

6/4/02

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Paper No. 11
JQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Seiko Instruments Kabushiki Kaisha

Serial Nos. 75/879,291 and 75/879,294

Dana Breitman of Fross Zelnick Lehrman & Zissu for
applicant.

Wendy B. Goodman, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Cissel, Quinn and Hohein, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Applications have been filed by Seiko Instruments
Kabushiki Kaisha, also trading as Seiko Instruments, Inc.,
to register the marks MINILOGIC and MINIANALOG for, in each
instance, a "semiconductor, integrated circuit."¹

In each application the Trademark Examining Attorney
has refused registration under Section 2(e)(1) of the

¹ Application Serial Nos. 75/879,291 and 75/879,294,
respectively, filed December 23, 1999, and alleging in each case
a bona fide intention to use the mark in commerce.

Ser No. 75/879,291 and 75/879,294

Trademark Act on the ground that applicant's mark, if applied to the goods, would be merely descriptive thereof.

When the refusals were made final, applicant appealed. Applicant and the Examining Attorney have filed briefs. An oral hearing was not requested. Because of the substantially similar issues involved in these appeals, the Board will decide them in one opinion.

The Examining Attorney maintains that the marks MINILOGIC and MINIANALOG merely describe miniature logic semiconductors and integrated circuits and miniature analog semiconductors and integrated circuits, respectively. In support of the refusal, the Examining Attorney has relied upon dictionary definitions of the terms "mini," "semiconductors," "integrated circuits," "chips," "logic chip," and "analog"; excerpts of articles retrieved from the NEXIS database showing use of terms such as "logic chips," "logic semiconductors," "analog integrated circuits," "analog semiconductors," "analog chips," "miniature chips," and "mini chips"; and excerpts from applicant's Website describing applicant's goods sold under the respective marks.

Applicant contends that there are no such words as "minilogic" and "minianalog," in that the terms are coined and that, therefore, the marks are just suggestive of

Ser No. 75/879,291 and 75/879,294

semiconductors and integrated circuits. In support of its contention, applicant has relied upon several third-party registrations of marks including MINI and ANALOG formatives for goods listed in International Class 9, pointing out that these marks have been found to be inherently distinctive. Applicant asserts that the registrations raise doubt about the descriptiveness of the terms sought to be registered, and that the doubt must be resolved in applicant's favor.

It is well settled that a term is considered to be merely descriptive of goods, 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. 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 in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or feature about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods for which registration is sought. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

Ser No. 75/879,291 and 75/879,294

The term "mini-" (prefix) is defined as "small; miniature" and (noun) as "something, such as a minicomputer, that is distinctively smaller than other members of its type or class." *The American Heritage Dictionary of the English Language* (3rd ed. 1992).

The Examining Attorney also has introduced a variety of excerpts from *Tech Encyclopedia* (2000) showing various terms defined and described as follows. The term "integrated circuit" is defined as "[t]he formal name for the chip." The term "chip" is defined as "[a] set of microminiaturized, electronic circuits that are designed for use as processors and memory in computers and countless consumer and industrial products...The terms chip, integrated circuit and microchip are synonymous." The term "semiconductor" is described as "[a] solid state substance that can be electrically altered." The excerpts also show that there are various types of chips classified by function, including logic chips and analog chips. The NEXIS evidence includes references to "logic chips" and "analog chips" as types of chips.

Also of record are excerpts retrieved from applicant's Website wherein the following appears: "The new 'Mini logic Series' features one standard logic gate in a super small package...suitable for small portable equipment."

Ser No. 75/879,291 and 75/879,294

The Website also includes the following: "The mini analog series integrates [sic] a wide use analog circuit in an ultra-small package."

The NEXIS evidence highlights the existence of miniature semiconductors and miniature integrated circuits. The following excerpts are representative of the evidence.

Intel claims mini chips put power of PC in a notebook.
(*PC User*, October 24, 1990)

...an organization which promotes sales of foreign-made mini-chips in the Japanese market.
(*Journal of Commerce*, June 8, 1987)

...vast quantities of information stored on mini-chips...
(*Advertising Age*, May 25, 1998)

Some people fear that products containing microchips (miniature integrated circuits) will think it is 1900 rather than 2000...
(*Bangor Daily News*, December 31, 1999)

One invention alone--the transistor in 1948--replaced vacuum tubes in electronic circuits, which led to miniature integrated circuits, which opened the door to modern computers and space exploration.
(*Wisconsin State Journal*, December 31, 1999)

The maker of miniature chips said two patents were issued to a laboratory...
(*Sun-Sentinel*, January 11, 2000)

Is the trend towards miniature chip components becoming too hard to handle?
(*Electronics Times*, April 6, 1999)

Ser No. 75/879,291 and 75/879,294

Based on the evidence of record, we find that the marks sought to be registered are merely descriptive of mini logic semiconductors, mini logic integrated circuits, mini analog semiconductors and mini analog integrated circuits. Applicant's own Website shows that applicant's goods are logic and analog semiconductors and integrated circuits in a miniature size. Thus, no imagination would be necessary for the relevant purchasers in the integrated circuit and semiconductor industry to perceive precisely the merely descriptive significance of the terms MINILOGIC and MINIANALOG as they relate to important features of the goods, namely the type of chip (logic or analog) in miniature size. See: In re Abcor Development Corp., supra at 219 [Rich, J., concurring: "The name [of the product] is 'Gas Monitoring Badge.' This may be regarded as the *full* name. However, the users of language have a universal habit of shortening full names--from haste or laziness or just economy of words. Examples are: automobile to auto, telephone to phone, necktie to tie, gasoline service station to gas station. I regard it as *inevitable* that a gas monitoring badge will be called a gas badge as the name of the goods to the same extent as gas monitoring badge is the name..."] (emphasis in original).

Ser No. 75/879,291 and 75/879,294

The third-party registrations have been carefully considered, but this evidence does not compel a different result. We recognize that the Office has registered a variety of MINI and ANALOG formative marks. We also recognize, however, that none of the registrations is for either of the same marks involved herein; moreover, none of the registrations covers semiconductors or integrated circuits. In any event, this evidence is of little moment in deciding the present appeal. While uniform treatment under the Trademark Act is an administrative goal, our task in this appeal is to determine, based on the record before us, whether applicant's particular marks are merely descriptive. As often noted, each case must be decided on its own merits. We are not privy to the records in the cited registrations and, moreover, the determination of registrability of a particular mark by the Office cannot control the result in the cases now before us. See: *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to [applicant's application], the PTO's allowance of such prior registrations does not bind the Board or this court."].

The fact that applicant could be the first and/or only entity to use the specific terms MINILOGIC and MINIANALOG

Ser No. 75/879,291 and 75/879,294

in connection with semiconductors and integrated circuits is not dispositive where, as here, the terms unquestionably convey a merely descriptive connotation. In re Polo International Inc., 51 USPQ2d 1061, 1063 (TTAB 1999). We find that others in the trade would have a competitive need to use these terms. See: 2 J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, § 11:18 (4th ed. 2001).

Decision: The refusals to register are affirmed.