

THIS DECISION IS NOT A
PRECEDENT OF THE TTAB

Mailed: July 20, 2012

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board**

In re Wet Technologies, Inc.

Serial No. 77135323
Filed March 20, 2007

Glenn J. Wurzel, Law Offices of Glenn J. Wurzel, for
applicant.

S. Michael Gaafar, Law Office 116, Michael W. Baird,
Managing Attorney.

**Before Bucher, Mermelstein, and Shaw, Administrative
Trademark Judges.**

Opinion by Mermelstein, Administrative Trademark Judge:

Applicant Wet Technologies, Inc. seeks registration of
the mark



for:

Particle blast cleaning machines; machine tools
for water blasting, descaling, derusting, wet
lapping, wet peening, slurry processing, and
deburring; wet etching machines

in International Class 7, and

Rust removal

Serial No. 77135323

in International Class 37.¹

Applicant appeals from the examining attorney's final requirement to disclaim the exclusive right to use "WET TECHNOLOGIES" apart from the mark as shown.

We affirm.

I. Relevant Facts and Law

Because this case involves some procedural anomalies, we explain the relevant facts and circumstances in more detail than usual.

A. Goods and Services on Appeal

At the time of appeal, the subject application included the following services in International Class 40, in addition to the Class 7 and 37 goods and services listed above:

Water blasting services; particle blasting services; metal finishing; wet peening; slurry processing; wet etching of metals; wet lapping; processing of metals, namely, mechanical descaling.

Applicant's notice of appeal – filed by mail – was timely received on September 10, 2010, along with an enclosed check for \$200.00. The fee for an ex parte appeal

¹ Based on first use and use in commerce as of June 1, 1999. The Office's database entry for this application indicates that a disclaimer of "WETTECHNOLOGIES" was submitted, although that is clearly incorrect; such a disclaimer was neither required by the examining attorney nor submitted by applicant. The Office's records will be corrected accordingly.

Serial No. 77135323

is \$100.00 per International Class, Trademark Rule 2.6(a)(18), and this application had three classes, leaving applicant's payment \$100.00 short of the required fee for an appeal of all three classes. When the appeal was instituted, the Board paralegal issued an order noting the deficiency and directing applicant to

advise whether it is appealing the refusal of registration in all three classes, and if so, to file an additional \$100.00, or to specify the classes in which it is appealing, failing which the appeal will go forward in the lowest numbered classes. Applicant is allowed until thirty days from the date hereof for this purpose.

Board Order² (Sept. 16, 2010).

There is no indication in the Board's file, the file of the application, or in the USPTO's Revenue Accounting and Management system³ that applicant ever responded to the paralegal order or tendered the deficient fee.

Accordingly, the fee submitted with the notice of appeal –

² The Board's order cited Trademark Rule 2.85(e), which is inapposite. A more appropriate citation would have been to Trademark Rule 2.6(a)(18) (fee \$100 per class), 2.141(b) (fee must be paid for each class; if insufficient fee is submitted and not remedied, the fee paid will be applied to the classes in ascending order), and 2.142(a) ("An appeal is taken by filing a notice of appeal . . . , and paying the appeal fee."). Notwithstanding the incorrect citation, the paralegal was entirely correct in handling the matter. See Trademark Rule 2.141(b).

³ A report of all fees paid with respect to the subject application indicates a \$650 payment for the application (by credit card) posted March 20, 2007; a \$375 payment (by check) for an additional class, posted June 25, 2008; and a \$200 payment (by check) for an ex parte appeal, posted September 14, 2010.

Serial No. 77135323

\$200.00, or enough for two classes of goods or services – is applied to the two lowest classes in this application, namely, International Classes 7 and 37.

Because the appeal fee has not been paid with respect to applicant's International Class 40 goods, the appeal is DISMISSED with respect to Class 40, and we will not consider applicant's appeal as to those services. Further, because the refusal of registration applied to applicant's class 40 services, the failure to perfect an appeal as to that class is fatal to those services, see Trademark Rule 2.64(a) (only proper response to a final refusal is appeal or compliance with requirement), and applicant's Class 40 services will be abandoned in due course.⁴ Trademark Rule 2.65(a) (abandonment).

B. Applicant's Goods and Services

To the extent relevant here, applicant sells machines for cleaning, water blasting, descaling, derusting, wet lapping, wet peening, slurry processing, deburring, wet etching, and similar operations, and provides rust removal services. According to the evidence of record, the

⁴ Applicant could have avoided this problem had it filed its notice of appeal using ESTTA, the Board's electronic filing system, which automatically calculates the correct filing fee. ESTTA is available at <http://estta.uspto.gov>. See generally TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 110.09, et seq. (3d ed. rev. 2011), for information on using ESTTA.

Serial No. 77135323

machines applicant sells and uses to perform its services employ a mixture of water and an abrasive (or sometimes just water), sprayed under pressure to ablate, clean, etch, or peen a surface. The kind of abrasive used, the pressure, and other variables can be adjusted to suit the application. Applicant's goods and services appear appropriate for, among other things, the thorough cleaning or (re)surfacing of parts with minimum damage in applications requiring a high degree of precision, such as in the aviation industry.

The following information is from promotional material submitted by applicant:

Wet Blast Slurry machines clean parts quickly without damaging sensitive machined surfaces with either manual or automatic equipment. No contamination is left on the surface to interfere with welding or dye penetrant inspection.

* * *

What does it mean to "**Wet Tec**" your parts?

- The **Wet Tec Slurry Process** is a mixture of media (abrasive) and water driven by a special pump, through an air accelerated nozzle or airless means across the surface of a part to enact a desired finish.
- The **Wet Tec High Pressure Process** - In many industrial applications, water only, elevated in temperature and pumped at high volume or pressure (from 20 to 8,000 psi) through nozzles can be effective for cleaning, oil removal, de-flashing and de-scaling.

Serial No. 77135323

- All of our manual and automatic systems provide closed loop filtered water to rinse parts clean.

* * *

[The] **Advantage** that the wet cleaning system has over other types is that you can increase the compressed air pressure at the manual nozzle for aggressive cleaning, then lower it to smooth or lap part surfaces while using the same media.

* * *

Other evidence of record sheds further light on wet blasting:

Wet Grit Blast Cleaning Solution meets aviation MRO needs.

September 10, 2009 – Enabling replacement of dry grit with wet grit blasting to reduce or eliminate parent material removal, Wet Tech Process helps meet and exceed SPOP for wet grit blasting of major rotating parts. Aqueous wet and water blast cleaning equipment and machinery suit advanced applications for OEM parts cleaning. . . .

Thomas Net News, <http://news.thomasnet.com/fullstory/565687>

(March 5, 2010). The same source quotes a news release from applicant:

The Wet Technologies high volume slurry process mixes and delivers a high concentration mixture of water and media to a nozzle or multiple nozzles where regulated compressed air is introduced to adjust the process aggressiveness. The parts are then rinsed with pressurized water from the included closed loop particle filtration system. . . .

C. Prosecution History

Upon his initial examination of this application, the

Serial No. 77135323

examining attorney issued a combined examiner's amendment and priority action (we are not concerned with the latter⁵). Pursuant to the examiner's amendment, applicant authorized the amendment of the application to include the following disclaimer:

No claim is made to the exclusive right to use "WET" and "TECHNOLOGIES" apart from the mark as shown.

Ex. Amend. (July 3, 2007). The examiner's amendment stated that it had been entered with the consent of applicant's counsel of record, and applicant voiced no objection to it.

After other issues were resolved, the examining attorney issued a priority action with a requirement to disclaim "WET TECHNOLOGIES" apart from the mark as shown:

The following newly raised issue was discussed in communication with Glenn J. Wurzel on March 20, 2009. The examining attorney apologizes for any issues caused by the timing of this requirement.

Disclaimer

The applicant disclaimed the individual words "wet" and "technologies"; however, these words appear together in the mark as the unitary phrase "wet technologies."

Unregistrable wording must be disclaimed in its entirety; words that form a grammatically or otherwise unitary expression must be disclaimed as a composite. See, e.g., *In re Med. Disposables Co.*, 25 USPQ2d 1801, 1805 (TTAB 1992)

⁵ During the course of examination, there were several office actions issued; all requirements other than the disclaimer issue before us have been satisfied.

(finding MEDICAL DISPOSABLES a unitary expression that must be disclaimed as a composite); *Am. Speech-Language-Hearing Ass'n v. Nat'l Hearing Aid Soc'y*, 224 USPQ 798, 804 n.3 (TTAB 1984) (finding CERTIFIED HEARING AID AUDIOLOGIST "a unitary expression that should be disclaimed in its entirety"); *In re Wanstrath*, 7 USPQ2d 1412, 1413 (Comm'r Pats. 1987) (finding "GLASS TECHNOLOGY" a unitary expression such that petitioner's request to substitute separate disclaimers of "GLASS" and "TECHNOLOGY" was denied).

Separately disclaiming the exclusive right to use individual components or phrases is generally appropriate when the components are sufficiently separated by registrable matter, which is not the case in this instance. TMEP § 1213.08(b).

Therefore, the applicant must amend the disclaimer to appear in the following format:

No claim is made to the exclusive right to use "WET TECHNOLOGIES" apart from the mark as shown.

See TMEP § 1213.08(a)(i).

Ofc. Action (March 24, 2009).

By response to the priority action, applicant declined to provide the required disclaimer, arguing that a disclaimer was unnecessary.⁶ The examining attorney then

⁶ In his brief, the examining attorney indicates that he interpreted applicant's refusal to disclaim "WET TECHNOLOGIES" "as a withdrawal of the disclaimer statement submitted in July, 2007," i.e., applicant's disclaimer of "WET" and "TECHNOLOGIES." We see no clear statement in the record that this was applicant's intent, nor was the examining attorney's interpretation stated in either of the two Office actions which followed applicant's initial refusal to disclaim "WET TECHNOLOGIES."

Serial No. 77135323

issued another non-final Office action,⁷ repeating the same requirement. See Ofc. Action (Sept. 23, 2009). Applicant filed a response disagreeing, but without any additional argument or evidence, Resp. (Feb. 16, 2002), whereupon the examining attorney made final his requirement for a disclaimer of "WET TECHNOLOGIES." Ofc. Action (March 15, 2010).

Finally, on September 10, 2010, applicant filed its notice of appeal with the Board, and on the same day filed a request for reconsideration, along with over 250 pages of

While the examining attorney's assumption clearly gave applicant the benefit of the doubt, it may have been better in this situation to allow applicant to speak for itself on whether it wished to withdraw its original disclaimer. While we accept the examining attorney's assumption that applicant intended to withdraw its disclaimer of the individual words, it is unclear whether that was in fact applicant's intention, or that it now disputes the descriptiveness of the individual words it had previously disclaimed.

⁷ It is unclear to us why the examining attorney's September 23, 2009, action was non-final. The same requirement had been previously made, and no new issues were raised. See generally TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPE) § 714.03 (8th ed. 2011). Although the examining attorney made a slightly different argument in support of the requirement and attached new evidence to this action, that is not generally a reason to issue a non-final action when the same refusal or requirement has been previously made.

While the examining attorney's failure to issue a final action on September 23, 2009, resulted in some delay, applicant was not without a remedy: Although rarely invoked, "[a] second refusal on the same grounds may be considered as final by the applicant for purpose of appeal." Trademark Rule 2.141(a). Had applicant been concerned with the delay in issuing a final action, it could have treated the September 23 action as final and filed an appeal within six months, rather than filing a response advancing no new argument or evidence.

Serial No. 77135323

new evidence, all but one page of which consisted of printouts from the USPTO's TESS database of applications and registrations. Although applicant's notice of appeal expressly indicated that applicant had filed a request for reconsideration, the Board did not remand the file to the examining attorney for further consideration, as should have been done, *see* TBMP § 1204. Moreover – although the examining attorney specifically mentioned applicant's request for reconsideration in his brief, Ex. Att. Br. at 6 – neither applicant nor the examining attorney requested that the Board remand the file for further examination in light of applicant's new evidence, and briefs were filed instead.

Although applicant's request for reconsideration was timely filed and should have been formally considered by the examining attorney prior to the submission of any briefs on appeal, a remand for that purpose would accomplish nothing but delay at this point. It is clear from the examining attorney's brief that he has in fact considered applicant's new evidence, although he denies that it merits a change in position. Ex. Att. Br. at 6-7. Further, we consider applicant's evidence to be of record and will include it in determining the merits of the appeal. Although the procedure was irregular, applicant

Serial No. 77135323

has gotten all of what it would have been entitled to had the file been remanded for consideration of the request for reconsideration prior to briefing, namely, entry of the new evidence and arguments into the record, consideration by the examining attorney, and consideration of the new evidence by the Board on appeal. We accordingly proceed as if the request for reconsideration had been properly considered and formally denied prior to briefing.

Finally, we note that – in addition to the evidence applicant submitted during examination (including with its request for reconsideration) – applicant listed in both its opening brief and in its reply brief what it claims are a number of registrations which have issued, App. Br. at 10-11; Reply Br. at 6-7, and referred to an addendum to its opening brief which lists more such marks and registration numbers. See App. Br. Addendum B. These lists raise several issues.

First, a list is not an appropriate way to make third-party registrations of record; copies of the registration records from the USPTO's database should be submitted (as applicant did with its request for reconsideration). *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1560 n.6 (TTAB 1996) (citing *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994)). Second, even if acceptable copies of the

registrations had been filed with applicant's briefs, evidence submitted with a brief is untimely. The record should be complete at the time of appeal; if applicant or the examining attorney wish to introduce additional evidence after an appeal is filed, the proper procedure is to request a remand for that purpose. Trademark Rule 2.142(d). While the examining attorney can waive any objection to evidence improperly submitted with applicant's opening brief⁸ – either explicitly, or implicitly by discussing or relying on the improper evidence without preserving an objection – the examining attorney did not do so in this case, and so we will not consider the registrations listed in either of applicant's briefs, except to the extent that evidence of them was properly submitted prior to appeal (e.g., with applicant's request for reconsideration).⁹

⁸ The examining attorney has no opportunity to object to evidence submitted with applicant's reply brief, so we will not consider potential objections to such evidence waived for failure to raise them. New evidence in or attached to a reply brief is manifestly untimely and will not be considered. *In re Zanova Inc.*, 59 USPQ2d 1300, 1302 (TTAB 2001).

⁹ Even if the examining attorney had waived his objection to applicant's lists, the waiver only allows consideration of what was actually submitted, *i.e.*, the list itself. The listing does not serve to introduce the full records of the listed registrations. *In re Houston*, 101 USPQ2d 1534, 1537 n.7 (TTAB 2012). As is often the case, applicant's lists are of little or no use, since they provide only the registration number, the word mark, and what appears to be a one- or two-word summary of the

D. Relevant Law

"The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable." Trademark Act § 6(a); 15 U.S.C. § 1056(a). Merely descriptive or generic terms are unregistrable under Trademark Act § 2(e)(1), 15 U.S.C. § 1052(e)(1), and therefore are subject to a disclaimer requirement if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is a ground for refusal of registration. See *In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1954 (TTAB 2006).

The examining attorney alleges that "WET TECHNOLOGIES" is merely descriptive of applicant's goods and services. A term is merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the goods with which it is used. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009-10

goods or services. (Applicant's Addendum B doesn't even include this summary of goods or services.) The information that applicant has made of record does not include vital data, such as the entire mark in question (including any stylization or design elements), the actual identification of goods or services, whether the registration is still in force, and whether it was registered pursuant to a disclaimer, a § 2(f) claim, or on the Supplemental Register. Without such information, we can draw no conclusions from applicant's lists.

Serial No. 77135323

(Fed. Cir. 1987). Whether a particular term is merely descriptive is determined in relation to the products for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the issue is whether someone who knows what the products are will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); *In re Patent & Trademark Servs. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Ass'n of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). "On the other hand, if one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product or service characteristics the term indicates, the term is suggestive rather than merely descriptive." *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978); *In re Shutts*, 217 USPQ 363, 364-65 (TTAB 1983); *In re Universal Water Sys., Inc.*, 209 USPQ 165, 166 (TTAB 1980).

II. Discussion

On appeal, applicant makes two arguments as to why a disclaimer is unnecessary: (1) the mark is a unitary, non-

descriptive term, which functions as a trademark; and
(2) the USPTO is estopped from requiring a disclaimer. We
begin with the second argument.

A. Estoppel

Applicant's estoppel argument is as follows:

The USPTO required separate disclaimers of the term "wet" and the term "Technologies" . . . and are [sic] estopped from asserting two years later that appellant must disclaim the term "wet technologies" in it's [sic] entirety. If the disclaimer at issue now would have been raised two years ago, when appellant's trademark application was filed, the subsequent two years involved in the various Office Actions (which had nothing to do with the current disclaimer issue) would not have occurred and this matter would have been resolved in a much timelier fashion.

App. Br. at 11-12.

Applicant cites no authority for this argument, and we are not aware of any. To the contrary, it is the statutory obligation of the USPTO to examine applications for registration in accordance with the applicable laws and regulations, and to issue only those registrations which are found to be warranted under law. *See generally* Trademark Act § 12; Trademark Rule 2.61. We are aware of no authority which holds that the USPTO is barred from raising a new refusal or requirement after a first (or subsequent) Office action, or — with one exception not

Serial No. 77135323

relevant here¹⁰ – after a certain amount of time. Simply put, the failure to raise a requirement or ground for refusal in a first Office action is not a promise or legal commitment by the USPTO that the mark will be registered or that no such refusal or requirement will ever be made. Indeed, at any time prior to registration (and possibly even after) the USPTO has both the authority and the duty to correct its own errors to avoid issuing a registration contrary to law. *Last Best Beef v. Dudas*, 506 F.3d 333, 340-41 (2007) (“it would be ‘an abuse of discretion to prevent an agency from acting to cure . . . legal defects.’” (quoting *Citizens Against the Pellissippi Pkwy. Extension v. Mineta*, 375 F.3d 412, 416 (6th Cir. 2004))).

It is true that examining attorneys are *expected* to raise all potential issues in a first Office action – at least to the extent possible. TMEP § 704.01 (“Every effort should be made to avoid piecemeal prosecution, because it prolongs the time needed to dispose of an application.”).

¹⁰ Pursuant to the Madrid Protocol and domestic implementing legislation, when examining an application under the Madrid Protocol, see Trademark Act § 66(a), 15 U.S.C. § 1141f(a), the USPTO must raise any *ex parte* ground for refusal of registration no later than eighteen months from receipt of the application from the International Bureau. See Trademark Act § 68(c); 15 U.S.C. § 1141h(c). (An opposition may be filed later than eighteen months, but only if the International Bureau has been notified of that possibility prior to the passage of eighteen months. *Id.*) However, this provision does not apply to applications for registration under Trademark Act §§ 1 or 44.

However,

[i]f in the first Office action an examining attorney inadvertently failed to refuse registration on a clearly applicable ground or to make a necessary requirement, the examining attorney must take appropriate action to correct the inadvertent error in a subsequent action. Examining attorneys should exercise great care to avoid these situations, and should take this step only when the failure to do so would result in clear error.

TMEP § 706.

Although this policy dictates that a new refusal or requirement should only be raised in cases of "clear error," we will not consider whether the examining attorney's failure to raise the requirement at issue would have been clear error, because the determination of "clear error" is committed to the discretion of the examining attorney and his supervisors. The Trademark Trial and Appeal Board has the authority to review the outstanding refusals or requirements under the applicable statute and rules, but it does not exercise supervisory authority over examining attorneys. An examining attorney's clear error determination is reviewable only by way of a petition to the Director. By contrast, "[t]he Board's determination on appeal is limited to the correctness of the underlying substantive [requirement or] refusal to register." *In re Trek 2000 Int'l Ltd.*, 97 USPQ2d 1106, 1107-08 (TTAB 2010)

Serial No. 77135323

(citing *In re Sambado & Son Inc.*, 45 USPQ2d 1312, 1314-15 (TTAB 1997)).

The delay in this case is regrettable. (We note the examining attorney's appropriate apology in his March 24, 2009, Office action and join in the sentiment.) But delay does not give applicant the right to a registration or provide a defense to a refusal or requirement if the mark is not otherwise entitled to registration.

B. Should "WET TECHNOLOGIES" be Disclaimed?

1. Unitary Expressions and Disclaimers

Applicant argues that its mark is "unitary," and that a disclaimer is therefore unnecessary. The examining attorney disagrees. We begin with a discussion of the concept of unitary expressions in trademarks.

A mark or portion of a mark is considered "unitary" when it creates a commercial impression separate and apart from any unregistrable component. That is, the elements are so merged together that they cannot be divided to be regarded as separable elements. *In re EBS Data Processing*, 212 USPQ 964, 966 (TTAB 1981). If the matter that comprises the mark or relevant portion of the mark is unitary, no disclaimer of an element, whether descriptive, generic, or otherwise, is required.

TMEP § 1213.05.

While an applicant may be required to disclaim any unregistrable (in this case descriptive) part of a mark, it has long been recognized that individual parts of a

Serial No. 77135323

trademark do not always create individual impressions. Two or more words or design elements can combine to form a single impression that is different from the individual elements. The unitary doctrine simply recognizes that the elements comprising a unitary expression should be considered together, as a single unit. It is improper to require the disclaimer of part of a unitary expression, because such an expression must be considered as a whole. However, the mere fact of being "unitary" will not shield an expression from a disclaimer requirement (or a refusal to register) if the entire unitary expression is unregistrable:

[T]wo descriptive words may, when combined, form a nondescriptive phrase. However, the mere act of combining does not in itself render the resulting composite a registrable trademark. Rather, it must be shown that in combination the descriptiveness of the individual words has been diminished, that the combination creates a term so incongruous or unusual as to possess no definitive meaning or significance other than that of an identifying mark for the goods.

In re Med. Disposables Co., 25 USPQ2d 1801, 1804 (TTAB 1992) (citing *Calspan Tech. Prods., Inc.*, 197 USPQ 647 (TTAB 1977) (affirming refusal of the unitary term FINGERSCAN as descriptive)).

For example, while a requirement to disclaim "TIRE" in the mark TIRE-X (for tire cleaner) was held improper

Serial No. 77135323

because "TIRE-X" is a unitary expression comprising both descriptive and distinctive matter, *"X" Labs., Inc. v. Odorite Sanitation Serv. of Balt., Inc.*, 106 USPQ 327, 329 (Comm'r 1955), disclaimer of "STEEL/GLAS" in the mark UNIROYAL STEEL/GLAS (for tires) was affirmed, *In re Uniroyal, Inc.*, 215 USPQ 716, 719 (TTAB 1982), as was the requirement to disclaim FIRST TIER apart from FIRSTIER and design (for banking services), in light of evidence that "first tier" describes a class of banks, *In re Omaha Nat'l Corp.*, 2 USPQ2d at 1860. In the latter two examples, "STEEL/GLAS" and "FIRSTIER" were both unitary expressions, but nonetheless held unregistrable because they were, as a whole, descriptive.



As summarized in the TMEP:

A compound word mark is comprised of two or more distinct words (or words and syllables) that are represented as one word (e.g., BOOKCHOICE, PROSHOT, MAXIMACHINE, and PULSAIR).

If a compound word mark consists of an unregistrable component and a registrable component combined into a single word, no disclaimer of the unregistrable component of the compound word will be required.

If a composite mark consists of a compound word combined with arbitrary matter, and the compound word is unregistrable, a disclaimer of the compound word may be required. . . .

TMEP § 1213.05(a) (Compound Word Marks).

Serial No. 77135323

As applicant characterizes it, the mark in this case "consists of the wording 'wettechnologies' in stylized lettering, along with a blue circular design element and a wavy line. . . ." App. Br. at 3. The terms WET and TECHNOLOGIES are physically situated next to each other with no intervening space, forming the single term "WETTECHNOLOGIES." This term is clearly unitary, because it is presented as a single compound word, *i.e.*, two words physically joined together.

Nonetheless, although "WETTECHNOLOGIES" in applicant's mark is run together, and therefore unitary, it is clear that prospective purchasers seeing applicant's mark would readily understand it to be comprised of the two separate words, WET and TECHNOLOGIES. As applicant points out, "wet" is presented in heavy, white lettering on a blue background within a circle, while "technologies" appears as blue lettering outside the circle, displayed in a lighter font. *Id.* The separate words comprising the compound are clearly visible as such. Moreover, neither applicant nor the examining attorney contend that the meaning of the combined words, *i.e.*, "WETTECHNOLOGIES" or "WET TECHNOLOGIES," has any significance different from the meaning of the individual words in the context of the identified goods and services in the way, for instance, the

Serial No. 77135323

combined words "blue moon" have a meaning different from either "blue" or "moon."

To the extent applicant argues that the literal portion of its mark (WETTECHNOLOGIES) is so inextricably integrated with the design elements in the mark as to comprise a visually or conceptually inseparable whole, we disagree. Applicant's mark includes two figurative elements, a solid blue circle, and a wavy line (half in the circle and half outside it, underlining the letters WETTECH).

In considering marks comprised of words and designs, recognizable words are almost always considered to be conceptually separable from design elements, and they will rarely be found to be "unitary" with design elements, even when the designs replace parts of the words. Unlike designs, words can be seen and remembered as such, and even more importantly, it is the words – not the design elements – that the relevant public typically uses to discuss, search for, or request the branded goods.

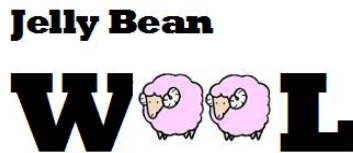
For example, the Board found the following mark not descriptive as a whole



for components of storage systems, but added that

[w]hen words which are merely descriptive, and hence unregistrable, are presented in a distinctive design, the design may render the mark as a whole registrable, provided that the words are disclaimed. . . . In our opinion, the tube-like rendition of the letter "C" in the words "construct" and "closet" make a striking commercial impression, separate and apart from the word portion of applicant's mark. Because of our finding that the words "CONSTRUCT-A-CLOSET" are merely descriptive of applicant's goods, however, applicant is not entitled to registration of its mark as a whole absent a disclaimer of the words "CONSTRUCT-A-CLOSET".

In re Clutter Control Inc., 231 USPQ 588, 589-90 (TTAB 1986) (citations omitted). Likewise, the TMEP provides the following hypothetical mark, noting that a disclaimer of WOOL would be required (for goods such as yarn, we assume):



TMEP § 1213.05(g)(1).

In the case of applicant's mark, the figurative and literal elements are even less integrated than those in the examples above. Although both the figurative and literal elements discussed are all part of the applied-for mark, the literal elements are easily recognized and separable, both visually and conceptually. Therefore, if WETTECHNOLOGIES is merely descriptive of applicant's goods and services, a disclaimer of "WET TECHNOLOGIES" – in its

entirety, and properly spelled¹¹ – may be required.

2. Descriptiveness of WETTECHNOLOGIES

Applicant seeks to register a mark comprising the term WETTECHNOLOGIES and a design. The examining attorney has required applicant to disclaim the exclusive right to use WET TECHNOLOGIES, apart from the mark as shown, based on the allegation that WET TECHNOLOGIES is merely descriptive of applicant's goods and services, and therefore unregistrable.

We note again that applicant disclaimed (by examiner's amendment) the words "WET" and "TECHNOLOGIES" on July 3, 2007, at the time the mark was first considered by the examining attorney. No reason for the disclaimer was specified in the examiner's amendment (none is required), although it seems likely that the reason for the disclaimer was applicant's agreement that the terms are merely descriptive – at least individually. Applicant has not formally withdrawn that disclaimer. Nonetheless, in light of applicant's refusal to supply a disclaimer of "WET TECHNOLOGIES," and the examining attorney's interpretation

¹¹ If a disclaimer is required of words which are misspelled in the mark, the applicant must disclaim the words as properly spelled. See *In re Carlson*, 91 USPQ2d 1198, 1203-04 (TTAB 2009) (URBANHOUSING in mark descriptive of real estate services; proper disclaimer would be of the term "URBAN HOUSING").

Serial No. 77135323

of applicant's actions, *see supra* note 6, we will not treat applicant's earlier disclaimer as a concession of the descriptiveness of "WET" or "TECHNOLOGIES." It is readily apparent, however, that these terms are descriptive in the context of applicant's goods and services.

The examining attorney submitted a dictionary definition of "wet," as meaning, among other things, "1 a: consisting of, containing, covered with, or soaked with liquid (as water)." MERRIAM WEBSTER ONLINE DICTIONARY, <http://www.merriam-webster.com/dictionary/wet> (March 15, 2010).

Applicant's International Class 7 machines and machine tools are identified in the application as used for "water blasting, . . . wet lapping, wet peening, slurry processing, and . . . wet etching. . . ." Identification of goods. Applicant's own promotional material and that of others likewise explains that such machines are used for surface finishing or refinishing, cleaning, deburring, *etc.*, employing a process by which water, or a slurry of water and an abrasive, are directed at a surface under pressure to accomplish the desired result. There is no question that such a process is "wet," in that the process uses water, and both applicant and others describe it and similar processes as such. See Thomas Net News, <http://news.thomasnet.com/fullstory/565687> (March 5, 2010)

Serial No. 77135323

("Enabling replacement of dry grit with wet grit blasting to reduce or eliminate parent material removal. . . ."); wettechnologies.com, FAQs <http://www.wettechnologies.com/faqs> (March 5, 2010) ("WHAT IS WET BLASTING, SLURRY BLASTING? In the Wet Technologies process, abrasive or non abrasive media is mixed with water by a specially designed, high volume pump. The mixture is then sent to a nozzle. . . ."); Wet Blasting, <http://www.nortonsandblasting.com/nsbwetblast.html> (March 15, 2010) (How wet blasting, also known as slurry blasting, wet etching, liquid abrasive blasting, and wet honing works: You've mixed water with abrasive before. Think of pumice hand soap. . . .").

The examining attorney also made of record a definition of "technology" as meaning:

1. **application of tools and methods:** the study, development, and application of devices, machines, and techniques for manufacturing and productive processes
 - *recent developments in seismographic technology*
-
2. **machines and systems:** machines, equipment, and systems considered as a unit
 - *the latest laser technology*

MSN ENCARTA DICTIONARY, <http://encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?refid=186178738> (March 15, 2010). See also MERRIAM WEBSTER ONLINE DICTIONARY, <http://www>

Serial No. 77135323

.merriam-webster.com/dictionary/technology (March 15, 2010)
("2: a manner of accomplishing a task especially using
technical processes, methods or knowledge.").

The examining attorney has included excerpts from
applicant's website and those of others as evidence of the
relevant use of "technologies." For instance, applicant
uses "technologies" on its website in reference to the
"limited technologies" of competing goods and services:

LIQUID ABRASIVE - WET BLASTING

Most traditional wet blast systems rely on
limited technologies such as suction, low volume
diaphragm, and low concentration pump designs.
At Wet Technologies Inc. we offer liquid abrasive
systems geared toward the customer application.
Our standard equipment utilizes our own design
urethane vortex submerged pump for heavy duty
use, extended wear life, wide range
concentration, and continuous cycle applications.

The "Wet Tech" Process and Experience, [http://www.](http://www.wettechnologies.com/process-description)

[wettechnologies.com/process-description](http://www.wettechnologies.com/process-description) (March 15, 2010).

Another firm involved in the surface treatment business
states that its "associates . . . will develop and market
superior corrosion-control and surface treatment
technologies that deliver innovative, high-performance and
finishing solutions to industry worldwide." Prism Surface
Coatings Pty. Ltd, <http://prismsurface.com/gritblasting>

.aspx (March 15, 2010).¹²

Finally, the record includes an excerpt from an article regarding a method "for applications ranging from decontaminating steel in nuclear plants to cutting meats and removing paint from airplanes" by using a "high-speed stream of nitrogen."¹³ The article discusses the previously-available techniques for such tasks:

Current technologies

Nitrogen jet technology arrives on the foundation of major developments in the cutting and surface cleaning technologies used within the industrial and food processing industries over roughly the past 20 years. Since the 1980s, cutting technology has steadily progressed away from conventional mechanical sawing and cutting to the rapid growth technologies of high-pressure water jet and laser cutting. Surface cleaning technologies have also progressed far beyond the conventional air-propelled sandblasting.

High-pressure water jet. In high-pressure water jet cutting, materials are cut or machined by a jet of water forced from a cutting nozzle at a speed three times that of sound (more than 2,100

¹² The Prism website does not mention "wet" blasting, and appears instead to be concerned with "dry" blasting. We nonetheless find this evidence relevant as the two processes are related and appear to compete, at least to some extent. See *The Wet Tech Process*, www.wettechnologies.com/faqs (March 15, 2010) (noting the differences between "dry" and "wet" blasting, and the advantages of the latter).

¹³ While it does not appear that this process competes with applicant's wet blasting method in the fields of nuclear decontamination or butchery, wet blasting is clearly suitable for airplane paint removal and related tasks. See www.wettechnologies.com/process-description (noting the suitability of applicant's wet blasting machinery for "paint and scale removal" and in "applications such as . . . aircraft engine and airframe overhaul").

Serial No. 77135323

mph). To output Mach 3 water, the water pressure is raised to 60,000 pounds per square inch (psi) by means of special pumps in a system that incorporates extremely complex materials technology and design. At these pressures a slight leak can cause permanent erosion damage to components.

For cutting harder materials, the system adds an abrasive material such as sand or garnet to the high-pressure water stream. As the technology for adding abrasive materials to the water jet has matured to produce a more aggressive cut path, the range of potential applications has been greatly expanded, especially for cutting stone and hard metals.

Media blasting. In the last 20 years, conventional sandblasting has evolved into numerous types of media blasting applied to a wide range of surface-treatment tasks, including cleaning, coating removal, and eroding. When a ship, airplane, or spacecraft is repainted, its previous coat of paint will likely need to be removed. Although solvents have played a major role in such large projects, increasingly strict environmental regulation of solvent use provides strong impetus to seek alternative surface-treatment technologies.

Goliath, *The Ultimate Clean Knife*, http://goliath.ecnext.com/coms2/gi_0199-2560801/The-Ultimate-Clean-Knife.html (March 15, 2010).

This evidence makes clear that the term "TECHNOLOGIES" is descriptive of both applicant's wet blasting machines, as well as applicant's rust removal services accomplished by wet blasting. Both applicant and others clearly refer to wet blasting and related techniques as "technologies," and we find that the term is merely descriptive of

applicant's identified goods and services.

The only remaining question is whether the combination of "WET" and "TECHNOLOGIES" as used in applicant's mark is descriptive, or whether the descriptive significance of the constituent terms has been lost in the process of combination. Applicant argues that

[t]he average consumer would view appellant's Mark as a single inseparable impression, rather than two divisible words, because of the proximity, letter formatting and circular design elements.^[14] The unusual arrangement in appellant's Mark results in a unique and catchy expression which is capable of distinguishing appellant's goods.

Furthermore, appellant's Mark forms a unitary whole through a rhyming pattern, use of alliteration and other sound that creates a distinctive impression.

App. Br. at 7 (citations omitted).

While we agree with applicant that WETTECHNOLOGIES is unitary – because the two words are physically connected – we cannot find on this record that their combination conveys any different meaning with respect to the goods as would the separate words "WET" and "TECHNOLOGIES."

Although applicant argues that the combined term would not be perceived as "two divisible words," we note again that

¹⁴ As discussed above, we do not find the wording WETTECHNOLOGIES and the design elements in applicant's mark to form a unitary whole.

Serial No. 77135323

the two words are displayed differently. As applicant points out, "WET" is in a heavy font displayed in white against the blue background made by a circular design, while "TECHNOLOGIES" is in a lighter font, displayed in blue, and is outside the circle. See App. Br. at 3. Visually, the two words are easily recognizable as such. It has often been held that compound terms like applicant's mark will easily be recognized as a combination of constituent terms and it is proper to hold such terms descriptive, *In re Orleans Wines, Ltd.*, 196 USPQ 516, 517 (TTAB 1977) (BREADSPREAD), or even generic, *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987) (SCREENWIPE), when warranted by the evidence.

Applicant also refers to what it calls the "unusual arrangement" of the words in its mark, "result[ing] in a unique and catchy expression." But applicant does not explain what is unique or catchy about its mark, and we do not see anything odd or unusual about the combination of "WET" and "TECHNOLOGIES" or their arrangement. As arranged in applicant's mark, "WET" precedes "TECHNOLOGIES," indicating that the technologies in question are "wet." Unlike the opposite arrangement, *i.e.*, "TECHNOLOGIESWET," which is somewhat cryptic, the meaning of the words as arranged in applicant's mark is perfectly clear.

Applicant also maintains that its mark has a "rhyming pattern," "us[es] alliteration," or "other sound" in creating a distinct impression. While we must take account of differing pronunciations of trademarks, see e.g., *Barton Mfg. Co. v. Hercules Powder Co.*, 88 F.2d 708, 33 USPQ 105, 107 (CCPA 1937), we do not see any possible way to vocalize WETTECHNOLOGIES so that it rhymes or alliterates; the words neither end in the same sound (rhyme), nor do they begin with the same sound (alliterate). While "WET" ends with the same sound ("t") that "TECHNOLOGIES" begins with, this does not seem particularly unusual or unique, and applicant does not explain why consumers of its goods and services would consider this repeated "t" sound to create a different and distinct impression of the individually descriptive words.¹⁵ In short, there is nothing about the appearance or sound of WETTECHNOLOGIES that changes its descriptive meaning.

Finally, applicant argues that the USPTO has granted

¹⁵ In this regard, we note that the mark considered by the Federal Circuit in *In re Omaha Nat'l Corp.*, was FIRSTIER, the telescoped form of FIRST TIER, which also features a "t" sound at the end of the first word and the beginning of the second. The court of appeals affirmed the requirement for a disclaimer. *Omaha Nat'l*, 2 USPQ2d at 1861. Such marks are not unusual, and are held descriptive when appropriate. See *In re Wells Fargo & Co.*, 231 USPQ 95, 96-97 (TTAB 1986) (EXPRESSERVICE held descriptive); *In re U.S. Steel Corp.*, 225 USPQ 750, 751-52 (TTAB 1985) (SUPEROPE held descriptive).

Serial No. 77135323

registration of similar marks in the past. As noted above, applicant submitted a number of records from the USPTO's database with its request for reconsideration, arguing that the examining attorney's analysis "is inapplicable," and that in the attached records, "the applicants were not required to disclaim the entire mark, as is being requested of applicant."¹⁶ Req. for Recon. (Sept. 8, 2010).

Applicant's evidence is problematic. By our count, applicant submitted 165 records from the USPTO TESS database of applications and registrations. Forty-five of the records were those of cancelled or expired registrations and three were of pending applications; neither category is probative. *In re DC Comics Inc.*, 211 USPQ 834, 835 (TTAB 1981) (dead registrations); *In re Binion*, 93 USPQ2d 1531, 1535 n.3 (TTAB 2009) (applications). Twenty-seven were records of registrations that have marks bearing no similarity whatever to applicant's, and we are at a loss to understand why they were submitted. While the remaining marks included the word TECHNOLOGIES or WET, fifty-nine were registered with disclaimers, fifteen on the Supplemental Register, and ten under the provisions of Trademark Act § 2(f). Six records

¹⁶ Applicant misconstrues the requirement at issue. Applicant was required to disclaim only WETTECHNOLOGIES, not the entire mark.

Serial No. 77135323

might possibly be seen as weak support for applicant's position (because they were registered without a disclaimer), but none were for the words WET and TECHNOLOGIES, and none involved goods related to those at issue here.

There is little we can make of this evidence. Each application must be judged on its own merit based on the evidence of record, and we are not bound by the decisions of examining attorneys in considering different applications for different marks and different goods or services. The Board must make its own findings of fact, and that duty may not be delegated by adopting the conclusions reached by an examining attorney. *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994); *In re BankAmerica Corp.*, 231 USPQ 873, 876 (TTAB 1986). But to the extent we can draw any general conclusions from applicant's evidence, it is that the USPTO has more often than not often treated both words WET and TECHNOLOGIES as descriptive, and that disclaimer of those terms may be required. While there may be some exceptions to the general principle, applicant has not indicated what they might be or why they should apply to the mark at issue. In sum, this evidence sheds but dim light on the question at hand, and if anything, it is more supportive of the

Serial No. 77135323

examining attorney's position than of applicant's.

We conclude that the relevant public would readily understand the words WETTECHNOLOGIES in applicant's mark to mean that applicant's blasting and wet etching machines, and applicant's rust removal services employ a "wet" method. The descriptiveness of a term is not considered in the abstract. Rather, it must be determined in the context of the identified goods, and from the perspective of the relevant purchasers of such goods and services. As we noted above, the issue is whether someone who knows what the products are will understand the mark to convey information about them. *E.g., Tower Tech*, 64 USPQ2d at 1316-17; *Patent & Trademark Servs.*, 49 USPQ2d at 1539.

In this case, potential purchasers of applicant's goods and services are not the general public, but customers with specialized needs for cleaning, etching, rust removal, and other surface treatments. It is also clear from applicant's web pages of record that the machines at issue are not inexpensive impulse purchases, and are likely purchased only after some investigation. While the significance of WETTECHNOLOGIES may not be apparent to the general public, we have no doubt that potential customers for applicant's goods would readily understand the mark to describe the means by which

Serial No. 77135323

applicant's blasting machines operate and the way in which applicant's rust removal services are performed.

Although applicant argues that its mark "is not descriptive, because [it] does not immediately inform consumers of the exact nature of the goods and services being offered by" applicant, Reply Br. at 3, there is no requirement that a mark reveal the "exact nature" of the goods in order to be held descriptive. It is enough that a term "describes the ingredients qualities, characteristics, features or parts of the goods, or if it immediately conveys information regarding a function, purpose, use or property of the goods." *In re H.U.D.D.L.E.*, 216 USPQ 358, 358-59 (TTAB 1982) (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978)). Applicant's mark easily meets this test.

III. Conclusion

We have carefully considered all of the evidence and argument properly presented, including any matters we have not specifically discussed. The appeal is DISMISSED with respect to applicant's International Class 40 services, and those services will be deemed abandoned.

We conclude that the term WETTECHNOLOGIES is merely descriptive of applicant's identified goods and services in International Classes 7 and 37, and that "WET TECHNOLOGIES"

Serial No. 77135323

must be disclaimed pursuant to Trademark Act § 6(a).

Decision: The refusal to register in the absence of a disclaimer of WET TECHNOLOGIES is AFFIRMED.

However, this decision will be set aside (with respect to applicant's International Classes 7 and 37 goods and services) if, within thirty days of the mailing date of this order, applicant submits to the Board a proper disclaimer of "WET TECHNOLOGIES." See Trademark Rule 2.142(g); TBMP § 1218 (3d ed. rev. 2012). The disclaimer should be worded as follows: "No claim is made to the exclusive right to use WET TECHNOLOGIES apart from the mark as shown." TMEP § 1213.08(a)(i).