

Mailed:03/16/05
2005

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

March 16,

GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Reaction Design**

Serial No. 76460914

Stacy L. Taylor and Michael A. Whittaker of **Foley & Lardner LLP** for **Reaction Design**.

James T. Griffin, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before **Hohein, Walters and Holtzman**, Administrative Trademark Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

Reaction Design has filed an application to register the term "REACTION DESIGN" for "computer software, namely[,] programs delivered on media such as CD-ROMs and via electronic communications networks for chemical reaction simulations, chemical kinetics simulations, and chemical flow simulations; and user manuals and instructions sold as a unit with the above" in International Class 9; "training in the use and operation of software for chemical reaction simulations, chemical kinetics simulations, and chemical flow simulations" in International Class 41; and "consultation in the field of modeling chemical

reactions, chemical kinetics, and chemical flows; [and] consultation in the field of incorporating software for chemical reaction simulations, chemical kinetics simulations, and chemical flow simulations into other software environments" in International Class 42.¹

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that, when used in connection with applicant's goods and services, the term "REACTION DESIGN" is merely descriptive thereof.

Applicant has appealed. Briefs have been filed,² but an oral hearing was not requested. We affirm the refusal to register.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d

¹ Ser. No. 76460914, filed on October 22, 2002, which is based on an allegation of dates of first use anywhere and in commerce of January 1, 1997 for the goods and January 1, 1996 for the services.

² As stated in his brief, "the examining attorney ... notes that the additional search engine printouts attached to the applicant's appeal brief, showing a printout date of September 13, 2004, are untimely, and the examining attorney accordingly objects to the Board's consideration of this evidence." Inasmuch as the Examining Attorney's objection is well taken, the objection is sustained and the additional evidence attached to applicant's brief has not been considered. Trademark Rule 2.142(d). It should also be pointed out, however, that even if such evidence, which is basically more of that which applicant properly made of record with its request for reconsideration of the final refusal, were to be considered, it would make no difference in the result herein.

1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, 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 such use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

Applicant contends in its brief that "[t]he term REACTION DESIGN simply does not in any way describe computer software, consulting, and training services in relation to chemical synthesis." According to applicant, "[t]he development and implementation of chemical reactions is typically referred to as either 'chemical synthesis' or, more broadly, as 'reaction engineering.'" Citing, in particular, the results of webpages located by its search of the term "reaction engineering" (rather than "reaction design") using the "Google" search engine,

applicant asserts that such evidence not only shows "[e]xtensive use of the ... phrase in the chemical industry to refer to processes for development of chemical reactions," but that:

Notably, not a single one of the references identified in the ... webpages utilizes the term "reaction design." Therefore, it is clear that the art considers the accepted term for development of chemical reactions to be "reaction engineering" and not "reaction design", and so would not recognize the latter phrase as referring to such processes.

Citing, in addition, definitions from Webster's II New College Dictionary (1999) of (i) the word "reaction," which is listed as noun meaning, among other things, "4. A chemical transformation in which a substance decomposes, combines with other substances, or interchanges constituents with other substances," and (ii) the word "design," which is variously defined, *inter alia*, as a verb meaning "2. To form a plan for <designed a marketing strategy>" and as a noun connoting "6. A project or plan,"³ applicant insists that, [a]s seen from the ... definitions of the words REACTION and DESIGN, none of these definitions are used to describe or suggest computer software, consulting or training services of the kinds offered by Applicant." Instead, applicant maintains, at best "the word

³ While the definition of "reaction" was made of record with its response to the initial Office Action, the definition of "design" was furnished only as an attachment to applicant's appeal brief and thus is technically untimely under Trademark Rule 2.142(d). Nevertheless, inasmuch as the Examining Attorney in his brief has not objected thereto, and since in any event it is settled that the Board may properly take judicial notice of dictionary definitions, we have considered such definition. *See, e.g.,* Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ

REACTION or the words REACTION DESIGN apply to many categories of goods and services that are designed but that does not make the word(s) descriptive of any such goods [or services]."

As a final consideration, applicant argues that the term "REACTION DESIGN" "simply does not immediately convey specific information about Applicant's ... computer software, consulting or training services." Reiterating its contention that "[t]he term itself is not one that is used in the chemical arts," applicant asserts with respect to the evidence furnished by the Examining Attorney that:

Indeed, the only use of the phrase "reaction design" in relation to chemical synthesis [which was] identified by the Examining Attorney was in a single news story (press release of 6/24/03), and even that was not a direct quote from the chemist being interviewed. As such, there is no evidence of record to indicate that the phrase is used in the chemical industry, or would be understood by consumers for Applicant's product [and services] as having any established meaning relevant to Applicant's products [and services].

The Examining Attorney, on the other hand, takes the position that the term "REACTION DESIGN" "immediately describes the purpose and intended use of the [applicant's] software and services, i.e. that they can be used in the design of chemical reactions." Relying on dictionary definitions which he made of record from The American Heritage Dictionary of the English Language (4th ed. 2000), which in relevant part list the word "design" as a verb meaning, among other things, "2. To plan out

505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 n. 7 (TTAB 1981).

in a systematic, usually graphic form: *design a building; design a computer program,*" the Examining Attorney urges that:

Applicant's software for chemical reaction simulations, chemical kinetics simulations, and chemical flow simulations allows a user to "design," or "plan out in systematic, usually graphic form," such reactions. As such, the [applicant's] mark is merely descriptive of the goods. Likewise, the mark is descriptive of services involving reaction design software, namely, training in the use of such software and consulting regarding such software.

With respect to applicant's argument that "the common term for the goods/services is 'reaction engineering' rather than 'reaction design,'" the Examining Attorney contends that the "printouts of several pages of 'hits' from the Google search engine showing usage of the term 'reaction engineering'" is not probative evidence that the term "REACTION DESIGN" is lacking in descriptive significance. In particular, the Examining Attorney maintains that:

[S]ince the actual text of the web pages that these hits link to was not included, it is unclear what the term "reaction engineering" means. The examining attorney submits that the search engine report fails to show that "reaction engineering" is the proper term to refer to the applicant's goods and services. Rather, it simply demonstrates the existence of the term.

In contrast, the Examining Attorney insists that he "has shown via printouts from the Lexis-Nexis database and via evidence from the Internet (both attached to the final refusal) that 'reaction design' is an industry term and that other entities are involved in the design of reactions or the creation

of software for reaction design." Of the excerpts made of record, the following are particularly relevant (emphasis added):

"[CEM Corporation and Synthematix] Inc. announced today that they have entered into a strategic alliance to co-develop a software platform based on Synthematix's Arthur Suite(TM) of reaction planning tools and CEM's ChemDriver(TM) reaction monitoring software for its line of systems designed for microwave-enhanced life science applications.

The software package will be the first tool to truly provide the market a combination of database, search engine, **reaction design**, and instrument control package. The software package will be designed to function as electronic institutional memory for the chemistries developed within an organization over time."
-- PR Newswire, October 27, 2003;

"Dr. Charette has distinguished himself in the area of asymmetric processes. He has also devised conceptually novel approaches to catalyst and **reaction design** with important applications in alpha-chiral amine synthesis and piperidines which are important subunits of bioactive compounds."
-- PR Newswire, June 24, 2003; and

"reaction design

In addition to making new molecules, sometimes we are interested in making new **reactions**. In some cases we are trying to **design** unique catalysts to help carry out difficult transformations. In other applications we are trying to control specificity through intermolecular cooperativity. We are tackling some important synthetic processes, reinventing ways of performing functional group transformations within the framework of Green Chemistry." -- website of the "Center for Green Chemistry," undated, which also sets forth the term "reaction design" in a list of topics which includes "solar energy devices"; "non-covalent derivatization"; "polymer chemistry"; "medicinal chemistry"; and "educational research."

According to the Examining Attorney, inasmuch as "[a]ll of this shows that 'reaction design' is a common industry term to refer to design of chemical and other types of reactions," and "[s]ince applicant's software performs this function, and applicant's services involve teaching and consulting about reaction design and reaction design software, the [applicant's] mark is merely descriptive of the goods and services."

Finally, "[a]s further evidence that applicant intends its software and services to be used in [the] design of chemical reactions," the Examining Attorney made of record "several printouts from applicant's own web site." One of such excerpts, we observe, provides the following information concerning applicant's goods and services:

In an industry dominated by competitive process technologies, kinetic modeling is essential in streamlining research and development. To improve yield while avoiding unwanted by products and prolonging catalyst life, Reaction Design's powerful software tools and consulting services offer a state-of-the-art engineering approach. Whether we develop customized kinetic models of your existing facility, apply reactor modeling toward optimizing plant operation, or develop models for use in the design of new facilities, we help our customers succeed in the global chemical industry.

....
Consulting services can range from development of custom CHEMKIN models or chemical mechanisms to development of system-level models that point out key areas for improvement and can be maintained onsite for continued use.

Another such excerpt, we note, sets forth the following "Company information" about applicant and its business:

Reaction Design, Inc. is the exclusive developer and distributor of CHEMKIN, the de

facto standard for modeling of gas and surface-phase chemistry. Today, as both a software developer and a services provider, we focus on reactor and combustor design and improvement. Our world-class engineers, chemists, and programmers have expertise that spans multi-scale engineering from the molecule to the plant. We incorporate our reactor models into our customers' design environments, drawing on our experience with a variety of simulation tools, and reaction chemistries.

....
We remain committed to the development of a comprehensive and easy-to-use set of software simulation tools, and also to providing expert consulting services to companies in order to deliver software-based solutions to specific chemical process problems. These software products and consulting services help our over 150 government and industrial customers develop better products faster, at lower costs, and with minimized impact on the environment.

The Examining Attorney, in addition, notes in particular that a third excerpt states that applicant "provides 'better reactions, by design'" and maintains, as to a fourth excerpt which bears the caption "Background," that such "indicates that the applicant markets, supports, enhances and expands the CHEMKIN software which aids in 'the design of processes that utilize chemical reactions.'" He concludes that "REACTION DESIGN, therefore, is clearly merely descriptive of software that aids in the design of chemical reaction processes."

Upon consideration of the evidence and arguments presented,⁴ we agree with the Examining Attorney that, when

⁴ We note that applicant has not criticized the evidence offered by the Examining Attorney on the ground that some of the excerpts are of limited probative value because their source is a wire service rather than a trade journal or other technical publication directed to the field of commercial and industrial chemical processes. See, e.g., In re Appetito Provisions Co. Inc., 3 USPQ2d 1553, 1555 (TTAB 1987) at n.

considered in its entirety, the term "REACTION DESIGN" is merely descriptive of applicant's "computer software ... for chemical reaction simulations, chemical kinetics simulations, and chemical flow simulations ..." as well as its "training [services] in the use and operation of" such software and its "consultation [services] in the field of modeling chemical reactions, chemical kinetics, and chemical flows [and] in the field of incorporating software for chemical reaction simulations, chemical kinetics simulations, and chemical flow simulations into other software environments." Specifically, it is clear from the record that, as contended by the Examining Attorney, "applicant's software and services are intended for use in designing chemical reactions" for industrial and commercial applications. The term "REACTION DESIGN" immediately conveys, without speculation or conjecture, that the purpose or subject matter of applicant's goods and services is the design of chemical reactions. Nothing in such term is incongruous, ambiguous or suggestive, nor is there anything which would require the exercise of imagination, cogitation or mental processing, or necessitate the gathering of further information, in order for the merely descriptive significance thereof to be readily apparent to customers and users of applicant's goods and services. Instead, to chemists, chemical engineers and others involved in designing, modeling

6 and *In re Men's Int'l Professional Tennis Council*, 1 USPQ2d 1917, 1918-19 (TTAB 1986). Nonetheless, in light of the ready availability of the Internet, we find that the wire service excerpts relied upon by the Examining Attorney are of some probative value in that they are indicative of the significance of the term "REACTION DESIGN" to at least those who write about developments in the field of chemical

and/or simulating of chemical reactions, the term "REACTION DESIGN" conveys forthwith that applicant's software, training services and consultation services are for use in the field of chemical reaction design.

Moreover, as to applicant's argument that "[t]he development and implementation of chemical reactions is typically referred to as either 'chemical synthesis' or, more broadly, as 'reaction engineering,'" suffice it to say that even if, for instance, potential competitors of applicant are able to describe or advertise the same or similar goods and services by terms other than "REACTION DESIGN," that does not mean that such term is not merely descriptive of applicant's goods and services. See, e.g., *Roselux Chemical Co., Inc. v. Parsons Ammonia Co., Inc.*, 299 F.2d 855, 132 USPQ 627, 632 (CCPA 1962). Thus, even if applicant is in fact the first and/or only user of the term "REACTION DESIGN" in connection with its software and training and consultation services, it is well settled that such does not entitle applicant to the registration thereof where, as here, the term has been shown only to immediately convey a merely descriptive significance in the context of applicant's goods and services. See, e.g., *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018, 1020 (TTAB 1983); and *In re Mark A. Gould, M.D.*, 173 USPQ 243, 245 (TTAB 1972).

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

reaction design. See, e.g., *In re Cell Therapeutics Inc.*, 67 USPQ2d 1795, 1797-98 (TTAB 2003).