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Subject: U.S. TRADEMARK APPLICATION NO. 79083340 - APPLIQUATOR -  
GLAWE-32477 - EXAMINER BRIEF

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)**

**APPLICATION SERIAL NO.** 79083340

**MARK:** APPLIQUATOR



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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**TTAB INFORMATION:**

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

**APPLICANT:** Gilltec GmbH

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

GLAWE-32477

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**EXAMINING ATTORNEY'S APPEAL BRIEF**

**INTERNATIONAL REGISTRATION NO. 1040878**

Applicant has appealed the Trademark Examining Attorney's Final refusal to register the proposed mark "APPLIQUATOR" for ""containers, cylinders, canisters filled with adhesives for industrial purposes," in Class 1 "containers, cylinders, canisters filled with cosmetics, tooth bleaching preparations or dental bleaching gels," in Class 3 and "containers, cylinders, canisters filled with dental cements, teeth filling material, dental adhesives, lacquer for dental purposes," in Class 5 and "dental instruments for use in applying dental substances" in Class 10 on the grounds that the mark is merely descriptive of the goods within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1).

**FACTS**

On July 1, 2010, applicant applied to register the mark APPLIQUATOR for “adhesives for industrial purposes, containers and application instruments adapted for the aforementioned substances,” “cosmetics; bleaching preparations for cosmetic purposes, in particular bleaching preparations for teeth; dental bleaching gels, containers and application instruments adapted for the aforementioned substances,” “chemical preparations for dental purposes; dental cements; teeth filling material; dentine and enamel adhesive (dental mastics); dental lacquer; containers and application instruments adapted for the aforementioned substances,” and “dental instruments, in particular application instruments for dental substances, for example adhesives, adhesion promoters, caustics, desensitizer, haemostatic solutions, cavity under fillings, dental lacquer, indicator fluids, fissure sealings, bleaching preparations, the aforementioned substances, in particular in fluid form or gel form.”

On July 12, 2010, the examining attorney issued a Provisional Partial Refusal as to the following goods “containers and application instruments adapted fir the aforementioned substance,” “chemical preparations for dental purposes,” “dentine and enamel adhesive (dental mastics),” “dental lacquer” and “ dental instruments, in particular application instruments for dental substances, for example adhesives, adhesion promoters, caustics, desensitizer, haemostatic solutions, cavity under fillings, dental lacquer, indicator fluids, fissure sealings, bleaching preparations, the aforementioned substance, in particular in fluid form or gel form.” On October 29, 2010, applicant responded to the Office action amending the identification of goods.

On March 21, 2011, the examining attorney issued a new Partial Refusal under Section 2(e)(1) as to the following goods “containers, cylinders, canisters filled with adhesives for industrial purposes,” “containers, cylinders, canisters filled with cosmetics, tooth bleaching preparations or dental bleaching gels,” “containers, cylinders, canisters filled with dental cements, teeth filling material, dental adhesives, lacquer for dental purposes,” and “dental instruments for use in applying dental substances.” On April 5, 2012, applicant responded to the office action arguing against the Partial refusal to register the mark under Section 2(e)(1).

On October 13, 2011, the examining attorney issued a Partial Final Refusal under Section 2(e)(1).

Applicant filed a Request for Reconsideration after a Final Action and a Notice of Appeal on April 5, 2012.

The examining attorney denied the request for reconsideration on May 18, 2012, and applicant subsequently filed its Appeal Brief.

### ISSUE

THE SOLE ISSUE ON APPEAL IS WHETHER THE MARK IS MERELY  
DESCRIPTIVE WHEN USED ON THE IDENTIFIED GOODS UNDER  
TRADEMARK ACT SECTION 2(e)(1)

### ARGUMENTS

BECAUSE THE PROPOSED MARK MERELY DESCRIBES THE GOODS IN THE APPLICATION, REGISTRATION MUST BE REFUSED.

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods. TMEP §1209.01(b); *see In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1009-10 (Fed. Cir. 1987). The applied-for mark is merely descriptive of a feature and characteristic of the identified goods.

Applicant is seeking registration of the proposed mark APPLIQUATOR for “containers, cylinders, canisters filled with adhesives for industrial purposes,” “containers, cylinders, canisters filled with cosmetics, tooth bleaching preparations or dental bleaching gels,” “containers, cylinders, canisters filled with dental cements, teeth filling material, dental adhesives, lacquer for dental purposes,” and “dental instruments for use in applying dental substances,” amongst other goods.

Applicant argues that its mark, APPLIQUATOR, is a coined term that is not recognized in any language and that as such the term is not a novel spelling or an intentional misspelling of the word APPLICATOR.

Applicant's proposed mark, APPLIQUATOR, is a novel spelling of the word “APPLICATOR,” which means a simple device, as a rod, spatula, or the like, for applying medication, cosmetics, glue, or any other substance not usually touched with the

fingers,” and “a device, such as a spatula or rod, for applying a medicine, glue, etc. (See definition in page 2 of the action mailed on March 21, 2011). A novel spelling or an intentional misspelling that is the phonetic equivalent of a merely descriptive word or term is also merely descriptive if purchasers would perceive the different spelling as the equivalent of the descriptive word or term. See *In re Hercules Fasteners, Inc.*, 203 F.2d 753, 97 USPQ 355 (C.C.P.A. 1953) (holding “FASTIE,” phonetic spelling of “fast tie,” merely descriptive of tube sealing machines); *Andrew J. McPartland, Inc. v. Montgomery Ward & Co.*, 164 F.2d 603, 76 USPQ 97 (C.C.P.A. 1947) (holding “KWIXTART,” phonetic spelling of “quick start,” merely descriptive of electric storage batteries); *In re Carlson*, 91 USPQ2d 1198 (TTAB 2009) (holding “URBANHOUSING” phonetic spelling of “urban” and “housing,” merely descriptive of real estate services); *In re State Chem. Mfg. Co.*, 225 USPQ 687 (TTAB 1985) (holding “FOM,” phonetic spelling of “foam,” merely descriptive of foam rug shampoo); TMEP §1209.03(j).

Applicant argues that “the difference between ‘qu’ and ‘c’ in the respective marks is so substantial,” and that “the pronunciation of Applicant's mark is quite distinguishable from that of the term ‘applicator’ in that Applicant's ‘qu’ would be pronounced as ‘kw,’ while the ‘c’ in ‘applicator’ would be pronounced ‘k.’” Applicant further argues that the proposed mark “is not a phonetic spelling of ‘applicator,’ but a different word altogether.”

There is no correct pronunciation of a mark because it is impossible to predict how the public will pronounce a particular mark. See *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101

USPQ2d 1905, 1912 (Fed. Cir. 2012); *Centraz Indus. Inc. v. Spartan Chem. Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006); TMEP §1207.01(b)(iv).

The examining attorney attached Internet website evidence from: (1) [www.classzone.com](http://www.classzone.com), (2), [www.say-it-in-english.com](http://www.say-it-in-english.com) and (3) Wikipedia, all showing that “QU” may be pronounced like a “K.” For example, the evidence from [www.classzone.com](http://www.classzone.com) states that “The letter q is always followed by the letter u in the English language. In some words, qu is pronounce /k/. When qu is pronounced /k/, it can appear in the middle of a word or at the end of a word.” (See page 2 of the action mailed on October 13, 2011.) No thought or imagination is required to see that “APPLIQUATOR” is a novel spelling of the word “APPLICATOR” and that it is merely descriptive of “containers, cylinders, canisters filled with adhesives for industrial purposes,” “containers, cylinders, canisters filled with cosmetics, tooth bleaching preparations or dental bleaching gels,” “containers, cylinders, canisters filled with dental cements, teeth filling material, dental adhesives, lacquer for dental purposes,” and “dental instruments for use in applying dental substances.”

Thus, the proposed mark is, in fact, a novel or intentional misspelling of the word “APPLICATOR,” and it will be pronounced in the same way; therefore, purchasers would perceive the proposed mark as the equivalent of “APPLICATOR.”

The evidence of record submitted by the examining attorney supports the refusal under Section 2(e)(1). The examining attorney attached excerpts from two websites located

during searches of the Internet using the *Google* search engine showing applicators used with or for goods similar to those identified by applicant. See on page 12 and 15 of action dated October 13, 2011. For example, among the evidence are an excerpt from [www.rockler.com](http://www.rockler.com) which describes the adhesive applicators as “air-tight containers the keeps glue fresh,” and an excerpt from [www.sephora.com](http://www.sephora.com) which show the use of applicators for cosmetic use. This evidence shows that the products are often distributed in applicator-equipped packaging and that applicant’s goods are basically the same as those shown in the evidence.

Based on the evidence submitted, applicant’s proposed mark serves merely to describe a feature and characteristic of the applicant’s goods. The evidence of record amply demonstrates that the term “APPLIQUATOR” is merely descriptive of a dispensing feature of the claimed “containers, cylinders, canisters filled with adhesives for industrial purposes,” “containers, cylinders, canisters filled with cosmetics, tooth bleaching preparations or dental bleaching gels,” “containers, cylinders, canisters filled with dental cements, teeth filling material, dental adhesives, lacquer for dental purposes.”

Furthermore, the evidence of record shows that the term is highly descriptive, if not generic for the applicator tools referenced in applicant’s “dental instruments for use in applying dental substances.” As already established the term APPLICATOR is device for applying medication, cosmetics, glue, or any other substance not usually touched with the fingers. Applicant’s goods as listed in the application are “applicators and/or devices” for applying dental substances, and therefore the term is highly descriptive and/or generic.

The proposed mark immediately conveys that the goods are devices or packaging features for use in applying adhesives and dental substances. Thus, the identified goods are in fact applicators and are therefore not entitled to registration on the Principal Register.

### CONCLUSION

Based on the evidence of record, the examining attorney believes the applied-for mark as used on the goods identified in the application is merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act

For the foregoing reasons, the refusal of registration under Section 2(e)(1) of the Trademark Act should be affirmed.

Respectfully submitted,

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