THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB   SEPT 29,98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
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Trademark Trial and Appeal Board
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In re Open Software Associates, Inc.
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Serial No. 74/672,042
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Michael J. Bevilacqua of Hale and Dorr for Open Software
Associates, Inc.

Cheryl S. Goodman, Trademark Examining Attorney, Law Office 102
(Myra Kurzbard, Managing Attorney).
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Before Simms, Hanak and Hohein, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

        Open Software Associates, Inc. has filed an application
to register the term "OPENMESSAGE" for a "feature of a computer
program for use in developing applications programs which
provides for the sending and receiving of data records over a
network".[1]

        Registration has been finally refused under Section
2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis

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[1] Ser. No. 74/672,042, filed on May 10, 1995, which alleges a bona fide
intention to use the term.

that, when used in connection with applicant's goods, the term "OPENMESSAGE" is merely descriptive of them.

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

Applicant, noting that the Examining Attorney "has provided a number of excerpts from the LEXIS®/NEXIS® database showing various usages of the term 'MESSAGE', together with dictionary definitions for that term and the term 'OPEN',"[2] argues that "[w]hat these materials do not show however, is any indication that the phrase 'OPENMESSAGE' is ever used in reference to the specific type of software [feature] which is identified by appellant's mark." Applicant further asserts, without having furnished any additional evidentiary support therefor, that "each of the terms 'OPEN' and 'MESSAGE' is frequently used in a variety of different contexts and in connection with a number of different types of products and services." Contending that "[b]ecause these terms do not specifically refer to the type of product offered by Appellant and have so many varied meanings, a mark comprising them is, by definition, ambiguous," applicant accordingly maintains that:

> Given this ambiguity, potential purchasers
> confronting Appellant's mark would not be
> able to immediately discern that that mark is
> used in connection with a computer program
> feature. Only through exposure to and
> investigation of the goods themselves would
> potential purchasers understand the nature of
> the goods.

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[2] The "NEXIS" excerpts, it should be pointed out, also show usages of the term "OPEN" in conjunction with the word "MESSAGE".

In view thereof, applicant insists that the term "OPENMESSAGE" is "at most suggestive" of its goods.

The Examining Attorney, on the other hand, contends that the term "OPENMESSAGE clearly identifies [a] software [feature] which develops applications programs [and] that sends and receives data across open systems or multiple hardware and software platforms." As such, the Examining Attorney urges that the term "OPENMESSAGE [is merely descriptive since it] identifies a use, purpose or feature of the [applicant's] goods." In support of her position, the Examining Attorney relies upon, inter alia, the following definitions of record from The Computer Glossary (7th ed. 1995):

> **"open,"** which among other things is listed at 279 as meaning "(3) Made to operate with other products";
>
> **"open system,"** which is set forth at 280 as referring to "[a] vendor-independent system that is designed to interconnect with a variety of products"; and
>
> **"message,"** which is defined at 245 as signifying, "[i]n communications, a set of data that is transmitted over a communications line. Just as a program becomes a job when it's running in the computer, data becomes a message when it's transmitted over a network."

Moreover, as an aid to understanding her position, the Examining Attorney has made of record a definition of the following term from the Random House Personal Computer Dictionary (2d ed. 1996) (*italics in original*):

> **"platform,"** which is defined at 413 as "[t]he underlying hardware or software for a system. ...."

The platform defines a standard around which a system can be developed. Once the platform has been defined, software developers can produce appropriate software and managers can purchase appropriate hardware and applications.

The term cross-platform refers to applications, formats or devices that work on different platforms. For example, *a cross-platform programming environment* enables a programmer to develop programs for many platforms at once."

The record also contains various excerpts of articles from the "NEXIS" database, of which the following are particularly pertinent (**emphasis added**):

"Provides **open message** exchange across enterprise networks and the internet." -- Digital News & Review, December 4, 1995.

"... unified messaging architecture, if the voice mail systems open up to client APIs for LAN access and move toward **open message** transport protocols like MIME and the ITU x.400 series. These protocols could enable servers to directly exchange messages ...." -- Business Communications Review, January 1995;

"It will now be used as a generic and **open message** handling system, as a platform upon which potential clients, application providers and system integrators can layer specific functionality, and as a communications platform for connecting legacy applications ...." -- Digital News & Review, December 20, 1993 (article headlined in part: "Incotel buys LAN messaging technology");

"Lotus ... is promoting its **Open Message** Interface, and Microsoft its equivalent, the Microsoft Application Programming Interface." -- CommunicationsWeek, February 10, 1992;

"... begin promoting what they hope will become a de facto messaging standard, delivering a set of common application programming interfaces (APIs) -- tentatively called **open message** interface (OMI) -- for Lotus' Notes and cc:Mail and IBM's

OfficeVision/2 LAN, officials said." -- <u>PC
Week</u>, August 19, 1991; and

"Eventually, the x.400 electronic-mail
standard will provide for **open message**
exchange between different E-mail systems."
-- <u>PC Week</u>, May 22, 1990.

In light of the above, the Examining Attorney asserts that the
term "OPENMESSAGE" merely describes "a feature of applicant's
computer software for developing applications program[s], namely,
sending and receiving data over networks across multiple
platforms."

With respect to applicant's essentially unsupported
contention that the terms "OPEN" and "MESSAGE" have varied
meanings and hence a mark which combines such terms is inherently
ambiguous rather than merely descriptive, the Examining Attorney
correctly observes that:

The registration of a term created by
combining two or more [otherwise]
unregistrable words depends on whether[,] in
combination, a new and different commercial
impression is created, and/or the term so
created imparts a bizarre or incongruous
meaning as used in connection with the goods.
In re Associated Theatre Club[s] Co., 9
USPQ2d 1660 (TTAB 1988); *In re Metcal Inc*., 1
USPQ2d 1334 (TTAB 1986); *In re Quik-Print
Copy Shop, Inc*., 205 USPQ2d 505(CCPA 1980)[.]
The combination of two descriptive words may
result in nothing more than the combination
of two descriptive words. *In re IBP, Inc*.,
228 USPQ 303 (TTAB 1985); *In re Wink Corp*.[,]
218 USPQ 739 (TTAB 1983); *In re Quik-Print
Copy Shop, Inc*., 205 USPQ 505 (CCPA 1980).
Where the combination of two descriptive
words creates no incongruity, and no
imagination is required to understand the
nature of the goods, the mark remains merely
descriptive. *In re Associated Theatre Clubs
Co*., 9 USPQ2d 1660 (TTAB 1988); *In re Gould
Paper Corp*., 5 USPQ2d 1110 (Fed. Cir. 1987);
In re Orleans Wines, Ltd., 196 USPQ 516 (TTAB

> 1977); *In re Scholastic Testing Service,*
> *Inc*., 196 USPQ 517 (TTAB 1977); *In re*
> *MBAssociates*, 180 USPQ 338 (TTAB 1973).

The Examining Attorney insists that, in this case, the two descriptive terms "OPEN" and "MESSAGE" are "known computer terms which are in common usage in the [software] trade," as evidenced by the dictionary definitions and "NEXIS" excerpts of record, and that "the combination of the terms OPEN and MESSAGE do not create a bizarre or incongruous meaning in connection with computer software for developing applications programs." Instead, the Examining Attorney maintains that the combined term "OPENMESSAGE" merely describes the open message feature of applicant's goods which is used in sending and receiving of data records over a network, including the deployment thereof for use with other vendors' products and/or across multiple hardware or software platforms.

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 an immediate idea of any ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 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 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 its 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).

In the present case, it is our view that, when applied to a feature of a computer program for use in developing applications programs which provides for the sending and receiving of data records over a network, the term "OPENMESSAGE" would be regarded by the systems analysts, software engineers and computer programmers who would constitute the principal purchasers and/or users of such goods as immediately describing, without any conjecture or speculation, a significant feature or purpose of applicant's goods. To such highly knowledgeable and technically trained purchasers and users of applicant's goods, there is nothing in combining the terms "OPEN" and "MESSAGE" into the term "OPENMESSAGE" which is bizarre, incongruous, indefinite or ambiguous, especially when viewed in the context of applicant's goods.

In particular, the fact that in the computer software industry, the term "MESSAGE" connotes, with respect to communications, a set of data (e.g., data records) that is

transmitted (i.e., sent and received) over a communications line (e.g., a computer network) means that, when coupled with the widely known and familiar term "OPEN," which signifies a system that is made to operate or interconnect with other products, there simply is nothing which requires the exercise of imagination, cogitation, mental processing or necessitates the gathering of further information in order for the merely descriptive significance of the combined term "OPENMESSAGE" to be immediately perceived. Clearly, to the purchasers and users of applicant's goods, such term readily conveys that a principal function or purpose of the feature of applicant's computer program for use in developing applications programs is to provide an open message capability in those programs which provides for the sending and receiving of data records over a network. Stated otherwise, an "OPENMESSAGE" feature of a computer program for use in developing applications programs which provides for the sending and receiving of data records over a network is one which can be used to enable computer programs written therewith to transmit messages openly, that is, the data sets which are sent and received can be from a variety of vendors' products and/or can operate on different hardware or software platforms within a network. As the dictionary definitions and "NEXIS" excerpts make plain, the combination of the descriptive terms "OPEN" and "MESSAGE" into the designation "OPENMESSAGE" results in a term which has the same meaning which ordinary usage in the trade would ascribe to the individual terms in combination. See, e.g., In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed.

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Cir. 1987) [term "SCREENWIPE," formed from combination of words "SCREEN" and "WIPE," is unregistrable for a "pre-moistened, anti-static cloth for cleaning computer and television screens"].

   Accordingly, because the term "OPENMESSAGE" forthwith conveys that a significant function or purpose of applicant's goods is the open message capability or feature which its software creates in the applications programs which its computer program develops, such term is merely descriptive within the meaning of the statute.

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

         R. L. Simms

         E. W. Hanak

         G. D. Hohein
         Administrative Trademark Judges,
         Trademark Trial and Appeal Board