

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: February 8, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Tofasco of America, Inc.
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Serial Nos. 85084630
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Reid Eric Dammann of Musick Peeler LLP
for Tofasco of America, Inc.

Dominick J. Salemi, Trademark Examining Attorney, Law Office 106,
Mary I. Sparrow, Managing Attorney.

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Before Bucher, Shaw and Hightower,
Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Tofasco of America, Inc. (“applicant”) seeks registration on the Principal
Register of the following mark:

The logo consists of the word "apen" in a stylized, lowercase, cursive font. The letters are thick and black, with a slight shadow or outline effect. The 'a' is lowercase and cursive, while the 'pen' is in a more blocky, rounded cursive style.

for the following goods and services:

digital pens in International Class 9; and

online retail and wholesale store, wholesale distributorship, catalogue ordering service and mail order service featuring digital pens in International Class 35.¹

The examining attorney has refused registration on the ground that the term is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). Furthermore, the examining attorney argues that the degree of stylization in the case of this special form mark is not sufficiently striking, unique or distinctive so as to create a commercial impression separate and apart from the unregistrable components of the mark. After the examining attorney made the refusal final, applicant appealed to this Board.

We reverse the refusal to register.

A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the products it identifies. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the term is used. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the question is whether someone who knows what the products are will understand the mark immediately to convey information about them. *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003).

¹ Application Serial No. 85084630 was filed on July 14, 2010, based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. The mark consists of stylized designation, "a Pen." No claim is made to the exclusive right to use the term "a Pen" apart from the mark as shown.

The examining attorney argues that potential purchasers of “digital pens” will clearly view the applied-for term as the generic designation, “a pen”;² that there is no reason to create a distinction between definite and indefinite articles, so cases holding terms such as THE PILL, THE GREATEST BAR, THE MAGAZINE FOR YOUNG WOMEN, THE COMPUTER STORE, etc., as non-distinctive are controlling herein; that there is no meaningful distinction between the instant case and the holding in “Aspirina”³ inasmuch as one adds the letter “a” to the end of a generic term while the other adds the letter “a” to the beginning of a generic term;⁴ that reported decisions on descriptiveness under Trademark Act § 2(e)(1) do not base the determination on whether competitors need to use the language in question; and that the degree of stylization in this case is not sufficiently striking, unique or distinctive so as to create a commercial impression separate and apart from the unregistrable components of the mark.

By contrast, applicant contends that this term is suggestive, not descriptive; that the examining attorney failed to prove descriptiveness for this designation as to these goods or services in that he did not provide any definitions or other evidence in support of the refusal; that in the absence of any stated logic or reasoning, applicant has been left only to speculate about the basis for the refusal; that there is no citation of legal precedent dealing with the use of an indefinite

² The refusal is based on mere descriptiveness, and the examining attorney has made no attempt to apply the test for genericness.

³ *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007).

⁴ This non-sequitur typifies the apparent frustration with the prosecution of this application by the examining attorney that applicant’s counsel alluded to in his briefs.

article such as is the case herein; that there is no showing that competitors need to use the designation “A Pen” to describe their product or services; that the designation “A Pen” does not convey an immediate idea of the characteristics of multifunctional electronic devices designed to capture, record, store and send data, or of the retail services related thereto; that this examining attorney has been most inconsistent in prosecuting companion applications inasmuch as he allowed applicant’s **A PEN** (in standard character format) application for these exact same services⁵; and finally, that any remaining doubt should be resolved in applicant’s favor.

We begin our analysis by examining the record to understand the characteristics of the relevant goods identified as “digital pens.”

Since before the days of the quill, the word “pen” as used in common parlance has referred to an implement for writing or drawing with ink. Yet, applicant points out that the significant attributes associated with digital pens include the ability to capture, record, store and send data. Furthermore, to the extent that veritable ink even exists in a few digital pens, it is, at best, an insignificant feature. While the record contains online references to digital pens, we are unaware of any standard reference materials having an entry for this relatively new technology. Nonetheless, the following entry that applicant pulled from Wikipedia seems to corroborate the other information contained within this record:

⁵ Application Serial No. 85069230 awaiting allegation of use, having recited as intended services “online retail store featuring electronic devices.”

Digital pen From Wikipedia

A **digital pen** is an input device which captures the handwriting or brush strokes of a user, and digitizes them so that they may be downloaded to a computer and displayed on its monitor. The data can then be interpreted by handwriting software (OCR) and used in different applications or just as graphics.

A digital pen is generally larger and has more features than a stylus. Digital pens typically contain internal electronics, and have features such as touch sensitivity, input buttons, memory, Bluetooth transmission capabilities, and electronic erasers.

In fact, the record includes references to a variety of types of digital pens. In brief, a digital pen is a peripheral device for a computer. The record shows that digital pens can come with a variety of features, and are designed to be compatible with many different applications and operating systems. For example:

- In some cases, the associated software creates a basic image file, while in most it also has the option of turning the handwriting into text data readable with a word processor.
- Sometimes it is a simple stylus for use with digital forms, mouse pads or tablet computers, or even involves a larger scanner pen that actually scans existing text. The stylus in these systems generally does not involve any actual ink.
- Other technologies involve pens that must be used with special digital “dot” or patterned paper; or more complex portable pens have built in data collectors. These latter types of systems may well have ink cartridges in the “pens.”
- Some have as integral features audio recording capabilities. Some pens offer editing or highlighting capabilities; some permit note-taking inside an existing document; others have changing colors of virtual ink; some pens have buttons or an LED display; some pens can double as a mouse; and some permit the user to make notes right on the computer desktop.

There are certainly some superficial similarities between a stylus or digital pen and an ink pen. One holds or grips the stylus or digital pen much as one would a pencil, an ink pen or a small paint brush. Both devices depend upon the “handwriting” or “brush stroking” of the user. On yet the other hand, we agree with applicant that whether this hand-held device is known as a pen or a stylus, the basic purpose of these devices is not to apply ink to paper.

While the technologies of digital pens, electronic pens or smart pens may differ, the stylus/pen is a handheld device reminiscent of other writing instruments, but it is simply one component of a larger system. In no case is it a standalone system; rather, the handheld device depends upon an array of other hardware and software. Applicant contends that consumers who are acquainted with extant digital pen technologies would not characterize this device as “merely a pen” inasmuch as “ink on paper” is not a significant characteristic of digital pens.

As to naming, we acknowledge that since the introduction of this technology, it appears that the various names (other than “stylus,” often used with state-of-the-art graphic tablet technologies) applied to this handheld component of the system have often included the analogous term “pen” – e.g., digital pen, smart pen, electronic pen, etc. Yet, while some digital pen technologies that use paper rather than graphic tablets may depend upon ink to capture the movements of the stylus, and hence will have ink cartridges, this appears to be part of the technology chosen to capture the handwriting as it is written in order to create machine readable text, not because the user ever intended to retain the paper on which the ink is placed.

As to the connotation of the leading letter “a,” it could well be perceived by some as the indefinite article in the English language generally chosen to precede words beginning with hard consonant sounds. However, to some, this leading letter “a” might be perceived as neither an indefinite article nor an arbitrary single letter of the alphabet, but may be suggestive of the first in an order, the first in a class, the grade for a superior quality, or even “opposite of.”

As to presentation, the fact that the letter “a” is in a lighter font but that the tail of the letter intersects with the word “pen” seems to detract from the sense of the letter “a” as an indefinite article. Moreover, as used by applicant within the record, the mark is used as “APEN,” “aPEN” or “aPen,”⁶ not “A PEN” or “a Pen.” In fact, provided the technologies are compatible, one could imagine a marketing campaign from applicant with a tagline like “aPen for iPad,” with each mark retaining its own source-identifying capability. Analogizing to Apple’s well-known series of marks for tablet computers, we note that Apple’s source identifier is represented variously as IPAD, iPad, ipad, or iPAD, but never as I PAD.

Finally, to the extent that there may be any doubt as to whether applicant’s mark is merely descriptive or suggestive of its goods, we resolve such doubt, in accordance with the Board’s practice, in favor of the publication of applicant’s mark

⁶ Prior to publication, we would suggest that the Office change the description of the mark as follows: The mark consists of the stylized designation, “aPen.” [without any space].

for opposition. See *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981) and *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).⁷

Decision: The refusal under Trademark Act § 2(e)(1) to register applicant's mark is hereby reversed.

⁷ We would also suggest in light of this opinion that prior to publication, the disclaimer be deleted from the record as unnecessary.