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Subject: U.S. TRADEMARK APPLICATION NO. 77873477 - MAGNESITA - MAGN6002/TJM - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 77873477

MARK: MAGNESITA

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GENERAL TRADEMARK INFORMATION:

http://www.uspto.gov/trademarks/index.jsp

TTAB INFORMATION:

http://www.uspto.gov/trademarks/process/appeal/index.jsp

APPLICANT: MAGNESITA REFRACTORIES COMPANY

CORRESPONDENT'S REFERENCE/DOCKET NO:

MAGN6002/TJM

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

In this case the Applicant appeals the Trademark Examining Attorney's Final Refusal of the proposed mark, MAGNESITA, for "Refractory products not made primarily of metal, namely, refractory bricks, refractory mixes for patching, lining or repairing high temperature apparatus and repairing the lining for furnaces, refractory furnace patching and repair mixes." Registration has been finally refused because the proposed mark appears to be generic as applied to the proposed goods. Alternatively, registration has also been refused because the mark is descriptive of the applicant's goods under Section 2(e)(1), 15 U.S.C. §1052(e)(1). Moreover, because of the highly descriptive nature of the proposed mark when used in connection with the goods named in the application, the Section 2(f) claim of acquired distinctiveness under the Trademark Act fails due to the insufficiency of proof to overcome the refusal of registration.

The application also includes the following services in International Class 37, "Providing information via a global computer network on constructing, maintaining, and repairing refractory apparatus using refractory products." The examining attorney has stated on the record that the proposed mark is acceptable on the Supplemental Register for the services in International Class 37.

The examining attorney respectfully requests that the Board affirm the refusal to register the proposed mark.

STATEMENT OF THE CASE

On November 16, 2009, the applicant filed an application for the mark, MAGNESITA, for the following goods and services, "Refractory products, namely, refractory bricks, refractory mixes

for patching, lining or repairing high temperature apparatus and repairing the lining for furnaces, refractory furnace patching and repair mixes," and "Computerized online commercial stores featuring refractory products by means of the Internet" and "Providing information via a global computer network on the use of refractory products to construct, maintain and repair refractory apparatus." On February 22, 2010, the examining attorney issued and office action requiring that the applicant pay for two of the three classes listed in the application, amend the recitation of services in International Class 35 and provide a translation of the proposed mark.

In response to the original office action, on March 18, 2010, the applicant paid the fee for two classes of services, amended the recitation of services in International Class 35 and provided a translation of the mark. On March 30, 2010 the examining attorney issued an examiner's amendment to put the translation statement in the proper format. Also on March 30, 2010, the examining attorney issued a refusal under Section 2(e)(1) of the Trademark Act because the proposed mark was descriptive of the goods and services based on the translation of the proposed mark.

On September 27, 2010, the applicant responded to the refusal to register the proposed mark under Section 2(e)(1) of the Trademark Act. On November 5, 2010, the examining attorney continued the refusal under Section 2(e)(1) and continued the requirement that the applicant properly amend the recitation of services in International Class 35.

On April 29, 2011, the applicant responded to the continuing refusal to register. The response resolved the recitation of services issue but did not resolve the refusal to register under Section 2(e)(1). On May 27, 2010, the examining attorney issued a Final Refusal under Section 2(e)(1).

On June 13, 2011, the applicant filed a response to the Final Refusal as well as an Amendment to Allege Use. In the response, the applicant deleted the services in International Class 35 and requested reconsideration of the refusal stating that the filing of the Amendment to Allege Use for the goods and services in International Classes 19 and 37 raised a new issue.

On June 23, 2011, the examining attorney issued a new non-final office action because the Amendment to Allege Use raised a new issue in the application. The specimens of use for the services in International Class 37 were unacceptable. The refusal under Section 2(e)(1) was maintained and continued. On December 15, 2011, the applicant responded to the refusal of the specimens by demonstrating how the specimens actually advertised the services and submitted arguments to overcome the refusal under Section 2(e)(1).

On January 9, 2012, the examining attorney, once again issued a Final Refusal under Section 2(e)(1) and a Final Refusal of the specimens of use in International Class 37. On January 12, 2012, the applicant responded to the Final Refusal of the specimens by stating that the same specimens had been accepted for International Class 37 in another registration and argued against the refusal under Section 2(e)(1).

On February 1, 2012, the examining attorney withdrew the Final Refusal because she had overlooked an issue with the indefinite recitation of services in International Class 37 that should have been addressed earlier. She continued the refusal under Section 2(e)(1) and the requirement for new specimens. On July 26, 2012, the applicant responded to the office action by amending the recitation of services in International Class 37.

On August 28, 2012, the examining attorney once again issued a Final Refusal under Section 2(e)(1). The recitation of services had been made of record. On February 22, 2013, the applicant responded to the Final Refusal by submitting a claim of acquired distinctiveness under Section 2(f).

On March 28, 2013, the examining attorney once again withdrew the Final Refusal because the applicant's Section 2(f) claim raised a new issue. The refusal under Section 2(e)(1) was maintained and continued and the examining attorney addressed the Section 2(f) claim and addressed another identification of goods issue that was previously overlooked.

On September 20, 2013, the applicant responded by amending the identification of goods in International Class 19 and provided arguments supporting the Section 2(f) claim of acquired distinctiveness. The applicant also submitted a voluntary amendment on September 30, 2013, supporting the Section 2(f) claim of acquired distinctiveness.

On October 4, 2014 the examining attorney issued a Final Refusal of the Section 2(f) claim and maintained the Final Refusal under Section 2(e)(1). On March 14, 2014 the applicant submitted a request for reconsideration of the Final Refusal. On March 27, 2014, the examining attorney denied the applicant's request for reconsideration.

On March 29, 2014, the applicant amended the application to the Supplemental Register. On May 27, 2014, the examining attorney withdrew the Final Refusal because the applicant's response raised a new issue. The examining attorney refused registration on the Supplemental Register in International Class 19 because the proposed mark was generic for the goods. Amendment to the Supplemental Register for the mark for the services in International Class 37 was acceptable.

On June 4, 2014, the applicant responded to the refusal on the Supplemental Register for the goods in International Class 19. On July 18, 2014, the examining attorney issued a Final Refusal on the Supplemental Register for the mark for the goods listed in International Class 19 because the mark was generic. On December 17, 2014, the applicant responded with a request for reconsideration after Final Refusal. On February 26, 2015, the examining attorney denied the request for reconsideration.

ISSUES ON APPEAL

Whether the proposed mark has been properly refused because MAGNESITA is generic for the goods in International Class 19 in the application under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1).

ARGUMENTS

Proposed Mark is Generic for the Goods

Generic terms require refusal because they are common names that the relevant purchasing public understands primarily as describing the genus of the applicant's goods or services. *In re Dial-A-Mattress*

Operating Corp., 240 F.3d 1341, 1344, 57 USPQ 2d 1807, 1810 (Fed. Cir. 2001); *H. Marvin Ginn Corp v. Int'l Ass'n of Fire Chiefs, Inc.,* 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986)

Respectfully submitted,

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