

**THIS OPINION IS NOT  
A PRECEDENT OF  
THE T.T.A.B.**

Oral Hearing: October 26, 2006

Mailed: January 4, 2007

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Sony Electronics Inc.

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Serial No. 76460006

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Robert B.G. Horowitz of Cooper & Dunham LLP for Sony  
Electronics Inc.

Kevon Chisolm, Trademark Examining Attorney, Law Office 103  
(Michael Hamilton, Managing Attorney).

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Before Hohein, Bucher and Cataldo,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Sony Electronics Inc., a Delaware corporation, has  
applied to register the mark ROUGH CUT in standard  
character form on the Principal Register, as amended, for  
"video and data storage system consisting of a storage  
drive, data storage tapes, cables and application software

used for scanning and creating back-up files for storage of video and data.”<sup>1</sup>

The trademark examining attorney has refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant’s mark is merely descriptive of a feature or quality of applicant’s goods.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed main briefs and applicant filed a reply brief. In addition, applicant and the examining attorney presented arguments directed toward the issue on appeal in an oral hearing held on October 26, 2006.

Applicant contends that its proposed mark is just suggestive and does not immediately describe its goods or a characteristic thereof. More specifically, applicant argues that the examining attorney defines “rough cut” as a preliminary edit of raw video footage; that, however, applicant’s goods perform no editing function; that, rather, applicant’s goods are used solely for storage of video data at any stage of editing; that purchasers and users of its goods thus would need to “exercise mature

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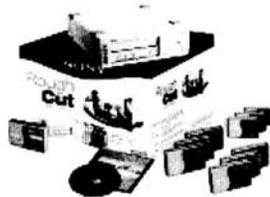
<sup>1</sup> Application Serial No. 76460006 was filed on October 15, 2002, based on applicant’s assertion of a bona fide intent to use the mark in commerce on the goods.

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thought or follow a multi-stage reasoning process to determine any descriptive meaning of ROUGH CUT in relation to [applicant's] goods" (brief, p. 7); and that, as a result, the mark ROUGH CUT is, at most, suggestive of the recited goods. Applicant has relied upon copies of printed advertisements, reproduced below, for the goods identified by the subject mark.

### What's in the Box

Sony AIT-2 Drive with  
i.LINK<sup>®</sup>/FireWire<sup>®</sup> Interface  
(also known as IEEE 1394)  
i.LINK/FireWire Cable  
Mezzo Quick Install CD-ROM  
3 AIT-2 – 50GB Media Tapes  
3 AIT-2 – 36GB Media Tapes  
3 AIT-1 – 25GB Media Tapes  
1 AIT Cleaning Cassette  
Getting Started Guide  
Bonus Pack-in: 2 DVD-R Discs (limited time)



### Supported Applications

Avid<sup>®</sup>, Media 100<sup>®</sup>, Pro Tools<sup>®</sup>, Apple<sup>®</sup> Final Cut Pro<sup>®</sup>, Digital Performer,  
Adobe<sup>®</sup> Premiere<sup>®</sup> and more...

### System Requirements

#### Operating System

Macintosh OS X v10.2 or OS 9 v9.1

#### CPU

Minimum Required: Macintosh G3 Blue and White or higher

#### Hard Disk

Minimum Required: 50MB of free hard drive space

#### Monitor

Recommended: 1280 x 1024 pixels or higher / millions of colors

#### For Installation

CD-ROM drive  
E-mail access



The information is preliminary and subject to change.

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**SONY.**

Sony Electronics Inc.  
1 Sony Drive  
Park Ridge, NJ 07656  
www.sony.com/roughcut

Printed in USA 05/03  
KD G373  
DM 579

**SONY**

# Rough Cut™

Advanced Video Editing Storage

**Retrieve it - don't recreate it.**

[www.sony.com/roughcut](http://www.sony.com/roughcut)

SONY

## STORING YOUR VIDEOS JUST GOT A WHOLE LOT EASIER

### Easy to Install

Unpack your drive and cables and hook them up to your computer. No need to shut down your system with the FireWire® Hot Swap capability. Pop in the CD-ROM and follow the on-screen instructions.

Be sure to register your software at [www.mezzotechnologies.com](http://www.mezzotechnologies.com) – just go to the "Registration & Authorization" section to be eligible for the latest news and updates.

### Easy to Use

Dragging and dropping to and from the desktop into the graphical interface is simple and intuitive to use. Mezzo™ software scans your project for all related files in your system and automatically creates a back-up queue. Mezzo software prompts the user for required storage media, flags errors, and even highlights missing project files. Powerful enough to run in the background, flawlessly sharing CPU usage while you complete other tasks in the system.

### Rough Cut™ Kit allows you to:

#### Store Work In Progress

No longer worry about those critical files getting lost or destroyed mid-project.

#### Eliminate Recreation of Work

Simply restore files from your back-up without having to rebuild lost files from scratch. Restoring is especially important for files that can't be recreated from non-time coded source reels or reels that are no longer available to reload.

#### Keep Multiple Edit Versions

Simply and easily save versions of your project and store each on its own data tape.

#### Consolidate Project Elements

Store multiple projects on single cassettes to save space. Move one or more projects off your system to make room on your edit system with the confidence that data restoration is quick and easy.

#### Save Back-Up Time

Copy only the files that have been updated in your project to your existing data tape. The software scans your system for updated files, preventing overwrites and lengthy transfers of unaltered files already safely backed-up.



Applicant further relies upon the declaration of Mr. Alan Sund, applicant's Director of Tape Sales and IT Storage Solutions. Portions of Mr. Sund's declaration are reproduced below:

6. When editing video, a person will take existing video data and modify it on a computer using instructions and commands. The person will, if using a Macintosh OS-based computer (which are the computers that interface with Sony's ROUGH CUT goods) use an editing software program...and

modify the video data with same. When a person reaches a point of completion, he or she will save the modified video in a storage medium of some kind, which is either on tape or in a hard drive. However, should such a person wish to modify the saved video in the future, the instructions and commands originally used to modify the video are not available and much time will be spent in recreating many of the same instructions and commands when modifying the video. As explained below, although Sony's goods do not play a role in the actions involved with actual video editing they do solve the above mentioned problem.

7. Sony's ROUGH CUT goods are comprised of an AIT2 data storage drive, high density storage tapes, MEZZO AV storage application software, and cables for connection to a computer. When used, the video data is stored onto the storage tapes with the commands and instructions used in the editing. This means that if a person ever wishes to change the video data in the future, he or she may do so far more easily since the instructions and commands used in the previous modification are accessible.

8. Importantly, the ROUGH CUT goods are used to store video data in any form (i.e., unedited, fully edited or partially edited) and perform no other function. Their desirability to users is that they store all video works with the editing instructions and commands intact. Their application is not limited to raw video footage being stored in the ROUGH CUT goods, the footage then edited by a computer, and then stored back in the ROUGH CUT goods. In many cases, finished videos will be stored using ROUGH CUT goods without the unedited video data first being stored.

In addition, applicant submitted with its brief printouts from the United States Patent and Trademark Office's Internet-based Trademark Applications and Registrations

Retrieval (TARR) system of third-party registrations for the marks ROUGH DRAFT and ROUGH-COTE. According to applicant, these third-party registrations "support the conclusion that [applicant's] ROUGH CUT mark is suggestive of its goods" (brief, p. 11).

The Examining Attorney maintains that the mark merely describes a feature or quality of the goods.<sup>2</sup> In particular, the examining attorney argues that the goods identified in the subject application are "used for completing rough cuts" (brief, unnumbered p. 3); that the mark ROUGH CUT "immediately conveys to potential purchasers that the goods are used for making a rough cut of a film" (*id.*); that, "[a]t the very least, applicant's storage system allows video editors to store various versions of 'rough cuts' so those editors can easily access those rough cuts and continue the editing process" (brief, unnumbered p. 5); and that, as a result, the mark ROUGH CUT merely describes a function or feature of the goods. In addition, pursuant to Trademark Rule 2.142(d), the examining attorney

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<sup>2</sup> The examining attorney filed his brief on this appeal nine days late. With his brief, the examining attorney filed a motion to accept the brief as timely filed. Applicant's objection to the examining attorney's motion, raised in its reply brief, subsequently was withdrawn at oral hearing. Accordingly, and in the interest of coming to a determination on the merits of the issue on appeal, we will consider the examining attorney's brief as timely filed.

objects to the third-party registrations appended to applicant's brief on the ground that they were not properly made of record prior to appeal.

In support of the refusal, the examining attorney has made of record articles retrieved from the Nexis database and Internet web pages. Excerpts from these articles and web pages follow (emphasis added):

On the other hand, running Final Cut Pro, the PowerBook rendered a three-second cross-dissolve in just over 13 seconds, barely enough time to get that fourteenth cup of coffee. For assembling **rough cuts** or most simple editing tasks, **software** rendering is acceptable at these processor speeds.

(EMedia Magazine, May 1, 2002)

"The bottom line," says the ABC's international communications manager, Tony Hill, "is making our people as flexible as possible. Doing a bi-media [radio and television] assignment, they will travel with digicam and a laptop with video-editing **software** so they can do a **rough cut** of images, either sent back via the Internet or on tape."

(Sydney Morning Herald, March 11, 2002)

Discovery is in the process of expanding the pilot to roll out an enterprise wide media management system with a single repository for video from B-roll to archives to **rough cuts** using Artesia's digital management **software** known as TEAMS. This software takes the logged video and incorporates it into a central repository of digital content, including not only video but also text, music and still photos. The **software**

is then used to create **rough cuts** of shows...The production team on "Living Pulse", slated to run internationally on Discovery Health later this year, used database **software** to manage its **rough cuts**, which had been transported digitally across the system.

(Electronic Media, September 10, 2001)

No more waiting while tapes rewind; just point and click to watch any take instantly. You can even use the StormVision **software's** assemble mode to do a **rough cut** on the fly...

(Daily Variety, June 25, 1999)

Kennedy says Flashcut is conducting a test with client Leo Burnett Advertising downloading **rough cuts** using a **software** called Creative Partner which allows the client to annotate the cut. He says it has only been used for testing because the image quality is inferior and, at conventional speed, is too slow to be efficient.

(Playback, November 20, 1995)

#### SONY'S ROUGH CUT BUNDLE STARS AS BACKUP SOLUTION FOR VIDEO EDITORS

"The Rough Cut kit is an engine to reduce re-work and help satisfy clients. Managers will value the way this solution boosts productivity and streamlines workflow. Editors will benefit because they can focus on delivering their most effective and creative work - not on re-digitizing, re-loading, and recreating files."

The first releases of the Rough Cut video editing storage kits are designed specifically for the post-production process using Apple Macintosh™ computer-based systems. It is ideal for independent videographers, corporate A/V departments and video production service firms...

The Rough Cut video editing storage kit relies on advanced AIT technology to enable fast, reliable storage and retrievals...

The kit includes Mezzo ES Generation 4 software that was specifically developed for project-based editing storage. Mezzo uses a drag-and-drop interface that allows users to automatically back up digital files to free space on their systems, while preserving their ability to review, restore and edit earlier sessions...

Sony's initial AIT-2 Rough Cut video editing storage solution, identified by the model number RCUT210MAC1, will be available in May for a suggested retail price of \$1,999, representing a substantial savings of 30 percent over individual component purchases.

(<http://news.sel.sony.com/pressrelease/3501>)

Applicant argues in reply that the evidence relied upon by the examining attorney supports applicant's contention that its goods are used solely for storage of video images; that its goods do not perform any editing functions; and that, as a result, the mark ROUGH CUT is suggestive of applicant's goods. In addition, applicant argues that the examining attorney asserted for the first time in his brief that because applicant's goods may be used to store "rough cuts," the mark is merely descriptive thereof; and that applicant submitted the third-party registrations with its brief in order to address that new argument. Applicant requests that, in view of the foregoing, the Board suspend the instant appeal and remand

the case to the examining attorney for consideration of the third-party registrations.

We first turn to the examining attorney's objection and to applicant's request for suspension of the appeal and remand to the examining attorney for further examination. We note initially that, as contended by the examining attorney, the third-party registrations appended as exhibits to applicant's main brief are manifestly untimely. See Trademark Rule 2.142(d) (the record in the application should be complete prior to the filing of an appeal). We note in addition that inasmuch as the issue on appeal is fully briefed, and the applicant and examining attorney have presented arguments thereupon at oral hearing, this matter is ripe for decision. We further note, however, applicant's assertion that it submitted the exhibits at issue in response to an argument raised by the examining attorney for the first time in his brief on appeal. An examination of the prosecution history of the involved application reveals this to be the case. Thus, while we do not find that suspension of the appeal and remand to be appropriate at this time, we will exercise our discretion to deem the third-party registrations to be made of record and consider them for their probative value with regard to the issue on appeal.

It is well settled that a term is considered to be merely descriptive of goods and/or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, feature or characteristic thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods and/or services. See Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052. See also *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods and/or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods and/or services for which registration is sought. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). Thus, "[w]hether consumers could guess what the product is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

In the instant case, the evidence made of record by the examining attorney and applicant supports a finding that, as applied to applicant's goods, the term ROUGH CUT

would immediately describe, without conjecture or speculation, a significant characteristic or feature of the goods, namely, that they may be used to store video images in "rough cut" form. Articles submitted by the examining attorney from the Nexis database establish that the term "rough cut" describes video data in partially edited form. It is settled that excerpts from articles taken from the Nexis database are competent evidence of how a mark may be perceived. *See In re Shiva Corp.*, 48 USPQ2d 1957 (TTAB 1998). The press release from applicant's Internet website, made of record by the examining attorney and reproduced above, establishes that the goods identified by applicant's ROUGH CUT mark are useful, *inter alia*, to video editors "by preserving their ability to review, restore and edit earlier sessions...." Applicant's press release further describes the goods as "The Rough Cut video editing storage kit." Material obtained from the Internet is acceptable in *ex parte* proceedings as evidence of potential public exposure to a term. *See In re Fitch IBCA, Inc.*, 64 USPQ2d 1058 (TTAB 2002). In addition, applicant's printed advertisement for its goods under the ROUGH CUT mark indicate that the goods provide "advanced video editing storage." Thus, prospective purchasers, upon confronting the term ROUGH CUT for applicant's goods, would immediately

perceive that the goods are used to store video images, including "rough cuts," for possible further editing.

The third-party registrations submitted by applicant for the marks ROUGH DRAFT and ROUGH-COTE for unrelated goods are of little help in determining the registrability of the mark at issue in this case. As often noted by the Board, each case must be decided on its own set of facts, and we are not privy to the facts involved with these registrations. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if 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."] See also *In re Best Software Inc.*, 58 USPQ2d 1314 (TTAB 2001). While uniform treatment under the Trademark Act is highly desirable, our task here is to determine, based upon the record before us, whether applicant's mark is registrable.

We note applicant's argument that its goods do not perform any editing function; and that, as a result, the ROUGH CUT mark is just suggestive thereof. However, in setting forth its argument, applicant appears to ignore the above-referenced evidence demonstrating that ROUGH CUT immediately conveys a significant feature or characteristic

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of applicant's goods, namely, that they may be used to store partially edited video data, or "rough cuts." Applicant's insistence that its goods do not create "rough cuts" is simply unpersuasive in light of the above-referenced evidence that its ROUGH CUT mark merely describes a type of video data that may be stored by its goods for ease of any further editing.

Accordingly, we find that applicant's mark is merely descriptive as contemplated by Section 2(e)(1) of the Act.

Decision: The refusal to register is affirmed.