... ." However, as was noted in Transgo I, the use of initial capital letters and/or the mere placement of an informal trademark notification symbol (™) cannot salvage an otherwise generic term. Moreover, in the absence of an alternative name for the goods, the way in which applicant pluralizes its alleged trademark (in the Gear ad, in the 2001 catalog, etc.) reinforces the conclusion that this two-word designation functions solely as the name of the goods.

As our reviewing court noted in Yamaha International Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988), "the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning." See also, Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); and *Restatement (Third) of Unfair Competition* (1993), Section 13, comment e.<sup>16</sup>

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<sup>16</sup> "The sufficiency of the evidence offered to prove secondary meaning should be evaluated in light of the nature of the designation. Highly descriptive terms, for example, are less likely to be perceived as trademarks and more likely to be useful to competing sellers than are less descriptive terms. More substantial evidence of secondary meaning thus will ordinarily be required to establish their distinctiveness. Indeed, some designations may be incapable of acquiring distinctiveness."

Accordingly, the quantity of evidence put forward by applicant might very well propel some types of marks onto the Principal Register with the benefit of Section 2(f) of the Lanham Act, but does not aid applicant herein.

In this case we have a term that is, at the very least, highly descriptive when used in connection with the identified goods. Thus, we conclude that more evidence than that which has been offered herein is necessary to establish the acquired distinctiveness of this highly descriptive, if not generic, designation.

The most recent declaration of applicant's president focuses primarily on the distribution of applicant's parts catalogs. As noted earlier, applicant's catalogs are basically terse parts listings of only a dozen pages or so, done in black and white without any images.<sup>17</sup> Moreover, as we have seen, within these pages, "Reprogramming Kit" is always used in a generic fashion, so all of the reported catalog exposure to applicant's products and asserted trademark(s) will not help potential customers to recognize this term as a source indicator.

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<sup>17</sup> As reflected earlier in this opinion, the front and back covers are made of colored, glossy paper and do contain photographic images of the product and packaging.

Nowhere has applicant listed the total dollar volume of its advertising expenditures. On this record, we have no basis on which to presume more than modest expenditures. Furthermore, even an annual, bottom-line figure of marketing expenditures would be meaningless unless we had examples of advertisements promoting "Reprogramming Kit" as a source indicator. The current record contains no information linking applicant's evidence "with use in contexts which would condition customers to react to or recognize the designation ... as an indication of source..." In re Leatherman Tool Group, Inc., 32 USPQ2d 1443, 1450 (TTAB 1994).

**Decision:** The refusals to register herein are affirmed: (1) We find that the term "Reprogramming Kit" is generic for applicant's identified goods; and (2) We find that even if applicant's designation REPROGRAMMING KIT is found not to be generic for applicant's kits, applicant has failed to demonstrate a sufficient level of acquired distinctiveness for such a highly descriptive term to function as a source indicator.