

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ATMEL Germany GmbH

Serial No. 78726773

Martin R. Geissler and Scott T. Wakeman of Muncy
Geissler Olds & Lowe, PLLC for ATMEL Germany GmbH.

Steven W. Jackson, Trademark Examining Attorney, Law Office
107 (J. Leslie Bishop, Managing Attorney).

Before Bucher, Grendel and Mermelstein, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

ATMEL Germany GmbH seeks registration on the Principal
Register of the mark **HFTAG** (*in standard character format*) for
goods identified in the application, as amended, as follows:

"semiconductors; semiconductor chips;
transponders; transponder chips;
communication systems, namely communication
hubs; transponder communication systems,
namely transponder communication hubs; radio
tracking devices, namely radio frequency
identification (RFID) tags and readers for
tracking persons, animals, vehicles, or goods
of any kind; electronic inventory control
devices, namely radio frequency
identification (RFID) tags and readers for
tracking inventory; electronic identification
devices namely radio frequency identification

(RFID) tags and readers; telecommunication and radio transmitters; telecommunication and radio receivers; radiotelephony transmitters and receivers; wireless telephony apparatus; miniature microwave components, namely antennas; monolithic integrated circuits; radios; integrated circuits; blank integrated circuit cards; computer software for programming transponders; data compression software for use in transponders; transmission software for use in transponders; decoder software for use in transponders; downloadable software for use in transponders; global positioning systems; software for the operational management of portable magnetic and electronic cards; software programmable microprocessors; theft alarms; vehicle locating, tracking and security system comprised of an antenna and radio transmitter to be placed in a vehicle; encoded micro particulates, tags and taggants of plastic, metal or silicate for use in the field of passive labeling, tracing or tracking of persons, animals, vehicles or goods of any kind; antennas; apparatus for transmitting radio programmes and radio relay messages; devices for wireless radio transmission; electronic readers/recorders for medical patient identification bands; radio frequency identification (RFID) tags; sensors for the determination of temperatures, positions and distances; sensor cards for the determination of temperatures, positions and distances" in International Class 9.¹

The Trademark Examining Attorney refused registration on the ground that the term is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

¹ Application Serial No. 78726773 was filed on October 5, 2005 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

After the Trademark Examining Attorney made the refusal final, applicant appealed to this Board. Applicant and the Trademark Examining Attorney have fully briefed the issues in this appeal. We affirm the refusal to register.

It is the position of the Trademark Examining Attorney that the term **HFTAG** aptly describes high frequency (HF) radio frequency identification (RFID) tags, and that the wording "HF TAG" is used regularly enough by competitors in this field that the relevant consumers are likely to perceive the alleged mark, **HFTAG**, as indicating a feature, function, and/or type of the identified goods.

By contrast, in support of registrability, applicant argues that its mark is, at most, suggestive because prospective purchasers will not *immediately* divide the unitary mark between its second and third letters and then analyze the two parts separately.

As evidence in support of his position, the Trademark Examining Attorney submitted: (1) initialism and dictionary entries showing that "HF" is an often-used abbreviation in this field for "high frequency," and that "tag" is the name given to these transponders; and (2) printouts from various Internet websites, which show the use of "HF tags" as a term of art for high frequency RFID transponders or tags.

The following entries from the Internet were made part of the record by the Trademark Examining Attorney:

HEADLINE: **HF Tags**

Escort Memory Systems extensive line of **HF RFID Tags** is rivaled by none in the industry. Our tags provide outstanding RFID solutions for demanding supply chain applications. Featuring over 50 different **HF tag** models our diversity of tags are a testament to more than twenty years we've been providing RFID Solutions for a wide variety of industrial applications. Tags can be mounted to product or product carriers, embedded in pallets walls and flooring and much more. Sizes range from tags that can fit on the tip of your finger to larger, long range tags. Our **HF tags** features include: ...²

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HEADLINES: **UHF vs. HF tags**

Item level tagging with RFID has been conducted mainly with HF (13.56 MHz) tags. There are more than one billion **HF tags** already in use. Even though UHF is also being trialed widely, most enterprises such as Metro in Germany, FDA in the US have favored **HF tags** with write capacity. In Europe, DHL has invited bids for 1 billion **HF tags** for consumption every year.

The Swiss packaging company, Zeller, which is supplier to Roche, has teamed up with Siemens to develop **HF tags** that will be used on ampoules and syringes. GCC, which is a chain of supermarket stores in the Middle East, is planning to tag every item in one of its stores by September 2005. The **HF tags** for the trial, which is expected to last for six months, will be provided by the Emirates Technical Innovations Centre (ETiC).

There are some retailers who prefer to use UHF tags for item-level tagging as they are already using the higher frequency UHF tags on cases and pallets. Tesco, for example, has delayed item-level tagging even though it obtained excellent results with **HF tags**. The companies wish to duplicate the success with UHF tags. The tag manufacturing companies such as Tagsys recommend **HF tags** for item-level tagging but most companies are currently concentrating on meeting the pallet-level tagging mandates of major customers such as Wal-Mart.

Even though certain readability and quality issues have to resolved regarding **HF tags**, the project by ETiC gives it a unique opportunity to conduct a trial in a large retail environment and learn about item-level tagging, specifically of food and other perishable items. GCC will use tagging to manage the supply chain across its 68 stores. ETiC is aiming to establish a production facility with a capacity of more than 1,200,000,000 tags/year. The facility will manage the assembly and attachment of the tags and will be able to provide self diagnostic strips, smart labels, time and temperature labels, etc.

² <http://info.ems-rfid.com/mainmenu/products/hf/tags/index.html>

In laundries, item-level tagging is done by using **HF tags** as the wet conditions preclude the use of UHF tags. Items in libraries are also tagged using **HF tags**. Japanese radio regulations do not permit the use of UHF for RFID; therefore Maruetsu, which is a prominent Japanese chain of stores, uses **HF tags** for tagging its food items. UHF finds use in conditions where a longer range is required and there are no metals in the vicinity, for example, in apparel stores. Also, UHF is being tested for item-level tagging in the pharmaceutical industry.³

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HEADLINE: **Blue- Collar RFID**

Each frequency offers tradeoffs in terms of performance, tag size and price. The UHF tags offer faster data transfer rates and longer read ranges than LF and **HF tags**. Compared to read ranges measured in inches for LF and **HF tags**, a UHF Gen2 tag can be read at distances up to 25 feet...⁴

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HEADLINE: **Study Says HF Rules for Pharma Items**

*In tests performed by ODIN Technologies, **HF tags** outperformed UHF tags for use on pharmaceuticals at the item level.*

Within RFID item-level tagging applications, specifically within the pharmaceutical industry, both ultra-high frequency (UHF) and high frequency (**HF**) **tags** are being tested and deployed in the supply chain.⁵

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HEADLINE: **RFID Vendors Unite to Promote UHF for Items**

If UHF tags can be made to use with magnetic coupling to operate in the near field, that does beg the question: Can **HF tags** be made to use electromagnetic coupling in the far field? The answer, according to Gokhale, is no. That's because lower frequencies generate weaker electromagnetic fields than higher frequencies do. **HF tags** operate at 13.56 MHz, while UHF operates in the 900 MHz range. "That is a 70-times multiple in frequency between the two — and why UHF can work with far-field antennas [antennas that have greater read ranges], and HF can't."⁶

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HEADLINE: **Technical Characteristics of RFID**

High-Frequency (HF): By comparison with UHF tags, passive **HF tags** have the drawback of low transmission range -- generally on the order of just over a foot. In general, they are also larger than UHF tags; flat **HF tags** are typically about 50mm by 100mm in size. **HF tags**, however, have the advantage of being readable in the presence of water.

³ <http://www.rfidgazette.org/2005/09/index.html>

⁴ <http://www.automationworld.com/feature-2520>

⁵ <http://www.rfidjournal.com/article/articleview/2226/1/1/>

⁶ <http://www.rfidjournal.com/article/articleview/2412/2/1/>

HF tags operate at 13.56 MHz, a frequency known as the industrial-scientific-medical (ISM) band. **HF tags** are popular in some smartcard applications and also for various industrial uses.⁷

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HEADLINE: **what's the frequency?**

On one side of the divide are those who back high-frequency (**HF**) tags; on the other, supporters of ultra-high-frequency (UHF) technology. Backers of **HF tags** claim they offer more accurate read rates than their UHF counterparts and are less susceptible to interference from metal and water. They also like to point out that the **HF tags**' smaller, tighter read ranges cut down on the risk of unwanted reads from tags on nearby objects.⁸

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HEADING: **Data capture basics**

Passive vs. active tags

1. High frequency (**HF**) tags have been used to identify and track assets for decades. These tags have a limited read range of 2 to 6 inches from the reader.⁹

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HEADING: **Frequently Asked Questions (FAQs)**

Q: What is the read range for a typical RFID tag?

A: The read range of passive tags (tags without on-board power supplies) depends on a lot of factors: the system frequency used, the power level of the reader, and interference from metal objects or other devices which generate radio frequencies. Generally, low-frequency (LF) tags have read ranges of less than 12 inches. High frequency (**HF**) tags have a read range of less than three feet, and UHF tags have read ranges up to about 20 feet. When users require longer range reads, such as for tracking railway cars in a depot, active tags (using on-board power) can yield read ranges of 300 feet or more.¹⁰

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HEADLINE: **RFID Primer**

TAGS: The recommended standard hardware for library RFID tagging is 13.56 MHz ISO15693. And the recommended data format for new libraries is the "Open Danish Model." (See definition below)

These tags are also known as High Frequency (**HF**) Tags. They have a better read distance than Low Frequency (LF) tags and are less directional than Ultra High Frequency (UHF) Tags. This makes them reasonably well suited for library

⁷ <http://www.rsa.com/rsalabs/node.asp?id=2121>

⁸ http://www.dcvelocity.com/articles/?article_id=812

⁹ <http://www.mmh.com/article/CA6458185.html?industryid=2098&q=HF+tags>

¹⁰ <http://www.rfidfactory.com/fags.html>

inventory management and security. The maximum readable distance to the tag is 10 to 20 inches depending on the size of the tag.¹¹

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HEADLINE: **Passive Tags**

Passive tags are the simplest type. Powered exclusively by RF energy sent from the reader, they don't have an integrated battery, so they can be inexpensive, mechanically robust, and quite small (e.g., about the size of a thumbnail). Passive tags have a limited reader-to-tag range, however, because the received power depends on their physical proximity to the RFID reader.

The range of the link is also affected by the RF frequency chosen. Low-frequency (LF) tags commonly utilize the 125-kHz-to-135-kHz portion of the spectrum; since their range is constricted, they are mainly used for access control and animal tagging. High-frequency (**HF**) **tags**, mostly operating in the 13.56-MHz band, allow a range of a couple of feet. They are typically used for simple one-on-one object reads, such as access control, toll collection, and tracking of portable items, such as library books.¹²

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HEADLINE: **Products**

Name **HF TAGS** 13.56 MHz
Category [Tag](#)
Company [UPM Rafsec](#)

Description The operating distance of a 13.56 MHz tag depends on the tag size and reader type. It can be close to one metre. Due to the anti-collision protocol, it is possible to identify many smart labels simultaneously. The tags can be inserted under almost any type of self-adhesive/pressure sensitive label using a simple process. Labels with metal foils should be avoided since metal has a diminishing effect on the reading distance. The added thickness of UPM Rafsec¹³

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HEADLINE: **Cracking the Frequency Code**

According to a March 2006 IDC Health Industry Insights Perspective Report, "**HF** (high frequency) **tags** have been used commercially for nearly a decade and have become the standard choice for item-level tagging because of their near perfect close-proximity read rates and preferable technical characteristics. **HF tags** regularly achieve over 99.9% readability within a 3 ft range and are better

¹¹ <http://www.idrecall.com/documentation/RFID%20Primer.pdf>

¹² <http://www.analog.com/library/analogDialogue/archives/40-09/rfid.html>

¹³ http://www.morerfid.com/details.php?subdetail=Product&action=details&product_id=5&display=RFID

suited than UHF (ultra high frequency) tags for application to liquid-containing products."

... In reality, **HF tag** costs are competitively priced and prices are dropping in order of magnitude as volumes are increasing...

*Are UHF and **HF tag** form factors comparable?* Claims have been made that UHF tag form factors are shrinking in size to meet pharmaceutical application needs and can compete with the tiny HF offerings that have already been implemented in successful pilot studies. To date, an **HF tag** weighing-in at a "nano footprint" of 8.9 mm in diameter appears to be the smallest offering on the market ...¹⁴

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HEADLINE: **RFID – HF Tags (13.56 MHz)**

We provide range of High Frequency tags mainly used for applications like:

- Systems security
- Cattle Management
- POS Systems
- Access Control
- Personal ID Systems
- Automatic data logging¹⁵

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HEADLINE: **Scanning the future**

Types of tags

Passive tags are extensively used in tracking consumer goods. Tags usually operate in two frequency bands. High-frequency (**HF tags**) have a range of up to 3 feet, while Ultra High Frequency (UHF) tags read from up to 20 feet. For longer ranges, active tags use batteries to boost read ranges to 300 feet and more.¹⁶

Inasmuch as the entire record shows the focus of applicant's identified products to be goods associated with radio frequency identification (RFID) tags, or transponders,

¹⁴ <http://www.pharmexeurope.com/europharmexec/article/articleDetail.jsp?id=387040>

¹⁵ <http://www.syncroft.com/>

¹⁶ http://www.channelbusiness.in/index.php?option=com_content&task=view&id=19&Itemid=83

the Trademark Examining Attorney argues that for the relevant members of the public, this designation immediately conveys the feature, function, and/or type of applicant's identified goods. We agree, being persuaded by the Internet evidence that "HF tag" is a commonly-accepted appellation for the goods identified by applicant herein.

Applicant, on the other hand, maintains that the average consumer would not recognize the five-letter-string **HFTAG** as a type of radio frequency identification tag:

"The record does not show that a prospective purchaser would immediately separate the subject mark between its second and third letters."

Applicant's reply brief at 3 - 4.

A term is merely descriptive if, as used on or in connection with applicant's goods, it immediately conveys information about a significant ingredient, quality, characteristic or feature of applicant's goods, or if it directly conveys information regarding the nature, function, purpose or use of applicant's goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); and *In re Eden Foods Inc.*, 24 USPQ2d 1757 (TTAB 1992). Of course, the issue of mere descriptiveness cannot be determined in a vacuum, but rather is analyzed as the term is used, or as it is intended to be used, on or in

connection with applicant's goods or services. *In re Abcor Development Corp.*, 200 USPQ at 217.

From the various initialism entries placed into this record, applicant is correct that the letters "HF" have dozens of possible meanings when viewed in a vacuum. Of course, any term alleged to be merely descriptive may have multiple meanings. Under our precedential decisions, it is in the context of the identified goods that we must make our determination on mere descriptiveness. In the instant context, when this alleged mark is used in connection with RFID tags, it is quite clear that the designation will be understood as if it were "HF Tag," the designation "HF" will immediately be understood and recognizable as an initialism for "high frequency."

The Internet articles reflect the classes of actual or prospective customers of applicant's particular goods. Accordingly, we conclude that the relevant members of the public, purchasers and potential purchasers of applicant's goods will run the gamut from pharmaceutical manufacturers, international package delivery companies, cattle managers, supermarket executives and other retailers, those responsible for library inventory management and security, to vendors of POS systems, personal ID systems, access control and institutional systems security, to name a few.

They would readily recognize and attribute this particular meaning to the term, when used in connection with applicant's goods. Under the controlling law on descriptiveness, that is enough:

Appellant advances a variation of this argument, arguing that the board failed to determine descriptiveness of "first tier" by its meaning to "average" or "ordinary" customers, citing *In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 385 (CCPA 1968) [descriptiveness determined from standpoint of "potential purchaser"]. See also *In re Abcor Development Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (CCPA 1978) ["descriptiveness ... is to be determined from the standpoint of the average prospective purchaser"]. Appellant asserts that the "vast majority" of its customers would not be knowledgeable of the meaning of "first tier" in the banking industry.

Appellant misunderstands the import of the above decision. In context, "average" or "ordinary" consumers simply refers to the class or classes of actual or prospective customers of the applicant's particular goods or services. In this sense, corporate users of banking services who, appellant admits, understand the industry meaning of a "first tier" bank are "average" or "ordinary" customers. That corporate customers may constitute a smaller number of accounts than individuals is irrelevant. Descriptiveness is not determined by its meaning only to the class of regular customers with the largest head count.

In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987).

The crux of applicant's argument seems to be that prospective purchaser would struggle to separate this mark between its second and third letters. We disagree.

The fact that applicant chose to eliminate the space between the initialism "HF" and the word "TAG" thereby compressing this into a five-letter string, does not change the significance of the term, and hence is immaterial to the result under Section 2(e)(1) of the Lanham Act. We find that relevant purchasers will readily recognize **HFTAG** as "HF TAG" in the context of applicant's goods, and so we are not persuaded by applicant's argument that one necessarily reaches a different result when taking out the space between the terms.

Our principal reviewing court specifically stated that the presence or absence of a space between the words was not determinative of its status as a "compound word." See *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) [SCREENWIPE generic for pre-moistened antistatic cloths for cleaning computer and television screens]. See also *In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718 (CCPA 1970) [CUSTOMBLENDED generic for custom blended gasoline]; *Cummins Engine Co. v. Continental Motors Corp.*, 359 F.2d 892, 149 USPQ 559 (CCPA 1966) [TURBODIESEL generic for internal combustion engines]; *In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) [SMARTTOWER merely descriptive of "commercial and industrial cooling towers and accessories

therefor, sold as a unit"]; *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628 (TTAB 1998) [MASSFLO is generic for flow meters for measuring flow of mass of fluid]; and *Turtle Wax, Inc. v. Blue Coral, Inc.*, 2 USPQ2d 1534 (TTAB 1987) [WASHWAX generic for product which simultaneously washes and waxes a vehicle].

Similarly, when these two descriptive terms are combined into **HFTAG** as presented in the typed drawing, the separate meanings of the individual components are not lost. Nor does the combination create any double entendre or incongruity that might render the combination registrable as a mark. Accordingly, we find that when these two components of the alleged mark are combined into **HFTAG**, it continues to be merely descriptive of these goods.

In conclusion, we agree with the Trademark Examining Attorney that applicant's designation, taken in its entirety, merely describes a significant feature, function, and/or type of applicant's goods. There is no question that, in purchasing applicant's tags, one will want the benefits associated with high frequency RFID tags. The asserted mark, as a whole, immediately informs prospective purchasers and/or purchasers of applicant's goods of a commonly accepted name for these goods. In fact, without

any doubt, we find that applicant's alleged mark is merely descriptive under Section 2(e)(1). We find that on the *Abercrombie & Fitch*¹⁷ spectrum of distinctiveness of marks, upon adoption by plaintiff, this term was much closer to the "highly descriptive" end of the continuum than to the "merely suggestive" side. See *In re Abcor Development Corporation*, 200 USPQ at 219 [J. Rich concurring that "the present name of the [gas monitoring badge] is GASBADGE"].

Decision: The refusal to register the term **HFTAG** under Section 2(e)(1) of the Lanham Act is hereby affirmed.

¹⁷ *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759 (2d Cir. 1976).