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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re PolymerLatex GmbH

Serial No. 79053418

Teresa C. Tucker of Grossman, Tucker, Perreault & Pfleger, PLLC for PolymerLatex GmbH.

Chrisie Brightmire King, Trademark Examining Attorney, Law Office 109 (Dan Vavonese, Managing Attorney).

Before Walters, Holtzman and Taylor, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by PolymerLatex GmbH (applicant) to register the standard character mark POLYMERLATEX for goods ultimately identified as follows:[1]

> Chemicals used in industry; dispersions, in particular colloidal dispersions of macromolecules, aqueous dispersions, binder dispersions; chemical binding agents, namely, for use in the manufacture of paper, carpets, foams; emulsions, in particular aqueous emulsions for use in the manufacture of

[1] Application Serial No. 79053418, filed October 26, 2007, based on a request for extension of protection under Section 66(a) of the Trademark Act.

concrete, paper, lacquers and paints; chemical impregnations in the nature of chemical agents for impregnating, binding or coating of textiles, furs and leather, non-wovens and fabrics; impregnating chemicals for textiles and shoes; adhesives used in industry; chemical thickeners for use in industry; chemical additives for adhesives; unprocessed artificial resins for industrial use; chemical additives for bitumen; vulcanisation accelerators; vulcanising preparations; chemical additives for use in the manufacture of paper, carpets, shoes, foams; chemical additives for use in the manufacture of concrete; chemical additives for building materials in the nature of cement mortar, plasters, and for adhesives for tiles; chemical intensifiers for rubber; chemical additives for rubber solutions; plastics dispersions being unprocessed plastics; unprocessed plastics In Class 1; and

Sealing agents, namely, adhesive sealants for use in roofing, grout sealant; rubber and goods made therefrom, namely, styrene-butadiene rubber, synthetic rubber, rubber derivatives, rubber for use in the manufacture of tires, cable, paper, rubber bars and rods, rubber sheets, rubber bands for commercial and industrial uses; sealing compounds, namely, sealing compounds for joints, caulking; sealants, namely, waterproof sealants, sealants for buildings, sealants for pavement joints, sealants for pipe joints; semi-processed foams being semi-worked synthetic plastic and synthetic resins as semi-finished products in the form of foams; semi-processed plastics; rubber, raw or semi-worked; semi-processed plastic in the form of pellets, blocks, sheets, tubes, bars, or rods, in Class 17.

The trademark examining attorney has refused registration on the ground that the mark is merely descriptive of the goods under Section 2(e)(1) of the Trademark Act.

When the refusal was made final, applicant appealed. Applicant and the examining attorney have filed briefs.

We affirm the refusal.

A term is merely descriptive within the meaning of Section 2(e)(1) if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods or services with which it is used. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). The question of whether a particular term is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the term is used, and the possible significance that the term is likely to have to average purchasers as they encounter the goods or services in the marketplace. See In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986).

The examining attorney argues that the mark POLYMERLATEX describes two ingredients or features of applicant's goods which include chemicals, adhesives and sealing agents. To support her position, the examining attorney submitted the following definitions of the terms "polymer" and "latex" from *The American Heritage Dictionary of the English Language* (Fourth ed. 2000):[2]

Polymer:

> Any of numerous natural and synthetic compounds of usually high molecular weight consisting of up to millions of repeated linked units, each a relatively light and simple molecule.

[2] From the website bartleby.com.

> Latex:
>
> 1. The colorless or milky sap of certain plants, such as the poinsettia or milkweed, that coagulates on exposure to air.
> 2. An emulsion of rubber or plastic globules in water, used in paints, adhesives, and various synthetic rubber products.
> 3. Latex paint.

In addition, we take judicial notice of an entry for "latex" from *The Columbia Encyclopedia* (2008), discussing natural and synthetic latex:[3]

> Emulsion of a polymer (e.g., rubber) in water (see colloid). Natural latexes are produced by a number of plants, are usually white in color, and often contain, in addition to rubber, various gums, oils, and waxes. ... Synthetic latexes may be prepared in two ways: the polymer may be prepared as an emulsion (emulsion polymerization), or the dry, powdered polymer may be dispersed in water. Both natural and synthetic latexes are widely used, especially in the production of rubber goods. Latex paints, sometimes called rubber-base paints, consist of a latex colored by the addition of a pigment.

The examining attorney has also introduced an entry from Wikipedia for the term "Latex (polymer)"[4]

> Latex is name collectively given to a group of similar preparations consisting of stable dispersions of polymer microparticles in a liquid matrix (usually water). Latexes may be natural or synthetic. Synthetic latexes are usually produced by emulsion polymerization using a variety of initiators, surfactants and monomers;....

[3] From the website credoreference.com.

[4] From the website wikipedia.org.

As shown by the entries above, the term "latex" refers either to the "milky sap" of the plant ("natural latex") or to the compound synthesized from the plant ("synthetic latex"). As stated in applicant's brief and on its website (polymerlatex.de), applicant is a manufacturer of "synthetic latex." The evidence shows that latex, in its synthetic form, is essentially an emulsion or dispersion of a polymer in water. Applicant's goods which are broadly identified in part as "aqueous dispersions" and "aqueous emulsions [for use in the manufacture of concrete]" in Class 1 include emulsions and dispersions of polymers in water, i.e., latex. It can also be seen, particularly from the definitions in *The American Heritage Dictionary* and *The Columbia Encyclopedia*, that latex, in its synthetic form, also refers to products derived from the polymer emulsions and dispersions. Such goods would include the "synthetic rubber" and "adhesive sealants for use in roofing, grout sealant" identified in Class 17 of the application.

Thus, the term "Latex" in applicant's mark, POLYMERLATEX, describes the nature of applicant's goods, which are, or include, "latex" in one form or another, and, at a minimum, the term "polymer" describes a component of the latex compound. As explained on applicant's website:

> Latex is described as a dispersion of minute polymer particles in water - a milky liquid with a water content of approx. 50%. The latex particles have

> diameters measuring tens of thousands of a millimetre with a polymer core that is surrounded by a polar shell that interacts with the water, thus stabilising the dispersion. ... The art of producing this 'milk' is selecting the correct polymer, creating the right size of polymer particles and then surrounding them with a suitable sheath.
>
> What is latex used for? Thanks to its enormous number of minute particles, latex has a gigantic surface area that can be modified with chemicals. During the drying process, latex forms 'sticky' polymer surface films. This is what makes plastic dispersions unique and capable of bonding, protecting or refining surfaces of contrasting materials. ...

Applicant's own descriptive use of the terms "polymer" and "latex" is strong evidence that the mark is descriptive. See, e.g., In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) ("Evidence of the context in which a mark is used...in advertising material...is probative of the reaction of prospective purchasers to the mark"); and In re Educational Communications, Inc., 231 USPQ 787, 790 (TTAB 1986) ("applicant's own highly descriptive usages of the components of its asserted mark ... is strong evidence of its generic nature").

Furthermore, polymer emulsions and dispersions such as those produced by applicant are commonly referred to as "polymer latex." The examining attorney has made of record several patent applications, excerpted below, showing that the combined term "polymer latex" is used by others in the industry to refer to a type or form of latex compound (emphasis added).

An application by The Dow Chemical Company entitled "**Polymer Latex** Composition and Coating Formulation Made Therefrom" describes the invention as a "polymer latex" composition:[5]

> Abstract: The present invention is a **polymer latex** composition comprising a water-borne **polymer latex** prepared from a hydroxy-functional acrylic monomer.... ... Coatings made from formulations comprising the **polymer latex** compositions of the present invention exhibit good durability and weatherability and are, therefore, especially suitable to prepare clearcoats for the automotive industry.

An application by BASF Corporation discusses the "Method and Apparatus for Predicting **Polymer Latex** Properties in an Emulsion Polymerization Process to Improve the Quality and Productivity of the Polymer Latex":[6]

> Abstract: ... The method for predicting one or more **polymer latex** properties for an emulsion **polymer latex** according to the invention includes conducting an emulsion polymerization process in a reactor including one or more reactor inputs to produce an emulsion **polymer latex**, measuring a set of process parameters for the emulsion polymerization process, performing a heat balance and a mass balance across the reactor based on the set of measured process parameters to determine a set of calculated **polymer latex** properties for the emulsion polymerization process....

We note applicant's statement that it is one of the three leading latex manufacturers and sellers of latex in Europe, together with BASF Corporation and The Dow Chemical Company. Use

[5] International Appl. No. PCT/US1993/007574 (wipo.org).

[6] International Appl. No. PCT/US2002/026406 (wipo.org).

of the term "polymer latex" in this clearly descriptive manner by applicant's largest competitors is persuasive evidence that purchasers for applicant's latex would view the term descriptively as well. See, e.g., BellSouth Corp. v. DataNational Corp., 60 F.3d 1565, 35 USPQ2d 1554, 1558 (Fed. Cir. 1995) ("competitor use is evidence of genericness.").

Another example of a patent application using "polymer latex" to refer to a form of latex is entitled "**Polymer latex** suitable for the preparation of dip-molded articles" (such as disposable medical gloves).[7] As explained in the Abstract, the invention relates to a polymer latex

> made by free-radical emulsion polymerization comprising polymer particles containing structural units derived from at least one conjugated diene component...that is particularly suitable for the production of dip-molded articles. Furthermore, the present invention relates to a process for making such a **polymer latex**, to the use of said **polymer latex** for the production of dip-molded articles, to a compounded **polymer latex** composition that is suitable for the production of dip-molded articles, to a method for making dip-molded latex articles as well as to the latex articles obtained thereby.

Applicant states that this application has been assigned to applicant, and applicant argues that the application therefore fails to show others using the mark in connection with similar goods. The fact that applicant now owns the application does not change the nature of the use of "polymer latex" in the

[7] USPTO Appl. No. 20060052513 (freshpatents.com).

application as a descriptive term, rather, it simply constitutes additional evidence of applicant's own descriptive use.

As further evidence that the composite term "polymer latex" would be perceived as descriptive, the examining attorney submitted printouts from a number of online scientific journals and publications showing use of "polymer latex" to refer to polymer emulsions of the type or form identified in the application. Some excerpts appear below (emphasis added).

A study reported in the *Journal of Chromatography A* (Vol. 1040, Issue 2, June 25, 2004) entitled "Determination of residual monomer in **polymer latex** by full evaporation headspace gas chromatography" refers to polymer emulsions as "polymer latex":[8]

> 1. Introduction: "Emulsion polymerization is an important industrial process. High conversion of monomer to polymer in such process is desired because it not only improves the efficient production of the polymers but also reduces the amount of residual monomers, which are generally regarded as toxic to the human health. ... In **polymer latex**, the residual monomer is distributed between the aqueous phase and the solid, polymer particle phase. ...
> ...
> 3. Results and discussion (3.1. Methodology): In a high conversion...**polymer latex** sample, it can be assumed that the monomer species are distributed in both aqueous and solid polymer particle phases. ... (3.2.1. Effect of temperature): ... When carrying out this type of analysis on **polymer latex** samples, the sample should be inhibited to prevent further polymerization, especially on heating. ...

[8] From the website ScienceDirect (sciencedirect.com).

An announcement for a "Short course on **polymer Latex** Technology slated for August in Switzerland" appearing in the magazine HighBeam Research (highbeam.com) describes the course as "an in-depth study of the synthesis, characterization, and properties of high **polymer latexes**."

A thesis or dissertation on "Direct Catalytic Hydrogenation of Unsaturated Diene-Based Polymers in Latex Form" describes the commercial process for producing synthetic rubber (polymer) used in the automotive and oil drilling industry:[9]

> Abstract: ... NBR [nitrile butadiene rubber) is a synthetic rubber of copolymerized acrylonitrile and butadiene produced in latex form by emulsion polymerization. ... As a result of this research project, new latex hydrogenation technologies were successfully developed to fulfill all major requirements for a solvent-free **polymer latex** hydrogenation route, which is a significant milestone for the improvement of this polymer modification technology. ...

Contrary to applicant's contention, "polymer latex" is not used in any of these examples as a reference to either applicant or its products. The term is clearly used in a manner that describes a form of latex or its composition, and not as indicating any particular source for the latex. Furthermore, the fact that the entities using this term may be familiar with applicant and recognize "PolymerLatex" as applicant's company

[9] From the University of Waterloo website, uwspace.uwaterloo.ca.

name is not evidence of their recognition of this term as a trademark.

Applicant's argument that the evidence does not show use of the term applied for is not understood, as there are many examples of such use in the record. To the extent that applicant is arguing that the evidence does not show use of the mark in the "form" applied for, that is, as a single term rather than two separate words, and that the presentation of its mark in this manner overcomes a finding that the combined term is not descriptive, this argument is not well taken.

It is not necessary that the evidence show use by others in the exact manner in which it is displayed as a mark. See In re SPX Corp., 63 USPQ2d 1592 (TTAB 2002). The point is that the evidence in this case shows use of the very combination of terms applicant is seeking to register. Further, this type of minor variation in the display of a descriptive term has frequently been held to be legally insignificant. See, e.g., In re Omaha National Corporation, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) (FIRSTIER, the equivalent of "first tier," merely descriptive of banking services); Weiss Noodle Co. v. Golden Cracknel and Specialty Co., 290 F.2d 845, 129 USPQ 411 (CCPA 1961) (HA-LUSH-KA generic equivalent of the Hungarian word "haluska"); In re Cox Enterprises, 82 USPQ2d 1040, 1043 (TTAB 2007) (THEATL, the equivalent of THE ATL, a common nickname for

the city of Atlanta, merely descriptive of publications featuring information about Atlanta).

Finally, we note that the examining attorney has made of record a printout of applicant's prior Registration No. 3564858 for the mark POLYMER LATEX (and design) for essentially the same goods wherein the term POLYMER LATEX has been disclaimed. It is true, as applicant argues, that the disclaimer in this registration does not in itself preclude applicant from obtaining registration for the mark in a subsequent application. The disclaimer is, nonetheless, further evidence that POLYMERLATEX, the equivalent of POLYMER LATEX, is a descriptive term. See Sweats Fashions Inc. v. Pannill Knitting Co. Inc., 833 F.2d 1560, 4 USPQ2d 1793, 1797 n.1 (Fed. Cir. 1987) ("disclaimers are evidence, albeit not conclusive, of descriptiveness of the term.").

There is no question that customers for applicant's aqueous emulsions and dispersions and products derived therefrom, i.e., latex, would, without any guesswork or the exercise of any imagination, immediately understand the meaning of POLYMERLATEX as applied to those goods. This is a descriptive term that competitors of applicant should remain free to use in connection with their own latex compounds.

Decision: The refusal to register under Section 2(e)(1) of the Trademark Act is affirmed.