

**THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Hearing:
November 16, 2005

Mailed: 3/6/06

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re MagCode AG

Serial No. 78233868

Neal E. Friedman of Davis & Bujold for MagCode AG

David Taylor, Trademark Examining Attorney, Law Office 112
(Janice O'Lear, Managing Attorney).

Before Seeherman, Quinn and Walsh, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

MagCode AG filed an application to register the mark
MAGCODE for "electrical sockets, electrical plugs,
electrical power adapters, electrical switches, electrical
cables and electrical connectors for subassemblies in
machines and vehicles, electrical switching boxes and
modules, electrical switch plates, connecting parts for
electric conductors, namely, data connection modules,
electrical connection boxes, electrical controllers,

electrical connectors, electrical distribution boxes and automobile data connectors."¹

The trademark examining attorney refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark, as applied to the goods, is merely descriptive thereof.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs. Applicant's counsel and the examining attorney appeared at an oral hearing held before the Board.

The examining attorney maintains that the matter sought to be registered is merely descriptive because the goods "feature magnets that will only connect and allow the flow of electricity when they are arranged in a specified manner" and that this arrangement "is equivalent to a code." (Brief, unnumbered p. 5). In support of the refusal, the examining attorney submitted dictionary listings for "mag"; an excerpt of an article retrieved from the Internet concerning applicant's goods; a press release about applicant; an excerpt from applicant's website; and excerpts of the websites of third parties. Based on the

¹ Application Serial No. 78233868, filed April 4, 2003, based on an allegation of a bona fide intention to use the mark in commerce.

evidence, the examining attorney concludes that the proposed mark "immediately conveys to potential purchasers that the goods feature magnets arranged in a code."

(Brief, unnumbered p. 6).

Applicant argues that its mark is only suggestive. Applicant contends that its goods do not include any code, magnetic or otherwise; rather, the term "code," as used in applicant's mark, is a metaphor that suggests a feature of the goods. Applicant places significant weight on the dictionary definition of "code" that it submitted for the first time with its brief, of which we take judicial notice:

Any systematic collection of the existing laws of a country, or those relating to a particular subject; any system or collection of rules and regulations; a system for communication by telegraph, heliograph, etc., in which long and short sounds, light flashes, etc., are used to symbolize the content of a message; a system used for brevity or secrecy of communication, in which arbitrarily chosen words, letters, or symbols are assigned definite meanings; a word, letter, number or other symbol used in a code system to mark, represent, or identify something; a system of symbols for representing information and the rules for their use; to arrange in a code; enter in a code; to translate (a message) into a code; encode; to translate (a program) into language which can be communicated to the computer.

The Random House Dictionary of the English Language (1971).

Applicant contends that its goods do not have a "code" (or "coding") as defined by the dictionary. According to applicant, "there are arranged polarized magnetic keys which are simply not, in any normal sense, a system of information, rules, symbols or communication or the like." Thus, applicant concludes, "the word 'code' is suggestive of applicant's goods which, when placed, turned and/or moved such that their magnet keys come into proper alignment, connect and effectively lock together and permit the flow of electricity." (Brief, pp. 8-9).

According to applicant, the magnet key arrangement employed by applicant's goods has no magnetic coding, and neither of the terms "magnetic coded" nor "magnetic coding" merely describes the goods. Applicant goes on to contend that the third-party materials relied upon by the examining attorney cover goods employing actual coding, making these goods different in nature from applicant's goods. With respect to applicant's own uses of "magnetically coded" and "magnetic coding" highlighted by the examining attorney, applicant asserts that the evidence does not show MAGCODE as a substitute for these other terms. In addition to the dictionary definition set forth above, applicant submitted

a printout of the results of a search of "MAGCODE" and variations thereof using the GOOGLE search engine.

A term is merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use or intended use. That a term may have other meanings in

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different contexts is not controlling. In re Polo International Inc., 51 USPQ2d 1061 (TTAB 1999); and In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). It is settled that:

....the question of whether a mark is merely descriptive must be determined not in the abstract, that is, not by asking whether one can guess, from the mark itself, considered in a vacuum, what the goods or services are, but rather in relation to the goods or services for which registration is sought, that is, by asking whether, when the mark is seen on the goods or services, it immediately conveys information about their nature.

In re Patent & Trademark Services Inc., 49 USPQ2d 1537, 1539 (TTAB 1998).

When two or more merely descriptive terms are combined, the determination of whether the composite mark also has a merely descriptive significance turns on the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. See, e.g., In re Tower Tech, Inc., 64 USPQ2d 1314 (TTAB 2002) [SMARTTOWER merely descriptive of commercial and industrial cooling towers]; In re Sun Microsystems Inc., 59 USPQ2d 1084 (TTAB

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2001) [AGENTBEANS merely descriptive of computer programs for use in development and deployment of application programs]; In re Putnam Publishing Co., 39 USPQ2d 2021 (TTAB 1996) [FOOD & BEVERAGE ONLINE merely descriptive of news information services for the food processing industry]; and In re Copytele Inc., 31 USPQ2d 1540 (TTAB 1994) [SCREEN FAX PHONE merely descriptive of facsimile terminals employing electrophoretic displays].

In order to properly analyze the issue, it is imperative to understand the nature of applicant's goods. Applicant offers the following remarks regarding its goods (Brief, pp. 5-6):

Certain of Applicant's goods feature or are connectors which, when placed, turned and/or moved into the one correct engagement position with respect to one another (i.e. when adjusted so that the magnetic keys of the components come into the correct alignment), connect and, in effect, lock together and permit the flow of electricity between the components. Such occurs only when the polarity of multiple magnetic keys on or near the surface of one of the connector component corresponds, by virtue of having placed, turned and/or moved a component into the correct position, with the oppositely charged polarity of the corresponding magnetic keys of another component.

More specifically, Applicant's connectors feature magnetic keys, with each connector having at least one

magnetic key with south polarity facing out and at least another magnetic key with north polarity facing out. In order to connect to a source of electricity, a component (e.g. an electrical plug) must be connected to a mating or corresponding component (e.g. an electrical socket). In order to, in fact, connect the components, such components must be placed, turned and/or moved about so that polarity of the corresponding magnetic keys (e.g. the keys at the end of the electrical plug and on the electrical outlet) are aligned properly into the correct locking position (e.g. the component must be turned so that the north and south poles of magnetic keys on the electrical plug are aligned to the correct locking position so as to face the corresponding but oppositely polarized magnetic keys on the electrical outlet).

Further, the components are designed so that their magnets interact with the electrodes of the components in a manner which permits the flow of electricity (e.g. from the electrical outlet to the electrical plug) only when the components are actually connected and locked together. By contrast, when not properly aligned, not only do the components fail to connect and lock together but electricity will not flow. Accidental short circuits and electrocution are thereby prevented even if a user places his or her hands directly on an electrically active outlet.

By way of analogy, Applicant's magnetic keys are analogous to the prongs used on ordinary electric plugs and the openings on corresponding outlets. In modern electrical plugs and outlets, one prong is normally larger than the

other and the corresponding electrical outlet will have one opening larger than another so that the plug can only be inserted into the outlet in the proper manner. Further, some plugs for components of higher voltage will include at least one prong facing at a right angle to another prong of the plug and the corresponding electrical outlet will have openings shaped only to accept such a plug. Where Applicant's goods differ in principle is that Applicant's magnetic keys also include a safety feature that prevents the flow of electricity entirely except when the magnetic keys of corresponding components connect and effectively lock.

The examining attorney submitted dictionary listings to show that "mag" is an abbreviation for the term "magnetic." www.acronymfinder.com; and www.encyclopedia.com. The examining attorney also furnished a dictionary definition of "magnetic": "of or relating to magnetism or magnets; having the properties of a magnet; capable of being magnetized or attracted by a magnet; operating by means of magnetism." The American Heritage Dictionary of the English Language (4th ed. 2000).

An article regarding new financing for applicant reads, in relevant part, as follows: "The company holds worldwide patent rights for magnetically-coded connector systems which are the basis of a new, secure transmission technology and outlet for electricity and data transmission

in the automotive industry." Mergers & Acquisitions Magazine (November 2001). Also of record is a press release from a venture capital company announcing its investment in applicant. The release reads, in pertinent part, as follows: "[Applicant] has global patents for magnetic-coded connection systems for the secure transmission of data and electrical power."

www.innotech.com

The record includes portions of applicant's website showing applicant's use of "magnetic coding" or "magnetically coded" in a merely descriptive manner in connection with applicant's goods. The website contains the following statement: "In contrast to conventional connectors, MagCode Systems are working with magnetically coded flat contacts instead of pins and pin holes." The website goes on to read:

The basic principle of the **MagCodeTechnology** is the use of the repulsive and attractive forces of permanent magnets in the **MagCodePort** as well as in the **MagCodeClip**. An arrangement of permanent magnets provides the pressure to assume reliable electric contacts. Different orientations of the individual magnets results in a coding effect that allows closure of the connections only in the proper way. Short circuits and misconnections are not possible...The flat contacts carry power only when the moveable plate in the **MagCodePort** that

carries the permanent magnets is attached by the permanent magnets in the **MagCodeClip** that are arranged in the same coding pattern as the magnets in the **MagCodePort**. Other metal objects or regular permanent magnets cannot energize the contact. This feature is the main characteristic of the **MagCodeTechnology**.

(Emphasis in original). The website also indicates the following: "Both *PowerSystems* are available as **MagCodePowerSystem 12V** and **MagCodePowerSystem 24V**, and/or **MagCodePowerSystemPro 12V** and **MagCodePowerSystemPro 24V**. Due to different magnetic coding, a mix of 12 and 24V products is impossible."

The examining attorney also introduced several excerpts of third-party websites with information about various types of switches. The information includes the following statements: "Where noncontact magnetically coded switches are required, the Euchner CMS series is based on coded magnets." (www.engineeringtalk.com); "Sipha non-contact safety switches consist of a magnetically coded sensor and actuator pair that prevents defeat of the safety system by simple magnets." (www.shareholder.com); "The Duraloc Electronic Switch is magnetically coded using multiple magnets arranged to provide a selection of different codes." (www.mistura.com); and "XCSDM non-contact safety interlock switches are designed for the same

functions as mechanical safety interlock switches. The difference is that the non-contact safety interlock switches are magnetically coded devices and require no contact between the switch and coded magnet. This is a benefit where door or guard mis-alignment is an issue, or where the machine designer does not want to use a mechanical device." (www.analogsquared.com).

Based on the record before us, we find that the applied-for mark MAGCODE, when used in connection with the goods, merely describes a significant characteristic or feature of them, namely, that applicant's goods are part of a magnetically coded connector system.

Among applicant's goods are "electrical switches for subassemblies in machines and vehicles." The examining attorney's evidence includes information relating to switches for machines sold by third-party manufacturers. As shown by that evidence, these switches are described as being "magnetically coded." Although it would appear that these switches are different in nature from applicant's switches, applicant's identification of goods, as worded, is broad enough to encompass all types of "electrical switches for subassemblies in machines and vehicles," including the types shown in the third-party websites.

As evidenced by the articles and press release about applicant, others have used the term "magnetically coded" or "magnetic coding" to describe applicant's goods. More significantly, applicant itself has used, as referenced above, the same words in a merely descriptive manner as applied to its products. Contrary to applicant's argument that the term "code" is metaphorical rather than descriptive, the evidence of record shows it being used in a merely descriptive manner by applicant and third parties in the machinery trade. Although this use of "code" may not be in the normal sense of the dictionary meaning, the term appears to have a recognized meaning in the trade when used in the context of "magnetic coding" for goods of the type sold by applicant. See *In re Hunter Fan Company*, ___USPQ2d___ (TTAB, ser. no. 78195616, February 15, 2006) [ERGONOMIC is merely descriptive of ceiling fans].

Applicant's goods, by their very nature, would be bought by knowledgeable purchasers (e.g., automobile manufacturers), and they necessarily would be aware of the "magnetically coded" feature of applicant's goods. The term MAGCODE, when encountered by these purchasers, immediately informs them, without conjecture or speculation, that the goods are magnetically coded.

Decision: The refusal to register is affirmed.