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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79109409

MARK: SOL-R



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: SFS intec Holding AG

CORRESPONDENT'S REFERENCE/DOCKET NO:

SFS-TM032WO-

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1107454

The applicant has appealed the examining attorney's final refusal to register the proposed mark SOL-R on the ground that this mark merely describes the goods with which it is used, under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1).

I. FACTS

On November 28, 2011, the applicant, SFS intec Holding AG (hereinafter "applicant"), applied for registration on the Principal Register, of the proposed mark "SOL-R" in standard character form for the following goods and services:

"Common metals and their alloys; metal building materials, screws, rivets, bolts; metal transportable constructions, metallic cables and wires, articles of small ironware, pipes and tubes of metal, metal goods, fixed installations for solar installations of metal, construction materials and roof covering materials incorporating metal frames and retaining systems for solar panels, ground supports with solar panels, metal rods and fixation systems assembled from such elements, uprights, supports and fixations for solar panels, fixations for roofs, walls and ground with metal solar panels." International Class 6;

"Building construction materials not metal-based, rods and fixing systems assembled thereof and not of metal, fixations for solar panels, roof, wall and ground fixations with solar panels not of metal, roof cladding and roofing elements with integrated photovoltaic elements; asphalt, pitch and bitumen; component parts, spare parts and accessories (included in this class) for all the aforementioned articles, roofs not of metal, with integrated solar cells." International Class 19;

"Screws, rivets, bolts not of metal." International Class 20;

"Building construction, repair services, installation services, setting up solar installations." International Class 37.

In the first Office action, dated March 14, 2012, the examining attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1), finding the proposed mark merely descriptive of the goods/services identified in the application. A refusal under

section 2(d) was made based upon one prior registration (registration no. 3942459). There was also a requirement to clarify the identification of goods/services.

The applicant responded to the first Office action on September 14, 2012, arguing against the refusals and amending the identification of goods and services. The refusal based upon Section 2(d) was withdrawn and the amendments to the identification of goods and services were accepted. On October 8, 2012 a Final Office action was issued based upon the refusal under Section 2(e)(1). The applicant filed a request for reconsideration of the final refusal on April 8, 2013, continuing the argument against the refusal under Section 2(e)(1) and deleting Class 37 from the application. In response, the Request for Reconsideration was denied on June 20, 2013. On October 25, 2013 the applicant filed their appeal brief. On January 13, 2014 request for jurisdiction was requested by the Examining Attorney to address the amendment to the identification of goods that was outside the scope of the original identification of goods. On January 15, 2015 an Office Action indicating that the amendments were outside the scope of the original application was issued. The applicant subsequently responded restoring the identification of goods to remain within the scope of the original application and the appeal process was resumed.

ISSUE ON APPEAL

The sole issue on appeal is whether applicant's proposed mark SOL-R for "Common metals and their alloys; building materials of metal, namely, metal hardware, namely, screws, rivets, bolts; metal transportable buildings; articles of small ironware, namely, bolts, nails, rivets, screws; metal goods, namely, nuts, washers; fixed installations of metal, namely, for solar installations; metal construction materials for solar panels, namely, braces, supports, and

cladding; metal roof covering materials, namely, flashing, panels, and tiles incorporating metal frames for solar panels; retaining systems comprised of metal cable wires and metal cantilevered brackets for solar panels; ground supports of metal for solar panels; steel rods for use with solar panels;” “ Non-metallic building materials, namely, roofing elements, non-metallic reinforcements for concrete and wood building construction, namely, rods; non-metal roof cladding and roofing elements for photovoltaic elements, namely, non-metal roofing panels, tiles, and roof coverings; structural component parts of the aforementioned goods; roofing, not of metal, incorporating solar cells;” and “Non-metal fasteners, namely, screws, rivets, and bolts” is descriptive with respect to the goods.

II. ARGUMENT

THE PROPOSED MARK IS MERELY DESCRIPTIVE OF THE APPLICANTS GOODS

A. LEGAL ANALYSIS

Section 2(e)(1) of the Trademark Act bars registration if a mark describes A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant’s goods and/or services. TMEP §1209.01(b); *see, e.g., In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543 (1920)).

The determination of whether a mark is merely descriptive is made in relation to an applicant’s goods and/or services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); *see, e.g., In*

re Polo Int'l Inc., 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the “documents” managed by applicant’s software rather than the term “doctor” shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of “computer programs recorded on disk” where the relevant trade used the denomination “concurrent” as a descriptor of a particular type of operating system).

“Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

A novel spelling of a merely descriptive term is also merely descriptive if purchasers would perceive the different spelling as the equivalent of the descriptive term. *Andrew J. McPartland, Inc. v. Montgomery Ward & Co., Inc.*, 164 F.2d 603, 76 USPQ 97 (C.C.P.A. 1947), *cert. denied*, 333 U.S. 875, 77 USPQ 676 (S. Ct. 1948) (“KWIXTART,” phonetic spelling of “quick start,” is descriptive of electric storage batteries); *In re Hercules Fasteners, Inc.*, 203 F.2d 753, 97 USPQ 355 (C.C.P.A. 1953) (“FASTIE,” as phonetic spelling of “fast tie,” connotes that which unites or joins quickly, and hence the notation is descriptive of the function and character of tube sealing machines); *C-Thru Ruler Co. v. Needleman*, 190 USPQ 93 (E.D. Pa. 1976) (C-THRU held to be the equivalent of “see-through” and therefore merely descriptive of transparent rulers and drafting aids); *In re Hubbard Milling Co.*, 6 USPQ2d 1239 (TTAB 1987) (MINERAL-LYX held generic for mineral licks for feeding livestock); *In re State Chemical Manufacturing Co.*, 225 USPQ 687 (TTAB 1985) (“FOM,” equivalent to word “foam,” is descriptive for foam rug shampoo); TMEP §1209.03(j).

The term SOL-R is simply a fanciful spelling of the term solar which is defined as “1. Of, relating to, or proceeding from the sun: solar rays; solar physics.” (see original Office Action definition from www.thefreedictionary.com). The mark SOL-R and the term SOLAR are pronounced the same and sound identical. The applicant’s goods and services feature solar products as evidenced by the identification of goods/services. Evidence was attached in the Final Office action showing that “sol-r” has been used by others as an alternate spelling of the term SOLAR such that consumers would understand the term to be an alternate spelling of the term SOLAR.

B. APPLICANT’S ARGUMENT

The applicant argues that the mark SOL-R is not descriptive since consumers would not immediately know that the applicant’s goods are used with solar panels and installations and that, as a result, the mark is suggestive. The applicant also argues that the mark requires thought and imagination in order to determine the features or characteristics of the goods. The examining attorney disagrees. The applicant’s original identification of goods clearly indicates that the goods are used for solar panels and installations. The original identification of goods was as follows:

“Common metals and their alloys; metal building materials, screws, rivets, bolts; metal transportable constructions, metallic cables and wires, articles of small ironware, pipes and tubes of metal, metal goods, fixed installations for **solar installations** of metal, construction materials and roof covering materials incorporating metal frames and retaining systems for **solar panels**, ground supports with **solar panels**, metal rods and fixation systems assembled from such elements, uprights, supports and fixations for **solar panels**, fixations for roofs, walls and ground with metal **solar panels** in Class 6;

“Building construction materials not metal-based, rods and fixing systems assembled thereof and not of metal, **fixations for solar panels, roof, wall and ground fixations with solar panels not of metal**, roof cladding and roofing elements with integrated photovoltaic elements; asphalt, pitch and bitumen; component parts, spare parts and accessories (included in

this class) for all the aforementioned articles, roofs not of metal, with **integrated solar cells** in Class 19;

“Screws, rivets, bolts not of metal. Screws, rivets, bolts not of metal.” Class 20.

and Building construction, repair services, installation services, setting up **solar installations** in Class 37.

The applicant deleted the services in Class 37 and amended the identification of goods in the other classes to delete reference to solar panels or installations. However, this amendment was outside the scope of the original identification of goods and the goods currently are as follows:

“Common metals and their alloys; building materials of metal, namely, metal hardware, namely, screws, rivets, bolts; metal transportable buildings; articles of small ironware, namely, bolts, nails, rivets, screws; metal goods, namely, nuts, washers; fixed installations of metal, namely, for solar installations; metal construction materials for solar panels, namely, braces, supports, and cladding; metal roof covering materials, namely, flashing, panels, and tiles incorporating metal frames for solar panels; retaining systems comprised of metal cable wires and metal cantilevered brackets for solar panels; ground supports of metal for solar panels; steel rods for use with solar panels.” International Class 6.

“Non-metallic building materials, namely, roofing elements, non-metallic reinforcements for concrete and wood building construction, namely, rods; non-metal roof cladding and roofing elements for photovoltaic elements, namely, non-metal roofing panels, tiles, and roof coverings; structural component parts of the aforementioned goods; roofing, not of metal, incorporating solar cells.” International Class 19.

“Non-metal fasteners, namely, screws, rivets, and bolts.” International Class 20.

The goods are in fact, used on or in connection with solar panels and installations. The applicant does not dispute that the goods are used in connection with solar panels and installations. Additionally, as previously indicated in the Final Office Action, the term SOL-R is used by others as an alternative spelling for the term SOLAR. See Final Office Action and

attachments from www.google.com. See also prior registration number 3942459 for SOL-R WASH for “Cleaning and maintenance of solar panels, solar tubes, solar troughs and solar mirrors” referenced in the First Office Action. The mark is registered on the Supplemental Register due to the descriptive nature of the mark. Consumers encountering the term SOL-R are going to understand that the term is an alternate spelling of the term SOLAR. Further, consumers encountering the mark in connection with the goods at hand will understand the term to refer to this feature of the goods and understand the term to have meaning with respect to the goods.

The determination of whether a mark is merely descriptive is made in relation to an applicant’s goods and/or services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b); *see, e.g., In re Polo Int’l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the “documents” managed by applicant’s software rather than the term “doctor” shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of “computer programs recorded on disk” where the relevant trade used the denomination “concurrent” as a descriptor of a particular type of operating system).

“Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test.” *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). The question is not whether someone presented only with the mark could guess what the goods and/or services are, but “whether someone who knows what the goods and[or] services are will understand

the mark to convey information about them.” *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)); *In re Franklin Cnty. Historical Soc’y*, 104 USPQ2d 1085, 1087 (TTAB 2012).

The applicant argues that consumers would not understand that the goods are used on solar panels and installations based upon just the mark alone. As indicated above, the test is not whether consumers could guess what the goods are by the mark alone but when used in connection with the actual goods. Consumers buying the goods in the current application would understand that many of these goods are used with solar panels and installations and are sought out by consumers for such use. Therefore, the mark does immediately convey information about the goods. Specifically, that they are used in connection with solar installations and panels. There is no imagination required to make this connection when the mark is used in relation to the actual goods. As a result, the mark SOL-R is descriptive of the applicant’s goods.

III. CONCLUSION

For the foregoing reasons, the refusal to register the proposed mark SOL-R based on Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), because it is merely descriptive as applied to the identified goods, should be affirmed.

Respectfully submitted,

/Rebecca Smith/

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