

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

Mailed:
June 4, 2009
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Columbia Insurance Company

Serial No. 77281250

Lisa A. Iverson and Jeremy M. Roe of Neal & McDevitt, LLC
for Columbia Insurance Company.

Kathleen M. Vanston, Trademark Examining Attorney, Law
Office 107 (J. Leslie Bishop, Managing Attorney).

Before Walters, Bucher and Bergsman, Administrative
Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

“... We can follow [the ants’] cue to create a more inspiring engagement – a partnership with nature. We can build factories whose products and by-products nourish the ecosystem with biodegradable material and recirculate technical materials instead of dumping, burning, or burying them. ... And there can be many of us and the things we make, because we have the right system – a creative, prosperous, intelligent, and fertile system – and like the ants, we will be ‘effective’.”

-- Architect William McDonough and chemist Michael Braungart,
CRADLE-TO-CRADLE: REMAKING THE WAY WE MAKE THINGS, at 156. (©2002)

Columbia Insurance Company seeks registration on the
Principal Register of the mark **CARPET TO CARPET** (*in
standard character format*) for services applicant has recited

as "receiving used carpet products for subsequent reclamation of the carpet" in International Class 37.¹

The Trademark Examining Attorney refused registration on the grounds that (1) applicant has failed to provide an acceptable recitation of services, and that (2) applicant has failed to disclaim the word "carpet" - a merely descriptive term under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

After the Trademark Examining Attorney made the refusals final, applicant appealed to this Board. We reverse both of these refusals to register this mark.

I. Proposed recitation of services

Applicant's original recitation was "receiving carpet products for subsequent reclamation of the carpet" in International Class 37. In her first Office Action, the Trademark Examining Attorney suggested instead: "carpet reclamation services, namely, *refurbishing carpets*" (*emphasis* supplied) in International Class 37.

¹ Application Serial No. 77281250 was filed on September 17, 2007 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

Applicant argues that this suggested language does not accurately represent the scope of services provided by applicant under this mark. Accordingly, applicant proposed the recitation of services listed above, merely adding the word "used" to its original recitation for further clarification: "receiving *used* carpet products for subsequent reclamation of the carpet."

The Trademark Examining Attorney argues that this is deficient because it is indefinite, may include services in more than one class, and that applicant's reliance upon prior registrations to establish the acceptability of the recitation of services is misplaced.

Applicant's Shaw Industries is a major manufacturer of floor coverings for commercial and residential applications. Like many others in the carpet manufacturing industry, it is seeking ways continuously to reduce its environmental footprint and divert as much used carpet as possible from burial in overflowing landfills across the nation. Applicant's commitment to the environment includes developing sustainable carpet products that can be broken down continually and reused, returning "carpet to carpet" (and "backing to backing") through a perpetual, closed-loop

or "cradle-to-cradle" recycling.² Applicant acknowledges that it is involved in activities such as transporting, sorting, processing and manufacturing activities. And undoubtedly, some small percentage of the used carpet that applicant receives may be repurposed - i.e., cleaned and refurbished and given to a charity, or re-entered into the marketplace as used carpet. However, the emphasis throughout the prosecution of this application has been on the intake part of the post-consumer cycle - the collection/diversion of post-consumer used carpet. Furthermore, the long-term goal of applicant's reclamation efforts is "closed-loop recycling" where the carpet components (e.g., nylon face fiber and proprietary backing materials) are reclaimed and recycled into the manufacture of new carpet.

As seen above, applicant's **CARPET TO CARPET** services involve collecting used carpet for reclamation.

Applicant has observed correctly that the Trademark Examining Attorney "has fixated on the term 'refurbishing'." The verb "refurbish" has connotations of making the carpet brighter and prettier, restoring the same

² For the test of materials for sustainability, applicant uses the Cradle-to-Cradle Design Protocol to determine whether individual materials are safe for humans and the environment. Secondly, it is critical that components can be recyclable through a closed-loop process that includes a post-consumer collection system.

piece of carpet to its former good condition in a cosmetic manner. It suggests a minor upgrade where the carpet may be cleaned, renewed and appropriately certified.

With its commitment to "cradle-to-cradle" sustainability, applicant rightly rejects an incorrect and limiting recitation of services suggesting that it renews carpet in a cosmetic manner. Applicant's analogy is apt in that enterprises involved in recycling aluminum cans are not in the business of "refurbishing" aluminum cans in order to re-use the same *old can*. Rather, the aluminum can recycler reclaims the technical nutrients of the old can to make an entirely *new can*.



for "receiving used aluminum products for subsequent reclamation of the aluminum" in International Class 37;³

³ Registration No. 1240595 issued on May 31, 1983; cancelled Sec. 8.



for "receiving used aluminum products for subsequent reclamation of the aluminum" in International Class 37;⁴

Given an even greater variety of downstream possibilities for the technical materials of used carpet, the concept of carpet "reclamation" is a broad term indeed. After collecting the used carpet, the next part of the cycle could include repurposing or refurbishing, recycling in a closed-loop to make new carpet, down-cycling to make other consumer products, or perhaps even burning it in a waste-to-energy plant.

The core services offered under this mark are the "collection" or "receiving" of carpet products. To the extent that applicant uses this very same mark for downstream services (e.g., transporting, processing and manufacturing activities), and desires the benefit of federal trademark protection therefor, applicant will need to submit other applications for these classes of services.

Accordingly, we find that applicant's proposed recitation of services is sufficiently definite to pass this mark on to publication.

⁴ Registration No. 1397119 issued on June 10, 1986; cancelled Sec. 8.

As to the related issue of whether the proposed recitation of services could include services in more than one class, again we agree with applicant. We see no hint in applicant's proposed recitation, for example, of any attempt to include materials treatment services that would be classified in International Class 40. Rather, the proposed recitation, on its face, is appropriately limited to services in International Class 37.

II. Disclaimer of the word "Carpet"

We agree with the Trademark Examining Attorney that the word "carpet" is descriptive when used in connection with the services applicant intends to provide under this mark, namely, the collection of post-consumer used carpet. Accordingly, the only remaining issue is whether the term is deemed to have lost its descriptive significance within this composite phrase.

In support of her position of requiring a disclaimer, the Trademark Examining Attorney points to a similarly-constructed mark for analogous services where the registration includes a disclaimer:



for "paper recovery and collection services for recycling" in International Class 37;

[Registration No. 2821935 issued on March 16, 2004. No claim is made to the word "Paper" apart from the mark as shown.]

In spite of the existence of this single analogous registration, we agree with applicant. When first encountering applicant's adopted term, one might well be put in mind of the expression, " ... earth to earth, ashes to ashes, dust to dust," from the *Book of Common Prayer*, or even the more recently-popularized, Twenty-First Century concept of "cradle-to-cradle" - a paradigm that seems to have inspired applicant. The way this almost-poetic turn of phrase rolls off the tongue, we find that it involves enough creativity to form a unitary whole, and hence, supports an exception to the need to disclaim an otherwise merely descriptive term. See TMEP § 1213.05(e).

Decision: We hereby reverse the refusals of the Trademark Examining Attorney. Hence, the mark in this application, namely **CARPET TO CARPET**, to be used in connection with services correctly recited as "receiving used carpet products for subsequent reclamation of the carpet" will be published for opposition in due course, without need for a disclaimer.