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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re X10 (USA) Inc.

Serial No. 77061662

X10 (USA) Inc., pro se.

Rebecca Smith, Trademark Examining Attorney, Law Office 110
(Chris A. F. Pedersen, Managing Attorney).

Before Holtzman, Rogers and Taylor, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

X10 (USA) Inc. (applicant) has filed an application to
register on the Principal Register the mark **iconRemote** in
standard character form, for "remote control with Liquid Crystal
Display (LCD) for displaying TV/cable channel icons," in Class
9.¹

¹ Application Serial No. 77061662, filed December 11, 2006, based on an
allegation of a bona fide intention to use the mark in commerce.
Applicant filed an amendment to allege use on March 24, 2007, accepted
by the examining attorney, which asserts a date of first use on
December 11, 2006 and first use in commerce on March 5, 2007.

The trademark examining attorney has refused registration on the ground that the mark is merely descriptive of the goods under Section 2(e)(1) of the Trademark Act.

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs.

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys knowledge of a quality, characteristic, function, feature, purpose or use of the goods or services with which it is used. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). The question of whether a particular term is merely descriptive must be determined not in the abstract or on the basis of guesswork, but by considering the mark in relation to the goods or services for which registration is sought, the context in which the term is used, and the possible significance that the term is likely to have to the average purchaser as he encounters the goods or services in the marketplace. See In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986).

We consider first the meaning of the individual words ICON and REMOTE in the mark to determine whether their combination results in a phrase which immediately conveys information regarding applicant's "remote control with Liquid Crystal Display (LCD) for displaying TV/cable channel icons." See In re Hester Industries, Inc., 230 USPQ 797, 798 n.5 (TTAB 1986) ("It is

perfectly acceptable to separate a compound mark and discuss the implications of each part thereof...provided that the ultimate determination is made on the basis of the mark in its entirety.").

The term REMOTE is a descriptive, if not generic, name for applicant's product which is identified as a "remote control." It can be seen in the printouts submitted by the examining attorney from applicant's website, x10.com, that a "remote control" device is often referred to simply as a "remote." The website states, for example, "the last remote you'll ever need"; "the...universal remote: one remote to rule"; "see what this remote can do"; and "Q: Do I need a computer to program my remote?" In addition, we take judicial notice of the definition of "remote" in *The Penguin English Dictionary* (2000) as "noun informal, a remote-control device operating e.g. a television set."²

As shown on applicant's website, applicant's remote contains an LCD screen which displays the logos, or "icons," of various networks such as HBO, CNN and A&E. The viewer can select the icon to access the particular network without having to remember which network is on which channel. Applicant's website materials

² From the website credoreference.com. The Board may take judicial notice of dictionaries, including online dictionaries which exist in printed format. See *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

state, for example, "Easy Icon Channel Change"; "The backlit LCD screen displays network icons, menu options, and custom setup"; and "Change the channel to HBO simply by selecting the HBO icon. Never again forget which network is on which channel." We take judicial notice of the definition of "icon" as "1. a. An image; representation. b. A simile or symbol." *The American Heritage Dictionary of the English Language* (new college ed. 1976). It is clear that the term ICON in applicant's mark describes the pictorial image on the screen that, as used on applicant's goods, represents a particular network logo.

The combination of the words ICON and REMOTE to form ICONREMOTE does not result in a term which is so unique or incongruous that it is any less descriptive than the individual words. In fact, the combination of these words provides a more specific description of the goods than either word alone. ICONREMOTE directly and immediately conveys the same information to purchasers about the special feature or characteristic of applicant's remote that allows the user to make viewing selections by using icons instead of channel numbers. Applicant's arguments to the contrary are not persuasive.

Applicant, in its brief, writes "Can you figure out what it does simply because it's called an iconRemote?" In applicant's view, the mark suggests that its product is "an icon of amazing engineering." However, as we have said, the question of whether

the mark is merely descriptive must be determined, not in a vacuum, but rather in the context of the mark and in relation to applicant's goods. "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." In re Tower Tech Inc., 64 USPQ2d 1314, 1316-17 (TTAB 2002). The word ICON, when considered in conjunction with applicant's LCD screen-equipped remote, would be immediately understood by purchasers of applicant's remote as referring to the images on the screen, and not to a quality of the product's engineering, i.e., "an icon of amazing engineering."

Applicant also argues that other marks have registered although, according to applicant, they, too, are descriptive. Applicant refers, in particular, to the term "Ultimate Omelette," which applicant claims is registered to Denny's restaurant.³ Applicant maintains that, unlike "Ultimate Omelette" as separate terms, the combination of ICON and REMOTE into a single term is not descriptive.

³ Although applicant did not submit a printout of this registration, the examining attorney did not object to this evidence as not properly of record, and moreover addressed the evidence on the merits. Therefore, we have considered it for whatever limited probative value it may have.

First, the alleged existence of another descriptive mark on the register, particularly a different mark for different goods, has no bearing on the question of whether applicant's mark is entitled to register, and it cannot justify registration of applicant's mark if it is in fact descriptive. It is well settled that each application is considered on its own merits, based on the particular mark, the particular goods or services, and the particular record in each application. See *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (Board's holding of THE ULTIMATE BIKE RACK as descriptive affirmed). See also *In re Scholastic Testing Service, Inc.*, 196 USPQ 517, 519 (TTAB 1977) ("a mark which is merely descriptive should not be registered merely because other such marks appear on the register.").

Furthermore, applicant's mark ICONREMOTE is simply a compressed version of the descriptive term ICON REMOTE without a space between the two words. As a single term, ICONREMOTE is equivalent in sound, meaning and impression to ICON REMOTE and is equally descriptive of applicant's goods. It has frequently been held that "telescoping" or joining two words which as a whole are merely descriptive of the goods into a single term does not avoid a finding of mere descriptiveness for the combined term. See, for example, *In re Omaha National*, supra (FIRSTIER, telescoped equivalent of "first tier," is merely descriptive of banking

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services); and In re A La Vieille Russie Inc., 60 USPQ2d 1895, 1897, n. 2 (TTAB 2001) ("the compound term RUSSIANART is as merely descriptive as its constituent words, 'Russian art.'").

We must also consider that applicant's mark, presented in typed or standard character form, is not limited to any special form or style as displayed on its goods. Phillips Petroleum Co. v. C.J. Webb, Inc., 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). See also Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1847-48 (Fed. Cir. 2000) (typed drawings are not limited to any particular rendition of the mark). This means that when a mark is presented in typed or standard character form, the Board must consider all reasonable manners in which applicant could depict its mark. See In re Cox Enterprises Inc., 82 USPQ2d 1040, 1044 (TTAB 2007). Applicant actually depicts its mark in its promotional materials as **iconRemote** using a format that creates a visual separation between the two terms.

As a final point, it is not relevant that "the word icon would not describe everything the remote does," as applicant claims. A mark does not have to describe each and every aspect of the goods in order to be considered merely descriptive; it is enough that the term describes one significant feature or attribute of the goods. See In re H.U.D.D.L.E., 216 USPQ 358, 359 (TTAB 1982). See also Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959) ("word

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may be descriptive though it merely describes one of the qualities or properties of the goods").

We find that ICONREMOTE when used in connection with applicant's remote control device, immediately describes, without any guesswork or the exercise of any thought or imagination, a significant feature of those goods.

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