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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SofTimeline, LLC

Serial No. 78913298

Kit M. Stetina of Stetina Brunda Garred & Brucker for
SofTimeline, LLC.

Esther A. Belenker, Trademark Examining Attorney, Law
Office 111 (Craig D. Taylor, Managing Attorney).

Before Walters, Kuhlke and Bergsman, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

SofTimeline, LLC, applicant, has filed an application
to register the mark VISUALTIMELINE PUBLISHING (in standard
character form) on the Principal Register for "computer
software for creating visual timelines" in International
Class 9.¹ Upon request of the examining attorney, applicant
disclaimed PUBLISHING apart from the mark as shown.

¹ Application Serial No. 78913298, filed on June 21, 2006, under
Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), alleging a
bona fide intention to use the mark in commerce.

The examining attorney has refused registration 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 of its goods. After the examining attorney made the descriptiveness refusal final, applicant filed this appeal. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

"A mark is merely descriptive if it 'consist[s] merely of words descriptive of the qualities, ingredients or characteristics of' the goods or services related to the mark." In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004), quoting, Estate of P.D. Beckwith, Inc. v. Commissioner, 252 U.S. 538, 543 (1920). See also In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003). The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a significant 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 a mark merely descriptive, that the mark describe each feature of the goods or services,

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only that it describe a single, significant ingredient, quality, characteristic, function, feature, purpose or use of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract, 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 Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

Finally, while a combination of descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning, In re Colonial Stores, Inc., 394 F.2d 549, 157 USPQ 382 (CCPA 1968), the mere combination of descriptive words does not necessarily create a nondescriptive word or phrase. In re Associated Theatre Clubs Co., 9 USPQ2d 1660, 1662 (TTAB 1988). If each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive. In re Oppedahl & Larson LLP, supra.

It is the examining attorney's position that applicant's proposed mark VISUALTIMELINE PUBLISHING "describes the function, purpose and use of the applicant's software, which is computer software for creating visual timelines" and this "combination of descriptive terms creates no incongruity, and no imagination is required to understand the nature of its goods." Br. pp. 11-12. In support of her refusal, the examining attorney submitted dictionary definitions for the words "visual," "timeline" and "publishing" set forth below:

Visual - seen or able to be seen by the eye; visible. The American Heritage Dictionary of the English Language (3d ed. 1992);

Timeline - 2a. A chronology. 2b. A representation or exhibit of key events within a particular historical period, often consisting of illustrative visual material accompanied by written commentary, arranged chronologically. The American Heritage Dictionary of the English Language (4th ed. 2000); and

Publishing - activity of preparing and producing material in printed or electronic form for distribution to the public.
<http://encarta.msn.com>.

In addition, she submitted excerpts of articles retrieved from the Nexis database and printouts of several webpages that contain the phrase "visual timeline." A representative sample are set forth below:

Within nine galleries, the show - taken from the exhibition at Althorp, the former Lady Diana

Spencer's ancestral home in Northampton, England - is a visual timeline of Diana's life, starting with childhood photos and home movies and culminating with the trappings more associated with the woman whose beauty, charm and humanitarian works captivated a generation. "The Lexington Herald Leader" (March 19, 2006);

The second disc's extras include still-frame art galleries, a visual timeline of Disney events from 1941 to 1945, a vintage 1956 "Disneyland" TV show "A Day in the Life of Donald Duck," and a 10-minute, well-deserved tribute to the "Good Duck Artist" creator Carl Barks... "The Washington Times LLC" (January 14, 2006);

The green, purple and gold markers were in high demand in Hensel's classroom last week as students worked together on visual timelines depicting the history of the annual celebration. "St. Petersburg Times (Florida)" (March 1, 2006);

Wilkinson, who now lives in Florida, primarily works on murals. He recently finished one that wraps around the center's first-floor ballroom, a visual timeline of Suffolk that starts with the city's colonial days. "Daily Press (Newport News, Virginia)" (September 7, 2006);

In spite of the book's title, the timeline section itself is limited to 16 pages only. The purpose of a visual timeline as a tool for tracing stylistic change is somewhat limited by such cursory treatment. "TSL Education Limited" (February 24, 2006);

Phillip Lessen has put together an interesting visual timeline of Google's homepage and the expansion of its services at Google Blogoscoped with screen captures of archived Google.com pages in the Internet Archive's Wayback Machine. "Yahoo Visual Timeline 1996-2006" searchenginejournal.com; and

San Diego Chargers ... Uniforms Visual Timeline ... The following images have been compiled by

San Diego Chargers super fan ...
www.chargers.com/history/uniforms-visual.

Based on this evidence, she concludes that "visual timeline" is generally understood by the public to mean "a visual or pictorial presentation of chronologies or events." Br. p. 10.

The examining attorney also submitted several third-party registrations for computer software that include the word PUBLISHING which is disclaimed. This evidence indicates the common use of the word PUBLISHING in the computer software field and the USPTO's treatment of it as being descriptive in that field.

The examining attorney contends that taken together the words VISUALTIMELINE PUBLISHING "immediately describe the purpose of the applicant's software, which is to create pictorial chronologies of events for electronic publication." November 24, 2006 Office Action p. 2.

The record in this case clearly supports a finding of mere descriptiveness of the phrase VISUALTIMELINE PUBLISHING. As noted above, we determine the descriptiveness of a term in the context of the goods or services at issue, not in the abstract. In re Chopper Industries, 222 USPQ 258 (TTAB 1984); In re Bright-Crest, Ltd., supra. Here, the goods are identified as "computer

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software for creating visual timelines." Thus, the mark immediately informs the consumer purchasing the software that it allows the consumer to create a visual timeline. Further, as shown by the third-party registrations, the addition of "publishing" in the context of computer software is similar to the addition of "publishing" to a book publisher's mark (e.g., Random House Publishing Group) which has no source-indicating significance. See e.g., Reg. No. 2524048 for the mark LEXIS PUBLISHING owned by Reed Elsevier Properties Inc., for, inter alia, computer software featuring word processor programs; and Reg. No. 2668176 for the mark PERMANENT PUBLISHING owned by Everest Domain Services, for, inter alia, computer database management software for accepting electronic information via a web-site on a global computer network.

We cannot agree with applicant that the examining attorney has improperly dissected the mark in her analysis. It is appropriate to analyze the separate terms and then to view the mark in its entirety to understand whether the separate terms retain their descriptiveness or are transformed into a unique or incongruous combination. As expressly stated in the June 30, 2006 Office Action, the examining attorney made a conclusion regarding the mark as a whole.

Applicant relies on *In re The House Store Ltd.*, 221 USPQ 92 (TTAB 1983), in support of its position that its proposed mark is "too broad to describe [applicant's] related goods with particularity," noting that goods and services that may be described by VISUALTIMELINE PUBLISHING include "hardware for printing timelines, books having timelines included therein, and authors who publish timelines." Applicant concludes that the proposed mark "is too broad to describe [applicant's] goods with immediacy and particularity." Br. p. 13.

In *The House Store*, the Board found that the phrase THE HOUSE STORE was suggestive of retail store services in the field of furniture and housewares. In making its finding, the Board found STORE to be an apt or descriptive term for the services but found "a hint of incongruity and fancy in the designation" HOUSE based on its broad connotation which suggested a number of possibilities (furniture stores, appliance stores, linen and drapery stores etc.) rather than describing something "directly related to a house as such." Id. 93. Here, the word PUBLISHING, in applicant's mark, is more akin to STORE in *The House Store* and does not create an incongruity. Moreover, unlike the word HOUSE which conveyed a broader connotation in the context of the recited services, the

compressed phrase VISUALTIMELINE has a specific connotation, "a visual or pictorial presentation of chronologies or events."

As to the argument that the proposed mark may describe other goods and services, such as hardware or books, and that it does not immediately convey that the goods include computer software, as noted above, the determination of whether a mark is merely descriptive is considered in relation to the identified goods, not in the abstract. *Abcor*, 200 USPQ at 218. In other words, the question is not whether someone presented only with the mark could guess what the goods are. Rather, the question is whether someone who knows what the goods are will understand the mark to convey information about them. In *re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002); In *re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); In *re Home Builders Association of Greenville*, 18 USPQ2d 1313, 1327 (TTAB 1990); In *re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). Accordingly, when viewing VISUALTIMELINE PUBLISHING as a whole, we find the evidence of record sets forth a prima facie case that such phrase is merely descriptive. Thus, we are persuaded that when applied to applicant's goods, VISUALTIMELINE PUBLISHING immediately describes, without need for conjecture or

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speculation, a significant feature or function of applicant's goods. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for prospective consumers of applicant's goods to perceive readily the merely descriptive significance of VISUALTIMELINE PUBLISHING as it pertains to applicant's goods.

Decision: The refusal to register under Section 2(e)(1) is affirmed.