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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Conversive, Inc.

Serial No. 78211492

Kent E. Baldauf, Jr. of The Webb Law Firm for Conversive,
Inc.

Ronald L. Fairbanks, Trademark Examining Attorney, Law
Office 117 (Loretta Beck, Managing Attorney).

Before Quinn, Walters and Cataldo, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Conversive, Inc. has filed an application to register
on the Principal Register the mark SEARCHAGENT for "computer
programs, namely an interactive natural language processing
knowledge base used to build and customize interactive
conversational mechanisms in the form of an animated or
virtual character, which assist, answer questions and
provide information to users of web sites, for use in real-

time Internet relay communications platforms," in International Class 9.¹

The examining attorney has issued a final refusal to register, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive in connection with its goods.

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

The examining attorney contends that, in relevant part, the term "search" is defined as "to examine a computer file, disk, database, or network for particular information" and the term "agent" is defined as "a program that works automatically on routine tasks specified by a user, for example, sorting email or monitoring the Internet,"² and, as such, the proposed mark is "simply a combination of two descriptive terms in the computer industry." (Brief, unnumbered p. 5.) The examining attorney asserts that "the term AGENT identifies an actual feature or technology already in existence [and] the fact that applicant's software may represent a next generation or improvement upon the technology already in existence in no way lessens the descriptive nature"; and that "the composite wording on its

¹ Serial No. 78211492, filed February 6, 2003, based on an allegation of a bona fide intention to use the mark in commerce.

face immediately informs the prospective consumer that the applicant's software in some way, shape, or manner provides an intelligent agent that has a search component or capability." (*Id.*, unnumbered p. 7.)

In support of his position, the examining attorney submitted excerpts from several websites, and examples are shown below:

Intelligent-agents.com - lists "**intelligent-agents**" partner sites, including "Agentland - information resource on **intelligent agents**"

Copernic.com - identifies its product as follows: "**Copernic Agent** - more than a simple Web search engine - **Copernic Agent** takes Internet searching to a whole new level: it doesn't leave you only with search results, its loaded with advanced management features like filtering, grouping and summarizing."

Compinfo-center.com - identifies itself as follows: "CompInfo - The Computer Information Center - The top one-stop reference resource for corporate IT, computers and communications"; under the heading - "**Intelligent Agents**-Outline" it includes the following statement: "**Intelligent agents** are programs that carry out a task unsupervised and apply some degree of intelligence to the task. The intelligence may be pretty minimal but often will include some degree of learning from past experience. For example, an **agent** that searches the Internet for interesting material can be told by the user whether what it found was interesting or not. In this way, it can be trained to be more successful in the future. ... There is considerable ongoing research in this field, with many exciting possibilities."

Agentland.com - Under a tab entitled "learn" it included the following listing:

² The cited reference is www.encarta.msn.com/dictionary.

"**Agent families**" - "meet the families of **agents** that live in AgentLand: find out what each one can do for you and learn how to use them." The listed **agents** are:

Searchagents; Webmasteragents; Webagents; Developanagent; Monitoringagents; Shopbots; Virtualassistants; Algames

...
Under the **Search agents** category is the following statement: **Search agents** improve your information retrieval on the Internet. Use them to find your way around the web easily, and quickly get to the information you need.

En.Wikipedia.org - The following is the entry for "**Software Agent**": "in computer science, a **software agent** is a piece of autonomous, or semi-autonomous proactive and reactive, computer software. Many individual communicative software agents may form a **multi-agent system**."

Answers.com - Computer Desktop Encyclopedia - the term "**search**" is defined as follows: "1. To look for specific data in a file or an occurrence of text in a file. A **search** implies sequential scanning of content or indexes in order to find the results rather than a direct lookup. A **search** on the web yields a list of web pages that contain all the words in the **search** criteria. 2. The file of **search** engine technologies."

Verbots.com - Includes the following statement in an advertisement for its product Verbot 4: "If you're interested in building your own exciting, entertaining **agents**, then you'll want to register your Verbot 4. ...

The Verbot Player allows you to interact with **intelligent agents**."

The examining attorney also included the results of an Internet search using the Google search engine. The list is not particularly informative due to the brevity of the entries. The following are a few examples:

"...**Personal search agent** from Agents Technologies..."

"UB (Buffalo.edu) SOM Student Resources - ... books on **software agents**; agent application sites..."

"Botspot.com - ...The latest sampling of new bots and **intelligent agents** from the botspot report ... Fido is a personal search agent whose purpose is ..."

Applicant contends that "the examining attorney's conclusion of mere descriptiveness is based upon an oversimplistic and/or inaccurate understanding of the product at issue" and describes its product as "software [that] enables the purchaser to build and customize a virtual character which responds, in a real-time conversational manner, to inquiries made by the users of the purchaser's web site." (Brief, p. 4.) Applicant acknowledges that the dictionary definitions of the individual terms "search" and "agent" submitted by the examining attorney are accurate, but asserts that "together, they define a software product that would automatically conduct searches [and] this does not describe [applicant's] product." (*Id.*) Applicant states that "at most, the mark SEARCHAGENT may convey a background software routine used for searching" (*id.*, p. 5). Applicant seeks to distinguish its mark and goods from the mark and goods involved in *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (AGENT BEANS merely descriptive of identified software where "beans" defined as "application development software" and "agent" defined as "software routine that waits in the background and performs actions

when a specified event occurs"), cited by the examining attorney, by arguing that the individual terms comprising the composite AGENT BEANS merely described the particular software, which applicant therein had conceded performed a background routine function, and which applicant claims is not the case herein.

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

Applicant admits that the definitions of "agent" and "search" in the record are accurate and we find that the evidence of record further supports the accuracy of those definitions. While some of the evidence includes references to "intelligent agents," the individual term "agent," as used in the evidence, has the same meaning as "intelligent agent." Contrary to applicant's contention, an agent is not limited to a program that searches the Internet; rather, the evidence of record indicates that an agent is semi-autonomous software that automatically examines (i.e., "searches") computer files, databases, etc. under certain parameters to retrieve certain types of information. The definition of "agent" submitted by the examining attorney refers to the function of searching the Internet as an example of, not a limitation on, the definition of an "agent." Moreover, combining the two terms into the composite term SEARCHAGENT does not result in a term that has a meaning different from, or incongruous with, the meanings of the individual terms.³

Applicant's software, as identified, essentially creates a virtual character to interact with the users of the software purchaser's website and, using natural language, answer the questions of the website user.

³ We also note that this conclusion is the same whether or not the terms are merged into a single word or remain as two separate words in the same order.

Applicant disputes that its software performs any automatic routine tasks, as noted in the definition of the term "agent," and, thus, its mark is not merely descriptive. However, it is only logical that, in order to answer the website user's questions, applicant's software must include, as an integral component, an "agent" that "searches" the website, and/or other websites, for the answers to the posed questions. This agent presumably routinely updates its searches of the website and other sources even when asked the same questions so that the answers reflect any updates made to the information contained on the website or other source. Without this component to its software, applicant's virtual character would be, perhaps, an innovative device, but it would be of little use. Thus, we find that the composite SEARCHAGENT exactly describes these significant and integral features and functions of applicant's software as identified in the application.

We agree that, as the applicant suggests, the examining attorney's rationale for why the applied-for term is merely descriptive is vague. However, the Board does not need to find that the examining attorney's rationale was correct in order to affirm; rather, we can rely on a different rationale. *See, In re AFG Industries Inc.*, 17 USPQ2d 1162 (TTAB 1990). Based on our discussion herein, we conclude

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that, when applied to applicant's goods, the term SEARCHAGENT immediately describes, without conjecture or speculation, a significant feature or function of applicant's goods, as described above. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's goods to readily perceive the merely descriptive significance of the term SEARCHAGENT as it pertains to applicant's goods. While this case may be different from *In re Sun Microsystems Inc.*, *supra*, on its facts, the result is the same.

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