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Paper No. 12
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Philips Electronics North America Corporation

Serial No. 75/673,321

Gregory L. Thorne for Philips Electronics North America Corporation.

Ellen Awrich, Trademark Examining Attorney, Law Office 113
(Meryl Hershkowitz, Managing Attorney).

Before Hairston, Bucher and Holtzman, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Philips Electronics North America Corporation has appealed from the final refusal of the Trademark Examining Attorney to register EDITSTREAM as a trademark for "a computer-based networked audio-video editing system, comprising computer software and hardware for the recording, editing and playback of digital and analog

audio/video media."¹ Registration has been refused pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C.

§1052(e)(1), on the ground that the applied-for mark is merely descriptive of the goods.

We affirm the refusal to register.

A mark is considered to be merely descriptive, within the provisions of Section 2(e)(1), if it directly conveys information regarding the ingredients, qualities, characteristics, function, purpose or use of the goods. In re Abcor Development Corp., 616 F.2d 525, 200 USPQ 215 (CCPA 1978). See also In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) [A mark is merely descriptive if it "immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods with which it is used"].²

The Examining Attorney has submitted definitions of "edit" as meaning "to prepare (written material) for publication or presentation, as by correcting, revising, or adapting; to prepare an edition of for publication; to

¹ Serial No. 75/673,321, filed April 2, 1999, asserting a bona fide intention to use the mark in commerce.

² Applicant cites Ex parte Heatube Corporation, 109 USPQ 423 (Com'r. Pats. 1956) for the test for determining if a mark is merely descriptive. In the 40 years since that case was decided, the test for determining mere descriptiveness has evolved, and we therefore quote the test set forth above by our primary reviewing court, a test which we are, in any case, constrained to follow.

modify or adapt so as to make suitable or acceptable"³ and "stream" as meaning "a contiguous group of data."⁴ The Examining Attorney asserts that the words individually describe the use of applicant's goods, which edit a stream of audio and video data. Further, the Examining Attorney submitted a number of excerpts from the NEXIS data base which refer to the editing of video, audio and data streams. The following are representative examples:

When used with certain specially coded software packages, this machine lets you input multiple **streams** of video, **edit** them with various effects, then output them in real time.
(PC Magazine; July 1, 1999);

Premier or Speed Razor with Matrox DigiSuite or DigiSuite ie cards allows users to **edit** two **streams** of DI video up to uncompressed quality with 32-bit animated graphics in realtime.
(Playback; January 11, 1999);

. . . software that lets you record, **edit**, and play back MIDI music, track a logical or physical entity that lets you record and **edit** an audio **stream** independent of the content of other tracks.
(Windows Sources; October 1995); and

In addition to the hardware, C-Cube will provide editing software able to input, convert, **edit**, and save the video **streams**.
(Techweb News; October 30, 1998).

³ The American Heritage Dictionary of the English Language (3d. ed. 1992).

⁴ Tech Encyclopedia, www.techweb.com.

When the two descriptive words EDIT and STREAM are combined in the mark EDITSTREAM, we agree with the Examining Attorney that the mark as a whole is merely descriptive of "a computer-based networked audio/video editing system, comprising computer software and hardware for the recording, editing, and playback of digital and analog audio/video media." That is, the relevant purchasers upon seeing this mark in connection with the goods will immediately understand that the goods are used to edit streams of audio and video data. Applicant's own brochure describes its system as "allow[ing] the editor to begin screening and editing incoming media within 5 seconds of the start of capture."⁵

Applicant argues that the mark is only suggestive because the word "stream" has additional definitions which have no relation to a networked computer-based system. In particular, applicant points to the definitions of the word "stream" which relate to water. Further, in this regard, applicant argues that the mark EDITSTREAM is in fact intended to bring about the suggestion of water because it is part of a group of products, each of which has a water

⁵ Although applicant based its application on an intent-to-use the mark, during the course of prosecution applicant submitted product brochures. We note, however, that applicant has not filed an amendment to allege use.

theme, namely MediaPool, Surf, and Wave. According to applicant, these are a related group of products which it offers for sale.

It is well-established that the determination of mere descriptiveness must be made not in the abstract or on a guesswork basis, 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 Recovery, Inc.*, 196 USPQ 830 (TTAB 1977). When applicant's mark is considered in connection with the identified goods, it is the meaning of "a contiguous group of data" that purchasers will ascribe to STREAM, and not such definitions as "a body of water flowing in a channel on the surface of the ground, in a cavern below the surface, or beneath or in a glacier," "brook, rivulet," or "an outpouring of a fluid from a source or container." Also, as noted by the Examining Attorney, purchasers may not necessarily be aware of applicant's other "water-themed" products when they encounter the involved goods.

Accordingly, we find that applicant's applied-for mark, EDITSTREAM, is not incongruous, creates no double entendre, and does not create or present a commercial

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impression or meaning other than the editing of audio and video streams of data.

Further, applicant's argument that the mark is not merely descriptive because the term is not used by anyone else is not well taken. A merely descriptive term used first or only by one party is no less descriptive because of its limited use, nor is it registrable as long as the relevant public perceives of the term as describing the goods.

Decision: The refusal to register is affirmed.

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