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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re International Business Machines Corporation

Serial No. 78740047

Gina M. Lyons of for International Business Machines Corporation.

Gina M. Fink, Trademark Examining Attorney, Law Office 109 (Dan Vavonese, Managing Attorney).

Before Quinn, Drost and Mermelstein, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

International Business Machines Corporation filed an intent-to-use application to register the mark OPEN

INVENTION NETWORK for

Printed matter, namely, newsletters, brochures, pamphlets, leaflets, and flyers, all in the fields of intellectual property, information technology, new technology innovation and research, technology transfer, licensing of intellectual property assets, acquisition of intellectual property assets, and incubation of intellectual property assets (in International Class 16);

Business consultation services and business advisory services, all pertaining to intellectual property, information technology, new technology innovation and research, technology transfer, licensing of intellectual property assets, acquisition of intellectual property assets, and incubation of intellectual property assets (in International Class 35);

Educational services, namely, conducting on-line exhibitions, conferences, symposiums, presentations, displays, interactive exhibits, programs, educational demonstrations, workshops, and seminars, all in the fields of intellectual property, information technology, new technology innovation and research, technology transfer, licensing of intellectual property assets, acquisition of intellectual property assets, and incubation of intellectual property assets (in International Class 41); and

Licensing of patents to licensees for consideration including the licensees' agreement to refrain from asserting their own patents against other licensees; providing educational information via an Internet website in the fields of patent and information technology (in International Class 42).

The trademark examining attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that the mark sought to be registered, if used in connection with applicant's services, would be merely descriptive thereof.

When the refusal was made final in all four classes of services, applicant appealed. Applicant and the examining attorney filed briefs.

Applicant contends that the examining attorney improperly has dissected the mark in an effort to conclude that the mark is merely descriptive. Applicant argues that the record establishes varied uses of the words "open" and "network," and that the various definitions of these words as used in the computer industry tend to indicate that the mark as a whole is just suggestive. Applicant points to the complete absence in the record of any descriptive uses of "open invention network" by applicant or any third party in the industry; all of the uses in printed publications submitted by the examining attorney are, applicant contends, as a source identifier of applicant's services. In support of its arguments, applicant introduced two declarations with accompanying exhibits, and third-party registrations.

The examining attorney maintains that the proposed mark is "merely descriptive of the applicant's Class 42 services and of the subject matter of applicant's goods and services in Classes 16, 35 and 41." According to the examining attorney, applicant has combined three descriptive terms that, when combined, create no separate,

nondescriptive meaning. The examining attorney points to the meaning of "open" as the "non-proprietary" or royalty-free feature of applicant's Class 42 services. The term "invention," according to the examining attorney, refers to the goods and services dealing with intellectual property, and "network" refers to the fact that "applicant's venture is a network of companies, institutions and individuals who have a similar interest in using and/or promoting invention." The examining attorney contends that applicant's "Class 42 licensing of patents venture is an open invention network." And, further, that the mark "immediately describes the open nature of applicant's royalty-free licensing venture, immediately describes the type of shared intellectual property and new technology innovation, namely, invention and finally immediately describes the network of individuals, companies, and institutions that are welcome to join the venture by sharing in the similar interest of promoting the use of Linux, while agreeing to not assert their own patent rights in return." The examining further contends that with respect to Classes 16, 35 and 41, the subject matter of the goods and services is "an open invention network," that is, "an open (royalty-free) venture where a network of individuals, companies and institutions can come together

with similar interests and concerns to promote invention.”
In support of the refusal, the examining attorney submitted dictionary definitions, and excerpts of websites and printed publications retrieved from the Internet.

In order to better understand the nature of applicant’s services,¹ we examine applicant’s website:

Open Invention Network is an intellectual property company that was formed to promote Linux by using patents to create a collaborative environment. It promotes a positive, fertile ecosystem for Linux, which in turn drives innovation and choice in the global marketplace. This helps ensure the continuation of innovation that has benefited software vendors, customers, emerging markets and investors.

Open Invention Network is refining the intellectual property model so that important patents are openly shared in a collaborative environment. Patents owned by Open Invention Network are available royalty-free to any company, institution or individual that agrees not to asserts its patents against the Linux system. This enables companies to make significant corporate and capital expenditure investments in Linux--helping to fuel economic growth.

Open Invention Network ensures the openness of the Linux source code, so that programmers, equipment vendors, ISVs and institutions can invest in and use Linux with less worry about intellectual property issues. Its

¹ Applicant has granted a license to Open Invention Network, LLC to use the applied-for mark.

licensees can use the company's patents to innovate freely. This makes it economically attractive for companies that want to repackage, embed and use Linux to host specialized services or create complementary products.

Open Invention Network believes that one of the keys to innovation in the Linux community is the ability to share software code and ideas. Open Invention Network acquires patents and makes them available royalty-free to any company, institution or individual that agrees not to assert its patents against the Linux System.²

An article described applicant's activities as follows:

Patent pools are more often created for offensive purposes: major patent holders in a narrow application domain privately agree to cross-license patents to each other, while creating an unopposable cartel that can fix royalty fees and demand payment from any other (non-cartel) companies. The Open Invention Network is something of the opposite: a patent pool created to promote patent *non-enforcement*, or non-aggressive patent use, to reduce patent litigation and create an opportunity for innovation in a patent-free (or mostly patent-free) global context. [emphasis in original] (www.xml.coverpages.org)

Thus, the essence of applicant's services is applicant's

² According to applicant, Linux is an operating system; the source code for Linux is available to everyone for free. See "Linux": "a trademark for an open-source version of the UNIX operating system." The American Heritage Dictionary of the English Language (4th ed. 2000).

acquisition of patents for cross-licensing purposes to defend the Linux environment; to accomplish this goal, applicant will provide open access to intellectual property related to the Linux environment. Applicant states that it does not seek revenues by asserting its patents. Rather, it intends only to assert its patents in a defensive way against those who attack Linux.

The following dictionary definitions are of record:

open: of, pertaining to, or providing accessibility; to mark an object, such as a file, accessible; non-proprietary; an open standard is one which can be used without payment.
(www.support.microsoft.com;
www.foldoc.org)

invention: the act or process of inventing; a new device, method, or process developed from study and experimentation.
(The American Heritage Dictionary of the English Language (4th ed. 2000).

network: a complex, interconnected group or system; an extended group of people with similar interests or concerns that interact and remain in informal contact for mutual assistance or support.
(The American Heritage Dictionary of the English Language (4th ed. 2000).

open source: of or relating to source code that is available to the public.
(The American Heritage Dictionary of the English Language (4th ed. 2000).

The record includes the declaration of Gerald Rosenthal, chief executive officer of Open Invention Network, LLC. He states, in relevant part, the following:

[Applicant] employs the mark OPEN INVENTION NETWORK to license patents in consideration for licensee's agreements to refrain from asserting their own patents and patent applications against other licensees. [Applicant] has not and does not intend to offer licenses under its patents to those who do not agree to cross license their own patents and patent applications.

I have not been aware of any descriptive usage of the term OPEN INVENTION NETWORK during my years [37] working for companies in the software industry. The only uses of OPEN INVENTION NETWORK that I have encountered, whether by [applicant] or by third parties, have been in reference to [applicant] and/or the services provided to date by [applicant] under the mark.

I am familiar with the term "open source" as used in the software industry, and consider it as referring to a software program in which the source code is available free of charge to the general public for its use and/or modification. I am not aware of any meaning for the term "open invention" or any descriptive use of this combination of words in the software industry.

Also of record is the declaration of William E. Malloy, a consultant to applicant who evaluates software patent portfolios. Mr. Malloy states in relevant part:

I am familiar [with] the words "open," "invention" and "network" and some of the uses of such terms in the field of computer operating systems, other software, and related fields.

I am unaware of any use of OPEN INVENTION NETWORK in a descriptive manner in any field, including but not limited to the fields of software development, operating systems, computer networking, patent licensing or educational services. The only uses of OPEN INVENTION NETWORK of which I am aware have been in reference to [applicant] and in identifying the source of services provided by [applicant].

I do not believe OPEN INVENTION NETWORK is descriptive of the educational services, the licensing or cross-licensing of patents, or the provision of information via an Internet website [as set forth in the application]. OPEN INVENTION NETWORK does not, to me, immediately convey the nature or characteristics of such educational services, patent licensing or information conveyance. The nature of [applicant's] services indeed had to be explained to me as the words OPEN INVENTION NETWORK did not describe them.

I do not equate the term "open source network" with OPEN INVENTION NETWORK. I also do not consider the term "open source network" as applying to any of the services described [in the application]. As used in a technical sense, I usually think of an "open source network" as a network of systems employing components based on open source software.

The examining attorney submitted eight excerpts of articles appearing in printed publications. In each instance, "Open Invention Network" is used in a service mark manner. That is, the uses show capitalization of the first letter of each term comprising the mark, and the author refers to "Open Invention Network" as a source identifier for applicant's services. Not a single descriptive use, either by applicant or any third party, is of record.

The Examining Attorney bears the burden of showing that a mark is merely descriptive of the relevant goods and/or services. *In re Merrill, Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). A mark is descriptive if it "forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [and/or services]." *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976) (emphasis added). See: *In re Abcor Development Corp.*, 616 F.2d 525, 200 USPQ 215 (CCPA 1978). Moreover, in order to be descriptive, the mark must immediately convey information as to the qualities, features or characteristics of the goods and/or services with a "degree of particularity." *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199,

1204-1205 (TTAB 1981). See: *In re Diet Tabs, Inc.*, 231 USPQ 587, 588 (TTAB 1986); *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949, 952 (TTAB 1981); *In re TMS Corp. of the Americas*, 200 USPQ 57, 59 (TTAB 1978); and *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

Given the dictionary definitions of record, the individual words comprising applicant's mark have commonly understood meanings. We do not believe, however, that the specific combination of the words OPEN INVENTION NETWORK results in a designation which, when considered in its entirety, is merely descriptive of applicant's goods and services. That is to say, applicant's mark, as proposed to be used in connection with applicant's goods and services, does not convey an immediate idea about the goods and services with any degree of particularity. As pointed out by applicant, this is borne out by the slightly different interpretations of the meaning of applicant's mark that have been offered by the Examining Attorney; the words comprising applicant's mark have varied uses in the computer software field. In sum, the significance of the mark as a whole, when considered in the context of the services, is somewhat vague and unclear, and we find that the mark is suggestive of the goods and services.

The prohibition against registration of merely descriptive designations is intended to prevent one party from precluding all others from fair use of descriptive terminology in connection with goods and/or services that are described thereby. Nothing in the record suggests that others in the computer or related fields have used or would need to use the three-word combination OPEN INVENTION NETWORK to describe their goods and/or services.

The Board has noted on a number of prior occasions that there is a thin line of demarcation between a suggestive and a merely descriptive designation. The present case is a close one. However, to the extent that any of the examining attorney's arguments and evidence raise doubts about the merely descriptive character of applicant's mark, such doubts are to be resolved in applicant's favor and the mark should be published, thus allowing a third party to file an opposition and develop a more comprehensive record. See e.g., *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992); *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981); and *In re Gourmet Bakers, Inc.*, supra.

Decision: The refusal to register is reversed.