

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF  
THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Interfashion U.S.A., Inc.

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Serial No. 76573122

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Anthony J. Casella, Esq. of Casella & Hespos LLP for  
Interfashion U.S.A., Inc.

Sonya B. Stephens, Trademark Examining Attorney, Law Office  
109 (Dan Vavonese, Managing Attorney).

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Before Hairston, Drost and Cataldo, Administrative  
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

On January 30, 2004 Interfashion U.S.A., Inc. filed an application to register the mark AVENA (in standard character form) on the Principal Register for "hair care preparations, namely, shampoos, conditioners, hair bleaches, hair dyes, hair tints, hair colors, hair setting and hair waving preparations." Applicant claimed first use anywhere and first use in commerce on March 1, 2002. In

addition, the application contained a statement that "[t]he term 'AVENA' in English means 'oats.'"

The trademark examining attorney originally refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark, as applied to the identified goods, was merely descriptive. In a response dated September 20, 2004 applicant amended the application to seek registration on the Supplemental Register. Applicant acknowledged that its "hair care preparations contain, as one of many ingredients, extracts of oats which are formulated as an additive to conditioning creams." (Brief at 2). The examining attorney then refused registration on the ground that AVENA is generic and is thus incapable of distinguishing applicant's goods from the goods of others.

When this refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs.

At the outset, we note that in view of applicant's amendment to the Supplemental Register, there is no question that AVENA is merely descriptive of applicant's hair care preparations. Thus, the issue on appeal is whether AVENA is generic when applied to such goods. Further, it is well settled that the foreign equivalent of a generic English word is no more registrable than the

English word itself. This is the case even if the foreign word is not well known to the American public generally. See *in re Atavio, Inc.*, 15 USPQ2d 1361, 1362 (TTAB 1992).

The examining attorney's position is that "Avena" is a generic term for a key ingredient of applicant's hair care preparations, and thus is similar to other terms which have been refused registration, including marks involved in the following cited cases: *In re Hask Toiletries, Inc.*, 223 USPQ 1254 (TTAB 1984) [HENNA 'N' PLACENTA]; *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224 (TTAB 1987) [LA LINGERIE]; *In re Helena Rubenstein, Inc.*, 410 F.2d 438, 161 USPQ 606 (CCPA 1969) [PASTEURIZED]; *In re Wickerware, Inc.*, 227 USPQ 970 (TTAB 1985) [WICKERWARE]; *In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219 (TTAB 1984) [HALF PRICE BOOKS RECORDS MAGAZINES]; and *In re Harcourt Brace Jovanovich, Inc.*, 222 USPQ 820 (TTAB 1984) [LAW & BUSINESS]. According to the examining attorney, "defining the genus of goods in the case at hand as hair care preparations featuring avena as an ingredient, purchasers would clearly understand the proposed mark 'AVENA' to refer to a central characteristic of the relevant genus of goods." (Brief at unnumbered 7). In support of the refusal, the examining attorney submitted

dictionary and encyclopedia excerpts listing the word "oat(s)" and Internet printouts.

In urging that the refusal be reversed, applicant argues that the examining attorney has not sustained the PTO's burden of proof. Applicant concedes that the term "Avena" is the generic Latin name for "oat," but argues that "Avena" is not understood by the relevant public to primarily refer to the class of goods at issue, i.e., hair care preparations. According to applicant, the fact that oat extracts are one of the ingredients in applicant's hair care preparations does not establish that AVENA is generic for such goods.

With respect to genericness, the Office has the burden of proving this refusal with "clear evidence" of genericness. In re Merrill, Lynch, Pierce, Fenner & Smith, Inc., 929 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). Evidence of the relevant public's perception of a term may be acquired from any competent source, including newspapers, magazines, dictionaries, catalogs and other publications. In re Leatherman Tool Group, Inc., 32 USPQ2d 1443, 1449 (TTAB 1994), citing in re Northland Aluminum Products, Inc., 777 F.2d 1566, 227 USPQ 961, 963 (Fed. Cir. 1985).

We now turn to look at the evidence made of record by the examining attorney. There are numerous dictionary and encyclopedia excerpts which show that "oat(s)" belong to the botanical genus "Avena." The following are representative:

oat: 1. often oats (used with a sing. or pl. verb) a. Any of various grasses of the genus *Avena*, especially *A. sativa*, widely cultivated for their edible grains. The American Heritage Dictionary of the English Language, Fourth Edition (2002).

oats: cereal plants of the genus *Avena* of the family gramineae (grass family). The Columbia Encyclopedia, Sixth Edition.

In addition, the examining attorney submitted the following excerpts from Internet printouts which she maintains show that "Oat(s)/Avena" is a common ingredient in beauty products:

Emu Oil Soap - Avena- Scent Free - 3.5 oz (100g)  
Price: \$6.00  
<http://www.uniquelyemu.com>

Buy Natural Honey Bath & Shower Gel 750 ml Avena (Oats)  
<http://www.officialshop.co.uk/fragrances>

Oatstraw Hair Rinse  
Shampoo hair as usual, rinsing and applying crème rinse if wanted. Pour 1 cup/250 ml strained oatstraw infusion over hair and massage in, don't rinse out.  
[www.sunweed.com](http://www.sunweed.com)

Oat extract can be used to soothe skin conditions, e.g. in baths, skin products, etc.  
<http://en.wikipedia.org>

Buy Oat Straw Products Below

Oat Straw Tincture 2 fl. oz., 100% Organic

Oat Straw is most often used as a topical remedy for irritated and inflamed dry skin.

705739020731 Retail: \$15.99 Our Low price: \$14.99, 2/\$27.99

Bones, Hair, Teeth & Fingernails Formula Tincture 2 fl. Oz., 100% Organic

This formula is very high in minerals and helps to nourish bones, hair and teeth and fingernails.

705793011409 Retail \$15.99 Our Low price: \$14.99, 3/\$36.00

<http://shop.store.yahoo.com/herbal-remedies-usa/oatstraw.html>

The critical issue in genericness cases such as this one is whether members of the relevant public primarily use or understand the term sought to be registered to refer to the genus or category of goods in question. See *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

In making our determination, we follow the two-step inquiry set forth in *Marvin Ginn*, namely:

- (1) What is the genus or category of good or services at issue? and
- (2) Is the designation sought to be registered understood by the relevant public primarily to refer to that genus or category of goods or services?

The genus or category of goods involved in this case is hair care preparations. Because hair care preparations are purchased by ordinary consumers, the relevant public is the public at large. The question then is whether

"Oat(s)/Avena" is used or understood by the relevant public to refer to the genus of goods.

The examining attorney submitted two references to "Oat(s)/Avena" in connection with "Emu Oil Soap - Avena - Scent Free" and "Natural Honey Bath & Shower Gel 750 ml Avena (Oats)". Apart from the fact that these uses appear to be descriptive, rather than generic in nature, they are for beauty products other than hair care preparations. There is also a reference to "Oat extract," which appears to be a generic use, but this is for skin and bath products, not hair care preparations. The two remaining references are to "Oat Straw," i.e., "Oat Straw Hair Rinse" and "Oat Straw Tincture Bones, Hair, Teeth & Fingernail Formula," which are arguably generic uses of "Oat."

It is incumbent upon an examining attorney to make a "substantial showing . . . that the matter is in fact generic." Indeed, this substantial showing "must be based on clear evidence of generic use." *Merrill Lynch*, 4 USPQ2d at 1143. Thus, it is beyond dispute that "a strong showing is required when the Office seeks to establish that a term is generic." *In re K-T Zoe Furniture*, 16 F.3d 390, 29 USPQ2d 1787, 1788 (Fed. Cir. 1994). Furthermore, doubt on the issue of genericness is resolved in favor of the applicant. *In re Waverly Inc.*, 27 USPQ2d 1620, 1624 (TTAB

1993). The two references to "Oat Straw" hair care preparations which appear to be generic in nature do not constitute a clear or substantial showing of generic use. The other references to "Oat(s)/Avena" for products other than hair care preparations are not particularly probative whether AVENA is generic as applied to hair care preparations. On this limited record, we have doubt as to whether AVENA is generic for hair care preparations.

Insofar as the cases cited by the examining attorney are concerned, we recognize that marks which describe a principal or key ingredient of goods or which describe the most important or central aspect of goods have been held unregistrable. In this case, however, we are not convinced from the evidence of record that prospective purchasers would understand AVENA to refer to a principal or key ingredient in applicant's hair care preparations.

Accordingly, we resolve our doubt in favor of applicant, thereby allowing any third party who believes it will be damaged to file a petition to cancel.

**Decision:** The refusal to register is reversed.