

**This Opinion is Not a
Precedent of the TTAB**

Mailed: September 9, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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*Tateho Kagaku Kogyo Kabushiki Kaisha d/b/a Tateho Chemical Industries
Co., Ltd.*
—

Serial No. 79119845
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Mark D. Alleman of Alleman Hall McCoy Russell & Tuttle LLP
for Tateho Kagaku Kogyo Kabushiki Kaisha d/b/a Tateho Chemical Industries.

Marc J. Leipzig, Trademark Examining Attorney, Law Office 115,
John Lincoski, Managing Attorney.

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Before Zervas, Lykos and Shaw,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Pursuant to Section 66(a) of the Act, 15 U.S.C. § 1141f(a), Tateho Kagaku Kogyo Kabushiki Kaisha d/b/a Tateho Chemical Industries. (“Applicant”) filed a Request for Extension of Protection of an international registration for the mark **PUREMAG** (in standard character format) on the Principal Register for “[c]hemicals and chemical materials used in industry, science and agriculture, namely, magnesium hydroxide, magnesium oxide, magnesium carbonate, calcium hydroxide, calcium oxide, calcium carbonate, zirconium oxide, calcium sulfite,

calcium peroxide, silicon carbide, silicon nitride; chemicals used in deposition, namely, chemical source material for the deposition of thin films; magnesium oxide ceramics in particle and compacted form used as target material for sputtering, electron-beam deposition, evacuated deposition; ceramic materials in particle and compacted form used as target material for sputtering, electron-beam deposition, evacuated deposition; ceramic materials for industrial use in powder, particle, and granular form; adhesives, not for stationery or household purposes; plant growth regulating preparations; fertilizing preparations” in International Class 1.¹

The Trademark Examining Attorney has partially refused registration of the mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the mark is merely descriptive of a portion of Applicant’s identified goods, namely, “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.”²

When the partial refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the Request for Reconsideration, the appeal was resumed. For the reasons set forth below, we affirm the partial refusal to register.

¹ Application Serial No. 79119845, based on international registration no. 1134223.

² During *ex parte* prosecution, the Examining Attorney withdrew the refusal under Trademark Act Section 2(d), 15 U.S.C. §1052(d) based on Registration No. 2504968.

I. Evidentiary Objection

Before addressing the substance of this appeal, we will consider first the Examining Attorney's objection to Applicant's submission of third-party registrations with its main brief as untimely. Trademark Rule 2.142(d) provides in relevant part that "[t]he record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed." Insofar as the Examining Attorney has timely interposed an objection to Applicant's late-filed evidence with his brief, the objection is sustained, and the evidence submitted concurrently with Applicant's appeal brief has been given no consideration. *See e.g., In re Fiat Group Marketing & Corporate Communications S.p.A.*, 109 USPQ2d 1593, 1596 (TTAB 2014) (examining attorney's objection to applicant's submission of registrations with appeal brief sustained).

II. Mere Descriptiveness Refusal

We now consider the substantive refusal before us. Section 2(e)(1) of the Lanham Act precludes registration of a mark that, when applied to the goods or services of the applicant, is merely descriptive of them. 15 U.S.C. § 1052(e)(1) (2006). "A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic 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)). The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract. *In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Bayer*, 82 USPQ2d at 1831. This requires consideration of the context in which the mark is used or intended to be used in connection with those goods/services, and the possible significance that the mark would have to the average purchaser of the goods or services in the marketplace. *In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Bayer*, 82 USPQ2d at 1831; *In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987). Evidence that a term is merely descriptive to the relevant purchasing public “may be obtained from any competent source, such as dictionaries, newspapers, or surveys.” *In re Bayer*, 82 USPQ2d at 1831 (quoting *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986)).

The Examining Attorney’s evidence of record supports a determination that Applicant's mark, **PUREMAG**, when considered in relation to “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” immediately informs prospective purchasers as to a “quality, feature...or characteristic” of Applicant’s goods. In support of the refusal to register, the Examining Attorney has submitted the following evidence:

- A dictionary definition of the word “pure” from *Random House Unabridged Dictionary* (1997)³ with the following relevant entries:

³ See <http://dictionary.infoplease.com/pure> attached to Office Action dated November 23, 2012. Because there was no evidence of exposure to U.S. consumers, the Board did not consider the entry for “British English” of the word “pure” obtained by the Examining Attorney from *Cambridge Dictionaries Online*.

1. free from anything of a different, inferior, or contaminating kind; free from extraneous matter: pure gold, pure water.

2. unmodified by an admixture; simple or homogenous.

- Evidence from two reference sources that the term “mag” is a commonly recognized abbreviation for “magnesium.”⁴

Applicant’s mark conveys that Applicant’s products contain magnesium in “pure” form, that is to say, free from any “different, inferior, or contaminating” matter and/or “unmodified by admixture.”

Applicant’s touting of its chemical products as “High Purity Magnesium Oxide” on its web site lends further support for the Examining Attorney’s refusal:

Tateho Chemical Industries developed the high purity magnesium oxide “PUREMAG® FNM-G” that contain not less than 99.99 percent by using the raw material selected carefully, and using a special processing technology.

Because it hardly contains impurities, it is possible to use it for high purity like an electric material, a phosphor raw material, a catalyst material, and various additives, etc...

See excerpt obtained from www.tateho-chemical.com/mgo/puremag.html, attached to Office Action dated July 6, 2013.

⁴ See entry for “mag” from the following:

<http://www.acronymfinder.com/MAG.html>, attached to Office Action dated November 23, 2012 and

<http://www.allacronyms.com/cat/7/MAG/Magnesium/1052653>, attached to Office Action dated July 6, 2013.

The Board did not consider the unverified source entry for “What does mag mean” from “Wiki Answers” at <http://www.wiki.answers.com> attached to Office Action dated July 6, 2013.

Applicant argues that its applied-for composite mark, **PUREMAG**, is not a known abbreviation for Applicant's "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." Rather, as Applicant contends, its mark is a coined term with no discernible meaning in the English language. Applicant's argument represents a misunderstanding of the descriptiveness analysis. A compound mark which consists of two or more words combined to create a single coined word is merely descriptive if (1) the individual words are descriptive and retain their descriptive meaning within the compound mark, and (2) the compound mark has no unique or incongruous meaning as applied to the goods and/or services. *See In re Cox Enters.*, 82 USPQ2d 1040, 1043 (TTAB 2007) (holding THEATL the equivalent of THE ATL, a common nickname for the city of Atlanta, merely descriptive of publications featuring news and information about Atlanta); *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002) (holding SMARTTOWER merely descriptive of highly automated cooling towers); *In re Entenmann's, Inc.*, 15 USPQ2d 1750, 1751 (TTAB 1990) (holding OATNUT merely descriptive of bread containing oats and hazelnuts), *aff'd per curiam*, 928 F.2d 411 (Fed. Cir. 1991). This precisely describes Applicant's applied-for mark **PUREMAG**. Here, Applicant has combined the two descriptive terms "pure" and "mag" to create a compound word mark with no other unique or incongruous meaning other than denoting that the specified goods comprised in part of magnesium virtually free of impurities. As the case law makes clear, there is no

requirement that the proposed mark constitute a known or discernible word. Rather, the critical inquiry is whether the mark “immediately conveys knowledge of a quality, feature, function, or characteristic of the goods”

Applicant further argues that its proposed mark requires some degree of imagination or mental leap on the part of the consumer to ascertain the nature of the goods. Applicant also disputes the Examining Attorney’s reliance on the reference materials showing that “mag” is an abbreviation for “magnesium” arguing that because “mag” could be associated with other terms (e.g. “magnetometer,” “magazine”) it should not be viewed as pointing uniquely to Applicant’s goods. Applicant maintains that “it is likely that MAG would conjure up other purely arbitrary words distinct from what MAG might indicate about Applicant’s goods.” Applicant’s Brief, p. 8. These arguments are not persuasive. As noted above, determination of whether a mark is merely descriptive is considered in relation to the identified goods and/or services, not in the abstract. *See, e.g., In re Polo Int’l Inc.*, 51 USPQ2d 1061 (TTAB 1999) (finding DOC in DOC-CONTROL would be understood to refer to the “documents” managed by applicant’s software, not “doctor” as shown in dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242 (TTAB 1987) (finding CONCURRENT PC-DOS merely descriptive of “computer programs recorded on disk” where irrelevant trade used the denomination “concurrent” as a descriptor of a particular type of operating system). In other words the issue is whether someone who knows what the products are will understand the mark to convey information about them. *In re Tower Tech, Inc.*,

supra, 64 USPQ2d at 1316-1317 (TTAB 2002); *In re Patent & Trademark Serv. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998). Therefore, the fact that a term may have a different meaning(s) in a different context is not controlling. *See In re RiseSmart Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012).

Applicant asserts that it is unlikely that competitors will need to use the term “puremag” to describe their own goods. Applicant argues that applied-for mark **PUREMAG** as no known significance in the relevant industry, and that rather than describing Applicant’s goods as “pure,” competitors in the industry are more likely to use tiered designators such as “3N,” “4N,” and “5N” to express the degree of purity of their own competing products. Applicant also points to the Examining Attorney’s failure to demonstrate use of the term “puremag” by competitors in the industry in promoting their own respective products. However, the fact that an applicant may be the first and only user of a merely descriptive designation does not justify registration if the only significance conveyed by the term is merely descriptive. *See In re Nat’l Shooting Sports Found., Inc.*, 219 USPQ 1018 (TTAB 1983).

Decision: The descriptiveness refusal to register Applicant’s mark in part as to the goods identified as “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” is affirmed. Application Serial No. 79119845 will proceed to registration for the remaining identified goods.