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EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION SERIAL NO. 77617272

MARK: GLASSFLAKE



CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Glassflake International Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF

I. INTRODUCTION

Applicant, Glassflake International Inc. (hereinafter "Applicant"), has appealed the final refusal to register the proposed mark GLASSFLAKE on the Supplemental Register for:

- "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 fixing 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.

Registration is refused pursuant to Trademark Act Section 23(c), 15 U.S.C. §1091(c), on the ground that the term GLASSFLAKE is generic of a key ingredient, characteristic or feature of Applicant’s goods and therefore incapable of registration.

It is respectfully requested that this refusal be affirmed.

II. STATEMENT OF FACTS

On November 19, 2008, Applicant filed an application for registration on the Principal Register for the standard character mark GLASSFLAKE for various goods in International Classes 1, 2, and 17. Registration was based on Applicant’s ownership of a foreign registration in the European Community.

On February 27, 2009, the undersigned examining attorney (“Examining Attorney”) refused registration under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), on the ground that the applied-for mark was merely descriptive in connection with Applicant’s goods. Applicant was also required to submit additional information about its goods, explain the applied-for mark’s significance, provide a copy of its foreign registration, and amend its identifications of goods.

On September 1, 2009, Applicant sought suspension of the application in order to provide the information required.

On September 21, 2009, the Examining Attorney refused to suspend the application pursuant to TMEP §716.02(b). The Examining Attorney issued a final refusal

of the applied-for mark under Section 2(e)(1). The various requirements were also made final.

On May 21, 2010, Applicant filed a request for reconsideration, in which Applicant amended the application to seek registration on the Supplemental Register. Applicant also satisfied various requirements.

On June 2, 2010, the Examining Attorney refused registration on the Supplemental Register on the ground that the applied-for mark was generic under Trademark Act Section 23(c), 15 U.S.C. §1091(c). The requirement for an amended identification of goods in International Class 17 was maintained.

On June 26, 2010, Applicant submitted arguments against the genericness refusal. Applicant also properly amended the International Class 17 identification of its goods.

On June 30, 2010, the Examining Attorney issued a final refusal of the applied-for mark under Section 23(c).

On December 17, 2010, Applicant filed the present appeal with the Trademark Trial and Appeal Board (“Board”).

III. ARGUMENT

A word or term does not need to be the name of the goods to be found incapable of serving as an indicator of origin. A word or term that is the name of a key ingredient, characteristic or feature of goods can be generic for those goods and thus, incapable of distinguishing source. *In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718 (C.C.P.A. 1970) (holding CUSTOM BLENDED generic for gasoline); *In re Helena Rubenstein, Inc.*, 410 F.2d 438, 161 USPQ 606 (C.C.P.A. 1969) (holding PASTEURIZED generic for face cream); *Roselux Chem. Co. v. Parsons Ammonia Co.*, 299 F.2d 855, 132 USPQ 627

(C.C.P.A. 1962) (holding SUDSY generic for ammonia); *In re Eddie Z's Blinds & Drapery, Inc.*, 74 USPQ2d 1037 (TTAB 2005) (holding BLINDSANDDRAPERY.COM generic for online retail store services featuring blinds, draperies and other wall coverings); *In re Candy Bouquet Int'l, Inc.*, 73 USPQ2d 1883 (TTAB 2004) (holding CANDY BOUQUET generic for “retail, mail, and computer order services in the field of gift packages of candy”); *In re Reckitt & Colman, N. Am. Inc.*, 18 USPQ2d 1389 (TTAB 1991) (holding PERMA PRESS generic for soil and stain removers); *In re Ricci-Italian Silversmiths, Inc.*, 16 USPQ2d 1727 (TTAB 1990) (holding ART DECO generic for flatware); *In re Hask Toiletries*, 223 USPQ 1254 (TTAB 1984) (holding HENNA ‘N’ PLACENTA generic of ingredients for hair conditioner); *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 1 USPQ2d 1364 (3d Cir. 1986) (holding CHOCOLATE FUDGE generic for diet sodas); *see* TMEP §§1209.01(c) *et seq.*

In this case, the evidence of record demonstrates that “GLASSFLAKE” is the name of a key ingredient, characteristic or feature of Applicant’s goods, namely, glass flakes. As such, the applied-for mark is generic and incapable of registration. Applicant’s arguments regarding its foreign registration and the Examining Attorney’s alleged “inconsistent legal positions” are unpersuasive.

A. “GLASSFLAKE” is the name of a key ingredient, characteristic or feature of Applicant’s goods, namely, glass flakes.

At the outset, it must be noted that one the goods listed in International Class 1 is “glass powder as a filler for fixing with various resins.” As this identification shows, “glass” is one of the goods being offered by Applicant. The word “flake” refers to the form in which the glass is provided, namely, powder made up of flakes. *See, e.g.:*

- The American Heritage® Dictionary of the English Language (4th ed. 2000), <http://education.yahoo.com/reference/dictionary/entry/flake> (defining “flake” as “a flat thin piece or layer; a chip”) (from the 09/21/2009 Office action);
- Merriam-Webster Online Dictionary (2010), <http://www.merriam-webster.com/dictionary/flake> (defining “flake” as “a small loose mass or bit <flakes of snow>” and “a thin flattened piece or layer; chip”) (from the 06/30/2010 Office action).

Moreover, “glass powder as a filler for fixing with various resins” is nearly identical to the definition of “glass flake” provided by the Examining Attorney in the February 27, 2009, Office action. *See, e.g.,* About.com, *Glass Flake*, <http://composite.about.com/library/glossary/g/bldef-g2444.htm> (defining “glass flake” as “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.”). Therefore, GLASSFLAKE is the generic name for these goods. Because GLASSFLAKE is generic in connection with at least one of the goods in International Class 1, registration of this class must be denied in its entirety. *See, e.g., In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 525, 205 USPQ 505, 507 (C.C.P.A. 1980) (“Registration will be denied if a mark is merely descriptive of *any* of the goods or services for which registration is sought.”) (emphasis added).

Applicant admits that its goods “have a large number of very small glass flakes incorporated therein.” Applicant’s Appeal Br. at 6. In addition to this admission, Applicant provided information about its goods with its May 21, 2010, request for reconsideration showing that glass flakes are a key ingredient, characteristic or feature of its goods. *See*:

- Applicant’s website printouts:

- *Innovation in Action*, <http://www.glassflake.com/innovation-content.htm> (“High specification glass flake products manufactured by Glassflake”);
- *Products*, <http://www.glassflake.com/products-content.htm> (“Glassflake Limited produces flake glass materials”; “A comprehensive range of glass flakes suitable for most applications.”; “Innovative ultra-thin glass flakes”; “A robust, modified C-type glass flake”; “Silver coated glassflakes imparting striking decorative effects, in addition to the acknowledged benefits of glassflake.”; and “A whole new dimension of decorative enhancement can be gained with this ingenious addition to our range of glassflake products.”);
- Patent Application for “Vehicle Tires,” *Summary of the Invention* (“According to the present invention, there is provided a vehicle tire having a tread and/or a sidewall containing a filler including glass flake.”);
- Patent Application for “Dental Fillings and Bone Tissue,” *Summary of the Invention* (“According to the present invention, there is provided a bone substitute composition comprising glass flake and a hardenable material.”).

Moreover, the Examining Attorney submitted additional evidence from

Applicant’s websites in the September 21, 2010, Office action demonstrating that glass flakes are a key ingredient, characteristic or feature of Applicant’s goods. *See*:

- GlassFlake International:
 - *Home – What is GlassFlake?*, <http://www.glassflake.net/>: “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.”
 - *About Us*, <http://www.glassflake.net/aboutus.htm>: “Other coatings manufacturers have products containing flake glass, but only GlassFlake International has proprietary glass flake sizing and treating equipment. This allows the complete incorporation of glass into the resin matrix, assuring totally overlapping strata, without the possibility of chemical intrusion, which results in poorly protected substrate areas.”

- *Technology*, <http://www.glassflake.net/technology.htm>: “Unlike many competitive coatings that use spherical fillers, our flaked glass reinforcement is chemically bonded to the base resin.”
- Glassflake Limited:
 - *Company Profile – Innovation in Action*, <http://www.glassflake.com/innovation.htm>: “High specification glass flake products manufactured by Glassflake originate from an R&D project pioneered in 1981, resulting in the development of a thinner flake with significantly improved performance characteristics.”
 - *Company Profile – History & Quality*, <http://www.glassflake.com/history-new.htm>: “Glassflake Limited is responsible for the development of a patented process for manufacturing high specification glass flakes.”
 - *Applications – Coatings*, <http://www.glassflake.com/coatings.htm>: “Flake glass products have played an important role in the coatings industry for many years, incorporated into epoxy and vinyl ester resin systems to achieve performance enhancements in environments as diverse as marine, oil and gas, petrochemicals and steel.”
 - *Applications – Pigments*, <http://www.glassflake.com/pigments.htm>: “Innovations in flake glass technology have enabled the production of thin glass flakes. ... Effect pigments based on glass flakes may be used in an array of applications, including cosmetics, plastics, automotive and architectural refinishes.”
 - *Applications – The Future*, <http://www.glassflake.com/future.htm>: “Use of nano glass flakes can extend to any material seeking performance improvements in areas including barrier properties, gas and moisture permeation and improved mechanical properties at low loadings.”
 - *Products – Flake Glass Material from Glassflake*, <http://www.glassflake.com/products.htm>: “Glassflake Limited produces flake glass materials in a range of nominal flake thicknesses, particle size ranges, chemical compositions and surface coatings to meet all application requirements.”
 - *Products – ECR Glassflake*, <http://www.glassflake.com/products-sfmilled.htm>: “A comprehensive range of glassflakes suitable for most applications. ... The ECR type glass utilised in Glassflake Ltd’s ECR glassflakes has been specifically formulated for the coatings market.”

- *Products – Nano Flake*, <http://www.glassflake.com/nanoflake.htm>: “Innovative ultra-thin ECR glassflakes delivering outstanding material improvements, with thicknesses available from 100nm up to 750nm.”
- *Products – C-Type Glassflake*, <http://www.glassflake.com/products-c-type-glassflake.htm>: “C-Type glassflake's economical single specification fulfills the requirements of many applications desiring the benefits that glassflake can bring, but without some of the cost associated with the addition of higher specification flakes.”
- *Products – Agflake*, <http://www.glassflake.com/products-agflake.htm>: “AgFlakes are silver-coated glassflakes imparting striking decorative effects, in addition to the acknowledged benefits of standard glassflake.”

Applicant is not the only party to use “glass flake” generically for the name of a key ingredient, characteristic or feature of goods. *See, e.g.:*

- From the 02/27/2009 Office action:
 - AllBusiness, *Toyo develops thin glass flake*, <http://www.allbusiness.com/manufacturing/chemical-manufacturing-paint/734750-1.html> (“This pigment is based on an ultra thin glass flake of 1/[micro]m thickness and covered by various kinds of special metals.”);
 - Carbonline, *Product Data: Glass Flake (GF) Additive*, [http://msds.carboline.com/website/carbmsds.nsf/\(all\)/62640BE51BE66D1B8525705A00434CBF/\\$file/Glass+Flake+Additive+PDS+4-04.pdf](http://msds.carboline.com/website/carbmsds.nsf/(all)/62640BE51BE66D1B8525705A00434CBF/$file/Glass+Flake+Additive+PDS+4-04.pdf);
 - U.S. Patent No. 5368885, *Method of applying coating powder and glass flake to produce a glass flake-containing finish*, <http://patft.uspto.gov/netacgi/nph-Parser?Sect1=PTO2&Sect2=HITOFF&p=1&u=%2Fnetacgi%2FPTO%2Fsearch-bool.html&r=1&f=G&l=50&col=AND&d=PTXT&s1=5368885.PN.&OS=PN/5368885&RS=PN/5368885> (“To form a sparkle finish by powder coating, an opaque initial layer is first applied to a substrate, e.g., by powder coating. Then a mixture of glass flake and clear coating powder is prepared by blending. This mixture is then applied to a substrate, e.g., electrostatically, and heated to fuse and/or cure the coating powder.”).
- From the 09/21/2009 Office action:
 - Polymer Technologies, *Glass Flakes*, <http://www.polymertec.com/glass.html> (“Glass flake is a discreet, thin plate-like particle.”);

- U.S. Patent No. 5002827, *Agglomerated glass flakes*, <http://patft.uspto.gov/netacgi/nph-Parser?Sect1=PTO2&Sect2=HITOFF&p=1&u=%2Fnetacgi%2FPTO%2Fsearch-bool.html&r=1&f=G&l=50&col=AND&d=PTXT&s1=5002827.PN.&OS=PN/5002827&RS=PN/5002827> (“Granules of glass flakes which comprise glass flakes in granular form and a binder which bonds the glass flakes to one another to form granules. The granules are used together with a molten thermoplastic resin.”);
- U.S. Patent No. 7226503, *Effect pigments based on coated glass flakes*, <http://patft.uspto.gov/netacgi/nph-Parser?Sect1=PTO2&Sect2=HITOFF&p=1&u=%2Fnetacgi%2FPTO%2Fsearch-bool.html&r=1&f=G&l=50&col=AND&d=PTXT&s1=%22effect+pigments+based+coated+glass+flakes%22.TI.&OS=TTL/> (“The present invention relates to effect pigments based on thin glass flakes and to a method for the production of such pigments. The resulting pigment can be used in any application for which pearlescent pigments have been heretofore used such as, for example, in plastics, paints, inks, cosmetic formulations, coatings including solvent or waterborne automotive paint systems, powder coatings, inks and agriculture foils.”);
- *Beautiful Music, Beautiful House*, ORLANDO SENTINEL, Apr. 27, 2003, at J6 (“The rust-encapsulating paint is made with heat-hardened glass flakes that form a protective barrier against moisture and dirt.”);
- *Home Tidbits*, THE STATE, Apr. 20, 2003, at G2 (“The paint dries to a rust-encapsulating coating that contains glass flakes. The glass interlocks with special resins to form a protective layer that moisture can't penetrate. No moisture, no rust.”).
- From the 06/30/2010 Office action:
 - Simon J. Brigham & Charles Watkinson, *Understanding and use of glass flake*, <http://www.highbeam.com/doc/1G1-201853954.html> (stating “glass flake quickly found its way into the coatings industry and it is here that the bulk of flake was used for many years”);
 - Corrocoat, *Polyglass*, <http://www.corrocoat.com/pages/products/polyglass> (“ECR glass flake imparts better qualities to Polyglass than standard glass flakes and in conjunction with highly modified resin systems provides a very low permeation, mechanically strong, tough and abrasion resistant coating with outstanding long-term performance.”);

- *Epoxy Swimming Pool Paint*, <http://www.line-a-pool.com/> (“Swimming Pool paint, epoxy by Epoxy-man is a non solvent epoxy swimming pool paint lining with glass flakes incorporated.”);
- Flakecoat, *Flakecoat Glassflake Reinforced Coatings & Linings*, http://www.flakecoat.com/index.php?option=com_content&task=view&id=3 (“We carry a comprehensive range of glassflake reinforced coatings & linings ...”);
- Fox Industries, *FX-3116 Glass Flaked Epoxy Coating*, <http://www.foxind.com/datasheet.asp?sheet=35> (“FX-3116 contains glass flake reinforcement and provides a tough, chemical resistant, flexible coating that is ideally suited for aggressive water service (salt, brackish).”);
- Garay, *Glass Flake Lining*, http://www.garay-group.com/enhtml/en_productos-flake-glass-lining.php (“GARAY S.A. has incorporated into its array of products a line of resins generically called Glass-Flake, which are based on a resin that serves as the support and a filler of overlapping glass flakes, forming various layers within the coating thickness.”);
- *Glass flake epoxy comes of age*, <http://www.allbusiness.com/manufacturing/chemical-manufacturing-paint/591290-1.html> (“Glass flake epoxy pigments play a major role in protecting structural steelwork against corrosion.”);
- Ronald C. Hearn, *Glassflake reinforced linings and coatings*, <http://www.emeraldinsight.com/journals.htm?articleid=1686905&show=abstract> (“Glassflake reinforced lining and coating systems have been under continuous development and evaluation for nearly two decades.”);
- Jotun, *Polyester coatings*, <http://www.jotun.com/www/com/20020113.nsf?OpenDatabase&db=www/com/20020115.nsf&v=10F2&e=uk&m=912&c=E71953A98A84D540C1256C59004FEF30> (“Polyester coatings are quick curing, glass flake reinforced, high build coatings.”);
- Motley Exim Co., *Floor Coating: Acid Resistant Glass Flake Coating*, <http://www.motleyexim.com/floor-coating.html> (“Glass flake filled epoxy is formulated with high performance resins, premium quality glass flakes and other filler.”);
- OriginalGlassflake.com, *What is GlassFlake?*, <http://originalglassflake.com/> (“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.”);

- S. Sathiyarayanan et al., *Corrosion protection coating containing polyaniline glass flake composite for steel*, http://www.sciencedirect.com/science?_ob=ArticleURL&_udi=B6TG0-4PP2CY9-3&_user=2502287&_coverDate=01%2F01%2F2008&_rdoc=1&_fmt=high&_orig=search&_sort=d&_docanchor=&_view=c&_searchStrId=1386728862&_rerunOrigin=google&_acct=C000055109&_version=1&_urlVersion=0&_userid=2502287&md5=7a46a57a17a818424c8eb194246776e4 (“Corrosion protection of steel by glass flake (GF) containing coatings is widely used in marine atmosphere.”);
- Sherwin-Williams, *Epoxy: Sher-Glass – Glass Flake Epoxy*, <http://protective.sherwin-williams.com/detail.jsp?A=sku-25878%3Aproduct-6851> (“SHER-GLASS FF is a glass flake reinforced amine epoxy coating formulated for immersion service or where steel or concrete protection is desired, in a wide range of harsh industrial environments.”);
- Christopher A. Stevens & David W. Mason, *Glass flake particles for enhanced permeation resistance of compounds*, <http://www.highbeam.com/doc/1G1-168089905.html>;
- Jeffrey Stewart et al., *Acid gas protection: using the right linings and protective coatings, along with the correct application processes, can extend the life of flue gas desulfurization systems and optimize a plant's investment. (FIELD-APPLIED COATINGS: FGD SYSTEMS)*, <http://www.highbeam.com/doc/1G1-177102114.html> (“These resins offer excellent properties for a lining system by themselves, but their performance is greatly enhanced by a mixture of additives, including glass flakes”).

Based on this evidence, the relevant purchasing public, when viewing the applied-for mark in connection with Applicant’s goods, would understand “GLASSFLAKE” primarily to refer to goods that contain glass flakes. Therefore, “GLASSFLAKE” is not only descriptive, it literally names a key ingredient, characteristic or feature of

Applicant's goods, namely, thin pieces of glass used as special reinforcing filler for various goods to impart special or improved properties.

Applicant argues that "GLASSFLAKE" is presented as a "single word in the singular, as opposed to a plural usage comprising two separate words, such as 'glass flakes.'" Applicant's Appeal Br. at 6. This argument is unpersuasive because the absence of the space between "GLASS" and "FLAKE" is not significant. *See In re Planalytics, Inc.*, 70 USPQ2d 1453, 1455 (TTAB 2004) (discussing difference between "GAS BUYER" and "GASBUYER") ("[W]e cannot see how the absence of the space creates a different meaning or perception of the term. Whether the term appears as GAS BUYER or GASBUYER, it would be understood by the relevant consumers to have the same meaning"); *In re SPX Corp.*, 63 USPQ2d 1592, 1596 (TTAB 2002) ("[T]elescoping two words which are merely descriptive of the goods into a single term by the deletion of a space does not avoid a finding of mere descriptiveness for the combined term."). Indeed, Applicant's own evidence and the evidence from Applicant's own websites shows that Applicant uses the wording "glass flake," "glass flakes," "glassflake" and "glassflakes" interchangeably.

In any event, an applied-for mark that is a compound term consisting of a combination of two or more words is generic if the evidence of record shows that each of the constituent words is generic, and that each word retains its generic meaning when combined such that the composite formed is generic and does not create a different, non-generic meaning. *See In re Gould Paper Corp.*, 834 F.2d 1017, 1018-19, 5 USPQ2d 1110, 1111-12 (Fed. Cir. 1987); *In re Wm. B. Coleman Co.*, 93 USPQ2d 2019, 2021 (TTAB 2010); TMEP §1209.01(c)(i). Here, the evidence shows that both "glass" and

“flake” are generic for a key ingredient, characteristic or feature of Applicant’s goods. The combination of the two generic words into one word does not create a different, non-generic meaning, and Applicant has provided no evidence of such a meaning.

Because the applied-for mark is the name of a key ingredient, characteristic or feature of Applicant’s goods (i.e., glass flakes), and because the relevant public would understand “GLASSFLAKE” to primarily refer to this key ingredient, characteristic or feature, the applied-for mark is generic. As such, it cannot be registered on the Supplemental Register because a generic designation cannot become a trademark under any circumstances.

B. Applicant’s foreign registration is not probative on the issue of genericness.

Applicant argues that “the implicit determination by the European Community that Appellant’s ‘GLASSFLAKE’ trademark is registrable – and therefore not a generic term – should be accorded probative weight.” Applicant’s Appeal Br. at 8. However, this foreign registration is of little, if any, probative value. *See In re Bayer*

Aktiengesellschaft, 488 F.3d 960, 969-70, 82 USPQ2d 1828, 1835-36 (Fed. Cir. 2007)

(footnote and citations omitted):

Bayer asserts that its evidence of registration of ASPIRINA in numerous foreign countries for a long period of time “evidenc[es] Applicant's ownership of trademark rights around the world, including throughout the Spanish speaking world” and provides evidence of consumer perception among potential purchasers of Bayer’s products. The Board indicated that these registrations were “immaterial to the issue of inherent distinctiveness and the registerability [sic] of the same term in the United States.” ... We agree. Evidence of registration in other countries is not legally or factually relevant to potential consumer perception of Bayer’s analgesic goods in the United States. ... [T]he fact that ASPIRINA is registered in numerous Spanish-speaking countries alone is not probative of the relevant consumer population’s perception of the mark in the United States.

... Each country that recognizes some form of trademark protection will have its own body of law and will evaluate a registration request in light of evidence of consumer perception in that country. This is why aspirin is entitled to trademark protection in many other countries though it was found generic for analgesic goods some time ago in the United States. ... Thus, evidence of registration of ASPIRINA in another country is of little value to our analysis of its entitlement to protection in the United States and we cannot say it overcomes the substantial evidence that otherwise supports the Board's decision in this case.

C. The prosecution history of this application does not support a finding that the applied-for mark is merely descriptive.

Applicant argues that the Examining Attorney has taken “inconsistent legal positions” regarding the nature of the applied-for mark. Applicant's Appeal Br. at 7-8. It is Applicant's belief that, because the applied-for mark was originally refused as merely descriptive, it supports a finding that the applied-for mark is descriptive. *Id.* at 7. However, this is not the case.

Procedurally, an examining attorney is not to initially refuse registration of an applied-for mark on the Principal Register on the basis that the applied-for mark is generic. *See* TMEP §1209.02(a) (“Even if it appears that the mark is generic, the proper basis for the initial refusal is §2(e)(1) descriptiveness.”). Accordingly, the appropriate refusal of the applied-for mark in this case (at least initially) was one of mere descriptiveness under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), as mandated by the *Trademark Manual of Examining Procedure*.

In its May 21, 2010, request for reconsideration, Applicant amended its application to seek registration on the Supplemental Register. The Examining Attorney was then permitted to formally refuse the applied-for mark as generic under the procedures set forth in the *Trademark Manual of Examining Procedure*. *See* TMEP §1209.02(a)(i):

If the applicant responds to a §2(e)(1) descriptiveness refusal by amending its application to the Supplemental Register, this amendment presents a new issue requiring consideration by the examining attorney. . . . If the examining attorney determines that the designation is a generic name for the applicant's goods or services, the examining attorney should then issue a nonfinal action refusing registration on the Supplemental Register. The statutory basis for such a refusal is §23 of the Trademark Act, 15 U.S.C. §1091.

Therefore, the fact that the applied-for mark was initially refused as merely descriptive because the Examining Attorney was procedurally required to do so is not evidence that there is any doubt that the applied-for mark is generic. In any event, “[t]he generic name of a thing is in fact the ultimate in descriptiveness.” *H. Marvin Ginn Corp. v. Int’l Ass’n. of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986).

IV. CONCLUSION

The applied-for mark GLASSFLAKE is the name of a key ingredient, characteristic or feature of Applicant's goods, namely, glass flakes. The relevant public, when viewing the applied-for mark in connection with Applicant's goods, would primarily understand “GLASSFLAKE” to refer to goods that contain glass flakes. As such, the applied-for mark is generic and incapable of registration on the Supplemental Register. Doing so would grant Applicant a monopoly on wording that is currently used generically by competitors as the name of a key ingredient, characteristic or feature of their own goods. *See In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1569, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987); *see* TMEP §1209.01(c). Therefore, because the applied-for mark is generic, it must be refused registration on the Supplemental Register under Trademark Act Section 23(c), 15 U.S.C. §1091(c).

For the foregoing reasons, the Examining Attorney respectfully requests that the refusal to registration under Trademark Act Section 23(c), 15 U.S.C. §1091(c), be affirmed.

Respectfully submitted,

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