

**THIS OPINION IS NOT A
PRECEDENT OF THE
TTAB**

Hearing:
August 17, 2011

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May 4, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re PRGCO, LLC.

Serial Nos. 77252690, 77252698 and 77252707

Robert W. Sacoff and Ashly A. Iacullo of Pattishall, McAuliffe, Newbury, Hilliard and Geraldson LLP, for PRGCO, LLC.

Gina Hayes, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Zervas, Mermelstein and Ritchie, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On August 10, 2007, Recycled Paper Greetings, Inc.¹ filed for registration of the following marks on the Principal Register, all for "greeting cards" in Class 16:

1. Application Serial No. 77252690 (in standard characters), asserting first use and first use in commerce on January 27, 1993 pursuant to Trademark Act

¹ During the prosecution of the applications, Recycled Paper Greetings, Inc., the original applicant, initiated a series of assignments of the marks, resulting in PRGCO, LLC owning all three applications. The assignment to PRGCO, LLC was recorded on September 21, 2011, at reel 4627, frame 0209.

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1(a), 15 U.S.C. § 1051(a), and claiming acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), of the entire mark:

RECYCLED PAPER GREETINGS

2. Application Serial No. 77252698 for the following mark, claiming an intent to use the mark in commerce under Trademark Act 1(b), 15 U.S.C. § 1051(b), and claiming acquired distinctiveness in RECYCLED PAPER GREETINGS:



3. Application Serial No. 77252707 for the following mark, asserting first use and first use in commerce on January 27, 1993 pursuant to Trademark Act 1(a), 15 U.S.C. § 1051(a), and claiming acquired distinctiveness in RECYCLED PAPER GREETINGS:



In each application, applicant claimed ownership of (i) Registration No. 1815545 for the standard character mark RECYCLED PAPER GREETINGS, and (ii) Registration No. 1830936 for the same mark as in application Serial No. 77252707, both on the Supplemental Register, for "greeting cards" and containing a disclaimer of RECYCLED PAPER.

The prosecution history of each case is difficult to follow and has left us with questions on the examining attorney's position(s) in each case. Suffice it to say,

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however, that the examining attorney has clarified her refusal, and her view on the registrability of each mark, at unnumbered p. 2 of her appeal brief. There, she states that the issue before us in each application is whether "[a] disclaimer of the words 'RECYCLED PAPER' is required for registration of the wording 'RECYCLED PAPER GREETINGS' for greeting cards under the provision of Section 2(f) of the Trademark Act." As to the two word and design applications, she explained at footnote 1 of her brief:

On July 7, 2010, in application SN 77252707 and 77252698, [and in] the examiner's letters denying the applicant's Requests for Reconsideration[,] the examiner mistakenly withdrew acceptance of the amendment under 2(f) as to the wording RECYCLED PAPER GREETINGS [and] requested a disclaimer of the entire phrase. As indicated in the office action dated May 5, 2009 and the final action dated December 3, 2009, the amendment under Section 2(f) is accepted. The only issue on appeal, as identified and briefed by both parties, is whether the wording RECYCLED PAPER must be disclaimed if the phrase RECYCLED PAPER GREETINGS is registered under Section 2(f) of the Trademark Act.²

In sum, each application stands refused under Trademark Act Section 6, 15 U.S.C. § 1056(a), due to applicant's failure to disclaim the term RECYCLED PAPER. The examining attorney has accepted applicant's showing of acquired distinctiveness of GREETINGS under Section 2(f) in

² Applicant has maintained during prosecution of its applications, and argued in its brief, that neither RECYCLED

each of these applications. Therefore, if RECYCLED PAPER is not generic for applicant's goods, whether RECYCLED PAPER GREETINGS has acquired distinctiveness is not an issue in this appeal.

Applicant filed an appeal brief and a reply to the examining attorney's brief.³ An oral hearing was held before the Board. We affirm the requirement for a disclaimer of RECYCLED PAPER in each application.

As a preliminary matter, we underscore that because applicant seeks registration of RECYCLED PAPER GREETINGS on the Principal Register pursuant to Section 2(f), and with other matter in two of the applications, applicant has effectively conceded that the words RECYCLED PAPER GREETINGS is, at a minimum, descriptive for "greeting cards." See *The Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 ("where an applicant seeks registration on the basis of Section 2(f), the mark's descriptiveness is a nonissue; an applicant's reliance on Section 2(f) during prosecution presumes that the mark is descriptive."). "However, by making the amendment, applicant is not viewed as having

PAPER nor RECYCLED PAPER GREETINGS are descriptive or generic for greeting cards.

³ On July 23, 2010, the Board granted applicant's motion to consolidate applicant's appeals.

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admitted that the composite is generic." *In re American Institute of Certified Public Accountants*, 65 USPQ2d 1972, 1980-81 (TTAB 2003).

A term is a generic name and not registrable as a mark if it refers to the class or category of goods and/or services on or in connection with which it is used. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). Determining whether a term is generic involves a two-step inquiry: "First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?" *Id.* at 530.

The examining attorney has the burden of establishing by clear evidence that a term is generic and, thus, unregistrable. *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). See also *In re Am. Fertility Soc'y*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991). Competent sources to show the relevant purchasing public's understanding of a contested term include purchaser

testimony, consumer surveys, dictionary definitions, trade journals, newspapers and other publications. *In re Dial-A-Mattress Operating Corp.*, *supra*; *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986).

Genus of Goods

Our first task under *Marvin Ginn* is to identify the genus of applicant's goods. The examining attorney states that "recycled paper greeting cards is the genus of the goods." (Emphasis in original, brief at unnumbered p. 8.) The identification of goods is not limited to greeting cards made from recycled paper, and the record reflects that there are a number of different categories of greeting cards, such as Christmas cards and Valentine cards, which are not necessarily made from recycled paper.⁴ We therefore do not agree with the examining attorney but agree with applicant that "greeting cards" is the proper genus. See *Magic Wand*, 19 USPQ2d at 1552 ("[A] proper genericness inquiry focuses on the description of [goods or] services set forth in the [application or] certificate of registration."); *In re American Institute of Certified Public Accountants*, 65 USPQ2d 1972, 1981 (TTAB 2003) ("Guided by these decisions [*Marvin Ginn* and *Am. Fertility*

⁴ See webpage from cardsdirect.com, submitted with the July 7, 2010 Office action.

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Soc'y], we discern no legal support for the examining attorney's argument that we should define the class of applicant's goods more narrowly than its identification.").

Does the relevant public understand
RECYCLED PAPER to primarily refer to the genus?

Next, we determine whether RECYCLED PAPER is understood by the relevant purchasing public (which, for greeting cards, the record supports is the public at large) to primarily refer to that genus of goods. The examining attorney argues that "a word or term that is the name of a key ingredient, characteristic or feature of the goods and/or service can be generic for those goods and/or services"; and that "'recycled paper' is a generic term for the principal ingredient of the applicant's goods." Brief at unnumbered pp. 3 and 5. The Board has long held that terms may be generic if they serve to identify a principal ingredient or key characteristic of the genus of the goods. See *In re Hask Toiletries, Inc.*, 223 USPQ 1254, 1255 (TTAB 1984) (HENNA 'N' PLACENTA for hair conditioner, "designation accurately describes the two key elements of the product to which applied, invests these generic terms with no special or new significance or different commercial impression to support a finding of trademark 'capability'"); *In re Demos*, 172 USPQ 408, 409 (TTAB 1971) (CHAMPAGNE "merely names the

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principal ingredient of (applicant's) salad dressing and to that extent ... forms part of the normal nomenclature therefor, i.e., champagne salad dressing" and therefore "is deemed unregistrable"); *In re Pepcom Industries, Inc.*, 192 USPQ 400 (TTAB 1976) ("JIN SENG" as flavor imparting ingredient incapable of registration on the Supplemental Register). See also, *A.J. Canfield v. Honickman*, 808 F.2d 291, 1 USPQ2d 1364 (3rd Cir. 1986) (CHOCOLATE FUDGE held generic for diet soda); *In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718 (CCPA 1970) (CUSTOMBLENDED for gasoline held generic); *In re Helena Rubenstein, Inc.*, 410 F.2d 438, 161 USPQ 606 (CCPA 1969) (PASTUERIZED for face cream held generic); *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991) (MULTI-VIS for multiple viscosity motor oil held generic); *In re Reckitt & Coleman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1991) (PERMA PRESS for soil and stain remover held generic); *In re Northland Aluminum Products, Inc.*, 221 USPQ 1110 (TTAB 1984), *aff'd*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985) (BUNDT for coffee cake held generic). Cf., *In re Central Sprinkler Co.*, 49 USPQ2d 1194, 1199 (TTAB 1998) (ATTIC "directly names the most important or central aspect or purpose of applicant's goods, that the sprinklers are used in attics, this term is

generic and should be freely available for use by competitors").

The examining attorney's evidence in support of her disclaimer requirement includes: (i) dictionary definitions of "recycled"⁵ and "paper";⁶ (ii) a printout of applicant's website which indicates that applicant uses recycled paper; (iii) an entry from wikipedia.com for applicant "Recycled Paper Greetings" explaining that the paper forming applicant's greeting cards is made from recycled materials; and (iv) an article from the *Chicago Tribune*, dated June 28, 2009, stating "Keiser, [applicant's founder, is] a Lakeview resident who made his fortune by co-founding a greeting cards company that uses recycled paper" The examining attorney also submitted various newspaper and magazine articles and printouts of third party greeting card company websites using the phrase "recycled paper" in connection with their greeting cards. See, for example:

Chicago Tribune (June 27, 2010); "Let's start with the Pacific Ocean. Mike Keiser, the Chicago visionary who prospered by using recycled paper to make witty greeting cards"

Orlando Sentinel (December 21, 2008); "Send virtual holiday greetings or look for cards made from recycled paper. After the holidays, place paper and cards in the recycling bin"

⁵ Defined as "made from waste" and "used again," respectively, with both definitions taken from encarta.msn.com.

⁶ Defined as "thin material made from wood pulp" in encarta.msn.com.

San Diego Union-Tribune (April 22, 2002);
"We encourage people to look at the small things they can do to make a better world. Use egg shells for compost, buy greeting cards made with recycled paper, car pool to work one day a week."

<http://www.cardrave.com>: "All of our products are printed on 100% recycled paper. Please choose a sub-category to view our designs."

<http://www.greenprinteronline.com>: "Choose from a multitude of recycled papers, finishes and color options."

<http://www.care2.com>: "Send 100 percent recycled paper or tree-free cards made by environmental organizations like Defenders of Wildlife."

<http://www.conservatree.com>: "Choosing to send greeting cards printed on recycled paper and using recycled wrapping paper is a perfect way to share beautiful gifts and cards with your loved ones while also helping to build a sustainable future."

<http://www.ohmysocute.com>: "Tam Tam handmade greeting cards from recycled paper."

The examining attorney also submits that "recycled paper" is a category of greeting cards defined by a principal ingredient, namely, those greeting cards made from recycled paper. Her evidence includes the following articles and websites:

Fort Wayne Journal-Gazette (May 12, 2006);
"... make Mom a recycled paper greeting card"

CNN.com (August 14, 2002); "GoodThings also makes and sells recycled-paper greeting cards."⁷

⁷ Obtained from Lexis/Nexis.

Chicago Sun Times (January 26, 1999); "A single mother working as a waitress to support her two children, Duet began making handmade, recycled paper greeting cards on her living-room floor in 1991."

Pine Rivers Press (April 2, 1997); "Many strainers and supermarkets stock recycled paper greeting cards and other paper products."

<http://www.cardsforcauses.com>: "Recycled paper Christmas cards & recycled holiday cards are made of environmentally or earth friendly recycled stock."

<http://www.cardsdirect.com>: "Recycled Paper Christmas Cards."

<http://www.etsy.com>: "Bunkless [sic] Handmade Recycled Paper Greeting Cards."

<http://www.smarter.com>: "Recycled Paper Greeting Card - Bicycle Man *HANDMADE.*"

<http://greenpromotionalitems.com>: "Recycled paper holiday cards are perfect for the office, friends and family! Customers will love the fact that you've gone "green" with recycled greeting cards this holiday season."

Applicant has a different view of the significance of "recycled paper" to the consuming public. According to applicant, the public understands "recycled paper" to mean paper that has been recycled, as opposed to greeting cards; "recycled paper" is simply "an eco-friendly raw material"; and "recycled paper" is not commonly understood by the public to refer to greeting cards. Brief at 5. For

support, applicant relies on a variety of evidence, including:

- search results from the Google database for "recycled paper" which primarily refer to applicant;
- the first thirty of more than seven-thousand hits on the ProQuest database for "national and regional publications" for a five year period between May 31, 2005, and May 31, 2010, which contain the phrase "recycled paper" but exclude "greeting cards," and a copy of about thirty selected articles presumably located in the ProQuest search;

Although some of the brief Google search results are fairly clear that the web pages which are summarized unlikely pertain to greeting cards, other results, such as those results which consist of only several words, are not clear and have limited probative value. See *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007) ("Bayer asserts that the list of GOOGLE search summaries is of lesser probative value than evidence that provides the context within which a term is used. We agree. Search engine results - which may provide little context to discern how a term is actually used on the webpage that can be accessed through the search result link - may be insufficient to determine the nature of the use of a term or the relevance of the search result to registration considerations."). Also, the probative value

of this evidence is reduced because we cannot discount that the search results have been organized at least in part on factors unrelated to the primary meaning of "recycled paper," such as the popularity of particular websites.

With regard to the material from the ProQuest database, the probative value of this material is limited because the search results only include the title of the article, the publication in which the article appeared, its location and date of publication, and exclude articles which refer to greeting cards. The individual who conducted the search states in her declaration that the search excluded "greeting cards" (plural form) and that "it was unnecessary to expressly exclude 'greeting card' because the singular form of this phrase is already automatically excluded when searching for the plural." Declaration of Diana J. Koppang, filed June 3, 2010, ¶¶ 18, 19 and 21. The search parameters do not indicate that she included "greeting cards" (plural form) in her search (although she did not exclude "greeting cards" from her search). It seems to us that at least by excluding "greeting card" (singular form) from the search, relevant articles may have been excluded from applicant's search.⁸

⁸ At p. 11 of its brief, applicant faults the examining attorney for including "greeting cards" as part of her searches for

In addition, applicant relies on the following:

- Samples of applicant's greeting cards offered to show that they contain other ingredients such as stickers, lace, ribbons, buttons or miniature music-playing devices;
- Copies of registrations owned by third-parties in which the registrant disclaimed RECYCLED PAPER pursuant to the examining attorney's requirement that RECYCLED PAPER be disclaimed, where the examining attorney stated that the term is "descriptive"; and
- Printouts from webpages offering goods such as notebooks, journals, gift wrap, bowls, trivets, napkins, paper plates, ornaments and stationery made from recycled paper, with applicant arguing that if recycled paper is generic for greeting cards, it is also a generic term for all of these other goods.

This material is not particularly persuasive. First, the fact that applicant's greeting cards include materials other than recycled paper does not preclude a finding that recycled paper remains a principal element of the greeting cards, and that recycled paper is generic for a type of greeting card. See *In re Northland Aluminum Products, Inc.*, 221 at 1114 ("Thus, as far as the issue of a term's genericness is concerned, it is beside the point whether

evidence in combination with "recycled paper." Applicant would have it that if "recycled paper" were generic for greeting cards, "greeting cards" would not be needed as a term to be combined with "recycled paper." This is not the examining attorney's position; she maintains that the term is the generic name for the key ingredient or component of applicant's greeting cards. The examining attorney was correct to consider the use of "recycled paper" in connection with greeting cards; the significance of the term in other contexts is not an issue.

the term may or may not accurately describe a particular product."). Second, the question of genericness does not concern goods applicant actually sells for which recycled paper may not be a principal ingredient; the question in these appeals concerns whether the goods identified in the applications, which are not limited to particular types of greeting cards, would include within their scope cards of recycled paper. Third, with regard to the third-party registrations on the Principal Register containing disclaimers, an examining attorney may request a disclaimer of a term on the ground that it is merely descriptive, even if in reality the term could also be called generic.

Office policy *requires* that examining attorneys not issue a refusal (or disclaimer requirement) in an application for registration on the Principal Register on the ground that a term is a generic name for the goods or services, unless the applicant asserts that the term has acquired distinctiveness under Section 2(f) in the application itself. See TMEP §1209.02(s). Thus, disclaimers such as those in the proffered registrations do not establish that "recycled paper" is not generic. Fourth, we are not bound by the prior determinations made by the Office; each case must be decided on its own set of facts. While uniform treatment under the Trademark Act is highly desirable, our

task here is to determine, based on the record before us, whether applicant's mark is registrable. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). Fifth, if "recycled paper" is generic for greeting cards, it may or may not be generic for other goods as well. However, whether "recycled paper" is generic for the other goods mentioned by applicant is not before us, and we do not speculate whether the term is generic for such goods.

Next, we address what appears to be the major point of contention on appeal, namely, whether a term in a mark that identifies a component or an ingredient of the goods can be generic and thus unregistrable. Specifically, applicant contends that "recycled paper" is merely descriptive as a class or name of a type of paper, which is an ingredient or component of applicant's goods, greeting cards. Brief at 12 - 13. In this case, the record demonstrates that "recycled paper" is a principal ingredient or component of the involved genus of goods, "greeting cards," and applicant's cards are known to feature this ingredient. Further, the evidence is clear that third parties use "recycled paper" to identify a particular type of greeting card, categorized according to this ingredient or component, namely, greeting cards that are printed on

recycled paper. See particularly the evidence described earlier in this opinion. Thus, "recycled paper" identifies a sub-genus within the broader genus "greeting cards," as readily as would the terms "birthday," "anniversary," "Christmas," "get well" or even "blank" (to indicate all-purpose cards in which the sender writes the message or greeting). *In re International Business Machines Corp.*, 81 USPQ2d 1677, 1683 (TTAB 2006) ("As such, we find that an 'eserver' is a category or sub-genus of a server."); *In re Bongrain International (American) Corp.*, 17 USPQ2d 1490, 1491 (TTAB 1990) ("We agree with what the Examining Attorney has stated ... that member of the food trade and the consuming public recognize the term 'Baby' as referring to a subgenus of small cheeses.") Applicant itself promotes the fact that its cards are made from recycled paper as a selling point for its greeting cards; and so too, the record shows, do others.

Applicant argued that the record is mixed, with ample evidence establishing that "Applicant is recognized by the public as the source of the greeting cards offered under Applicant's marks." Brief at 7. Applicant cites to *In re Merrill Lynch, supra*, where the Federal Circuit reversed the Board's holding that CASH MANAGEMENT ACCOUNT a generic term for financial services. The Court found that the

evidence of public perception contained in the material retrieved by the examining attorney from the LEXIS-NEXIS data base did not establish that the term CASH MANAGEMENT ACCOUNT was generic. Many of the articles retrieved through use of the LEXIS/NEXIS data base referred specifically to services offered by Merrill Lynch under the designation CASH MANAGEMENT ACCOUNT. Because the evidence showed a "mixture of uses" of CASH MANAGEMENT ACCOUNT, the Court concluded that there was insufficient evidence for a finding that the public recognized CASH MANAGEMENT ACCOUNT as a generic term for the services rendered by applicant under that designation. That is, the evidence in the record was substantial and showed recognition that the applicant was the source of the CASH MANAGEMENT ACCOUNT brokerage services. See also, *In re America Online Inc.*, 77 USPQ2d 1618 (TTAB 2006), which concluded that a "mixed record" existed, stating:

[T]he mere fact that a record includes evidence of both proper trademark use and generic use does not necessarily create a mixed record that would overcome an examining attorney's evidence of genericness. Quite simply, it would be fairly easy for a well-heeled applicant to ensure that there were at least some stories that would properly use an applicant's mark. However, in this case, the evidence of generic use is offset by applicant's evidence that shows not only a significant amount of proper trademark use but also trademark recognition by customers, publishers, and third parties.

In considering applicant's "mixed record" argument, we note the following evidence for "recycled paper greetings," as opposed to the evidence regarding "recycled paper" discussed above:

- Declarations of approximately ten sellers of greeting cards, or persons employed by sellers of greeting cards, stating that they recognize RECYCLED PAPER GREETINGS as a particular brand of greeting cards associated with a single source;⁹
- Examples of unsolicited media coverage referring to applicant by name, Recycled Paper Greetings (with initial capitalization of each term) located as a result of a search on the ProQuest database;¹⁰
- Google search results listing for the search term "recycled paper greetings";¹¹
- Evidence of advertising expenditures, retail sales dollar volume and total sales volume for greeting cards bearing RECYCLED PAPER GREETINGS;

⁹ Many of the declarations are from American Greetings Corporation, which is applicant's parent company. Such declarations reflect applicant's own viewpoint, rather than that of the relevant public.

¹⁰ The examples were taken from searches on the ProQuest database for "recycled paper greetings." From the listing of search results, it is not always apparent how the searched phrase is used. See e.g., entry no. 48 entitled "Former mayor assumes duties in greater Las Cruces, N.M."; and entry no. 56 entitled "Endangered landmarks." Exh. 1, decl. Diana Koppang, dated April 3, 2009.

¹¹ Some results do not use "recycled paper greetings" as an indicator of source. See, e.g., Google search result no. 91, stating "Find Moonshine Coffee Mug recycled paper greetings EUC in the Home Garden, ..."; no. 163, stating, "recycled inkjet paper, recycled kraft [sic] paper rolls, recycled butcher paper, recycled wrapping paper rolls, recycled paper greetings ..."; and no. 166, "Manufacturer, supplier and exporter of handmade greeting cards, handcrafted greeting cards, handmade paper cards, recycled paper greetings from India" Ex. 1, decl. Diana Koppang, dated April 3, 2009.

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- Evidence that applicant's RECYCLED PAPER GREETINGS greeting cards are sold through major retailers such as Wal-Mart, Target and Wegmans;
- Evidence that RECYCLED PAPER GREETINGS is displayed with applicant's branded signage in the greeting card section of most retail stores that sell applicant's products; and
- Alleged use of RECYCLED PAPER GREETINGS as a source identifier for over fifteen years.¹²

Notwithstanding applicant's significant use of "recycled paper" in its name, the record is clear that recycled paper is a principal component or ingredient of greeting cards and that the consuming public considers recycled paper as a sub-genus of goods. *Merrill Lynch*, its statements regarding a mixed-record and the allegedly mixed-record in this case do not compel a decision in applicant's favor. First, *Merrill Lynch* is distinguishable from the present case in that the entire designation CASH MANAGEMENT ACCOUNT was allegedly generic; here, the examining attorney contends that only part of RECYCLED PAPER GREETINGS is generic. Second, applicant relies on uses of "Recycled Paper Greetings" as a whole, which the examining attorney does not contend is generic, to overcome the disclaimer requirement. For *Merrill Lynch* to be

¹² Applicant submitted much of this evidence through the declaration of Mark Martin, applicant's vice-president and chief marketing officer, dated April 3, 2009.

persuasive, we would need to see mixed uses of "recycled paper," the term which is the subject of applicant's disclaimer. In sum, we are not persuaded that the allegedly "mixed record" here compels us to reverse the refusal to register in light of *Merrill Lynch*. *C.f.*, *In re Hotels.com LP*, 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009) (affirming Board ruling finding clear evidence of genericness on totality of record despite survey evidence and declarations).

In view of the foregoing and the evidence in the record, the examining attorney has established that "recycled paper" refers to a sub-genus of goods within the genus of greeting cards. As such, "recycled paper" is generic for greeting cards composed of recycled paper. Our determination is consistent with applicant's actions in Registration Nos. 1815545 and 1830936 on the Supplemental Register noted at the beginning of this opinion, where applicant entered disclaimers of RECYCLED PAPER. The Office requires disclaimers of generic terms in marks sought to be registered on the Supplemental Register. See TMEP § 1213.03(b) ("If a mark is comprised in part of matter that, as applied to the goods/services, is generic ... the matter must be disclaimed to permit registration on ... the Supplemental Register.").

Decision: The requirement for a disclaimer of RECYCLED PAPER in each application is affirmed. If applicant submits the required disclaimer in each application within thirty days of the mailing date of this decision, this decision will be set aside and the applications will move forward for publication.¹³

¹³ The standardized printing format for the required disclaimer text is as follows: "No claim is made to the exclusive right to use RECYCLED PAPER apart from the mark as shown." TMEP §1213.08(a) (8th ed. October 2011).