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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; dba Tateho Chemical Industries Co., Ltd.
Applied for Mark	PUREMAG
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Date	10/08/2014

other purely arbitrary connotations separate from what the mark conveys about the product.

(2) It is not likely that competitors will need to use the term in connection with their goods; and, other sellers have not used the mark on similar merchandise – such infrequent use indicates non-descriptiveness.

(3) It is probable that consumers will regard the mark as a symbol of origin or as self-laudatory.

Accordingly, based on the evidence of record, the only conclusion that may be reached is that the applied-for mark is at least suggestive of the refused goods. Therefore, Applicant requests that the Board reconsider its decision, and reverse the refusal to register.

(1) The mark requires a high level of imagination, thought and perception to reach a conclusion as to the nature of the goods; and, it is likely that the mark will conjure up other purely arbitrary connotations separate from what the mark conveys about the product.

Applicant first requests that the Board reconsider its finding that the arguments pertaining to the arbitrariness of the applied-for mark and the resultant mental leap required to come to an understanding of the refused goods are not persuasive. The Board found that the issue is whether someone who knows what the products are will understand the mark to convey information about them (Decision at 7). However, the Board overlooks the fact that because a term may hold numerous different meanings – regardless of whether a consumer is familiar with the refused goods – it is likely that the term would conjure up other purely arbitrary terms. As a result of the arbitrary nature of the term “MAG,” Applicant submits that the compound mark requires a certain level of imagination to ascertain the nature of the refused goods and, thus, is sufficiently distinct so as to support registration. 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.”).

First, Applicant maintains that MAG is not a common abbreviation for magnesium due to the arbitrary nature of the word MAG. 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 and will require a certain level of creativity and imagination to determine the true nature of the refused goods. The level of arbitrariness of an applied-for mark and the level of imagination required by a consumer to understand the nature of the refused goods are inextricable. See *Commc’ns Satellite Corp. v. Comcet, Inc.*, 429 F2d 1245 (4th Cir. 1970). This factor sufficiently supports a finding of distinctiveness of the applied-for mark so as to support registration. Thus, Applicant requests that the Board reconsider Applicant’s arguments pertaining to the arbitrariness of the applied-for mark and the resultant mental leap required to come to an understanding of the refused goods as not persuasive.

(2) It is not likely that competitors will need to use the term in connection with their goods; and, other sellers have not used the mark on similar merchandise – such infrequent use indicates non-descriptiveness.

Next, Applicant requests that the Board reconsider its finding that Applicant’s mark is merely descriptive and that even though Applicant may be the first and only user of its mark, the mark does not justify registration since the only significance conveyed by the term has been found to be merely descriptive. In response, Applicant refers to the arguments and evidence supplied under the first factor relating to the lack of significance and the resulting arbitrary nature of the applied-for mark. As a result of the applied-for mark’s

arbitrary nature, Applicant respectfully submits that it is highly unlikely that competitors will require the term PUREMAG to describe their own goods. There are a host of other names for goods provided by Applicant's competitors so as to not require the exact coined term PUREMAG. Applicant notes that it is not claiming any rights in the term PURE alone. Rather, Applicant's rights are in the coined composite term PUREMAG, a term that does not appear in any dictionary and has no particular established meaning in connection with the recited goods or in this trade or industry.

The statutes and regulations governing the issuance of trademark registrations permit any persons who believe they may be damaged to oppose registration of terms which are descriptive. Competitors of Applicant who are actively engaged in the marketplace are in a much better position to gauge whether or not Applicant's mark is descriptive than the Board who may have limited exposure to the daily operation of a particular industry, much less the chemicals and chemical materials industries. Indeed, if any such competitors believe they may be damaged by the issuance of a registration, they can initiate an opposition proceeding.

Therefore, Applicant requests that the Board reconsider its decision pertaining to this factor in support of registration of the applied-for mark.

(3) It is probable that consumers will regard the mark as a symbol of origin or as self-laudatory.

Finally, Applicant requests that the Board reconsider Applicant's remarks regarding the applied-for mark's ability to be seen as a source indicator, capable of distinguishing the origin of Applicant's goods, which is not addressed in the Decision. Applicant also reasserts that the applied-for mark is not self-laudatory. 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 requests that the Board reconsider this factor in favor of registration.

Conclusion

For the reasons presented in Applicant's Request for Reconsideration of the Final Decision, and for the reasons above, Applicant's applied-for mark is sufficiently distinctive so as to support registration.

DATED this 8th day of October, 2014.

Respectfully submitted,

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