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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SEI Manufacturing, Inc.

Serial No. 78648865

Otto Zsigmond of Nexus Law Group LLP for SEI Manufacturing, Inc.

Darryl M. Spruill, Trademark Examining Attorney, Law Office 112 (Angela Wilson, Managing Attorney).¹

Before Cataldo, Mermelstein and Wolfson,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

SEI Manufacturing, Inc. filed an application to register on the Principal Register the mark HANGBOARD in standard characters for "winter sports and recreation equipment, namely, snowboards, sleds" in International Class 28.²

¹ The above application originally was examined by another examining attorney, but subsequently was reassigned to the attorney whose name is shown to prepare the appeal brief.

² Serial No. 78648865 was filed on June 12, 2005 under Section 44(e) of the Trademark Act, based on Canadian Registration No. TMA704087, issued on January 8, 2008.

The examining attorney refused registration on the ground that the mark is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). After applicant amended its application to seek registration on the Supplemental Register, the examining attorney refused registration, under Section 23 of the Trademark Act, 15 U.S.C. § 1091, on the ground that applicant's proposed mark is incapable of identifying applicant's goods and distinguishing them from those of others. When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs on the issue under appeal.

A mark is a generic name if it refers to the class, genus or category of goods and/or services on or in connection with which it is used. *See In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The test for determining whether a mark is generic is its primary significance to the relevant public. *See* Section 14(3) of the Act, 15 U.S.C. § 1064. *See also In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d

1551 (Fed. Cir. 1991); and *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, *supra*. The examining attorney has the burden of establishing by clear evidence that a mark is generic and thus unregistrable. See *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Evidence of the relevant public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. See *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

In the case of *In re American Fertility Society*, *supra*, our primary reviewing court stated that if the PTO can prove "(1) the public understands the individual terms to be generic for a genus of goods and species; and (2) the public understands the joining of the individual terms into one compound word to lend no additional meaning to the term, then the PTO has proven that the general public would understand the compound term to refer primarily to the genus of goods or services described by the individual terms." (*Id.* at 1837.)

In the case of *In re Dial-A-Mattress Operating Corp.*, *supra*, 1-888-M-A-T-R-E-S-S for "telephone shop-at-home

retail services in the field of mattresses," the court further clarified the test as follows (*Id.* at 1810):

Where a term is a "compound word" (such as "Screenwipe"), the Director may satisfy his burden of proving it generic by producing evidence that each of the constituent words is generic, and that "the separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to those words as a compound." *In re Gould Paper Corp.*, 834 F.2d 1017, 1018, 5 USPQ2d 1110, 1110 (Fed. Cir. 1987). However, where the proposed mark is a phrase (such as "Society for Reproductive Medicine"), the board "cannot simply cite definitions and generic uses of the constituent terms of a mark"; it must conduct an inquiry into "the meaning of the disputed phrase as a whole." *In re The Am. Fertility Soc'y*, 188 F.3d at 1347, 51 USPQ2d at 1836. The *In re Gould* test is applicable only to "compound terms formed by the union of words" where the public understands the individual terms to be generic for a genus of goods or services, and the joining of the individual terms into one compound word lends "no additional meaning to the term." *Id.* at 1348-49, 51 USPQ2d at 1837.

The court concluded that "1-888-M-A-T-R-E-S-S," as a mnemonic formed by the union of a series of numbers and a word, bears closer conceptual resemblance to a phrase than a compound word, and the court reiterated that the PTO must produce evidence of the meaning the relevant purchasing public accords to the proposed mnemonic mark "as a whole."

In this case, we find that HANGBOARD is more analogous to the compound word considered in *Gould* than it is to the phrase considered by the court in either *American Fertility*

or *Dial-A-Mattress*. Thus, we look first to the dictionary definitions of the terms comprising HANGBOARD to determine whether they support the refusal to register the proposed mark.

The examining attorney submitted with Office actions several such definitions, of which the following are typical: HANG³ - "suspend or be suspended from above with the lower part not attached;" and BOARD - "a thin, flat, rectangular piece of stiff material used for various purposes."⁴ Based upon these definitions, HANGBOARD may be defined either as: (1) a thin, flat, rectangular piece of stiff material that is suspended with the lower part not attached (a board that hangs); or, in the alternative, (2) a thin, flat, rectangular piece of stiff material from which one may be suspended from above with the lower part not attached (a board from which one hangs). These definitions do not adequately establish that the mark is generic for the recited goods.

In addition, the examining attorney submitted with three Office actions articles retrieved from various Internet web pages. Certain excerpts from these articles follow (emphasis supplied):

³ www.askoxford.com

⁴ Id.

Hangboards

Snowboard bindings for a unique ride. While you can mount this rig onto your regular snowboard it of course is more than just another binding. ...

One morning after meditating it was an image of low-level flying over snow that sparked the idea of **hangboarding** for Don Amey who also owns the largest aerial firefighting equipment company in the world and has been a pilot for years.

(stoked.at/news?p=4);

Arthur Black hangboards!

AI SIZES



Well known Canadian humourist and radio personality Arthur Black spend an afternoon **hangboarding** at Mt. Washington Alpine Resort with Dan, Mira, Lucas and the rest of the **HangBoard** crew. Here he speeds downslope.

(flickr.com/photos/hangboard);

The **HangBoard™** is the snow sport revolution! The **HangBoard™** (PATENTS PENDING CANADA, U.S. & FOREIGN) combines the three well established sports of snowboarding, hang gliding and mountain biking. With other snow sports, the rider's

perspective is vertical. **HangBoarding** brings a horizontal perspective to the slopes. Absolutely nothing compares to the feeling of "flying" head first over the snow while suspended only a foot in the air! ...

HangBoarding is easy to learn. Control comes from body weight shifting (like hang gliding) and foot operated rudders. When both rudders are applied at the same time, they function as powerful snow brakes. This dual function system makes **HangBoarding** easy to learn. New riders progress rapidly with the assurance of this unique rudder/brake system.

HangBoards are the perfect cross trainer for skiing and snowboarding. Each of these develops the lower part of the body, while **HangBoarding** develops the upper body. By adding **HangBoarding** to your winter sports regimen, you get more complete body conditioning. ...
(persianhub.org);

Hangboarding - a new craze coming to a ski slope near you - is a combination of hang gliding, snowboarding, and well, sheer lunacy. Basically, you climb on to the **hang board** which is an apparatus suspended from a crane like contraption. Once strapped in, you're suspended in air above the board. You make use of a T-shaped bar to navigate your way down the slope.

And yes, to make sure that you have absolutely no chance in hell of surviving a crash your feet are clamped into rudders at the back, which you then use to navigate the slopes.

The **hangboard** is the brainchild of Canadian inventor Don Amey, and a company called the **Hangboard** SnoFlight is readying for the commercial launch of its **hangboard**. ...
(vagabondish.com); and

HangBoarding. The coolest new winter sport is here and it brings together the best three high-

energy adventure sports into one: hang gliding, snowboarding and mountain biking, and yet it's something completely different all at once. ...

So, how do you "hangboard"?

It begins with a snowboard and the **HangBoard** rig.
...

The first **hang board** was tested in 2002 and in the past few years, the design has evolved and improved. **HangBoards** are not yet available, but they have been steadily promoted at ski destinations in British Columbia and Washington State, through a series of demos and trial. ... (tripatlas.com).

Based upon the identification of goods in the involved application, we find that that "winter sports and recreation equipment, namely, snowboards, sleds" is the name of a genus of goods. *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) ("[A] proper genericness inquiry focuses on the description of [goods or] services set forth in the [application or] certificate of registration"). Next, we must determine based upon the evidence of record whether the designation HANGBOARD is understood by the relevant purchasing public primarily to refer to that genus of services.

On this record, of which the above-excerpted examples are illustrative, we are constrained to find that the examining attorney has failed to show that the designation HANGBOARD has acquired no additional meaning to consumers

of "winter sports and recreation equipment, namely, snowboards, sleds" than the terms "HANG" and "BOARD" have individually. That is to say, although the terms "HANG" and "BOARD" may be generic for, respectively, being suspended from above and a thin, flat, rectangular piece of stiff material, the record falls somewhat short of establishing that the compound word HANGBOARD, comprised of those individual terms, is generic for snowboards or sleds. This is not a case where the Office has clearly proven that the designation as a whole is no less generic than its constituents. Indeed, the dictionary definitions fail to clearly support a finding of genericness, and the Internet evidence shows mixed usage of HANGBOARD as a mark and as a descriptive term for an apparatus that allows the user to ride a snowboard while hanging from above as opposed to being attached at the feet. Thus, while HANGBOARD may be an apt name for a piece of stiff material or board from which one may be suspended or hang, the evidence does not show that it is used as a generic name for snowboards or sleds.

We find, based on the limited evidence of record, that the Office has not met its difficult burden of establishing by clear evidence that the designation HANGBOARD, as a whole, is generic for the identified goods. *See In re*

Merrill Lynch, supra. Genericness is a fact-intensive determination, and the Board's conclusion must be governed by the record that is presented to it. Although we understand the examining attorney's concerns, it is the record evidence bearing on purchasers' perceptions that controls the determination, not general legal rules or our own subjective opinions. Any doubts raised by the lack of evidence must be resolved in applicant's favor. *Id.* Further, on a different and more complete record, such as might be adduced by a competitor in an opposition proceeding, we might arrive at a different result on the issue of genericness, but we must base our determination herein on the record now before us.⁵

Decision: The refusal of registration on the Supplemental Register, under Section 23 of the Trademark Act, is reversed.

⁵ We observe, in that regard, that such terms as "surf board," "skate board," "snow board" and "paddle board" were in all likelihood coined by the earliest enthusiasts of the sports with which they are associated.