

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

Mailed: June 22, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sanuk Technology International Corp.

Serial No. 76587886

John S. Hale of Gipple & Hale for Sanuk Technology
International Corp.

Katherine Stoides, Trademark Examining Attorney, Law Office
101 (Ronald R. Sussman, Managing Attorney).

Before Cataldo, Mermelstein and Wellington,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Sanuk Technology International Corp., has
applied to register the mark EPCCONFIGURATOR in standard
character form on the Principal Register for the following
goods, as amended: "software for identifying and matching
for compatibility sensors, readers, antennae, software and

networks used in radio frequency networking solutions" in International Class 9.¹

The trademark examining attorney 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 briefs on the issue under 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, characteristic or feature 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

¹ Application Serial No. 76587886 was filed April 21, 2004, based upon applicant's assertion of its bona fide intent to use the mark in commerce in connection with the recited goods.

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 this case, the examining attorney's evidence supports a finding that the acronym "EPC" stands for "electronic product code." In particular, an article from an Internet website contains the following information:²

The Electronic Product Code (EPC)

Just as the UPC code has transformed retail operations around the globe over the past twenty years by increasing productivity and efficiency within the supply chain, the ePC (electronic product code) could take supply chain dynamics to the next level...

The ePC code is a new product numbering standard that goes way beyond identifying products. The ePC assigns a unique number to every single item that rolls off a manufacturing line! (e.g. Every single bottle of soda would have its own unique ePC number). The ePC will allow every company in the supply chain, including retailers, to track products at the individual item level...

² We note that the examining attorney also relies upon definitions of "electronic product code" from the open-source Internet encyclopedia Wikipedia, which corroborates the above definition.

The ePC number is designed to be embedded within an electronic tag that can be applied to each item for a very low cost. One way to think of the ePC is to imagine a UPC that is appended with a unique serial number and stored electronically on every item. The ePC tag can be read by radio frequency scanners when brought into range of a tag reader.

In addition, applicant concedes in its December 7, 2005 response to the examining attorney's second Office action that "the letters EPC have a general meaning within the trade of electronic product code" (response, p. 1).

The examining attorney further submits articles from the Nexis computer database in which the term "configurator software" appears.³ The following examples are illustrative (emphasis added):

The Phases Easy Design **configurator software** is a menu-driven program that walks the user, via guided steps and individual screens, to design a hydrostatic transmission...
(Diesel Progress North American Edition, July 1, 2005)

"...yet another set of forward-thinking companies who see the value of leveraging BigMachine's Lean

³ The examining attorney's submission of a copy of the summary of her search of "configurator software" on the Google Internet search engine has no probative value because the search results are so truncated that they do not provide context for the occurrence of the search term. See *In re Remacle*, 66 USPQ2d 1222 n.2 (TTAB 2002). See also TBMP 11208.03 (2nd ed. rev. 2004). In short, the summary results contain too little information to be of use in determining whether the mark EPCCONFIGURATOR or the component term "CONFIGURATOR" has any descriptive meaning as applied to applicant's goods.

Front-End web **configurator software** to nimbly support their various sales channels in the global market place," Abel adds.

"BigMachine's LFE **configurator software** was a natural fit for our business," said Kevin Woods, Sr. Director of Marketing for Mirapoint. (Business Wire, February 11, 2005)

One type of tool that is showing up frequently on web sites is the product **configurator**.

Configurators are specialized **software** that guide engineers through the steps required to pick the right product from an individual vendor's many offerings to solve the design...

(Design News, June 28, 2004)

Swagelok Modular Platform Components (MPC), together with **configurator software**, make it easy to develop and assemble complete process analyzer sample-handling systems using an ANSI/ISA...

The **configurator software** allows the user to place, define and connect surface-mount components on a computerized layout grid.

(Oil, Gas, & Petrochem Equipment, March 1, 2004)

The above examples, which are representative of the evidence made of record by the examining attorney, clearly indicate that "configurator software" is software that may be used to design and configure various systems.⁴ 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

⁴ We are not persuaded by applicant's contention that the absence of a definition of the term "configurator" from the relevant page of the American Heritage College Dictionary is conclusive evidence that the term has no meaning.

1998). Based upon the above evidence, EPCCONFIGURATOR merely describes software that configures or designs systems based upon their electronic product codes.

In its brief (p. 4-5) applicant indicates that its goods allow users to:

pull down various RFID tags, hand held and fixed readers, printer and operating systems of varying manufacturers to determine whether the specific software and hardware will operate with each other....The various hardware items and software items are identified by commercial product name and when pulled down into a design area will allow a professional to custom design a company's RFID system. The software recognizes incompatible connections in the respective links and will not allow them to be connected together in the design of the RFID system and also will present compatible hardware/software selection for the various components which have been pulled down into the design area.

Thus, as applied to applicant's goods, the term EPCCONFIGURATOR would immediately describe, without conjecture or speculation, a significant characteristic or feature of the goods, namely, that they are used to configure RFID systems based upon the components' electronic product codes. In other words, prospective purchasers, upon confronting the term EPCCONFIGURATOR used in connection with applicant's goods, would immediately perceive that a significant feature or characteristic of its goods is to identify and recognize incompatibilities, and present compatible components - i.e., configure - such

systems based upon their electronic product codes.

Applicant's assertions and evidence regarding third-party registrations for marks containing the term CONFIGURATOR are of little probative value in determining the registrability of the mark at issue in this case. First, we note that the marks in those registrations are not the same as that in the application at issue herein. Further, we note that in the two third-party registrations in which the term CONFIGURATOR stands alone and not part of a telescoped mark, (KNOWLEDGE-BASED CONFIGURATOR and EKWIK CONFIGURATOR), the first mark is registered on the Supplemental Register and the second is registered on the Principal Register with a disclaimer of CONFIGURATOR apart from the mark as shown. Thus, these third-party registrations tend not to support a finding that CONFIGURATOR is viewed by the Office as a distinctive or suggestive term. Finally, and 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. See *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.

Finally, even if applicant is the first or the only user of EPCCONFIGURATOR in connection with its goods, it is well settled that such does not entitle applicant to the registration thereof where, as here, the term has been shown to immediately convey only a merely descriptive significance in the context thereof. See, e.g., *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018, 1020 (TTAB 1983); and *In re Mark A. Gould, M.D.*, 173 USPQ 243, 245 (TTAB 1972).

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.