Paper No. 10
HRW

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 6/2/00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pitsco, Inc.

Serial No. 75/332,218

Thomas H. Van Hoozer of Hovey, Williams, Timmons & Collins for Pitsco, Inc.

Steven M. Perez, Trademark Examining Attorney, Law Office 109 (Ronald R. Sussman, Managing Attorney).

Before Simms, Wendel and Holtzman, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Pitsco, Inc. has filed an application to register the mark INVENTIONEERING for an "educational product, namely, a kit consisting of components including rubber bands, paper clips, wheels, balloons, gears, and straws and instructions

for the design and construction of structural and mechanical models."[1]

Registration has been finally refused on the ground that the mark is merely descriptive under Section 2(e)(1) of the Trademark Act. Applicant and the Examining Attorney have filed briefs, but no oral hearing was requested.

The Examining Attorney maintains that the proposed mark INVENTIONEERING describes or immediately conveys information regarding the purpose or use of applicant's goods. Although acknowledging that "inventioneering" is not a term found in the dictionary, the Examining Attorney argues that the term, even if coined as applicant contends, is one which has had considerable use beyond that of applicant. He has introduced evidence both from the Nexis database and from Internet web pages as support for his assertion that the term is used by others to describe a children's educational area or activity used to develop problem-solving skills.

Before turning to applicant's substantive arguments with respect to this refusal, we must consider the objections which applicant has raised to the Internet printouts which the Examining Attorney made of record at

[1] Serial No. 75/332,218, filed July 29, 1997, based on an allegation of a bona fide intent to use the mark in commerce.

the time of making the refusal final. Applicant contends that under TMEP § 1106.01 the Examining Attorney's action should have been complete as of the first action and that the "delinquent" reliance by the Examining Attorney upon the Internet printouts in the second (and final) action placed applicant at a disadvantage, since applicant had no opportunity to respond thereto. Applicant further objects to the Internet printouts on the bases that there is no provision in TMEP § 1106.07(a) for reliance by the Office on evidence obtained from the Internet and that the Examining Attorney failed to indicate the full parameters of the search used to obtain this evidence.

In the first place, the requirement under TMEP § 1106.01 is that the first action be complete as to grounds for refusal, requirements, and objections. If additional grounds or requirements are added in the second action, the action cannot be made final, because the applicant has not had an opportunity to respond to the newly raised grounds or requirements. See TMEP § 1105.04. The mere supplementation of a previously raised ground of refusal with additional evidence is not a newly raised ground and applicant is not entitled to an additional opportunity to respond thereto. The only pertinent requirement is that

the record be complete prior to appeal. This requirement was satisfied by the Examining Attorney.[2]

Insofar as reliance upon Internet evidence per se is concerned, the Board has previously determined that information obtained from the Internet may be admissible, so long as applicant has the opportunity to check the reliability of the evidence. See In re Total Quality Group, Inc., 51 USPQ2d 1474 (TTAB 1999). Cf. Raccioppi v. Apogee Inc., 47 USPQ2d 1368 (TTAB 1998)[Internet evidence admissible for purposes of summary judgment if properly introduced]. Here the Internet printouts which were made of record as part of the final action include the Internet addresses at which the Examining Attorney accessed the information and at which applicant could review the information. We find no need for any greater identification of the source of the Internet information. If applicant deemed that rebuttal was necessary, applicant could have filed a request for reconsideration with additional evidence.

Looking now to applicant's substantive arguments, we find applicant's major contention to be that its proposed

[2] In its reply brief, applicant has further objected to the evidence which it asserts has been newly introduced by the Examining Attorney with his appeal brief. We would simply point out that these are copies of the evidence previously made of record by the Examining Attorney and not new evidence.

mark INVENTIONEERING does not directly describe the parts or qualities of its educational model kits, nor convey information as to the nature or function of the kits, namely, to construct models. Instead, according to applicant, the "coined" term is used to 'suggest an abstract notion of discovery and ingenuity." (Brief, p.6). Applicant insists that it would take a multi-stage reasoning process for a purchaser to associate the attributes of applicant's educational model kits with the term INVENTIONEERING. Applicant argues that the evidence being relied upon by the Examining Attorney, even if admissible, shows use of the term in an abstract sense in connection with creative or imaginative educational classes or activities, or as a service mark for the same, not in a descriptive sense in connection with goods of any sort, including applicant's model kits.[3] Finally, applicant points to printouts of third-party registrations for marks using variations of the words "invention" and "imagineer," which applicant obtained from the U. S. Patent and

[3] Applicant raises the issue of relevance of unregistered third party uses of the mark INVENTIONEERING after the filing date of the present application. Our chief reviewing court made it explicitly clear in In re Thunderbird Products Corp., 406 F.2d 1389, 160 USPQ 730 (CCPA 1969) that the question of registrability, and specifically, the question of descriptiveness, extends at least until the time the application is acted on by the Office. All evidence of use of the term

Trademark Office Trademark Database and attached to its brief, as evidence of the suggestiveness, as opposed to descriptiveness, of such terms.[4]

A term or phrase is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys information about a characteristic or feature of the goods or services with which it is being used. Whether or not a particular term is merely descriptive is not determined in the abstract, but rather in relation to the goods for which registration is sought, the context in which the mark is being used, and the significance the mark is likely to have, because of the manner in which it is used, to the average purchaser as he encounters the goods bearing the mark. See In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that the term or phrase describe all the characteristics or features of the goods or services in order to be merely descriptive; it is sufficient if the term or phrase describes one significant

---

introduced by the Examining Attorney is relevant, all being prior to the time of examination.

[4] Thus, it is applicant who has introduced new evidence after the appeal has been filed, in violation of Trademark Rule 2.142(d). The Examining Attorney has failed to object to the evidence on this basis, however, and has in fact responded thereto. Accordingly, we have also considered the third-party registrations. See TMEP § 1106.07(a).

attribute thereof. See In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991).

The evidence which the Examining Attorney has made of record to support his contention that the term "inventioneering" has a connotation which would be merely descriptive of applicant's educational model construction kits includes excerpts from the Nexis database, of which the following are particularly noted:

> ...Different theme each week, including marine biology, archaeology, dinosaurs, kitchen chemistry and inventioneering. Prices vary; lunch available... *Sun-Sentinel(Fort Lauderdale)* (April 18, 1993).

> ...Pegasus School, lightbulbs have been going off in front of children's eyes and in their minds. As part of a two-week "inventioneering" program, students designed and built electromagnets, board games, paper airplanes and other projects while studying famous inventors... *The Orange County Register (*August 2, 1990*).*

The Internet printouts in general are found to be directed to use of the term "inventioneering" in connection with educational programs or school curriculum, such as the references to the "inventioneering class" at the 1997 Dharra school, the "Inventioneering Workshop" for the fourth, fifth and sixth graders at the Stone Creek Elementary School in the Fall of 1997, the "inventioneering" classes at the Northern Kentucky University Summer Enrichment Program and a museum program

in which students “will learn inventioneering skills which can turn them into great inventors.”

We find this evidence fully adequate to demonstrate use of the term “inventioneering” by others to describe educational programs or activities directed to the development of inventive or creative skills. Even if “inventioneering” is a coined term, rather than one of standard dictionary definition, it clearly has a recognized connotation or meaning in the educational field. Moreover, the applicability of this term cannot be relegated solely to creative classes or activities per se, as argued by applicant, but instead the term may also be descriptive of goods which are used in connection with the classes or activities. Thus, we agree with the Examining Attorney that students or parents of students familiar with inventioneering classes or activities would immediately recognize the purpose or use of an INVENTIONEERING educational kit, in the same manner that they would recognize the purpose or use of a chemistry or anatomy kit. Moreover, these are the persons who would be most likely to be potential purchasers of applicant’s educational model kits.

It is a general principle that the descriptiveness of the term must be determined as viewed in connection with

the goods, not in the abstract. Thus, the question is not whether the term describes the particular components in applicant's kits or conveys the information that these are kits for constructing models. Instead the question is whether the term INVENTIONEERING, when viewed in connection with the educational model kits, would immediately and directly convey information as to a significant attribute of the goods. We believe that INVENTIONEERING does just that; it informs potential purchasers that these are educational model kits which may be used in participation in creative activities of the nature encompassed by the term "inventioneering."

The third-party registrations introduced by applicant for marks containing variations of the words "invention" or "imagineer" for a variety of goods and services are irrelevant. The mark involved here is INVENTIONEERING, a term not found in any of these marks, and the issue is the descriptiveness of the term when used in connection with applicant's particular goods.

Accordingly, we find INVENTIONEERING to be merely descriptive of the educational kits for the design and construction of models with which applicant intends to use the mark.

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

R. L. Simms

H. R. Wendel

T. E. Holtzman
Administrative Trademark Judges,
Trademark Trial and Appeal Board