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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

As a preliminary matter the instant appeal brief superseded the incomplete appeal that was erroneously sent on May 14, 2015. The examining attorney requests that the Board disregard the previously submitted incomplete brief. Applicant's Counsel has been advised of the error. The examining attorney apologizes for any confusion this may have caused.

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" in International Class 19. Registration has been finally refused because the proposed mark appears to be generic as applied to the proposed refractory products.

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 an 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 Refractory Products

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). See TMEP §1209.01(c). Generic terms, by definition incapable of indicating source, are the antithesis of trademarks, and can never attain trademark status. *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). Refusal is required because registering generic terms "would grant the owner of [a] mark a monopoly, since a competitor could not describe the goods as they are. *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d at 1569, 4 USPQ2d at 1142.

Determining whether a mark is generic requires a two-step inquiry:

- (1) What is the genus of goods and/or services at issue?
- (2) Does the relevant public understand the designation primarily to refer to that genus of goods and/or services?

In re 1800Mattress.com IP, LLC, 586 F.3d 1359, 1363, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009) (quoting *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)); TMEP §1209.01(c)(i).

Regarding the first part of the inquiry, the genus of the goods and/or services is often defined by an applicant's identification of goods and/or services. See *In re Country Music Ass'n*, 100 USPQ2d 1824, 1827-28 (TTAB 2011) (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 640, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991)).

In this case, the identification, and thus the genus, is "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".

Regarding the second part of the inquiry, the relevant public is the purchasing or consuming public for the identified goods and/or services. *Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1952 (TTAB 2014) (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d at 640, 19 USPQ2d at 1553). In this case, the relevant public is large industrial operations that require large scale refractory apparatus.

Determining whether an applied-for mark is generic turns on if "the relevant public primarily uses or understands the mark to refer to the category or [genus] of goods [and/or services] in question." *In re Nordic Naturals, Inc.*, 755 F.3d 1340, 1342, 111 USPQ2d 1495, 1497 (Fed. Cir. 2014); see *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); TMEP §1209.01(c). In such a determination, the "relevant public" represents the purchasing or consuming public for the identified goods and/or services. *Frito-Lay N. Am., Inc. v. Princeton Vanguard*,

LLC, 109 USPQ2d 1949, 1952 (TTAB 2014) (citing Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 640, 19 USPQ2d 1551, 1553 (Fed. Cir. 1991)).

The applicant argues that the relevant public are all general consumers because refractory products are sold at stores open to the general public such as Lowe's®, Home Depot®, and Wal Mart®. The examining attorney categorizes the relevant public as large industrial consumers, such as steel mills, that utilize refractory products as a part of their business. The applicant's specimens demonstrate that the applicant provides "refractory solutions," "service solutions," "minerals," "technical support department," and "research and development center." In addition, the applicant submitted another page from its website that maintains that, "Magnesita is the most integrated refractory industry in the world. Over 70% of the raw material used in production is taken from its own mines." (Applicant's response, February 22, 2013, page 2). The applicant also submitted an article discussing the applicant's acquisition of a German refractory product manufacturer. The article's subtitle is "Brazil's leading magnesite producer acquires German dolomite and refractories group, gaining a global customer base and raw material supply." (Applicant's response, March 14, 2014, page 4) The article also discusses the fact that in Brazil, the applicant controls 70% of the steel refractories market and 80% of the cement refractories market and that the applicant is attempting to expand its customer base by acquiring the German company. All of this evidence points to the fact that the applicant caters to large scale industrial operations as its customers and not to the general public.

Key Component of Goods

As discussed above the applicant's goods are "refractory bricks, refractory mixes for patching, lining or repairing high temperature apparatus and repairing the lining for furnaces, refractory furnace patching and repair mixes." The applicant stated in the response to the first office action that

the proposed mark MAGNESITA is “magnesia” from Italian and “magnesite” from Spanish and Portuguese.

The name of an ingredient, a key aspect, a central focus or feature, or a main characteristic of goods and/or services may be generic for those goods and/or services. See *In re Tires, Tires, Tires, Inc.*, 94 USPQ2d 1153, 1157 (TTAB 2009) (holding TIRES TIRES TIRES generic for retail tire store services); *In re Cent. Sprinkler Co.*, 49 USPQ2d 1194, 1199 (TTAB 1998) (holding ATTIC generic for automatic sprinklers for fire protection used primarily in attics); TMEP §§1209.01© *et seq.*; see also *In re Northland Aluminum Prods. Inc.*, 777 F.2d 1556, 1559-60, 227 USPQ 961, 963-64 (Fed. Cir. 1985) (holding BUNDT generic for cake mix); *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895, 1900 (TTAB 2001) (holding RUSSIANART generic for art dealership services); *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 292, 1 USPQ2d 1364, 1365 (3d Cir. 1986) (holding CHOCOLATE FUDGE generic for diet sodas). Thus, a term does not need to be the name of a specific product and/or service to be found generic.

In this case, magnesia or magnesite is a key ingredient in refractory products. In the office action sent on March 30, 2010, the examining attorney attaches excerpts from a variety of websites that discuss the uses of magnesite. For example, the website *geology.com* lists “Magnesite-Mineral Properties and Uses” which are refractory bricks, cement. (page 2) Also attached to the same March 30, 2010 office action is a website entitled *Minerals Zone World Mineral Exchange*, which shows that magnesite in various forms are used for basic refractories. (pages 6 and 7). Finally, in the same office action the website from *Peter W. Harben, Inc. Industrial Mineral Consultants* demonstrates that magnesite and magnesia are used in refractories.

The office action sent on November 5, 2010 contains more evidence that magnesite is a primary component in refractory products. The first attachment to this office action was from the website *Dictionary.com*, which states in the definition for magnesite that it is used in the manufacture of

refractory bricks, a good specifically listed in the applicant's identification of goods. (page 2). In the office action sent on May 27, 2011, the examining attorney attached the abstract of several articles that discuss the uses of magnesite in the refractory industry. (page 4)

The attachments to the office action sent on March 27, 2014 include *Hawley's Condensed Chemical Dictionary, 14th ed., 2011*, that show in an entry for magnesite that its uses are for refractories. (page 2) In another attachment to the same office action from the *Materials Handbook, 14th ed.*, states that magnesite is used in the manufacture of bricks for basic refractory furnace linings. (page 11)

Finally, the examining attorney returns to the applicant's website attached to the February 22, 2013 response that states "Over 70% of the raw material used in production is taken from its own mines." The examining attorney also points to the article attached to the response of March 14, 2014, that refers to the applicant as the "Leading Brazilian magnesite producer." The examining attorney has demonstrated that magnesite is a key component in refractory bricks and other refractory products. The applicant is a leading magnesite producer. It is reasonable to conclude that magnesite is a primary component in the applicant's refractory products.

Translation of Foreign Wording

Under the doctrine of foreign equivalents, a mark that consists of or comprises a word or words from a modern foreign language will be translated into English to determine genericness. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005); see *In re Sambado & Son Inc.*, 45 USPQ2d 1312, 1315 (TTAB 1997); TMEP §1209.03(g).

The doctrine is applied when it is likely that an ordinary American purchaser would “stop and translate” the foreign term into its English equivalent. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d at 1377, 73 USPQ2d at 1696 (quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976)); cf. TMEP §1207.01(b)(vi)(A). The ordinary American purchaser refers to “all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English.” *In re Spirits Int’l, N.V.*, 563 F.3d 1347, 1352, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009); see *In re Thomas*, 79 USPQ2d 1021, 1024 (TTAB 2006) (citing J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* §23:36 (4th ed., rev. 2006), which states “[t]he test is whether, to those American buyers familiar with the [modern] foreign language, the word would denote its English equivalent.”).

Generally, the doctrine is applied when the English translation is a literal and exact translation of the foreign wording. See *In re Oriental Daily News, Inc.*, 230 USPQ 637, 638 (TTAB 1986); *In re Zazzara*, 156 USPQ 348, 348 (TTAB 1967); TMEP §1209.03(g).

In this instance the applicant responded to the examining attorney’s first office action on March 18, 2010 with the translation of MAGNESITA as magnesite or magnesia. The applicant spent a lot of time and effort to demonstrate in its response of December 17, 2014 that the word MAGNESITA does not appear in any English language dictionaries and cannot be found in any of the websites of manufacturers of refractory products. The examining attorney submits that the fact that the word MAGNESITA is not found on the English language websites or in English language dictionaries is irrelevant.

The applicant states that MAGNESITA translates to magnesite from Spanish and Portuguese. Common, modern languages include Spanish, French, Italian, German, Chinese, Japanese, Russian, Polish, Hungarian, Serbian and Yiddish. See, e.g., *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*,

290 F.2d 845, 129 USPQ 411 (C.C.P.A. 1961) (Hungarian); *In re Tokutake Indus. Co.*, 87 USPQ2d 1697 (TTAB 2008) (Japanese); *In re Joint-Stock Co. "Baik,"* 80 USPQ2d 1305 (TTAB 2006) (Russian); *In re Perez*, 21 USPQ2d 1075 (TTAB 1991) (Spanish); *In re Oriental Daily News, Ltd.*, 230 USPQ 637 (TTAB 1986) (Chinese); *In re Ithaca Indus., Inc.*, 230 USPQ 702 (TTAB 1986) (Italian); *In re Jos. Schlitz Brewing Co.*, 223 USPQ 45 (TTAB 1983) (German); *In re Westbrae Natural Foods, Inc.*, 211 USPQ 642 (TTAB 1981) (Japanese); *In re Optica Int'l*, 196 USPQ 775 (TTAB 1977) (French); *In re Bagel Nosh, Inc.*, 193 USPQ 316 (TTAB 1976) (Yiddish); *In re Hag Aktiengesellschaft*, 155 USPQ 598 (TTAB 1967) (Serbian); *In re New Yorker Cheese Co.*, 130 USPQ 120 (TTAB 1961) (Polish).

In this instance the examining attorney also suggests that some of the people who work for the applicant's customers or in the industry here in the United States more than likely speak Spanish. In the office action dated, November 5, 2010, the examining attorney attached several articles discussing the rise in Spanish in the United States. Spanish is the second most common language spoken in the United States.

The applicant's mark, MAGNESITA, translates to magnesite or magnesia, which is a primary ingredient in the applicant's "refractory products" in International Class 19. Accordingly, the term is considered generic for the goods.

CONCLUSION

The applicant conceded that the term MAGNESITA is translated as magnesia or magnesite. It is undisputed that magnesite is a primary component of refractory products which are the applicant's goods. As such the proposed mark is generic for the applicant's goods in International Class 19. The examining attorney respectfully requests that the Board affirm the refusal to register on the Supplemental Register under Section 23 of the Trademark Act because the proposed mark is generic for the refractory products in International Class 19.

Respectfully submitted,

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