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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77873477
Applicant	Magnesita Refractories Company
Applied for Mark	MAGNESITA
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APPLICANT'S REPLY BRIEF

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ARGUMENT

This brief is in reply to the Examining Attorney's Appeal Brief dated June 1, 2015, which erroneously argues that the relevant public is limited to large industrial consumers, such as steel mills, that utilize refractory products as part of their business and that magnesia or magnesite is a key ingredient in refractory products making the proposed mark generic.

A. THE EXAMINING ATTORNEY HAS NOT ESTABLISHED BY CLEAR EVIDENCE THAT THE RELEVANT PUBLIC PRIMARILY USES THE MARK TO REFER TO THE CATEGORY OF GOODS IN QUESTION.

In proving genericness, the Office has the difficult burden of proving the refusal with "clear evidence" of genericness. *In re Trek 2000 Int'l Ltd.*, 97 U.S.P.Q.2d 1106, 2010 WL 50099653 * 2 (TTAB 2010). The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be registered to refer to the genus or category of goods in question. *In re Trek 2000 Int'l Ltd.*, 2010 WL 50099653 * 3 (citing *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986)). In making this determination, we cannot lose sight of the primary purpose behind this policy, which is to prevent competitive harm. *In re Trek 2000 Int'l Ltd.*, 2010 WL 50099653 * 3. Doubt on the issue of genericness is resolved in favor of the applicant. *In re Interfashion U.S.A., Inc.*, 2006 WL 3147914 * 3 (non-precedential) (citing *In re Waverly Inc.*, 27 USPQ2d 1620, 1624 (TTAB 1993)). In this case, Applicant submits that the Examiner has failed to establish by clear evidence that the mark "MAGNESITA" is used or understood by the relevant purchasing public to primarily refer to the class of goods at issue, i.e., refractory products not made primarily of metal.

1. THE RELEVANT PUBLIC ARE NOT LIMITED TO INDUSTRIAL OPERATIONS THAT REQUIRE LARGE SCALE REFRACTORY APPARATUS.

As discussed by the Court of Appeals for the Federal Circuit (“CAFC”), the relevant public is limited to actual or potential purchasers of the goods or services. *Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 641 (Fed. Cir. 1991). In making this determination, the TTAB should look at the identification of goods to determine the potential or actual customers. *Id.* at 641. Applicant submits that the Examining Attorney has not established by clear evidence that the relevant public is solely limited to “large industrial consumers, such as steel mills, that utilize refractory products as part of their business,” as asserted on page 9 of the Examining Attorney’s Appeal Brief. The identification of goods of the present application 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,” and is the sole basis to determine the actual or potential customers of the identified goods, and is clearly not limited to large industrial consumers, such as steel mills, that utilize refractory products as part of their business.

For example, in *Magic Wand*, the CAFC held that the TTAB properly rejected Magic Wand’s assertion that the relevant public comprises solely operators and manufacturers of car wash equipment. *Magic Wand Inc.*, 940 F.2d 641. Specifically, the CAFC found that according to the certificate of registration, the mark applied to automobile washing services, not automobile washing equipment, and determined that the relevant purchasing public for automobile washing services encompasses automobile owners and operators, while vendors, operators, and manufacturers of washing equipment are a very small part of the relevant purchasing public. *Id.*

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In this case, as discussed in the Applicant's Brief filed March 31, 2015, the goods of the present application are identified as "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." Although such goods can be purchased by large industrial consumers, the actual or potential customers are not limited to the relatively small number of people who work in the refractory industry as suggested by the Examining Attorney in the Examining Attorney's Appeal Brief. Rather, the identified goods are directed to any actual or potential purchasers of refractory product, which can be purchased by the general public. For example, as previously discussed in the Request for Reconsideration filed December 17, 2014, as seen in Exhibits AA to EE, to the Declaration About Generic Terms on Web Pages, the refractory products are sold by the well-known retailers Lowe's, Home Depot, Walmart, and Amazon to the general public (Dec. ¶ 30-34). Therefore, as is clear from the plain reading of the identification of goods in Class 19, the refractory products are not limited to a particular small group of Applicant's customers, but to any *actual or potential purchaser* of "[r]efractory product not made primarily of metal, namely, refractory bricks, refractory mixes for patching, lining or repairing high temperature apparatus and repairing the lining of furnaces, refractory furnace patching and repair mixes." Moreover, since any doubt on the issue of genericness is resolved in favor of the applicant, Applicant submits that the relevant public in this genericness determination is the general purchasing public, since the general public actually or potentially purchases the refractory product. *See In re Interfashion U.S.A., Inc.*, 2006 WL 3147914 * 3.

**2. THE RELEVANT PUBLIC DOES NOT USE OR UNDERSTAND
“MAGNESITA” TO REFER TO REFRACTORY PRODUCTS.**

The Examining Attorney has also failed to provide clear evidence that the relevant public *primarily* refers to refractory products by the present mark. In determining the second step of the genericness determination, the court must determine whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question. *See H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 U.S.P.Q. 528 (Fed. Cir. 1986); *see also* TMEP § 1209.01(c). Where the evidence of record does not show that competitors use the designation in issue, this may create doubt, depending on the totality of the record, as to whether a term primarily refers to a genus of goods such that “sellers of competing brands cannot compete effectively without using the name to designate the product they are selling.” *In re Trek 2000 Int'l Ltd.*, 2010 WL 5099653 * 4. In this case, the Examining Attorney has not met the Office's burden to establish by clear evidence that the relevant public uses or understands the mark “MAGNESITA” as primarily referring to refractory products.

Although the Examining Attorney in the Examining Attorney's Appeal Brief suggests that since magnesia or magnesite is a key ingredient in refractory products, “MAGNESITA” is generic, Applicant does not observe the necessary evidence to support this conclusion. Rather, Applicant submits that the test for genericness is not whether any ingredient may be generic for those goods, but rather, whether the relevant public would *primarily* use or understand the term sought to be protected to refer to the genus of goods in question. *See H. Marvin Ginn Corp.*, 782 F.2d at 991 (emphasis added) ; *see also In re Trek 2000 Int'l Ltd.*, 2010 WL 5099653 * 3.

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As an initial matter, Applicant submits that the Examining Attorney has not established that magnesia or magnesite, let alone the mark "MAGNESITA," is a primary component in refractory products. Rather, as clearly seen in the evidence of record, refractory products can be made from a number of different materials, including calcia, yttria, magnesia, silica, and alumina. For example, as seen on the website firebrickengineers.com provided by the Examining Attorney in the Office Action of February 26, 2015, the fire brick is made of 50% or more of alumina and can, but not necessarily, contain magnesia (pages 17-25 of the Office Action). Similarly, as seen in the Tech Data for Mt. Savage Firebrick also provided by the Examining Attorney, Fireclay is primarily composed of 59.9% silica and 32.0% alumina, and only contains 0.89% of MgO (magnesium oxide) (page 28 of the Office Action). Furthermore, as seen in the Technical Data Sheet from Plibrico Company LLC, the low cement castable has 91.7% alumina and only 6.3% magnesium oxide (page 35 of the Office Action).

That is, while some refractory products may comprise magnesite, Applicant submits that the question whether "MAGNESITA" is generic must be determined for Class 19 for refractory products not made primarily of metal, and statements about Class 1 in which the material magnesite is found are not on point. In any case, the Examining Attorney has failed to establish by clear evidence that magnesia or magnesite, let alone the mark "MAGNESITA," is a primary component in refractory products to be used to determine the genericness of the proposed mark.

As discussed above, the primary purpose of the relevant policy is to prevent competitive harm. The critical issue in determining whether a proposed mark is generic is whether the relevant public would *primarily* use or understand the term sought to be registered to refer to the category or class of goods in question. *In re Trek 2000 Int'l Ltd.*, 2010 WL 5099653 * 3 (emphasis added).

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The Examining Attorney has failed to establish through record evidence that the relevant public uses or understands the mark "MAGNESITA" to *primarily refer* to the class of refractory products not made primarily of metal. Rather, as evidenced by Exhibits A to AJ filed with the Request for Reconsideration of December 17, 2014, the relevant public uses a variety of terms including "fire brick," "refractory brick," "refractory products," "castable refractories," and "fettling materials" as generic terms directed to refractory products (Dec. ¶¶ 4-39). For example, Allied Mineral Products refers to its products as "refractory products," "castable refractories," and "precast refractory shapes." (Dec. ¶ 4). Similarly, BNZ Materials, Inc. uses the generic term "insulating firebrick, (Dec. ¶ 7), while Fire Brick Engineers Company uses the generic terms "refractory products" and "fire brick." (Dec. ¶ 12). Applicant, however, does not observe and the Examining Attorney has not provided clear evidence that establishes that the relevant public uses or understands the term magnesia or magnesite, let alone the mark "MAGNESITA," to be generic to *primarily refer* to refractory products.

As discussed by this Board in *In re Trek 2000 Int'l Ltd.*, where the evidence of record does not show that competitors use the designation in issue, this may create doubt, depending on the totality of the record, as to whether a term primarily refers to a genus of goods such that "sellers of competing brands cannot compete effectively without using the name to designate the product they are selling." *In re Trek 2000 Int'l Ltd.*, 2010 WL 5099653 * 4; *see also In re Minnetonka, Inc.*, 3 USPQ2d 1711, 1987 WL 124303 * 3 (TTAB 1987) ("This body of evidence is persuasive, and the Examining Attorney does not claim otherwise, to show that there exists a fairly substantial number of competitors in the business of selling liquid hand soap; that none of these competitors uses the term 'soft soap' descriptively, generically or otherwise in connection with its product.").

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The Examining Attorney has not provided any evidence that competitors of Applicant, let alone any seller of refractory products, uses the mark "MAGNESITA" to generically and *primarily* refer to its refractory products in any way. In fact, Applicant does not observe any evidence that the term magnesia or the term magnesite, let alone the term "MAGNESITA," is used by any competitor of Applicant to primarily refer to any refractory product. In so doing, in line with the principal purpose of the relevant policy, the record compels one conclusion, namely, that the sellers of refractory products would not in any way be prevented from competing effectively with Applicant, after the mark "MAGNESITA" is registered.

The record lacks the required clear evidence to establish that the relevant public uses or understands the terms magnesia and magnesite, let alone the term "MAGNESITA," to *primarily refer* to the refractory brick or lining.

Since the Examining Attorney has failed to establish by clear evidence that the mark "MAGNESITA" is generic for the identified goods, Applicant submits that the Examining Attorney has erred in denying registration of the mark "MAGNESITA" on the Supplemental Register.

CONCLUSION

Applicant respectfully submits that the application should be approved for registration because the mark "MAGNESITA" is not generic for the recited goods in the present application. Specifically, the term "MAGNESITA" is not understood by the relevant public, i.e., the general public, to *primarily* refer to the class of goods at issue, i.e., refractory product not made primarily

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of metal. Therefore, Applicant respectfully submits that the mark "MAGNESITA" is not generic and should be registered on the Supplemental Register.

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