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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Arcat, Inc.

Serial No. 76458198

Gene S. Winter of St.Onge Steward Johnson & Reens LLC for
Arcat, Inc.

Kathleen M. Vanston, Trademark Examining Attorney, Law
Office 103 (Michael Hamilton, Managing Attorney).

Before Simms, Seeherman and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On October 15, 2002, Arcat, Inc. (a Connecticut corporation) filed an application, based on Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), to register the mark SPECWIZARD on the Principal Register for services amended to read "application service provider featuring software for use in creating specifications for builders and architects" in International Class 42. Applicant's claimed

date of first use and first use in commerce is June 25, 2002.

The Examining Attorney refused registration on the ground that the term SPECWIZARD, when used in connection with the identified services of applicant, is merely descriptive of those services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

When the refusal was made final, applicant appealed to the Board. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

Preliminarily we address an evidentiary matter. As part of applicant's combined request for reconsideration and appeal brief on the case¹ it submitted additional evidence (consisting of a typed list of the marks and numbers of several third-party applications and/or registrations). The Board forwarded the application to the Examining Attorney. She denied applicant's request for reconsideration and she objected to the typed list as untimely filed with applicant's appeal brief, but she also argued the merits in case the Board considered the typed list. Applicant did not submit a supplemental brief as was

¹ This paper was filed within six months of the issue date of the final refusal, and therefore, it was a request for reconsideration, not a request for remand. See Trademark Rules 2.64(b) and 2.142(d).

allowed by the Board; the Examining Attorney filed her brief; and in applicant's reply brief, it included a slightly different and smaller list of third-party registrations.

While the Examining Attorney is correct that the record should be complete prior to appeal, applicant's initial typed list of third-party applications and registrations was part of applicant's timely filed request for reconsideration. The Examining Attorney's objection is overruled and the initial typed list is considered of record for whatever, if any, probative value it may have.

With regard to the typed list in applicant's reply brief, that is clearly untimely and has not been considered, except to the extent that the information appeared on the original list. See Trademark Rule 2.142(d).²

Turning to the merits of the refusal to register on the basis that the term SPECWIZARD is merely descriptive, the Examining Attorney contends that "spec" refers to "specifications" and "wizard" refers to an interactive help utility in computer software that assists the user in performing a particular task; that in combination the term

² We add that even if the additional listings had been considered, they would not have altered our decision herein.

SPECWIZARD connotes that applicant functions as an application service provider and provides an interactive wizard that assists the user in describing desirable product specifications; and that the term is merely descriptive of a significant attribute of applicant's services.

In support of her position, the Examining Attorney submitted definitions from www.pcwebopaedia.com defining "spec" as "2. short for specification," and "wizard" as "1. a utility within an application that helps you use the application to perform a particular task..." She also submitted a definition from www.linuxguruz.com defining "wizard" as "4. An interactive help utility that guides the user through a potentially complex task, such as configuring a PPP driver to work with a new modem. Wizards are often implemented as a sequence of dialog boxes which the user can move forward and backward through, filling in the details required. ..."

In addition, the Examining Attorney relies on applicant's use of the terms "spec" and "wizard" on its specimens of record (printouts of pages from applicant's website) as well as additional pages from applicant's website. The following are examples of applicant's use of the terms: (i) "Create custom building product

specifications using SpecWizard"; (ii) "Coming Soon: SpecWizard An interactive specification system that writes customized specs based upon answers to specific product/usage questions."; and (iii) "ARCAT Launches SpecWizard an interactive spec writing service containing manufacturer specs."

In further support of her position, the Examining Attorney submitted: (i) copies of several excerpted stories retrieved from the Nexis database showing use of the phrase "specification wizard" in relation to builders/architects; and (ii) printouts of pages from a few third-party websites showing use of applicant's "specwizard" thereon to show that applicant's program is a series of dialog boxes through which the user moves, filling in the user's requirements.

Examples from the Examining Attorney's Nexis database evidence showing use of the phrase "specification wizard" are shown below:

Headline: Fit Ball: F Ball is to extend its factory because of growing demand for its products
...But he hastens to add: "That doesn't mean that we are against technological advances. We have put RAG online. Our CD Rom has a specification wizard. So we can certainly be proactive when there is a need to be. But we feel the personal touch is essential and

customers approve of this. ... "Contract Flooring Journal," June 2003;

Headline: Material Selection; Services
...These tools include the chemical compatibility wizard, the fluid blender, an RTV material selector, specifications wizards, a viscosity at temperature calculator and the weatherseal wizard. ... "Rubber World," September 22, 2002;

Headline: Silicone Specifications; Services; Brief Article
...A search wizard searches for a product with keywords, competitive offsets, CAS numbers, documents and alphabetically. Specification wizards allow users to specify a product from the company in their application and find a silicone product which meets their compliance specification. ... "Rubber World," June 22, 2002; and

Headline: Master Builders unveils new electronic tool
...architects develop custom concrete and admixture specifications for projects. The Master Builders Material Specification Developer contains a specification wizard that poses a series of questions the user must answer regarding the concrete required in a project. "Concrete Products," September 2001.

Applicant urges reversal on the basis that the burden of establishing the mere descriptiveness of a mark is on the USPTO; that the Examining Attorney improperly dissected the mark rather than considering the mark as a whole in determining descriptiveness; that the combination of "spec" and "wizard" results in a registrable mark; that the mark

SPECWIZARD "does not apprise the user of all of the characteristics of the service" (brief, p. 3); that the mark does not immediately and directly convey information about the particular characteristics of the services, but rather purchasers must exercise thought and a multi-stage reasoning process to determine the attributes of the involved services; that the Examining Attorney's definition of the term "wizard" does not apply to applicant's services, but instead, the term "is suggestive of a mentor or guide who navigates the user through the specification-writing process" (reply brief, p. 2); and that the USPTO has determined that the term "wizard" used in connection with software is entitled to trademark protection as shown by applicant's initial typed list of about 40 third-party applications and registrations.

In explaining why applicant asserts the term "wizard" is not descriptive in relation to its services, applicant argues as follows (brief, p. 4):

...wizards [e.g., "letter wizard,"
"install wizard"] are components of a
program that help a user utilize the
program.

In contrast, the SPECWIZARD service is
not a component or utility that helps a
user to utilize a program or
application. SPECWIZARD is the
program, which is an expert system that
simulates the judgement and behavior of
a human expert with knowledge and

experience in the creation of construction specifications. SPECWIZARD is not a utility of a specification writing program, which [would be] known as specification writers or spec writers in the industry. As such, the service provided by SPECWIZARD is the expert guidance to a user for the creation of a building specification.

A term is merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it immediately conveys information concerning an ingredient, quality, characteristic or feature thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a term or phrase describe all of the properties or functions of the goods or services in order for it to be considered merely descriptive thereof; rather, it is sufficient if the term or phrase describes a significant attribute of the goods or services.

The issue of whether a particular term or phrase is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used on or in connection with those goods or services, and the possible significance that the term or

phrase is likely to have to the average purchaser of the goods or services because of the manner in which it is used. See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). See also, 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §§11:66-11:71 (4th ed. 2001). Further, the question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

In this case, the Examining Attorney has met the burden of establishing a prima facie case of mere descriptiveness. In fact, this record includes ample evidence that in the context of applicant's services, "application service provider featuring software for use in creating specifications for builders and architects," the term "spec" refers to "specifications" (see e.g., dictionaries and applicant's own use of the word and the

abbreviated word),³ and the term "wizard" refers to a computer software tool or utility which guides the user through a step-by-step process (see e.g., the dictionary definitions, Nexis database excerpts, and pages from applicant's website). The term SPECWIZARD, considered as a whole and in its entirety, when used in connection with applicant's service featuring software for use in creating specifications for builders and architects, is merely descriptive of a significant feature, purpose and function of the service. Specifically, the purchasing public would readily understand, without imagination or conjecture, that applicant's service features software that is an interactive tool or utility used in relation to arriving at appropriate specifications for construction and other projects of builders and architects.

Applicant's argument that, in the context of applicant's services, purchasers would understand the term "wizard" to refer to its pre-computer meaning of a guide or mentor is not persuasive. Applicant's own specimens include the following wording:

Solution: Software That Listens and
Remembers!

³ Applicant does not contest this point. At page 4 of its brief, applicant stated: "As to the term 'spec', applicant submits that it is commonly understood in connection with specifications."

SpecWizard™ is a software solution specially created for the preparation of CSI-formatted specifications. It uses a familiar technique that is easy to understand, fast and accurate.

...

This software-driven selection process determines how to populate multiple sections within the spec. The questions and answers are presented graphically to make the process intuitively simple to understand and use.

This confirms consumers' understanding of the term "wizard" as it is now defined in the context of an interactive help utility in computer software.

Based on the record, we find that the term SPECWIZARD, when used in connection with the involved services, immediately conveys to the purchasing public the idea of the featured software which is an interactive guide tool or utility in relation to applicant's service. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (APPLE PIE merely descriptive of potpourri); *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) [FIRSTIER (stylized) merely descriptive of banking services]; *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) (SCREEN FAX PHONE merely descriptive of facsimile terminals employing electrophoretic displays); and *In re Cryomedical Sciences Inc.*, 32 USPQ2d 1377 (TTAB

1994) (SMARTPROBE merely descriptive of disposable cryosurgical probes).

Further, even if applicant is the first (and/or only) entity to use the term SPECWIZARD in relation to its identified services, such is not dispositive where, as here, the term unquestionably projects a merely descriptive connotation. See *In re Tekdyne Inc.*, 33 USPQ2d 1949, 1953 (TTAB 1994), and cases cited therein.

With respect to the typed list of third-party registrations of various "WIZARD" marks (showing only the mark and the number) submitted by applicant, this evidence is not persuasive of a different result in this case.⁴ First, mere typed listings of third-party registrations are not an appropriate way to enter such material into the record, and the Board does not take judicial notice of registrations in the USPTO. See *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992); *Cities Service Company v. WMF of America, Inc.*, 199 USPQ 493 (TTAB 1978); and *In re Duofold Inc.*, 184 USPQ 638 (TTAB 1974).

Second, the list does not indicate whether any of the marks were registered with a disclaimer of the term

⁴ Applicant's typed list included application serial numbers. Third-party applications, even if properly submitted, are evidence of nothing except that the applications have been filed.

"wizard," or under the provisions of Section 2(f) of the Trademark Act. Nor does the list indicate the specific goods involved.⁵ Even if such information were of record, while uniform treatment under the Trademark Act is an administrative goal, the Board's task in an ex parte appeal is to determine, based on the record before us, whether applicant's mark is merely descriptive. As often noted by the Board, each case must be decided on its own merits. We are not privy to the records of the third-party registration files and, moreover, the determination of registrability of those particular marks by the Trademark Examining Attorneys cannot control our decision in the case now before us. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some prior registrations had some characteristics similar to [applicant's application], the PTO's allowance of such prior registrations does not bind the Board or this court.")

Decision: The refusal to register under Section 2(e)(1) of the Trademark Act is affirmed.

⁵ Applicant stated in its combined request for reconsideration and appeal brief (p. 6) that the third-party applications and/or registrations were "in Class 9 for software related products."