

ESTTA Tracking number: **ESTTA720878**

Filing date: **01/15/2016**

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

Proceeding	79109409
Applicant	SFS intec Holding AG
Applied for Mark	SOL-R
Correspondence Address	JOHN J O'MALLEY VOLPE AND KOENIG PC 30 S 17TH STREET PHILADELPHIA, PA 19103-4009 UNITED STATES trademarks@vklaw.com, Jomalley@vklaw.com, ktinker@vklaw.com, jhanna@vklaw.com
Submission	Appeal to CAFC
Attachments	Notice of Appeal-SFS.pdf(56998 bytes) SFS-TM032WO-US-Board_Decision-20151116.PDF(81374 bytes)
Filer's Name	John J. O'Malley
Filer's e-mail	jomalley@vklaw.com, trademarks@vklaw.com, litigationparalegals@vklaw.com
Signature	/John J. O'Malley/
Date	01/15/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE IN RE TRADEMARK APPLICATION	
Applicant: SFS intec Holding AG Appln. No.: 79/109,409 Filed: Nov 28, 2011 Mark: SOL-R	Trademark Attorney: Rebecca Smith Law Office: 110 Our File: SFS-TM032WO-US Date: January 15, 2016

APPLICANT’S NOTICE OF APPEAL TO THE FEDERAL CIRCUIT

Applicant, SFS intec Holding AG (“SFS” or “Applicant”) hereby gives notice pursuant to 37 U.S.C. § 2.145(a) of its appeal to the United States Court of Appeals for the Federal Circuit from the Opinion, Paper 31, of the Trademark Trial and Appeal Board (“the Board”), entered in this matter on November 16, 2015.

The Applicant anticipates that the issues on appeal may include the following:

1. Whether Applicant’s mark is merely descriptive of the identified goods in all three classes under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

Copies of the Notice of Appeal are being filed simultaneously with the Director of the United States Patent and Trademark Office, the Trademark Trial and Appeal Board and the Clerk of the United States Court of Appeals for the Federal Circuit.

Respectfully Submitted,

SFS intec Holding AG

s/John J. O'Malley

John J. O'Malley

Attorneys for Applicant

January 15, 2016

Volpe and Koenig P.C.
30 South 17th Street
Philadelphia, PA 19103
215-568-6400 Phone
215-568-6499 Facsimile

JJO/kat

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing APPLICANT'S NOTICE OF APPEAL TO THE FEDERAL CIRCUIT was filed with the Trademark Trial and Appeal Board on January 15, 2016 using the ESTTA System.

The undersigned hereby further certifies that on January 15, 2016, three true and correct copies of the foregoing APPLICANT'S NOTICE OF APPEAL TO THE FEDERAL CIRCUIT and the Final Decision were filed (along with the fee set forth in Federal Circuit Rule 52) with the Federal Circuit via UPS at the following address:

Clerk of Court
United States Court of Appeals for the Federal Circuit
717 Madison Place, N.W., Room 401
Washington, DC 20439

The undersigned hereby further certifies that on January 15, 2016, two true and correct copies of the foregoing APPLICANT'S NOTICE OF APPEAL TO THE FEDERAL CIRCUIT and the Final Decision were served on the Director of the U.S. Patent and Trademark Office via UPS at the following address:

Director of the United States Patent and Trademark Office
Office of the General Counsel, 10B20, Madison Building East
600 Dulany St.
Alexandria, VA 22314-5793

Respectfully Submitted,

SFS intec Holding AG

s/John J. O'Malley
John J. O'Malley
Attorneys for Applicant

January 15, 2016

Volpe and Koenig P.C.
30 South 17th Street
Philadelphia, PA 19103
215-568-6400 Phone
215-568-6499 Facsimile

This Opinion is not a
Precedent of the TTAB

Mailed: November 16, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

In re SFS Intec Holding AG
—

Serial No. 79109409
—

John J. O'Malley of Volpe & Koenig P.C.,
for SFS Intec Holding AG.

Rebecca A. Smith, Trademark Examining Attorney, Law Office 110,
Chris A. F. Pedersen, Managing Attorney.

—
Before Lykos, Shaw and Greenbaum,
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

SFS Intec Holding AG (“Applicant”) seeks registration on the Principal Register
of the mark SOL-R (in standard characters) for goods ultimately identified as

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 in 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 covering; structural component parts of the aforementioned goods; roofing, not of metal, incorporating solar cells in International Class 19, and

Non-metal fasteners, namely, screws, rivets, and bolts in International Class 20.¹

The Trademark Examining Attorney has refused registration of Applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant's mark is merely descriptive of the identified goods in all three classes.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

I. Applicable Law

Section 2(e)(1) of the Trademark Act provides for the refusal of registration of "a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them." 15 U.S.C. § 1052(e)(1). A term is merely descriptive of goods or services within the meaning of Section 2(e)(1) "if it immediately conveys knowledge of a quality, feature, function, or characteristic

¹ Application Serial No. 79109409 was filed on November 28, 2011, based upon a request for extension of protection filed under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141(f).

of the goods or services with which it is used.” *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). *See also In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (quoting *Estate of P.D. Beckwith, Inc. v. Comm’r*, 252 U.S. 538, 543 (1920) (“A mark is merely descriptive if it ‘consist[s] merely of words descriptive of the qualities, ingredients or characteristics of’ the goods or services related to the mark.”)), *cited with approval in In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015).

The determination of whether a mark is merely descriptive must be made “in relation to the particular goods for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use.” *Bayer Aktiengesellschaft*, 82 USPQ2d at 1831 (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978)). In other words, the question is not whether someone presented only with the mark could guess the goods listed in the identification of goods. Rather, the question is whether someone who knows what the goods are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *Abcor Dev. Corp.*, 200 USPQ at 218. In addition, it is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods, only that it describe a single, significant ingredient,

quality, characteristic, function, feature, purpose or use of the goods. *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219 (quoting *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005)); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

II. Evidence and Argument

The Examining Attorney asserts that SOL-R simply is a novel spelling of the word “solar.” The Examining Attorney relies on the following dictionary definition of the word “solar: “[o]f, relating to, or proceeding from the sun: solar rays; solar physics.”² As the identification of goods in the application features products that are used specifically with solar installations and solar panels, and roofing that incorporates solar cells, the Examining Attorney contends that the proposed mark describes a significant feature of the identified goods.

In addition, the Examining Attorney introduced excerpts from two third-party websites showing that others use “sol-r” as an alternate spelling of the term “solar” for other solar products (<gullsolar.com> sells SOL-R-FLOR “active solar water heaters,”³ and <nythermal.com> sells SOL-R-THERM “solar thermal domestic hot water heating” systems⁴), and a third-party registration that issued on the Supplemental Register for the mark SOL-R-WASH for “cleaning and maintenance of solar panels, solar tubes, solar troughs and solar mirrors.”⁵

² <freedictionary.com> attached to March 14, 2012 Office Action.

³ Attached to October 8, 2012 Office Action.

⁴ Attached to October 8, 2012 Office Action.

⁵ Reg. No. 3942459 registered on April 5, 2011.

Based on this evidence, it is the Examining Attorney's position that the word "solar" is merely descriptive of solar products such as those identified in the application, and Applicant's proposed mark SOL-R also is merely descriptive because SOL-R is the equivalent of the word "solar."

In traversing the refusal, Applicant argues that consumers who view SOL-R alone would not immediately know that Applicant's goods are used with solar panels and installations, and therefore the proposed mark is suggestive rather than descriptive. However, this is not the standard. As noted above, we must consider the context in which the mark is used in connection with the goods identified in the application, and understand the significance that the mark would have to the average purchaser of the goods in the marketplace. *See DuoProSS Meditech Corp.*, 103 USPQ2d at 1757. As discussed below, purchasers seeking Applicant's solar products would immediately understand Applicant's proposed mark SOL-R to mean that Applicant's products are used with solar installations and solar panels, and roofing that incorporates solar cells.

In a similar vein, Applicant also argues that SOL-R "by itself does not immediately convey the word 'solar,'" and even if "SOL-R indicates some relationship to 'solar' or even the sun, there is nothing about the mark or the identification of goods that definitely indicates the products' function, characteristics, or use with specificity."⁶ However, Applicant's use of the term "solar" throughout Applicant's identification of goods belies this contention. Again,

⁶ 27 TTABVUE 16.

the test is not whether a purchaser who views Applicant's proposed mark SOL-R in a vacuum could guess what Applicant's products are. *See Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219.

On this record, we find that SOL-R is an alternative spelling of the word "solar" and would be perceived as such, and that SOL-R would be pronounced as "solar."⁷ We further find, and Applicant does not dispute, that Applicant's goods are used on or in connection with solar panels and installations, and roofing that incorporates solar cells.⁸

Based on the identification of goods and the excerpts from the third-party websites mentioned above, we find that the proposed mark SOL-R is merely descriptive of a significant feature or characteristic of Applicant's identified goods. No imagination is required by a purchaser or user to discern that the mark, when applied to the identified goods, describes products that are used on or in connection with solar panels and installations, and roofing that incorporates solar cells. A slight misspelling of a merely descriptive word, such as "sol-r," generally does not turn the descriptive word into an inherently distinctive trademark. The Supreme Court has held that:

The word, therefore, is descriptive, not indicative of the origin or ownership of the goods; and, being of that quality, we cannot admit that it loses such quality and

⁷ Applicant has proposed no alternative pronunciation for the term SOL-R, and we are aware of none.

⁸ Applicant does not argue that the "[n]on-metal fasteners, namely, screws, rivets, and bolts" identified in Class 20 should be treated differently from the goods identified in Classes 6 and 19, some of which are specifically limited to solar applications, nor has Applicant sought to divide out the Class 20 goods from the application.

becomes arbitrary by being misspelled. Bad orthography has not yet become so rare or so easily detected as to make a word the arbitrary sign of something else than its conventional meaning

Standard Paint Co. v. Trinidad Asphalt Mfg. Co., 220 U.S. 446, 455 (1911). *See also* *Armstrong Paint & Varnish Works v. Nu-Enamel Corp.*, 305 U.S. 315 (1938) (NU held equivalent of “new” in the mark NU-ENAMEL); *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 n.9 (CCPA 1980) (holding QUIK-PRINT descriptive: “There is no legally significant difference here between ‘quik’ and ‘quick.’”); *The Fleetwood Co. v. Mende*, 298 F.2d 797, 132 USPQ 458, 460 (CCPA 1962) (“TINTZ [is] a phonetic spelling of ‘tints’”); *King-Kup Candies, Inc. v. King Candy Co.*, 288 F.2d 944, 129 USPQ 272, 273 (CCPA 1961) (“It is clear, therefore, that the syllable ‘Kup,’ which is a full equivalent of the word ‘cup,’ is descriptive.”); *Andrew J. McPartland, Inc. v. Montgomery Ward & Co.*, 164 F.2d 603, 76 USPQ 97, 99 (CCPA 1947) (“the term ‘KWIXTART’ is but a phonetic spelling of the term ‘quick start’ and was intended to describe merely that appellant’s battery would start a motor or engine quickly.”); *In re Carlson*, 91 USPQ2d 1198, 1200 (TTAB 2009) (URBANHOUSING found to have same meaning as URBAN HOUSING).

Thus, Applicant’s proposed mark SOL-R does not become an inherently distinctive mark by the slight misspelling of the commonly used and understood descriptive term “solar.” An ordinary consumer encountering Applicant’s proposed mark SOL-R in connection with Applicant’s products, which are used on or in connection with solar panels and installations, and roofing that incorporates solar

cells, would immediately perceive the misspelled term as the phonetic equivalent of the merely descriptive term “solar.”

We also have considered the Examining Attorney’s evidence of one third-party registration issued on the Supplemental Register for SOL-R-WASH as showing that the USPTO has treated the term SOL-R-WASH as merely descriptive for “cleaning and maintenance of solar panels, solar tubes, solar troughs and solar mirrors.” Although this evidence is entitled to some probative value, it is not conclusive on the issue of mere descriptiveness of the term SOL-R. Each case must stand on its own merits. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

We conclude that Applicant’s proposed mark SOL-R, when applied to the goods identified in the application, is merely descriptive thereof under Section 2(e)(1).

Decision: The refusal to register Applicant’s proposed mark SOL-R is affirmed.