

Oral Hearing:

January 7, 1998

Paper No. 18

GDH/cj

THIS DISPOSITION IS NOT

CITABLE AS PRECEDENT OF THE TTAB

NOV. 18, 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 Canon Kabushiki Kaisha

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Serial No. 74/631,952

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Dolores Moro-Grossman, Pasquale A. Razzano and William J. Burnet  
of Fitzpatrick, Cella, Harper & Scinto for Canon Kabushiki  
Kaisha.

Peter Cataldo, Trademark Examining Attorney, Law Office 103  
(Michael Szoke, Managing Attorney).

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Before Simms, Seeherman and Hohein, Administrative Trademark  
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Canon Kabushiki Kaisha has filed an application to  
register the term "MULTIPASS," in the stylized form shown below,

as a trademark for "facsimile machines connectable to personal  
computers and having printer function, scanner function and  
copying function and their accessories[,] namely[,] driver  
software therefor."<sup>1</sup>

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<sup>1</sup> Ser. Number 74/631,952, filed on February 9, 1995, which alleges a  
bona fide intention to use such term in commerce.

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

Applicant has appealed. Briefs have been filed<sup>2</sup> and an oral hearing was held. We affirm the refusal to register.

In support of his position, the Examining Attorney has made of record and principally relies upon various excerpts, of which the following are especially pertinent, from his searches of the "NEXIS" database (**emphasis added**):

"The BJ-200e, an enhanced version of the company's popular BJ-200 **printer**[,] features a **multipass** printing mode to eliminate banding ...." -- Computer Reseller News, February 28, 1994;

"C. Itoh announces two new bar-code **printers** featuring **multipass** ribbon cartridge design." -- MIDRANGE Systems, August 18, 1992;

"The CLC 500 uses a **multipass** indirect electrostatic process -- one pass for each color -- to print four colors ...." -- Byte, October 1991 (article headlined: "Color Laser **Printing**");

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<sup>2</sup> The Examining Attorney, in his brief, notes that "applicant has attached materials to its appeal brief and indicated that they are for review by the Board." While, pursuant to Trademark Rule 2.142(d), the Examining Attorney "objects to the introduction of any such materials and their consideration as part of the record" on the basis that "[i]t is well established that materials may not be submitted as evidence at the appeal stage and that untimely evidence will not be considered," the materials attached as exhibits to applicant's initial brief are merely duplicate copies, as applicant correctly points out in its reply brief, of the documents which it properly made of record with its timely request for reconsideration of the final refusal. Accordingly, the Examining Attorney's objection is overruled and we have considered such materials.

"Electrostatic **printing** and plotting tend to be large-format and based on one of three techniques: **multipass**, single pass or helical scan. With both single and **multipass**, the medium is roll-fed paper." -- Government Computer News, March 20, 1989;

"The printer's single-pass operation allows for more exact and stable alignment than that of **multipass printers**." -- InfoWorld, May 21, 1984;

"The unit can generate images with a resolution of up to 300 dots per inch, about twice that of the best **multipass** dot-matrix **printers**." -- Byte, March 1984;

"The Facit 4528T **printer** is a **multipass** unit ...." -- Computerworld, August 29, 1983;

"Model 358 is a dual-mode **printer** providing bidirectional draft, **multipass** correspondence quality **printing** and four-color or seven-color print capability." -- Computerworld, June 6, 1983;

"Facit, Inc. announced the Facit 4528 near letter-quality intelligent **printer**. It is a **multipass** unit which can print normal text, variable size matrix characters, pin graphics and nine-bar codes ...." -- Computerworld, May 23, 1983; and

"[T]he new unit has 18 wires staggered in a zigzag pattern to produce print quality about equal to that of **multipass** dot-matrix **printers** with 150-character/second speed of the original Paper Tiger model." -- Electronics, April 7, 1981 (article headlined: "One-pass matrix **printer** offers **multipass** quality").

The Examining Attorney, in view of such evidence, maintains that "the term 'multipass' is used to describe a function, feature or characteristic of printers and photocopiers" and thus is merely descriptive of applicant's goods. In particular, according to the Examining Attorney:

The evidence of record demonstrates that the term "multipass" merely describes printers and copiers that make more than a single pass over objects to be printed or copied. Applicant's goods perform the functions of printers and copiers. As such, MULTIPASS merely describes a significant function, feature or characteristic of the goods; namely, that they utilize multiple passes to perform printing and copying functions.

Moreover, to the extent that the evidence may be said to show, as argued by applicant, that the term "multipass" has specifically different meanings depending upon the goods in connection with which it is used, and that none of the "NEXIS" articles, in any event, utilizes such term to describe any aspects of applicant's goods, the Examining Attorney insists that:

It is not surprising that "multipass" appears in the several contexts pointed out by applicant given the technologically different types of printers and copiers identified in the articles and the multitude of purposes for which those goods are used. It is highly significant that the evidence of record indicates different types of printers and copiers have in common "multipass" functions, features and characteristics. The term "multipass" is thus not merely descriptive of a particular type of printer or copier. Rather, it merely describes a function, feature or characteristic of many types of printers and copiers [including products of the type offered by applicant].

Applicant, on the other hand, contends that the term "MULTIPASS" "is, at most, suggestive" as applied to its goods. According to applicant, "[t]he numerous articles cited by the Examining Attorney do not show common use of the term 'multipass' in association with goods of the type found in this application, but rather show use of the term to mean a variety of things

depending on the subject matter of the article ...." Moreover, although a copy thereof was not provided, applicant insists that:

The definition of "multi", according to Merriam Webster's Collegiate Dictionary (10th ed. 1993), is "many : multiple : much ...". The term "pass" has numerous definitions including: "move, proceed, go"; "to render a decision, verdict or opinion"; "a means ... by which a barrier may be passed or access to a place may be gained." Merriam Webster at pp. 848-49.

Applicant asserts, in view thereof, that "the prefix and suffix alone [in the term 'MULTIPASS'] are subject to more than one meaning and the connotations afforded their coupling are myriad," although it fails to mention any specific examples which would be plausible in the context of applicant's goods. Applicant further insists that "the Examining Attorney's own articles support Applicant's argument that the term 'multipass' is not descriptive" of its goods inasmuch as "[e]ach article provides a different definition of the term 'multipass' and[,] more significantly, none of the articles use[s] the term 'multipass' to describe the Goods of this application."

Applicant also maintains that "[s]ince imagination is required to associate the mark MULTIPASS (Stylized) with Applicant's Goods, it is unlikely that the combination MULTIPASS (Stylized) will be needed by Applicant's competitors to describe their respective products." In particular, applicant notes that it "has undertaken an investigation in the NEXUS [sic] database to uncover other uses of the term 'multipass'," using "the same search strategy provided with the excerpted articles attached to the Final Action," and that the search "uncovered a number of

articles not cited by the Examiner." Applicant maintains that such articles, as indicated by the following excerpts, "show that the subject Goods are not referred to as 'multipass' machines, but rather, are known in the trade as 'multi-function peripherals'" (**emphasis added**):

"When Canon, Ricoh, Okidata, and Xerox released **multifunction peripherals** a few years back, they seemed like a great idea: Tuck your fax machine, copier, printer, and scanner into one tidy box. The new units were spiffy, sexy, expensive--and a complete marketing flop. In a turn of events, the MFP (**Multifunction Peripheral**) is back with a vengeance, fueled by the growing SOHO (Small Office/Home Office) market and new product launches from major manufacturers.

This review examines four new MFP products aimed ... at the SOHO market. Brother, Canon, Hewlett-Packard, and Lexmark each produce computer controlled **multifunction machines** that offer five functions: plain-paper fax, PC fax, printer, copier, and scanner. ....

....  
The **MultipASS** 1000 is the newest and most complete member of Canon's **multifunction peripheral** family. Based on Canon's 360-dpi BubbleJet printer, the **MultipASS** boasts six functions. However, the sixth function is just the telephone handset. ....

We received a prerelease version of the Canon **MultipASS** 1000 and several updates to its componentry throughout the testing process. The final release is scheduled for mid-June." -- Byte, August 1995;

"You're setting up your own office. What equipment do you absolutely need? From the largest Fortune 500 company to the one-person home business, three functions are essential: printing, faxing, and copying. .... For a fraction of what you would spend to buy these tools individually, you can get a **multifunction device** (MFD) that combines a printer, fax machine, and copier, along with scanning and fax -modem features. Our Usability Labs staff put five MFD's through their paces: Lexmarks' Medley, Xerox's

Document WorkCenter 250, Brother's MFC-4500ML, Canon's **MultiPass** 100, and Hewlett-Packard's OfficeJet LX. ...." -- PC/Computing, January 1996; and

"They print; they fax; they copy; they scan. But is the new breed of **multifunction peripherals** good enough at everything--or anything--to meet your needs?

Now that small office has emerged as a major market, manufacturers are tripping over themselves looking for ways to target it. One of the more intriguing results is the **multifunction printer**: a gadget that typically combines a printer, fax machine, copier, and sometimes more in a single package. ....

....  
Be aware that there were several products that arrived too late for testing or were not shipping in time for this review. .... By the time you read this, the **MultiPass** 1000 should also be available; it will add scanning and faxing to and from the PC to the Canon repertoire. ...." -- PC Magazine, June 13, 1995.

Applicant, in support of its position, also submitted both an ad by "Egghead" which, in addition to advertising a "Scorpio ... single-pass color scanner," offers the "Canon MultiPASS 1000 6-in-1 Document Processing System!," and an ad by "TOPS" for a "brother MULTI-FUNCTION MACHINE". Applicant urges that "since the 'Brother' advertisement of record [for a printing and faxing unit similar to applicant's product] ... as well as the [other] articles submitted ... show that the industry refers to 'multi-function' machines or devices, MULTIPASS (Stylized) is clearly not necessary to describe these types of products."

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 immediately describes

an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See *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). Consequently, "[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 applicant's "facsimile machines connectable to personal computers and having printer function, scanner function and copying function and their accessories[, ] namely[, ] driver software therefor," the term "MULTIPASS" immediately describes, without conjecture or speculation, a significant feature or characteristic of applicant's goods, namely, that the printer, scanner and/or copying functions of its facsimile machines



utilize a multipass method or technique to print, scan and/or copy rather than, for instance, the "single-pass" scanning feature found in the "Scorpio" color scanner. The fact that the "NEXIS" excerpts furnished by the Examining Attorney show that, from a technological perspective, the term "multipass" can mean any number of passes other than the single pass employed in "one-pass" multifunction machines does not mean that such term is vague, ambiguous or otherwise so indefinite that it fails to precisely describe a significant feature or characteristic of applicant's goods. Like the words "single-pass" or "one-pass," there is nothing in the combination of the terms "MULTI" and "PASS" into the term "MULTIPASS" which is incongruous or otherwise subject, in the context of multifunction products such as applicant's facsimile machines for connection to personal computers, to a myriad of possible meanings.<sup>3</sup> Instead, the "NEXIS" excerpts unambiguously demonstrate that the term "MULTIPASS" is an established term in the trade for both a type of printer and kind of printing. Consequently, as applied to multifunction facsimile machines which, like applicant's goods, scan and copy in addition to printing, such term would retain its technical meaning irrespective of the actual number of scans or

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<sup>3</sup> We judicially notice, in this regard, that in relevant part The American Heritage Dictionary of the English Language (3d ed. 1992) at 1186 defines "multi-" as a prefix signifying "[m]any; much; multiple: *multicolor*" and at 1322 defines "pass" as a noun meaning "[a] single complete cycle of operations, as by a machine or computer program." It is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and *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 505 (Fed. Cir. 1983).

passes utilized in the printing or other reproduction processes performed by the machines.<sup>4</sup>

It is thus clear that, even among those ordinary consumer purchasers who may be relatively lacking in technological sophistication, there is nothing in the term "MULTIPASS" which requires that purchasers and/or users of applicant's goods either utilize imagination, cogitation or mental processing, or else gather further information, in order to perceive readily and precisely the merely descriptive significance thereof. The individual terms comprising the terminology "MULTIPASS" plainly have a meaning when combined which ordinary usage would ascribe to those terms in combination, and the fact that such term is not found in the dictionary is simply not controlling on the question of registrability. See *In re Gould Paper Corp.*, 824 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987) and *In re Orleans Wines, Ltd.*, 196 USPQ 516, 517 (TTAB 1977). Moreover, the fact that applicant may be the first and only user of the term "MULTIPASS" in connection with its multifunction facsimile machines does not justify registration when, as the "NEXIS" excerpts clearly show, such term is merely descriptive of the printing, scanning and/or copying functions of

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<sup>4</sup> While, as applicant argues, the "NEXIS" articles which it furnished illustrate that competitors in the marketplace for combination or multi-purpose printing, scanning and copying machines may not need the term "multipass" to describe such multifunction units, the term "multipass" is nevertheless used in the trade, as demonstrated by the "NEXIS" excerpts submitted by the Examining Attorney, to describe a key characteristic or feature of the printing, scanning and/or copying features of multifunction facsimile machines.

applicant's goods. See, e.g., In re National Shooting Sports Foundation, Inc., 219 USPQ 1018, 1020 (TTAB 1983).

Accordingly, because the term "MULTIPASS" conveys forthwith a significant feature or characteristic of applicant's "facsimile machines connectable to personal computers and having printer function, scanner function and copying function and their accessories[, ] namely[, ] driver software therefor," it is merely descriptive of such goods within the meaning of the statute. See, e.g., In re Pennzoil Products Co., 20 USPQ2d 1753, 1755-56 (TTAB 1991) [term "MULTI-VIS" held merely descriptive of multiple viscosity motor oil].

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

R. L. Simms

E. J. Seeherman

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