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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lincoln Global, Inc.

Serial No. 78296068

Gregory S. Vickers and Robert V. Vickers of Fay Sharpe LLP for Lincoln Global, Inc.

Georgia Ann Carty Ellis, Trademark Examining Attorney, Law Office 117 (Loretta C. Beck, Managing Attorney).

Before Hairston, Bucher and Taylor, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Lincoln Global, Inc. seeks registration on the Principal Register of the mark **COAXIAL TRANSFORMER TECHNOLOGY** for goods identified in the application as "electric arc welders and power supplies therefore" in International Class 9.[1]

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to

[1] Application Serial No. 78296068 was filed on September 4, 2003 based upon applicant's allegation of a bona fide intention to use the mark in commerce. No claim is made to the word "Technology" apart from the mark as shown.

register this designation under Section 2(e)(1) of the Trademark Act based upon the ground that the mark is merely descriptive when considered in relation to applicant's identified goods, i.e., that the term "coaxial transformer technology" immediately informs potential purchasers about the nature of applicant's goods.

Applicant and the Trademark Examining Attorney have fully briefed the issues involved in this appeal.

We affirm the refusal to register.

Preliminary matters

Applicant specifically objected to the entry and the reliance on evidence obtained after its Notice of Appeal was filed. However, inasmuch as this evidence was directed to the issue for which reconsideration was sought, we will not exclude it. In effect, applicant's request for reconsideration allows the Trademark Examining Attorney to supplement the record:

> If the examining attorney, upon consideration of a request for reconsideration (made with or without new evidence), does not find the request persuasive, and issues a new final or nonfinal action, the examining attorney may submit therewith new evidence directed to the issue(s) for which reconsideration is sought….

TBMP § 1204 at 1200-28 (2d ed. rev. 2004).

Applicant's second basis for objection to some of the Trademark Examining Attorney's Internet evidence is based on the fact that the evidence was obtained from foreign sources. While it is true that sometimes excerpted stories appearing in foreign publications may be found to be of limited probative value [*In re Couture*, 60 USPQ2d 1317, 1318 (TTAB 2001)], in such a case, they would still not be stricken from the record.[2] Moreover, in particular situations, including the engineering field, it is reasonable to assume that engineering professionals will utilize all available resources, regardless of country of origin or medium. Accordingly, in cases such as the instant case, involving sophisticated technology, it is reasonable to consider a relevant article from an Internet website, particularly from an English language site, about technological innovations in another country inasmuch as that resource is likely to be of interest worldwide regardless of its country of origin. *In re Remacle*, 66 USPQ2d 1222, 1224, fn. 5 (TTAB 2002).

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[2] However, as to the probative value of Internet hits that are quite abbreviated, the mere appearance of a term in a brief summary has very limited probative value, especially compared with evidence that provides the context within which a term is used. *See In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828 (Fed. Cir. 2007); and *In re King Koil Licensing Co.*, 79 USPQ2d 1048 (TTAB 2006).

Is term merely descriptive?

A mark is merely descriptive, and therefore unregistrable pursuant to the provisions of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), if it immediately conveys "knowledge of a quality, feature, function, or characteristics of the goods or services." *In re Bayer Aktiengesellschaft*, 82 USPQ2d at 1831 [ASPIRINA is merely descriptive of analgesic product]. *See also In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987) [APPLE PIE merely descriptive of potpourri mixture]; and *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980). To be "merely descriptive," a term need only describe a single significant quality or property of the goods. *Gyulay*, 3 USPQ2d at 1009. Descriptiveness of a mark is not considered in the abstract, but in relation to the particular goods or services for which registration is sought. That is, when we analyze the evidence of record, we must keep in mind that the test is not whether prospective purchasers can guess what applicant's goods are after seeing applicant's mark alone. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) [GASBADGE merely descriptive of a "gas monitoring badge"; "Appellant's abstract test is deficient – not only

in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as required by statute"]. Hence, the ultimate question before us is whether the term **COAXIAL TRANSFORMER TECHNOLOGY** conveys information about a significant feature or characteristic of applicant's goods with the immediacy and particularity required by the Trademark Act.

A mark is suggestive, and therefore registrable on the Principal Register without a showing of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. "Whether a given mark is suggestive or merely descriptive depends on whether the mark 'immediately conveys … knowledge of the ingredients, qualities, or characteristics of the goods … with which it is used,' or whether 'imagination, thought, or perception is required to reach a conclusion on the nature of the goods.'" (citation omitted) *In re Gyulay*, 3 USPQ2d at 1009]; *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990) [NEW HOME BUYER'S GUIDE merely descriptive of "real estate advertisement services"]; and *In re American*

Greetings Corp., 226 USPQ 365, 366 (TTAB 1985) [APRICOT is merely descriptive of apricot-scented dolls]. Rather, the proper test in determining whether a term is merely descriptive is to consider the applied-for mark in relation to the goods or services for which registration is sought, the context in which the mark is used, and the significance that the mark is likely to have on the average purchaser encountering the goods or services in the marketplace. *See In re Omaha National Corp*., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) [the term "first tier" describes a class of banks]; *In re Intelligent Instrumentation Inc*., 40 USPQ2d 1792 (TTAB 1996) [the term VISUAL DESIGNER is merely descriptive of "computer programs for controlling the acquisition of data from measurement devices"]; *In re Pennzoil Products Co*., 20 USPQ2d 1753 (TTAB 1991) [MULTI-VIS is merely descriptive of "multiple viscosity motor oil"]; *In re Engineering Systems Corp*., 2 USPQ2d 1075 (TTAB 1986) [DESIGN GRAPHIX merely descriptive of computer graphics programs]; and *In re Bright-Crest, Ltd*., 204 USPQ 591 (TTAB 1979) [COASTER-CARDS merely descriptive of a coaster suitable for direct mailing].

In arguing for registrability, applicant contends that its mark is suggestive at worst, if not even arbitrary; that it requires a great deal of imagination in order for the relevant public to perceive any significance of the words of the mark, taken as a whole, as it relates to the applicant's goods.

By contrast, the Trademark Examining Attorney contends that applicant has selected three descriptive terms to create its mark, and that the joining together of these three descriptive terms does not obviate the descriptive nature of the mark as a whole. She argues that the evidence shows that this is a term of art in the field of arc welding, or alternatively, that even if applicant should be the first and sole user of a merely descriptive designation, this does not justify registration where the evidence shows that the term is merely descriptive of the identified goods.

In reviewing the evidence from the Internet placed into the record by the Trademark Examining Attorney, we agree with a number of applicant's criticisms.

First, to the extent that the Trademark Examining Attorney gets a hit based upon the inclusion of a particular combination of words within a website's

metatags, such hits are worthless. Some of the entries appear to be included based on the term's placement in metatags inasmuch as the searched words do not appear anywhere on the screen prints reproduced for the record.

Second, among the sources that one can locate when doing a search on the Internet, some individuals who post information in chat rooms or elsewhere on the web leave behind writings that are of questionable credibility.

Third, online electronic supply houses will clearly list *coaxial* power plugs on one page and power *transformers* on another. This is neither relevant to, nor supportive of, the position of the Trademark Examining Attorney herein.

Fourth, some of the websites contain terms such as "coaxial transformer" but use this in connection with unrelated products, including some in totally unrelated industries.[3] For instance, this is especially true with coaxial cables that are used with radio antennaes, where this combination of words is used in multiple excerpts drawn from the Internet or Lexis/Nexis, but its usage in

[3] Although Applicant has objected to the entry of this material into the record, we permit it to be part of the record. Nonetheless, we find that when the excerpts use this terminology in technologies unrelated to power supplies for products like electric arc welders, the articles have no probative value.

this context has no relevance to the involved welding or power supply technologies.

Accordingly, even when considering foreign websites dealing in some way with relevant technologies, we find very little in the hefty attachments placed into the record by the Trademark Examining Attorney that supports the conclusion that applicant's involved mark is merely descriptive of these goods.

On the other hand, we find that the most probative usage of the combined term "coaxial transformer" by a third party is in the context of Eldec® brand induction heating equipment. While applicant is correct that induction heating is clearly a different process from arc welding, it is another industrial method for joining metals. While the methodology for joining metals may be quite different, it is not as clear that the technology for high frequency power supplies are so very different when used with inductive brazing, pre-weld inductive heating or electric arc welding equipment. The record shows that Eldec inductive heating and/or brazing machines have "coaxial transformers" of some kind. The entire record, including applicant's own literature, confirms that coaxial winding transformers involve a power supply technology that is

different from the underlying technology of conventional transformers.

Both applicant and the Trademark Examining Attorney have placed into the record various definitions of the word "coaxial":

- "[h]aving or mounted on a common axis"[4]
- "having coincident axes; mounted on concentric shafts"[5]

In this context, the single item in the record most helpful to the position of the Trademark Examining Attorney is a discussion of applicant's involved goods:

What is Coaxial Transformer Technology™?

To transform large amounts of power as is needed for welding, the power source transformer is a critical factor. Traditional transformers become more inefficient the larger they become. This becomes a problem especially for large power sources (i.e. submerged arc power sources). If the transformer becomes inefficient, it requires more power to be dissipated in all of the components before the transformer. This results in a drastically reduced overall efficiency, components that run at higher temperatures, and reduced reliability.

Coaxial Transformer Technology eliminates these problems. Regardless of the size (power level) a coaxial transformer has superior coupling and efficiency. This is obtained through the coaxial orientation of the primary and secondary windings.

The benefits for the customer include:

- Higher power capabilities (submerged arc inverters)
- Higher efficiency (reduced energy costs)
- Higher reliability (lower stresses on components)

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[4] THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE, (4th ed. 2000), also found at www.Bartleby.com.

[5] WEBSTER'S SEVENTH NEW COLLEGIATE DICTIONARY.

[6] Entire text of this section is as follows:

What is Coaxial Transformer Technology™?

It is clear from this entire record that applicant's enumerated goods include high frequency transformer modules for use in electric arc welding. Applicant's literature stresses the ways in which efficiency and reliability can be compromised in high amperage transformers if the resulting heat is not dissipated sufficiently from the transformer. The winding shape (e.g., in the involved transformers, "the *coaxial* orientation of the primary and secondary windings") has a significant influence on the *transformer* properties (e.g., low and controlled leakage inductance) and the possibilities for cooling the power supply.

As seen above, applicant pictures the transformer windings in concentric cylindrical tubes.

To transform large amounts of power as is needed for welding, the power source transformer is a critical factor. Traditional transformers become more inefficient the larger they become. This becomes a problem especially for large power sources (i.e. submerged arc power sources). If the transformer becomes inefficient, it requires more power to be dissipated in all of the components before the transformer. This results in a drastically reduced overall efficiency, components that run at higher temperatures, and reduced reliability.

Coaxial Transformer Technology eliminates these problems. Regardless of the size (power level) a ***coaxial transformer*** has superior coupling and efficiency. This is obtained through ***the coaxial orientation of the primary and secondary windings***.

The benefits for the customer include:
• Higher power capabilities (submerged arc inverters)
• Higher efficiency (reduced energy costs)
• Higher reliability (lower stresses on components)

The logo presentation of the mark within an oval also accentuates this patented design feature.

While Applicant repeatedly takes the position that there is no such thing as a "coaxial transformer" in relation to its electric arc welding products, applicant's own literature says that "[r]egardless of the size (power level) a ***coaxial transformer*** has superior coupling and efficiency." This lower case usage of this term seems to belie applicant's continuing assertions about the inherent source-indicating function of this term. Hence, while we cannot agree with the Trademark Examining Attorney's alternative argument that "coaxial transformer" has been shown to be a term of art in the field of arc welding, it is nonetheless a term that appears to be readily understandable in the closely related fields of inductive heating and/or brazing machines.

And of course, as correctly noted by the Trademark Examining Attorney, even if applicant were the first user of the term in the electric arc welding industry, the fact that an applicant may be the first and sole user of a merely descriptive or generic designation does not justify registration where the evidence shows that the term is

merely descriptive of the identified goods and/or services. *In re Acuson*, 225 USPQ 790 (TTAB 1985) [COMPUTED SONOGRAPHY descriptive of ultrasonic imaging instruments]; and *In re National Shooting Sports Foundation, Inc.,* 219 USPQ 1018 (TTAB 1983) [SHOOTING, HUNTING, OUTDOOR TRADE SHOW AND CONFERENCE held apt descriptive name for conducting and arranging trade shows in the hunting, shooting and outdoor sports products field].

As to the meaning of the word "Technology," not only has the Trademark Examining Attorney placed a dictionary definition of this descriptive word into the record, but applicant has disclaimed this unregistrable term. Applicant's usage of "COAXIAL TRANSFORMER TECHNOLOGY" (within the oval, as shown above) depicts the two words "Transformer Technology" in identical lettering, and this is used in connection with *power supplies* having design features that applicant touts as being *patented*.[7]

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[7] We see no inconsistency with the holding of our primary reviewing court in the case of *In re Hutchinson Technology Inc.*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988). This was a surname case. Hence, to the extent that the *Hutchinson Technology* decision is even applicable to a discussion under Section 2(e)(1) of the Act, where here applicant uses the combined form "Transformer Technology" in the context of a patented power supply, the term has a great deal more "particularity" than it has when used in connection with computerized products generally.

We agree with the Trademark Examining Attorney that these three words, when combined as applicant has done, do not lose the descriptive connotations of the several components. That is, there is no novel or incongruous meaning that is created within this combination.

Accordingly, we find that in light of the ordinary meaning of the words, supported by some third-party usage in related fields of technology, and applicant's own descriptive usage, there is sufficient support for concluding that this composite is merely descriptive.

While applicant finds support for its position in the case of *In re EBSCO Industries Inc.*, 41 USPQ2d 1917, we do not find this case to be analogous. In *EBSCO*, the board found that applicant's single instance of laudatory advertising was insufficient to meet the Office's burden of demonstrating that the involved configuration of goods was *de jure* functional. However, the standard for showing that a design configuration is *de jure* functional (an absolute bar to registration growing out of public policy concerns) is higher than that for demonstrating mere descriptiveness (where the line between merely descriptive matter and suggestive marks is not always so clear, and doubt is resolved in favor of registration). Furthermore, in this

case, in addition to applicant's own descriptive, if not generic usage, we have the ordinary meanings of the individual words, with additional corroboration that the term "coaxial transformer" is used by other merchants and manufacturers in connection with parallel heating and welding technologies.

Decision: We hereby affirm the refusal to register this matter under Section 2(e)(1) of the Lanham Act.