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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 11
PTH

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Berthold Types Limited

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Serial No. 75/769,753

Mark B. Harrison of Venable, Baetjer, Howard & Civiletti
for applicant.

Jennifer M. Martin, Trademark Examining Attorney, Law
Office 102 (Thomas Shaw, Managing Attorney).

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Before Hohein, Hairston and Bottorff, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Berthold Types
Limited to register the mark BERTHOLD STANDARD for
"typeface fonts, namely, alphabet symbols and graphic
fonts, recorded on magnetic media for reproduction and
duplication for the creation of texts using graphic
techniques; digitally stored typefaces, in particular on
electric and/or magnetic data carriers, magnetic discs,

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cd[-]roms and diskettes; computer software in the field of desktop publishing; [and] computer software downloadable from computer information networks for generation of typefaces and fonts.”¹

The Trademark Examining Attorney has required that applicant disclaim STANDARD apart from the mark as shown and has refused to register the mark in the absence of a disclaimer. See Section 6 of the Trademark Act, 15 U.S.C. 1056.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested.

At the outset, we note that accompanying applicant’s brief on the case are a signed declaration by applicant’s president; a list of the type fonts offered by the company Adobe Systems; and a list of keywords which may be used to search for typefaces in the Adobe Type Library. The Examining Attorney has objected to these materials as being untimely submitted.

As noted by the Examining Attorney, materials submitted for the first time with an applicant’s brief on

¹ Application Serial No. 75/769,753 filed, August 6, 1999; alleging dates of first use and first use in commerce as early as June 9, 1999.

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the case are generally considered untimely, and thus, are not considered by the Board. See Trademark Rule 2.142(d). With respect to the declaration, we note that applicant submitted an unsigned copy of this declaration during the prosecution of the application. Although the Examining Attorney, in her final refusal, noted that the declaration was unsigned, she did not specifically object to the declaration on this basis. In fact, she went on to state that she was not persuaded by the declaration. Thus, we consider the Examining Attorney to have waived any objection to the declaration on the basis that it was unsigned. Inasmuch as applicant has simply submitted a signed copy of the same declaration, we do not consider this to be new evidence, and thus, will treat the signed declaration as of record in this case. As to the other material, however, inasmuch as it was submitted for the first time with applicant's brief, it is untimely, and will be given no consideration in deciding this appeal.²

We turn then to the disclaimer requirement. It is the Examining Attorney's position that STANDARD is merely descriptive of applicant's goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). In support of

² We hasten to add, however, that even if we had considered this material, our decision herein would be the same.

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her mere descriptiveness argument, the Examining Attorney has submitted various types of evidence, which she contends show the merely descriptive significance of "standard" as that term is applied to applicant's goods. The evidence includes a dictionary definition of the word "standard," which The American Heritage Dictionary of the English Language (3d ed. 1992)(electronic version licensed by INSO) defines as follows:

1. Serving as or conforming to a standard of measurement or value.
2. Widely recognized as a model of authority or excellence: a standard reference work.
3. Acceptable but of less than top quality: a standard grade of beef.
4. Normal, familiar or usual: the standard excuse.
5. Commonly used or supplied: standard car equipment.
6. Linguistics. Conforming to established educated usage in speech or writing.

The Examining Attorney points to the fourth-listed definition of "standard" as the definition which is most relevant to this case.

In addition, she submitted excerpts of articles retrieved from the NEXIS database, which show the word "standard"

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used in connection with fonts and/or typeface. The following are representative:

For standard business memos and documents, you need't worry about fonts, just use the default (automatically selected by the program) font. Stick to standard font and style rules, or make sure you set up your own rules with enough line-spacing, large-enough characters, and a simple style that makes for easy reading.
(The Record, January 30, 1996);

Focus the resume on job skills and areas of specific knowledge. Maximize the use of your industry's jargon and acronyms. Use standard font and keep the size between 10-14 points
(The Boston Herald, December 16, 1996);

After conversion to ASCII, your text document will be stripped of all special formatting (bolding, italics, underscoring) and converted to a standard font.
(The Legal Intelligencer, November 18, 1999);

Under the font option in you word processor, you can see a sample of each font style. Remember too that if you have a recent laser printer, you may have many of the standard fonts like Times New Roman already available through the printer.
(New Jersey Lawyer, November 1, 1999);

A typical Des Moines Sunday Register takes 171 rolls of newsprint, each containing 11.2 miles of paper. That's a lot of newsprint.

. . .
By redesigning routine elements such as section titles and page labels and by adding more than 14 pages of news per week, we've offset the space reduction. Also, our new standard typeface, Imperial, packs more words per inch yet is more readable than our old type.
(The Des Moines Register, March 19, 2000); and
As the most popular handheld computing device on the market, the Palm Pilot would seem like the perfect way to download and read an e-book.

3Com's latest Pilot incarnation, the Palm IIIc is a step up in terms of readability - its color screen is easier on the eyes than the standard backlit monochrome green and standard fonts are larger.
(Austin-American Statesman, July 28, 2000).

In addition, the Examining Attorney submitted material downloaded from websites. One printout is from the website of Adobe Systems. It details the solutions for reinstalling fonts on a printer, and identifies the problem as "Standard Fonts (e.g., Times, Helvetica) Don't Appear in Font Menu or On-Screen When Typed." A second printout from a different website is titled "Our Standard Font List" and lists over eighty fonts.

The Trademark Examining Attorney argues that the evidence of record establishes that, in the printing field, the word "standard" identifies a font which conforms to industry standards and contains the familiar or usual typeface qualities. Thus, it is the Examining Attorney's position that, as used in connection with applicant's goods, STANDARD immediately describes a significant characteristic or feature thereof.

Applicant, in urging reversal of the refusal to register, argues that "[t]here is absolutely no evidence that there is anything such as an 'industry standard' in the typeface field, or that there are 'familiar or usual

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typeface qualities' that consumers would know and understand as 'standard.'" Further, applicant argues that any doubt on the issue of mere descriptiveness should be resolved in its favor. As noted above, applicant submitted the declaration of its president, Harvey Hunt, who has worked in the type industry since at least as early as 1981. Mr. Hunt states, in relevant part, that:

To the best of my knowledge and belief, after inquiry, there is no "standard" font in the type industry.

To the best of my knowledge and belief, after inquiry, the term STANDARD as understood in the type industry has no significance other than to identify the typeface marketed by Berthold under the mark BERTHOLD STANDARD.

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 forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, 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). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re*

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MBAssociates, 180 USPQ 338 (TTAB 1973). 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 the term would have to the average purchaser of the goods or services because of the manner of its use. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

After careful consideration of the evidence and the arguments herein, we find that STANDARD is merely descriptive of applicant's goods, and thus, must be disclaimed.

There is sufficient evidence of record to establish that the term STANDARD merely describes a feature or characteristic of a font or typeface which is not unusual looking, but instead, is basic and normal in appearance, and commonly used in printing primarily because it is easy to read. In this regard, we agree with the Examining Attorney that the fourth-listed definition of "standard" (normal, familiar, or usual) supports this conclusion. In addition, in at least two of the NEXIS excerpts (the second and third) the word "standard" is used in a generic manner to describe a font that is not unusual in appearance, but rather basic and normal looking, and thus, easy to read.

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Because the use of a basic and normal looking, easy to read font or typeface is especially important when preparing certain documents (e.g., resumes, business proposals, memos), competitors in the printing industry should be free to use the word "standard" in describing their fonts and typeface of this nature. This is the case, even if applicant is not using STANDARD to describe a font or typeface that is basic and normal looking and thus, easy to read.

We are not persuaded by applicant's argument and the declaration of its president to reach a different result in this case. We recognize that there is no such thing as a single standard font or typeface in the printing field. Also, there is no evidence in this record that there are specific font or typeface qualities that are considered standard. For example, there is no evidence that a "12 point" font is considered "standard" in the printing industry. This is not necessary, however, in order for STANDARD to be merely descriptive of applicant's goods.

Decision: The requirement for a disclaimer of STANDARD and the refusal to register in the absence of a disclaimer are affirmed. Nonetheless, this decision will be set aside and applicant's mark published for opposition

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if applicant, no later than 30 days from the mailing date hereof, submits an appropriate disclaimer of STANDARD.