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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77873477
Applicant	Magnesita Refractories Company
Applied for Mark	MAGNESITA
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Application Serial No.:	77873477
Application Filing Date:	November 16, 2009
Mark:	MAGNESITA
Owner/Appellant:	Magnesita Refractories Company
Attorney's Reference:	MAGN6002/TJM

APPLICANT'S BRIEF

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March 30, 2015

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I. DESCRIPTION OF THE RECORD

The record is described by the Trademark Status and Document Retrieval ("TSDR") of the U.S. Patent and Trademark Office ("Office") as follows:

<u>Date</u>	<u>Item</u>
Feb. 26, 2015	NOTIFICATION OF ACTION DENYING REQ FOR RECON E-MAILED
Feb. 26, 2015	ACTION DENYING REQ FOR RECON E-MAILED
Feb. 26, 2015	ACTION CONTINUING FINAL - COMPLETED
Jan. 13, 2015	EX PARTE APPEAL-INSTITUTED
Jan. 13, 2015	JURISDICTION RESTORED TO EXAMINING ATTORNEY
Jan. 13, 2015	EXPARTE APPEAL RECEIVED AT TTAB
Dec. 18, 2014	TEAS/EMAIL CORRESPONDENCE ENTERED
Dec. 17, 2014	CORRESPONDENCE RECEIVED IN LAW OFFICE
Dec. 17, 2014	TEAS REQUEST FOR RECONSIDERATION RECEIVED
Jul. 18, 2014	NOTIFICATION OF FINAL REFUSAL EMAILED
Jul. 18, 2014	FINAL REFUSAL E-MAILED
Jul. 18, 2014	FINAL REFUSAL WRITTEN
Jun. 04, 2014	TEAS/EMAIL CORRESPONDENCE ENTERED
Jun. 04, 2014	CORRESPONDENCE RECEIVED IN LAW OFFICE
Jun. 04, 2014	TEAS RESPONSE TO OFFICE ACTION RECEIVED
May 27, 2014	NOTIFICATION OF NON-FINAL ACTION E-MAILED
May 27, 2014	NON-FINAL ACTION E-MAILED
May 27, 2014	NON-FINAL ACTION WRITTEN
Apr. 11, 2014	TEAS/EMAIL CORRESPONDENCE ENTERED
Apr. 11, 2014	CORRESPONDENCE RECEIVED IN LAW OFFICE

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Mar. 29, 2014	TEAS REQUEST FOR RECONSIDERATION RECEIVED
Mar. 27, 2014	NOTIFICATION FOR REQ FOR RECON DENIED NO APPEAL FILED
Mar. 27, 2014	ACTION FOR REQ FOR RECON DENIED NO APPEAL FILED E-MAILED
Mar. 27, 2014	ACTION REQ FOR RECON DENIED NO APPEAL FILED COUNTED NOT MAILED
Mar. 15, 2014	TEAS/EMAIL CORRESPONDENCE ENTERED
Mar. 14, 2014	CORRESPONDENCE RECEIVED IN LAW OFFICE
Mar. 14, 2014	TEAS REQUEST FOR RECONSIDERATION RECEIVED
Oct. 04, 2013	NOTIFICATION OF FINAL REFUSAL EMAILED
Oct. 04, 2013	FINAL REFUSAL E-MAILED
Oct. 04, 2013	FINAL REFUSAL WRITTEN
Oct. 03, 2013	TEAS/EMAIL CORRESPONDENCE ENTERED
Oct. 03, 2013	CORRESPONDENCE RECEIVED IN LAW OFFICE
Sep. 30, 2013	TEAS VOLUNTARY AMENDMENT RECEIVED
Sep. 20, 2013	TEAS/EMAIL CORRESPONDENCE ENTERED
Sep. 20, 2013	CORRESPONDENCE RECEIVED IN LAW OFFICE
Sep. 20, 2013	TEAS RESPONSE TO OFFICE ACTION RECEIVED
Mar. 28, 2013	NOTIFICATION OF NON-FINAL ACTION E-MAILED
Mar. 28, 2013	NON-FINAL ACTION E-MAILED
Mar. 28, 2013	NON-FINAL ACTION WRITTEN
Feb. 22, 2013	TEAS/EMAIL CORRESPONDENCE ENTERED
Feb. 22, 2013	CORRESPONDENCE RECEIVED IN LAW OFFICE
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<u>Date</u>	<u>Item</u>
Aug. 28, 2012	NOTIFICATION OF FINAL REFUSAL EMAILED
Aug. 28, 2012	FINAL REFUSAL E-MAILED
Aug. 28, 2012	FINAL REFUSAL WRITTEN
Jul. 27, 2012	TEAS/EMAIL CORRESPONDENCE ENTERED
Jul. 26, 2012	CORRESPONDENCE RECEIVED IN LAW OFFICE
Jul. 26, 2012	TEAS RESPONSE TO OFFICE ACTION RECEIVED
Feb. 01, 2012	NOTIFICATION OF NON-FINAL ACTION E-MAILED
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Jan. 12, 2012	CORRESPONDENCE RECEIVED IN LAW OFFICE
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Dec. 15, 2011	TEAS RESPONSE TO OFFICE ACTION RECEIVED
Jun. 24, 2011	NOTICE OF ACCEPTANCE OF AMENDMENT TO ALLEGE USE E- MAILED
Jun. 23, 2011	NOTIFICATION OF NON-FINAL ACTION E-MAILED
Jun. 23, 2011	NON-FINAL ACTION E-MAILED
Jun. 23, 2011	USE AMENDMENT ACCEPTED

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Jun. 23, 2011	NON-FINAL ACTION WRITTEN
Jun. 20, 2011	AMENDMENT TO USE PROCESSING COMPLETE
Jun. 13, 2011	USE AMENDMENT FILED
Jun. 13, 2011	TEAS AMENDMENT OF USE RECEIVED
Jun. 13, 2011	TEAS/EMAIL CORRESPONDENCE ENTERED
Jun. 13, 2011	CORRESPONDENCE RECEIVED IN LAW OFFICE
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May 27, 2011	NOTIFICATION OF FINAL REFUSAL EMAILED
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May 27, 2011	FINAL REFUSAL WRITTEN
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Nov. 05, 2010	NOTIFICATION OF NON-FINAL ACTION E-MAILED
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Mar. 30, 2010	APPROVED FOR PUB - PRINCIPAL REGISTER
Mar. 30, 2010	EXAMINER'S AMENDMENT ENTERED
Mar. 30, 2010	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED
Mar. 30, 2010	EXAMINERS AMENDMENT E-MAILED
Mar. 30, 2010	EXAMINERS AMENDMENT -WRITTEN
Mar. 26, 2010	TEAS/EMAIL CORRESPONDENCE ENTERED
Mar. 26, 2010	CORRESPONDENCE RECEIVED IN LAW OFFICE
Mar. 25, 2010	ASSIGNED TO LIE
Mar. 24, 2010	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP
Mar. 18, 2010	TEAS RESPONSE TO OFFICE ACTION RECEIVED
Feb. 22, 2010	NOTIFICATION OF NON-FINAL ACTION E-MAILED
Feb. 22, 2010	NON-FINAL ACTION E-MAILED
Feb. 22, 2010	NON-FINAL ACTION WRITTEN
Feb. 22, 2010	ASSIGNED TO EXAMINER
Nov. 20, 2009	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM
Nov. 19, 2009	NEW APPLICATION ENTERED IN TRAM

II. STATEMENT OF THE ISSUE

Whether the final Office Action dated July 18, 2014, is correct in asserting that the present mark MAGNESITA (word without design or stylization) is generic with respect to the goods:

Class 19: 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.

The Office has conceded that the mark MAGNESITA (word without design or stylization) is not generic for the services:

Class 37: Providing information via a global computer network on constructing, maintaining, and repairing refractory apparatus using refractory products.

The Office Action dated May 27, 2014, expressly states that the “amendment to the Supplemental Register is acceptable for the services named in International Class 37.”

III. RECITATION OF THE FACTS

The Declaration About Generic Terms on Web Pages filed on December 17, 2014, states as follows:

1. All statements made herein of my own knowledge are true, and all statements made on information and belief are believed to be true.
2. I have conducted searches on the Internet for web pages that offer refractory products for sale in the United States.
3. The attached exhibits are based on these searches, and accurately reflect the web page at the address at the top, and at the date and time shown at the lower right of each exhibit.
4. The attached Exhibit A shows at least the top of a web page at the alliedmineral.com website. Allied Mineral Products appears to market refractory products. I reviewed at least a portion of the website

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and observed use of the generic terms “castable refractories,” and “precast refractory shapes.” I did not observe any use of the term “magnesita” at this website.

5. The attached Exhibit B shows an image of a search for “magnesita” at the alliedmineral.com website.
6. The attached Exhibit C shows at least the top of a web page at the zircoa.com website. Zircoa appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term "refractory brick." I did not observe any use of the term "magnesita" at this website.
7. The attached Exhibit D shows at least the top of a web page at the bnzmaterials.com website. BNZ Materials, Inc. appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term "insulating firebrick." I did not observe any use of the term "magnesita" at this website.
8. The attached Exhibit E shows at least the top of a web page at the ssfbs.com website. Smith-Sharpe Fire Brick Supply appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term "fire brick." I did not observe any use of the term "magnesita" at this website.
9. The attached Exhibit F shows at least the top of a web page at the alsey.com website. Alsey refractories co. appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms "firebrick," “mortar” and “castable.” I did not observe any use of the term "magnesita" at this website.
10. The attached Exhibit G shows at least the top of a web page at the heatstoprefractorymortar.com website. Heat Stop appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms “refractory mortar” and "firebrick." I did not observe any use of the term "magnesita" at this website.
11. The attached Exhibit H shows at least the top of a web page at the axner.com website. Axner appears to market refractory products. I reviewed at least a portion of the website and observed use of the

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generic terms "refractory brick" and "firebrick." I did not observe any use of the term "magnesita" at this website.

12. The attached Exhibit I shows at least the top of a web page at the firebrickengineers.com website.

Fire Brick Engineers Company appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms "refractory products" and "fire brick." I did not observe any use of the term "magnesita" at this website.

13. The attached Exhibit J shows at least the top of a web page at the morganthermalceramics.com website. Morgan Advanced Materials appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms "fire brick," and "firebrick." I did not observe any use of the term "magnesita" at this website.

14. The attached Exhibit K shows an image of a search for "magnesita" at the morganthermalceramics.com website.

15. The attached Exhibit L shows at least the top of a web page at the ortonceramic.com website. Orton to market testing of refractory products. I reviewed at least a portion of the website and observed use of the generic terms "refractory shapes," "refractory brick" and "refractory materials." I did not observe any use of the term "magnesita" at this website.

16. The attached Exhibit M shows at least the top of a web page at the tflhouston.com website. TFL Incorporated appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms "firebrick," and "refractories." I did not observe any use of the term "magnesita" at this website.

17. The attached Exhibit N shows an image of a search for "magnesita" at the tflhouston.com website.

18. The attached Exhibit O shows at least the top of a web page at the hitempincusa.com website. Hi Temp Refractories to market refractory products. I reviewed at least a portion of the website and

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observed use of the generic terms “firebrick,” and “castables.” I did not observe any use of the term “magnesita” at this website.

19. The attached Exhibit P shows at least the top of a web page at the louisvillefirebrick.com website.

Louisville Firebrick appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms “firebrick,” and “refractory brick.” I did not observe any use of the term “magnesita” at this website.

20. The attached Exhibit Q shows at least the top of a web page at the kandg.net website. K&G Industrial

Services appears to market the installation of refractory products. I reviewed at least a portion of the website and observed use of the generic term “refractory brick.” I did not observe any use of the term “magnesita” at this website.

21. The attached Exhibit R shows at least the top of a web page at the firebricks.com website. Firebricks

appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term “refractory bricks.” I did not observe any use of the term “magnesita” at this website.

22. The attached Exhibit S shows at least the top of a web page at the elginbutler.com website. Elgin

Butler appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term “fire brick.” I did not observe any use of the term “magnesita” at this website.

23. The attached Exhibit T shows at least the top of a web page at the larkinrefractory.com website.

Larkin Refractory Solutions appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term “fire brick.” I did not observe any use of the term “magnesita” at this website.

24. The attached Exhibit U shows at least the top of the Terminology page at the larkinrefractory.com

website. I observed use of the generic term “fire brick.” I did not observe any use of the term “magnesita” at this website.

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25. The attached Exhibit V shows at least the top of a web page at the vitcas.com website. Vitcas appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms “fire brick,” and “firebrick.” I did not observe any use of the term “magnesita” at this website.
26. The attached Exhibit W shows an image of a search for “magnesita” at the vitcas.com website.
27. The attached Exhibit X shows at least the top of a web page at the nockrefractories.com website. The Nock Refractories Company appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term “fire brick.” I did not observe any use of the term “magnesita” at this website.
28. The attached Exhibit Y shows at least the top of a web page at the nwironworks.com website. The Northwest Iron Works appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term “fire brick.” I did not observe any use of the term “magnesita” at this website.
29. The attached Exhibit Z shows at least the top of a web page at the miamistoneinstallers.com website. Miami Stone Installers.com appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms “firebrick” and “fire brick.” I did not observe any use of the term “magnesita” at this website.
30. The attached Exhibit AA shows at least the top of a page at the lowes.com website. Lowe’s appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term "firebrick." I did not observe any use of the term "magnesita" at this website.
31. The attached Exhibit AB shows at least the top of a page at the homedepot.com website. The Home Depot appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term "fire bricks." I did not observe any use of the term "magnesita" at this website.

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32. The attached Exhibit AC shows at least the top of a page at the walmart.com website. Walmart appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms "fire brick" and "firebrick." I did not observe any use of the term "magnesita" at this website.
33. The attached Exhibit AD shows an image of a search for "magnesita" at the walmart.com website.
34. The attached Exhibit AE shows at least the top of a page at the amazon.com website. Amazon appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic terms "fire brick" and "firebrick." I did not observe any use of the term "magnesita" at this website.
35. The attached Exhibit AF shows at least the top of a page at the rescoproducts.com website. RESCO Products, Inc. appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term "brick." I did not observe any use of the term "magnesita" at this website.
36. The attached Exhibit AG shows at least the top of a page at the vesuvius.com website. Vesuvius appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term "brick." I did not observe any use of the term "magnesita" at this website.
37. The attached Exhibit AH shows at least the top of a page at the rhi-ag.com website. RHI appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term "brick." I did not observe any use of the term "magnesita" at this website.
38. The attached Exhibit AI shows at least the top of a page at the hwr.com website. ANH Refractories appears to market refractory products. I reviewed at least a portion of the website and observed use of the generic term "brick." I did not observe any use of the term "magnesita" at this website.

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39. The attached Exhibit AJ shows at least the top of a page at the mineralstech.com website. Minerals Technology to market refractory products. I reviewed at least a portion of the website and observed use of the generic term "brick." I did not observe any use of the term "magnesita" at this website.

The Declaration of Change of Name filed March 14, 2014, states as follows:

The attached Exhibit A is copy of the change of name of Applicant from LWB Refractories Company to Magnesita Refractories Company signed on November 20, 2009, and filed with the Corporation Bureau of the Pennsylvania Department of State on November 30, 2009.

The Declaration of Gross Sales filed March 14, 2014, states as follows:

The gross sales of refractory products under the trademark MAGNESITA from May 1 to December 31, 2010 were in excess of 280,000 metric tons and US \$103,000,000 for domestic production.

The gross sales of refractory products under the trademark MAGNESITA from January 1 to December 31, 2011 were in excess of 440,000 metric tons and US \$200,000,000 for domestic production.

The gross sales of refractory products under the trademark MAGNESITA from January 1 to December 31, 2012 were in excess of 500,000 metric tons and US \$200,000,000 for domestic production.

IV. ARGUMENT

A. THE STANDARD OF REVIEW.

In ex parte cases, the question is simply “whether or not, based on the record before the examiner, the examiner's action was correct.” *In re Bose Corp.*, 772 F.2d 866, 869, 227 USPQ 1 (Fed. Cir. 1985). See also *In re AFG Industries, Inc.*, 17 U.S.P.Q.2d 1162 (TTAB 1990) (In determining an ex parte appeal, the Appeal Board's sole task is “to determine if the refusal to register was correctly made.” *Id.* at 1163).

B. THE EXAMINING ATTORNEY HAS NOT ESTABLISHED CLEAR EVIDENCE TO SHOW GENERICNESS OF THE MARK.

The present refusal is based on the statutory provision that requires the mark to be “capable of distinguishing the applicant’s goods and services.” 15 U.S.C. §1091(c) (2005). In view of such statute, the Patent and Trademark Office (PTO) has indicated that generic terms are “incapable of functioning as registrable trademarks denoting source, and are not registrable on the Principal Register under §2(f) or on the Supplemental Register.” (TMEP § 1209.01(c)).

In proving genericness, the Office has the difficult burden of proving the refusal with “clear evidence” of genericness. *In re Interfashion U.S.A., Inc.*, 2006 WL 3147914 * 2 (TTAB 2006) (non-precedential) (citing *In re Merrill, Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987)); see also *In re Steelbuilding.com*, 415 F.3d 1293, 1296, 75 USPQ2d 1420 (Fed. Cir. 2005). 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 Interfashion U.S.A., Inc.*, 2006 WL 3147914 * 3 (citing *H. Marvin Ginn Corp. v. International Ass’n*

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of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986)). In making this determination, courts follow the following two-step inquiry: 1) What is the genus or category of good or services at issue? and 2) Is the designation sought to be registered understood by the relevant public primarily to refer to that genus or category of goods or services? *H. Marvin Ginn Corp.*, 782 F.2d 987, 228 USPQ 528. Doubt on the issue of genericness is resolved in favor of the applicant. *In re Interfashion U.S.A., Inc.*, 2006 WL 3147914 * 3 (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 understood by the relevant public to be generic by primarily referring to the class of goods at issue, i.e., refractory products not made primarily of metal.

1. THE CATEGORY OF THE GOODS AT ISSUE IS REFRACTORY PRODUCTS.

In determining the first step of genericness, Applicant submits that the category of goods at issue is refractory products. Specifically, as amended in the response filed September 20, 2013 and suggested by the Examining Attorney in the Denial of the Request for Reconsideration of February 26, 2015, the goods are "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 mix."

**2. THE RELEVANT PUBLIC WOULD NOT UNDERSTAND THE WORD
“MAGNESITA” TO REFER TO REFRACTORY PRODUCTS.**

The Examining Attorney has failed to properly identify the relevant public and 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 identify the relevant public by identifying who actually or potentially purchases or consumes the goods, and 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.*, 782 F.2d at 989; *Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 641, 19 USPQ2d 1552 (Fed. Cir. 1991); *see also* TMEP § 1209.01(c). In this case, the Examining Attorney has not established that the relevant public would have understood the mark “MAGNESITA” as primarily referring to refractory products.

Although the Examining Attorney suggests in the Final Action of July 18, 2014 that the relevant public are people who work in the refractory industry and purchase refractory products on a regular basis, the Examining Attorney has not provided clear evidence to support this conclusion. Rather, as discussed in the Request for Reconsideration filed December 17, 2014, Applicant submits that the relevant public is not the narrow field of people who work in the refractory industry and purchase refractory products on a regular basis, but rather the general public. Specifically, since the relevant public for a genericness determination is the *actual or potential purchaser* of the goods, the relevant public in this case is any actual or potential purchaser of refractory products, which in this case is the general public. *See Magic Wand, Inc.*, 940 F.2d at 641. For example, 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

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group of customers, but to any *actual or potential purchaser* of “[r]efractory products 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.” In other words, 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 public, since the general public actually or potentially purchases the refractory products. *See In re Interfashion U.S.A., Inc.*, 2006 WL 3147914 * 3.

Next, although the Examining Attorney suggests that since magnesia and magnesite may be used in the goods, the ingredient may be generic for the goods, 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.

In *H. Marvin Ginn Corp.*, the registrar registered the mark to “a magazine directed to the field of fire fighting.” *H. Marvin Ginn Corp.*, 782 F.2d at 991. The Federal Circuit indicated that it did not discern any record evidence which suggests “that the relevant portion of the public *refers* to a class of fire fighting publications as ‘Fire Chief.’” *Id.* (emphasis added). Therefore, the Federal Circuit concluded that the TTAB clearly erred in finding the mark directed to the field of fire fighting to be generic. *Id.*

In the present appeal, not only has the Examining Attorney admitted in the Final Action of July 18, 2014, that “the public at large would not necessarily understand that the term MAGNESITA translates to magnesia or magnesite,” the Examining Attorney has not provided record evidence to suggest that the term “MAGNESITA” *primarily refers* to the class of refractory product 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 would have understood that the terms “fire brick” and “refractory brick” are generic terms directed to different goods in the cited class (Dec. ¶ 4-39). Applicant, however, does not

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observe and the Examining Attorney has not provided clear evidence that the relevant public would have understood the term "MAGNESITA" to be generic to *primarily refer* to refractory products.

Moreover, even assuming *arguendo* that the relevant public are people who work in the refractory industry and purchase refractory products, and that they would understand that the term "MAGNESITA" means magnesite or magnesia, Applicant submits that the Examining Attorney has not provided clear evidence to show that the relevant public used or would have understood the term "MAGNESITA" to *primarily refer* to refractory products.

Applicant submits that the present goods are not magnesia or magnesite, where magnesite has the chemical formula $MgCO_3$ and is used to produce magnesia having the chemical formula MgO . The present goods are "refractory products not made primarily of metal." While some of these refractory products may comprise magnesite, magnesite is a compound in Class 1 and not in Class 19. In other words, while magnesia and magnesite are generic terms to identify minerals, the Examining Attorney has not provided clear evidence to establish that magnesia and magnesite are generic terms to *primarily* identify refractory products. *See In re Interfashion U.S.A., Inc.*, 2006 WL 3147914 *3 ("The two references to "Oat Straw" hair care preparations which appear to be generic in nature do not constitute a clear or substantial showing of generic use.")

The Examining Attorney has not provided any evidence that the relevant public uses the term "MAGNESITA" to refer to the refractory brick or any refractory product. *See 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.") At most, the Examining Attorney has established magnesia can be used as a component of the goods sold on various websites, e.g. refractory brick, lining, etc. For example, as seen in the Mt. Savage Firebrick Tech Data for Fireclay

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provided by the Examining Attorney on February 26, 2015, Fireclay has only 0.89% of MgO and is primarily composed of Silica (SiO₂) and Alumina (Al₂O₃) (at page 28 of the Office Action). Similarly, as seen in the printed web-page for Fire Brick Engineers Company, the refractory alumina brick has various concentrations of magnesia, but primarily contains alumina (at page 12 and following of the Office Action). What the Examining Attorney has failed to establish by clear evidence, however, is that the relevant public uses the terms magnesia or magnesite to *primarily refer* to the class of refractory product. *See In re Interfashion U.S.A., Inc.*, 2006 WL 3147914 *4 (“In this case, however, we are not convinced from the evidence of record that prospective purchasers would understand AVENA to refer to a principal or key ingredient in applicant’s hair care preparations.”) That is, Applicant does not observe the necessary clear evidence to establish that the relevant public uses the terms magnesia and magnesite, let alone the term “MAGNESITA,” to *primarily refer* to the refractory brick or lining, i.e., the record lacks clear evidence that shows that the relevant public uses the terms magnesia or magnesite to *primarily refer* to the refractory brick or lining being sold.

Furthermore, Applicant submits that the meaning of “MAGNESITA” should be evaluated on the basis of the lack of definition from the Merriam-Webster Unabridged Dictionary (filed December 15, 2011) and not based on the translation, as suggested by the Examining Attorney. The use of a translation is inappropriate under, and unjustified, by current case law.

As discussed in the Request for Reconsideration filed December 17, 2014, the relevant public would have understood that the term “MAGNESITA” is not generic, as shown in Exhibits A to AJ to the “Declaration About Generic Terms on Web Pages,” as stated above.

Applicant submits that the Examining Attorney has failed to establish by clear evidence that the relevant public uses the term “MAGNESITA” to *primarily refer* to refractory products and only has established that magnesia and magnesite can be used as a component of refractory brick or lining.

V. SUMMARY

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 of metal... Moreover, the Examiner Attorney has not met the difficult burden to show the genericness of the mark "MAGNESITA" with respect to refractory products not made primarily of metal. Therefore, Applicant respectfully submits that the mark "MAGNESITA" is not generic and should be registered on the Supplemental Register.

Respectfully submitted,

/Thomas J. Moore/

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