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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Glassflake International Inc.

Serial No. 77617272

Edwin D. Schindler for Glassflake International Inc.

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(Angela Bishop Wilson, Managing Attorney).

Before Bucher, Holtzman, and Wellington,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Glassflake International Inc. has filed an application
to register in standard characters GLASSFLAKE for the
following goods:

Chemicals used in industry, science and photography;
chemicals used in agriculture, horticulture and
forestry, except fungicides, insecticides and
parasiticides; chemical additives for use in the
manufacture of coatings, pigments, paints, polymers
and vehicle tires; chemical filler preparations for
use in the repair, resurfacing and patching of wood,
fiberglass, metal, plastic, plaster masonry materials
and concrete surfaces; chemical preservatives for use
as corrosion inhibitors on metals; mineral fillers in
the nature of anorthosite used in the manufacture of
glass, paint and vehicle tires; glass powder as a
filler for mixing with various resins

[in International Class 1];

Paints, varnishes, lacquers; pigments; preservatives against rust and against deterioration of wood in the nature of a coating; enamel paints; colorants; metals in foil and powder form for painters and decorators [in International Class 2]; and

Additives for plastics; mica for use as fillers for plastics; expansion joint fillers; insulating paints; reinforcing materials, not of metal, for pipes, namely, pipe joint compound, pipe joint sealant, insulated pipe supports; sealing and insulating materials; plastics in extruded form for use in manufacture; plastic materials in the form of non-textile sheets, rods, blocks and of tubes, all for use in manufacture; asbestos; raw and semi-worked rubber; asbestos and rubber articles, namely, asbestos boards and rubber for use in the manufacture of vehicle tires [in International Class 17].¹

Registration was originally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that GLASSFLAKE is merely descriptive of applicant's goods. Applicant subsequently amended the application to seek registration on the Supplemental Register. In response, the examining attorney refused registration on the Supplemental Register under Section 23 of the Trademark Act, 15 U.S.C. § 1091, on the ground that GLASSFLAKE is generic and incapable of identifying applicant's goods.

Applicant has appealed the refusal and the sole issue on appeal is whether GLASSFLAKE is generic for applicant's

¹ Application Serial No. 77617272, based on a European Community registration under Section 44(e). The foreign registration issued on June 4, 2008.

goods and, thus, unregistrable on the Supplemental Register.

When a proposed mark is refused registration as generic, the examining attorney has the burden of proving genericness by "clear evidence." *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); see also *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987). The critical issue is to determine whether the record shows that members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods or services in question. *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986); *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992). Making this determination "involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?" *Ginn*, 228 USPQ at 530. Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. *Merrill Lynch*, 4 USPQ2d at 1143, and *In re*

Serial No. 77617272

Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

With respect to the question of what are the genera of goods at issue in this case, we note that applicant and the examining attorney briefed the genericness ground for refusal based on applicant's identification of goods in each class. We agree that the genera of goods are adequately identified by the application's identification (recited above). It does warrant pointing out that there is more than one genus of goods inasmuch as the refusal to registration is being asserted against three international classes of goods and the goods vary in nature, even within the same class. However, the examining attorney need only establish that the proposed mark is generic for one of the goods within each international class of goods described in the application, and that it is then appropriate to deny registration for that entire class of goods for which registration is sought. See *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 525, 205 USPQ 505, 507 (CCPA 1980).

We now look to whether the purchasing public understands GLASSFLAKE to refer to a genus of goods within each class of the identified goods. In doing so, we initially address arguments put forth by applicant. First, applicant notes that its proposed mark GLASSFLAKE is "a

Serial No. 77617272

single word in the singular, as opposed to a plural usage comprising two separate words, such as 'glass flakes'." Brief, p. 6. The fact that applicant's proposed mark is a compound term lends no additional meaning to the individual words "glass" and "flake" and consumers will simply perceive the mark as the combination thereof without a space. Likewise, the use of the singular versus plural with regard to the term "flake(s)" is irrelevant inasmuch as consumers will perceive no real difference in the meaning of the mark when viewed in connection with the identified goods. Indeed, while the record shows the term "glass flakes" more often, there are several instances where it is used in the singular.

Applicant also tries to make hay out of the examining attorney's failure to raise the genericness refusal in the first Office Action. Applicant states that the examining attorney has "taken inconsistent legal positions by initially refusing registration of [applicant's] mark on the ground that GLASSFLAKE was merely descriptive, then subsequently refusing registration of [the mark] as generic," after applicant amended the application to seek registration on the Supplemental Register. Reply Brief, p. 4. We find no such inconsistency; rather, the examining attorney's handling of the application was in accord with

the Trademark Manual of Examining Procedure (TMEP). See TMEP § 1209.02(a) (7th Ed. rev. October 2010) ("Even if it appears that the mark is generic, the proper basis for the refusal is...descriptiveness. ...If the applicant responds to a [descriptiveness] refusals by amending its application to the Supplemental Register,...the examining attorney should then issue a nonfinal action refusing registration [based on] § 23 of the Act...").

Finally, we address what appears to be the major point of contention on appeal, namely, whether a mark that identifies an ingredient may be found generic and thus unregistrable. Specifically, applicant contends that its mark GLASSFLAKE is descriptive, but not generic, as it only identifies a "feature," and that because its goods "are not literally a 'glass flake' or 'glass flakes[,]'" it cannot reasonably be said that [GLASSFLAKE] 'names' that which are [applicant's goods]." Brief, p. 6.

The Board has long held that marks may be generic if they serve to identify a principal ingredient or key characteristic of the goods. See *In re Demos*, 172 USPQ 408, 409 (TTAB 1971) [CHAMPAGNE "merely names the 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

Serial No. 77617272

unregistrable"]; and *In re Hask Toiletries, Inc.*, 223 USPQ 1254 (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'"]. See also, *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"]; *In re Northland Aluminum Products, Inc.*, supra [BUNDT for coffee cake held generic]; *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]. Accordingly, if the evidence is clear that GLASSFLAKE names a primary ingredient of the goods, applicant's proposed mark is generic for such goods.

Serial No. 77617272

In this case, the record clearly establishes that "glass flakes" are used as a filler or additives in various materials and that ultimately the term GLASSFLAKE would be understood as identifying either the actual goods or a principal ingredient of said goods, as identified in each of the application's international classes of goods. The examining attorney did an exemplary job in creating a record that supports these findings. This includes: printouts from various websites, including applicant's, describing "glass flakes" and their uses; copies of several patents (and patent applications) discussing the use of glass flakes in the invention; and numerous articles describing glass flakes and their uses. The examining attorney furthermore did a thorough job in his brief summarizing the record and providing bulleted examples illustrating the relevant evidence. Indeed, the entire record is replete with evidence demonstrating widespread generic use of the term "glass flakes" and further demonstrating the various uses of glass flakes. In general, the term "glass flake" refers to "a filler produced by blowing molten type E-glass into a very thin tube, then pulverizing the tube into small fragments. The flakes pack closely in thermosetting resin systems,

producing strong products with good moisture resistance."²
It may be used as a primary or key ingredient in various materials, including plastics, rubber, paints, and other materials to provide a stronger, more impermeable product or finish.

In view of the above and, again, based on the entire record, it is clear that the mark GLASSFLAKE precisely names applicant's "glass powder as a filler for mixing with various resins" (in International Class 1). As discussed above, manufacturing glass flakes involves pulverizing the tube of glass into small fragments; thus, applicant's use of "glass powder" would also include glass flakes. Likewise, the goods described in the application as "additives for plastics" (International Class 17) encompass glass flakes. As demonstrated by several articles, Internet websites, including applicant's and those of third-parties, glass flakes are used as additives in resins and plastics to create a beneficial quality, finish or

² Taken from website www.about.com; printout submitted with Office Action dated February 27, 2009. The description is corroborated by the entire record, including applicant's own website description, e.g., "What is GlassFlake?...GlassFlake is a severe service coating and lining which utilizes 1/32" or 1/8" chemical grade flaked glass. When incorporated into our polyester, vinyl ester, novolac vinyl ester, novolac epoxy, or furan base resins, the glass flakes overlap and stratify to create a maze-like structure that is 15-20 times more impermeable than resin alone."

Serial No. 77617272

texture to the finished products. We further find that glass flakes may be a primary ingredient of "paints, varnishes, lacquers" (International Class 2) and the mark GLASSFLAKE, when used in connection with such goods, would be understood by consumers as referencing this ingredient. Applicant's own usage of its mark in a generic manner is certainly relevant in this regard. See *Gould*, 5 USPQ2d at 1019 ("Gould's own submissions provided the most damaging evidence [that the word is generic]"). In addition to statements made on its website (see, e.g., footnote 3), applicant admits in its brief that its goods include "a wide range of unrelated products that may have a large number of very small glass flakes incorporated therein." Brief, p. 6.

Based on this record, the examining attorney clearly established that GLASSFLAKE is generic for the identified goods in each of the application's three international classes and, under the language of Section 23, the proposed mark is not "capable of distinguishing the applicant's goods or services." 15 U.S.C. § 1091(c).

Decision: The refusal to register on the Supplemental Register based on genericness under Section 23 is affirmed.