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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Network Associates Technology, Inc.

Serial No. 76426050

Sandra Edelman of Dorsey & Whitney LLP for Network Associates Technology, Inc.

M. Catherine Faint, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Quinn, Hairston, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On June 28, 2002, Network Associates Technology, Inc. (applicant) applied to register the mark VIRUSSCAN, in typed form, on the Principal Register under the provision of Section 2(f) of the Trademark Act (15 U.S.C. § 1052(f) for goods in International Class 9 identified as:

> computer utility software; computer software for protecting and securing the integrity of data, computer software, and computer and communications

networks; computer software for identifying and correcting faults and errors in the operation of computer software and over computer and communications networks.

The application (Serial No. 76426050) alleged dates of first use anywhere and in commerce of December 16, 1993. Furthermore, the application claimed ownership of Registration No. 1,936,202 for the same mark on the Supplemental Register (issued November 14, 1995) for "computer programs for data integrity and security" in International Class 9.

The examining attorney refused registration on the ground that the mark was generic. In response, applicant argued that its mark was not generic and it submitted additional evidence that the mark had acquired distinctiveness under Section 2(f). After the examining attorney made the refusal final, applicant filed a request for reconsideration that was denied and this appeal followed.[1]

While the examining attorney has discussed applicant's evidence of acquired distinctiveness, the examining attorney (brief, ninth page) ultimately "asserts VIRUSSCAN cannot be registered due to its generic nature, therefore acquired distinctiveness is irrelevant." See also Brief,

[1] An oral hearing was held on November 17, 2004.

eighth page ("the term 'virus scan' is so highly descriptive for computer software for protecting data that it is not capable of acquiring sufficient secondary meaning in the minds of the purchasing public").

Evidence

Both applicant and the examining attorney have presented significant evidence in support of their positions. The following summary highlights the evidence of record. The examining attorney's evidence consisted of numerous printouts from the LEXIS/NEXIS database.

> Because your system is doing so many strange things not easily attributable to Winzip, download the latest virus definitions for your computer and run a complete **virus scan.**
> *South Bend Tribune*, July 1, 2002.

> IF YOU HAVE BEEN HACKED - What to do. Immediately disconnect the phone or cable jack from the computer. Run a complete **virus scan** on your computer to remove software such as a Trojan Horse, which hackers may have planed.
> *Consumers Reports*, June 2002.

> But unfortunately, GuardDog must not have been totally removed, because it pops up when I reboot or shut down my computer. It also interferes with Norton **virus scans.**
> *St. Paul Pioneer Press*, April 1, 2002.

> Many applications on a computer, such as third-party **virus-scan** software, create comprehensive logs when they are used.
> *ASAP*, March 1, 2002.

> Here are some steps you can follow to create a clutter-free computer. Perform a **virus scan.** With the likelihood that at least one person in your family

regularly downloads information from the Internet or exchanges e-mail with attachments, it's important to check for viruses regularly.
San Diego Union-Tribune, June 27, 2001.

If you set your **virus scan** software to constantly scan your computer for viruses, you may have unknowingly have set the program to automatically scan the floppy drive, too, at regular intervals.
Des Moines Register, March 27, 2001.

As far as I'm concerned, electronic drives and disks are as good as the latest computer **virus scan** program, but a folder full of paper is forever.
Denver Rocky Mountain News, January 16, 2000.

The new technology is deceptively simple. During normal on demand **virus scans**, the software actively scans all processes running in memory and identifies any malicious processes.
eWeek, March 3, 2003.

However, a wireless device with e-mail software certainly could retrieve dangerous attachments, then sync those attachments back to the desktop, providing a back door for malicious code to enter the enterprise. PDA **virus scan** software is available from the usual suspects: Norton, McAfee and Trend Micro, to name a few.
Wireless Week, June 3, 2002.

The security management products do not claim to give users the security they'd get from using a firewall, **virus scanning** software or IDS.
Network World, March 18, 2002.

The only problem we encountered was that the Java-based interface tended to conflict with active **virus-scanning** software. It's best to disable **virus scanning** while using the management functions.
Government Computer News, March 4, 2002.

The best way to defend against viruses is to use a **virus scanner.** Unfortunately, viruses mutate quickly. For this reason, all popular **virus scanning** software comes with an update service.
Broadcast Engineering, July 2001.

> I ran a full scan using Norton and found no virus. Then, I used three free online **virus scans** and two declared the computer clean and one found and deleted a virus that was not even listed by Norton.
> *Sacramento Bee*, March 20, 2003.

> A full anti-**virus scan** should be done weekly, and then anti-virus software should scan all inbound and outbound e-mail.
> *San Diego Union-Tribune*, February 17, 2003.

> Tip: Configure your antivirus software to update virus definitions and run **virus scans** automatically.
> *Computer Shopper*, May 1, 2003.

The examining attorney also included a definition from TechWeb, the Business Technology Network, (TechEncyclopedia) that defined a "virus scanner" as "an antivirus program that searches for binary signatures (patterns) of known viruses that have attached themselves to executable programs." Another Internet record defines a "virus scan" as "a program which a PC user will invoke in order to check that their PC contains no known viruses." See www.users.bigpond.com. In addition, the examining attorney submitted definitions of the individual terms, "virus" ("a computer virus") and "scan" ("to search (stored data) automatically for specific data"). *The American Dictionary of the English Language* (1992).

Applicant, on the other hand, has submitted the following evidence that its mark is not generic and that it has acquired distinctiveness: numerous registrations

containing the word "scan," normally spelled as one word or with a hyphen; a declaration that proved sales figures (in millions: 1999 - $89.7; 2000 - $76.1; 2001 - $81.2); advertising figures (in millions: approximately $2.5 in 2002 and estimated $1.95 in 2003) and that more than 40,000 companies use VIRUSSCAN software products.[2] Another declarant indicated that VIRUSSCAN software sales in the retail market averaged approximately 1,000,000 units between 1999 to 2002;[3] and "there are approximately two million active subscribers to the company's online software subscription services. The overwhelming majority of these two million customers use the company's 'VirusScan Online' service to monitor and protect their computers and networks."[4] Regarding its websites (www.mcafee.com and www.mcafee-at-home.com), applicant's declarant (Doug Cavit) indicated that in January of 2003, approximately 20 million unique visitors accounted for 610 million page views and "the vast majority of these visitors to these web sites are exposed to VIRUSSCAN products or services as well as prominent display of the VIRUSSCAN brand."

Applicant also submitted evidence that it is unaware that any of "its competitors use the term 'VIRUSSCAN' to

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[2] Declaration of Ryan McGee.
[3] Declaration of Lisa Citron.

identify the brand or generic names of their products." McGee II declaration at 3. Applicant's evidence included examples of how anti-virus software is marketed, advertised, and displayed without using the term VIRUSSCAN except as a trademark of applicant. Furthermore, applicant also argues that, according to its NEXIS search, 96% of the results of its search of the term VIRUSSCAN contained a reference to applicant. See Response dated May 19, 2004 at 6 and Exhibit F.

In addition, applicant submitted excerpts from various online and paper dictionaries to show that the term "virus scan" or its equivalents were not listed. See Response dated May 19, 2003, Ex. G (Bartleby.com, Merriam-Webster's.com, Webopedia.com, Netlingo.com, The Computer Glossary, McGraw-Hill Encyclopedia of Personal Computing, Microsoft Press Computer Dictionary, Official Internet Dictionary, Prentice Hall's Illustrated Dictionary of Computing, and Webster's New World Dictionary of Computer Terms).[5] Applicant maintains that these dictionaries support applicant's argument that "anti-virus" is

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[4] Declaration of Jonathan Wong at 1.

[5] We note that several of applicant's online dictionary entries do not indicate that applicant searched the term "virus scan" along with the terms "virusscan," "virus scanning," or "virus scanner." The absence of evidence that the most relevant term was searched undercuts the persuasiveness of the online definitions.

recognized as the name of applicant's goods and "virus scan" is not a recognized generic name.

In addition, applicant introduced a survey to demonstrate that the term VIRUSSCAN is not generic for computer software. The survey was addressed to approximately 150 individuals who were responsible for making software purchases for their company and who were involved in making decisions about "the purchase of computer software for protecting network security." Simonson declaration ¶ 13. The survey asked the following relevant questions:

Question 6: "What do you call the type or category of computer software that is designed to protect and secure computer data, software, and computer communications networks?

Question 7: What other name or names, if any, do you use when referring to this type or category of software?[6]

The results of the survey are as follows:

Question 6 results:

Answer	%	# of Responses (out of 110)
Anti-virus software	16.4	18

[6] While applicant maintains (brief at 6) that respondents had three opportunities to identify the generic name in the survey, only two questions (## 6 and 7) asked respondents to provide a generic name. The other question simply asked: "Are you familiar with this product [software designed to protect and secure computer data, software, and computer communications networks]"? Simonson declaration, ¶ 17.

Firewall software	10.0	11
Firewall	22.7	25
Firewall protection	0.9	1
Security	5.5	6
Security software	7.3	8
Norton	4.5	5
Encryption/ Encryption software	1.8	2
Norton Anti Virus/ Virus protection Software	3.6	4
Virus/virus software	2.7	3
Other	20.0	22
Don't know	6.4	7

Question 7 results:

Answer (Italics = new answer)	%	# of Responses (out of 103)
Anti-virus software	16.5	17
Firewall software	3.9	4
Firewall firmware	1.0	1
Router	1.0	1
Firewall	4.9	5
Firewall protection	0.9	1
Security	0	0
Security software	1.0	1

Norton	4.9	5
Encryption/ Encryption software	1.0	1
Norton Anti Virus/ Virus protection Software	1.0	1
Virus/virus software	1.0	1
McAfee	5.8	6
Network security	1.9	2
Network security Software	1.0	1
Zone Alarm	1.9	2
Other	15.5	16
Don't know	49.5	51

Among the other responses were one response for "virus scan" and another response for "virus protection scan." Simonson declaration, ¶ 21. The remaining responses include: Security Firewall, Security Data, Virus and Security Software, Virex, Tape Backup, Citrix, Nortons Personal Firewall and Anti-Virus, Netware, Personal Firewall, Internet Security, Noris, Secure Data, Norton Security Program, Network Security Software or Hardware, Novell, Norton Utilities, Tecom Software, Sonic Wall, and Span [sic] Proof.

Based on this survey, Mr. Simonson (declaration, ¶ 21) concluded that these "results indicate unequivocally that 'VirusScan' is not a generic term."

Arguments

The examining attorney argues (Brief, fourth page) that the term "virus scan software" is "commonly used as an alternative generic form of 'antivirus software.'" In addition, the examining attorney points out (Brief, fifth page) that applicant's "own evidence shows that its software product scans for computer viruses." In addition, the examining attorney (Brief, sixth page) faults applicant's survey because it is "limited to a small, non-random sample of 153 individuals who make software purchasing decisions for their company or organization."

On the other hand, applicant asserts that the examining attorney erred by rejecting applicant's survey and giving insufficient weight to its marketplace evidence. Applicant also points to the evidence that its "principal competitors in the marketplace do not use the word 'SCAN' to identify their anti-virus products." Brief at 2. Finally, applicant claims (Brief at 2-3) that the examining attorney "failed to adhere to the heavy burden imposed upon her to prove that Appellant's mark is generic."

Genericness

The key issue in this case is whether applicant's term VIRUSSCAN is generic for applicant's software. Inasmuch as applicant seeks registration under Section 2(f), there is no issue concerning the descriptiveness of the mark. Yamaha Int'l Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) ("Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact").

The Court of Appeals for the Federal Circuit has held that: "The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question." H. Marvin Ginn Corp. v. Int'l Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Marvin Ginn goes on to explain that:

> Determining whether a mark is generic therefore involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?
>
> Id.

In this case, the examining attorney has presented significant evidence showing the generic use of the term "virus scan" for anti-virus software. The following examples indicate that at least some members of the purchasing public use the term generically: "third-party virus-scan software"; "perform a virus scan"; and "set your virus scan software." Certainly, the examining attorney has met her initial burden of creating a prima facie case that the term VIRUSSCAN is generic.

However, the next question is whether applicant has rebutted this prima facie case of genericness. Applicant has submitted significant evidence of its sales and advertising and its competitors' business practices. This evidence shows the extensive marketing of applicant's VIRUSSCAN products. It has nearly 2,000,000 subscribers to its VIRUSSCAN online software subscription services, approximately 40,000 business customers, more than $75 million dollars in sales annually, approximately $2 million in advertising annually, and more than 20,000,000 unique visitors in one month to its websites featuring VIRUSSCAN products. Applicant has also submitted evidence that 96% of the results of its search of the term VIRUSSCAN contained a reference to applicant. See Response dated May 19, 2004 at 6 and Exhibit F.

In addition, applicant submitted evidence in the form of a survey. According to applicant's survey results, virtually no one in the survey identified "virus scan" as a generic term for applicant's software. These results lead applicant's survey expert to conclude that applicant's term is not generic. At first glance, applicant's survey results appear very impressive. Of 110 respondents to survey questions six and seven, only one responded that the term "virus scan" was a name for the software and another responded that "virus protection scan" was the generic name of the goods. On its face, these results of the survey would strongly support applicant's argument that its mark was not generic.

However, upon closer analysis, the results are less impressive. Applicant's survey asked "What do you call the type or category of computer software that is designed to protect and secure computer data, software, and computer communications networks." The largest response (37 of 110) to the initial question identified "firewall," "firewall software" or "firewall protection" as the generic name of the software. Another 14 responses identified "security" and "security protection" as the generic name, while 22 identified other names. The largest number of responses identified a generic term for a different type of computer

protection product, i.e. a firewall, in response to applicant's survey question No. 6.[7] Applicant's survey questions are more like a guessing game. The questions provide just enough information so that participants can guess about applicant's product but not enough information to understand what the specific product is. Applicant's survey would be similar to asking prospective purchasers: "What do you drive that has four wheels and a motor?" While it is likely that the vast majority of responses would be "car," "truck," and "motor vehicle," it would hardly demonstrate that unmentioned terms such as "SUV," "subcompact," or "sedan" were not generic terms also. Therefore, we certainly cannot agree with applicant's declarant who claims that the survey results "indicate unequivocally" that applicant's term is not generic. A survey that establishes a generic name for a product not at issue (firewall) is not very relevant.[8]

While we have reason to question the persuasiveness of the survey, we must give it some weight. At this point, we

[7] Even when the answers to question No. 7 are considered, firewall-related responses remain the largest response.
[8] The issue in this case is whether VIRUSSCAN is generic for software that protects against computer viruses, not for all computer software. In re CyberFinancial.Net Inc., 65 USP

note that at its bare minimum more than 100 people with some familiarity with business software were asked twice to provide the name of computer software that is designed to protect and secure computer data. Virtually no respondent identified "virus scan" as the name of the software. Marvin Ginn requires us to determine if the term sought to be registered is understood by the relevant public primarily to refer to that genus of goods.

Under the applicable case law, the examining attorney's burden to establish genericness is not an easy one. Undoubtedly, the examining attorney has submitted significant evidence of generic use. However, applicant has responded with evidence that would lead one to believe that the term VIRUSSCAN is not generic. This evidence includes a "survey" in which virtually no one identified "virus scan" as the name of the goods, the lack of evidence of use of the term by competitors and retailers, the absence of the term from the many general and technical dictionaries of record, the high percentage of use of the term in association with applicant in articles, and applicant's extensive and long use of the term. Ultimately, if we are to find that a term is generic, we must conclude that the evidence clearly shows that the term is understood by the relevant public primarily to refer to

that genus of the goods. Based on the present record, which is extensive, but nonetheless a limited ex parte record, we are unable to conclude that the evidence clearly shows that applicant's mark is generic. In re Merrill Lynch, Pierce, Fenner and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987) ("The mixture of usages unearthed by the NEXIS computerized retrieval service does not show, by clear evidence, that the financial community views and uses the term CASH MANAGEMENT ACCOUNT as a generic, common descriptive term for the brokerage services to which Merrill Lynch first applied the term") (footnote omitted).

Having concluded that the record, when considered n light of the Federal Circuit's decisions on genericness, requires us to find that applicant's mark is not generic, we must consider whether applicant has demonstrated that its mark has acquired distinctiveness under the provision of Section 2(f). Applicant has the burden of proving that its mark has acquired distinctiveness. In re Hollywood Brands, Inc., 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954)("[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant"). "[L]ogically that standard becomes more difficult as the mark's descriptiveness increases." Yamaha

Int'l Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988).

In this case, we find that if applicant's mark is not generic, applicant's evidence shows that its mark has acquired distinctiveness. We note that applicant's sales for its VIRUSSCAN products are approximately $100 million dollars a year with several million dollars in advertising. Applicant's VIRUSSCAN products protect millions of computers, more than 2 million users subscribe to its online anti-virus products, and more than 20 million unique viewers visit its website where its VIRUSSCAN products are featured. The examining attorney primarily argues (Brief, ninth page) that the mark "cannot be registered due to its generic nature, therefore acquired distinctiveness is irrelevant." Inasmuch as we have concluded that applicant's mark is not generic, evidence of acquired distinctiveness is relevant. We are persuaded that this evidence is sufficient to show that applicant's mark has acquired distinctiveness.

DECISION: The refusal to register applicant's mark VIRUSSCAN on the ground that the mark is generic is reversed.