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

Proceeding	79119845
Applicant	Tateho Kagaku Kogyo Kabushiki Kaisha; (doing business as; Tateho Chemical Industries Co., Ltd.)
Applied for Mark	PUREMAG
Correspondence Address	MARK D ALLEMAN ALLEMAN HALL MCCOY RUSSELL & TUTTLE LLP 806 SW BROADWAY, SUITE 600 PORTLAND, OR 97204 UNITED STATES saing@ahmrt.com, alleman@ahmrt.com, harnett@ahmrt.com, garrett@ahmrt.com
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Filer's Name	Mark D. Alleman
Filer's e-mail	alleman@ahmrt.com, saing@ahmrt.com, garrett@ahmrt.com, harnett@ahmrt.com
Signature	/Mark D. Alleman/
Date	06/17/2014

The level of imagination, thought or perception required to reach a conclusion as to the nature of the goods; and, the likelihood that the mark will conjure up other purely arbitrary connotations separate from what the mark conveys about the product

As an initial matter, Applicant maintains that its applied-for mark PUREMAG is not merely descriptive of the following refused goods in International Class 001 as the mark does not immediately convey the nature of Applicant's goods: magnesium hydroxide, magnesium oxide, magnesium carbonate; magnesium oxide ceramics in particle and compacted form used as target material for sputtering, electron-beam deposition, evacuated deposition. In the Examining Attorney's appeal brief, it is argued that "the evidence of record includes applicant's own web page, which consumers can and do encounter in the marketplace" and thus, the applied-for mark *does* convey a characteristic of Applicant's goods (see pages 7 and 8 of Examining Attorney's appeal brief). In response, Applicant notes that, to the relevant consumer of Applicant's goods, it is common practice to indicate the extent to which a substance is free of extraneous matter and that, as purity in this context is a matter of degree, the binary categories "pure" and "impure" are imprecise and uninformative. Rather, those in the trade use terms such as "high-purity" to express a high degree of freedom from extraneous materials or tiered designators such as "3N", "4N", and "5N" to express purity grades (see Exhibit A of Applicant's Request for Reconsideration). In this marketplace context, it can be surmised that some degree of imagination is required on the part of the relevant consumer in order to reach a conclusion about the nature of Applicant's goods. Additionally, Applicant respectfully submits that, to the best of Applicant's knowledge, PUREMAG is a coined term that has no known significance specific within Applicant's industry or to Applicant's products or any well-known meaning in any other context. Thus, Applicant submits that its composite mark PUREMAG is at least suggestive of Applicant's goods and is sufficiently distinctive to support registration. See *Nife Incorporated v. Gould-National Batteries, Inc.*, 128 U.S.P.Q. 453, 1961 WL, 8056 (T.T.A.B. 1961)

(wherein the Board found NICAD, for use with nickel cadmium, sufficiently arbitrary, deciding that the mark did not constitute a recognized abbreviation of “nickel cadmium”).

Further, the Examining Attorney asserts that the Applicant concedes that the evidence of record establishes that MAG is a “common” abbreviation for magnesium (see page 7 of Examining Attorney’s appeal brief). In response, Applicant disagrees with the claim that MAG is a common abbreviation for magnesium and instead posits that the evidence strongly suggests that MAG is arbitrary in nature. Applicant believes that more weight should be given to the arbitrary nature of MAG, as opposed to how often a consumer would assert MAG’s connection to the word “magnesium.” The evidence of record shows that MAG is an abbreviation for a host of different terms including metal active gas, magnetometer, magazine, etc., and that MAG is not exclusively used as a common abbreviation for magnesium-containing compounds. Due to the numerous words for which MAG is an abbreviation, it is likely that the mark will conjure up other purely arbitrary connotations separate from what the mark might convey about Applicant’s goods. See *Commc’ns Satellite Corp. v. Comcet, Inc.*, 429 F2d 1245 (4th Cir. 1970); See 2 *McCarthy on Trademarks and Unfair Competition*, §12.37 (4th ed. 2013) (“If the abbreviation is not recognizable as the original generic term, then the abbreviation is like a fanciful mark and protectable.”). Thus, Applicant maintains that its applied-for mark PUREMAG is sufficiently distinctive so as to support registration.

The likelihood that competitors will need to use the term in connection with their goods; and, the extent to which other sellers have used the mark on similar merchandise – frequent use will indicate descriptiveness

Turning now to the third and fourth factors, also supporting the assertion that PUREMAG is not merely descriptive is that it is unlikely that competitors will need to use the mark PUREMAG in connection with their own goods. See, e.g., *FM 103.1, Inc. v. Universal Board*, 929 F. Supp. 187 (D.N.J.

1996). The Examining Attorney seems to overlook this factor altogether. However, it should be appreciated that the distinctiveness of the applied-for mark is in part due to the numerous ways of labeling magnesium hydroxide, magnesium oxide, magnesium carbonate, or magnesium oxide ceramics in particle and compacted form used as target material for sputtering, electron-beam deposition, and evacuated deposition. Indeed, and as stated above, to the best of Applicant's knowledge, PUREMAG has no known significance specific to Applicant's industry or products or any well-known meaning in any other context. As such, Applicant submits that it is unlikely that competitors would require use of the term "PUREMAG" in relation to their goods, nor does there appear to be frequent use of "PUREMAG" by third-parties within the relevant industry.

Additionally, the evidence of record demonstrates that there is infrequent use of "PUREMAG" by third-parties within the relevant industry and, as a result, it can be surmised that it is unlikely that competitors will need to use the term "PUREMAG" in relation to their goods. As such, PUREMAG is not a necessary term for competitors to promote or sell their chemical products. In fact, the Examining attorney failed to show any use of "PUREMAG" by competitors, much less use in regards to chemical products.

The probability consumers will regard the mark as a symbol of origin or as self-laudatory

Turning now to the fifth and final factor, Applicant respectfully submits that the mark PUREMAG will not be seen by consumers as merely self-laudatory, but will be seen as a source indicator, capable of distinguishing the origin of Applicant's goods. The fact that PURE and MAG are joined as one, coined word (PUREMAG) with no established dictionary or industry meaning, strongly suggests that consumers will not interpret the mark as merely describing the nature or quality of Applicants goods, but will view the mark as a source indicator. When consumers encounter a coined word labeling goods in a marketplace, for which they know no other definition, and which is merely

suggestive or arbitrary of the goods it labels as in the instant case, then consumers are likely to interpret the word as a symbol of origin of the goods being labeled. Further, the lack of third party uses of similar marks mean that consumers will encounter PUREMAG in the marketplace *only* in association with Applicant's goods, further increasing the ability of the mark to serve as a source indicator. Accordingly, Applicants respectfully submit that this factor will weigh in favor of registration.

Conclusion

For the reasons presented in Applicant's Reply Brief, and for the reasons above, Applicant's applied-for mark is sufficiently distinctive so as to support registration.

DATED this 17th day of June, 2014.

Respectfully submitted,

Alleman Hall McCoy Russell & Tuttle LLP



Mark D. Alleman
Oregon Bar Member
Attorney of Record
806 S.W. Broadway, Suite 600
Portland, Oregon 97204
Telephone: (503) 459-4141
Facsimile: (503) 459-4142