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Subject: U.S. TRADEMARK APPLICATION NO. 79119845 - PUREMAG - ACO13403MADU - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79119845

MARK: PUREMAG



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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: Tateho Kagaku Kogyo Kabushiki Kaisha; (d
ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO:

ACO13403MADU

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1134223

Applicant Tateho Kagaku Kogyo Kabushiki Kaisha appeals the examining attorney's refusal to register PUREMAG for "Chemicals 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." Registration was refused under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), on the ground that the applied-for mark is merely descriptive of certain of the identified goods.

ISSUE

Whether applicant's proposed mark merely describes a feature of certain of the identified goods so as to preclude registration under Section 2(e)(1) of the Trademark Act.

STATEMENT OF FACTS

On November 8, 2012, applicant filed a Request for Extension of Protection for the mark PUREMAG. The goods are limited in Class 1 to: "Chemicals 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.”

On November 23, 2012, the examining attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that the applied-for mark is merely descriptive of the identified goods.

On July 6, 2013, the examining attorney made final the refusal to register, limiting the refusal to certain goods within the identification of goods. The examining attorney denied applicant’s Request for Reconsideration on January 26, 2014. Applicant appealed the refusal to register on December 30, 2013 and filed its Appeal Brief (“Brief”) on March 28, 2014.

OBJECTION TO EVIDENCE

Applicant has submitted new evidence with its appeal brief. Specifically, applicant included copies of nine (9) registrations containing the word “PURE,” arguing that “[t]he presence of these marks on the [P]rincipal [R]egister is strong evidence that use of PURE in combination with other words and phrases can result in a distinctive mark as a whole, deserving of registration.” See Brief at 9-10.

The record in an application should be complete prior to the filing of an appeal. 37 C.F.R. §2.142(d); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c). Because applicant’s new evidence was untimely submitted during an appeal, the trademark examining attorney objects to this evidence and requests that the Board disregard it. See *In re Fiat Grp. Mktg. & Corp. Commc’ns S.p.A*, 109 USPQ2d

1593, 1596 (TTAB 2014); *In re Pedersen*, 109 USPQ2d 1185, 1188 (TTAB 2013); TBMP §§1203.02(e), 1207.01; TMEP §710.01(c).

ARGUMENT

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., DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (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)).

A mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services." *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if a mark describes only one significant function, attribute, or property. *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 In re Oppedahl & Larson LLP*, 373 F.3d at 1173, 71 USPQ2d at 1371.

Further, determining the descriptiveness of a mark is done in relation to an applicant's goods and/or services, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. *See In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP

§1209.01(b). Descriptiveness of a mark is not considered in the abstract. *In re Bayer Aktiengesellschaft*, 488 F.3d at 963-64, 82 USPQ2d at 1831.

Applicant has applied for the mark PUREMAG for goods including magnesium hydroxide, magnesium oxide, magnesium carbonate, magnesium oxide ceramics in particle and compacted form used as target material for sputtering, electron-beam deposition and evacuated deposition.

Generally, if the individual components of a mark retain their descriptive meaning in relation to the goods and/or services, the combination results in a composite mark that is itself descriptive and not registrable. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012); TMEP §1209.03(d); *see, e.g., In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs, and pillows where the evidence showed that the term “BREATHABLE” retained its ordinary dictionary meaning when combined with the term “MATTRESS” and the resulting combination was used in the relevant industry in a descriptive sense); *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services, because such wording “is nothing more than a combination of the two common descriptive terms most applicable to applicant’s services which in combination achieve no different status but remain a common descriptive compound expression”).

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods and/or services is the combined mark registrable. *See In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013).

In this case, both the individual components and the composite result are descriptive of applicant's goods and/or services and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods and/or services.

Indeed, applicant acknowledges that the evidence offered by the examining attorney "establishes that MAG is a known abbreviation for magnesium . . .but not as an abbreviation for magnesium-containing compounds in general." See Brief at 7. In particular, the evidence of record supports the finding that the term "MAG" is a common abbreviation for "magnesium":

- <http://www.acronymfinder.com/MAG.html>, attached to Office Action dated November 23, 2012
- <http://www.allacronyms.com/cat/7/MAG/Magnesium/1052653>, attached to Office Action dated July 6, 2013
- http://www.wiki.answers.com/Q/What_does_mag_mean, attached to Office Action dated July 6, 2013

In addition, the word "PURE" references something simple and homogeneous, "unmodified by an admixture." See <http://dictionary.infoplease.com/pure> and http://dictionary.cambridge.org/dictionary/british/pure_1, both attached to Office Action dated November 23, 2012.

Notwithstanding the descriptive connotations of the terms "PURE" and "MAG," applicant nonetheless asserts that "PUREMAG is a term coined by Applicant, with no immediately discernible meaning in the English language." See Brief at 7. "Since Applicant's composite mark does not immediately convey the nature of Applicant's goods, upon encountering the mark in the marketplace, some degree of imagination is required on the part of the consumer in order to reach a conclusion about the nature of the goods." *Id.* To the contrary, the evidence of record includes applicant's own web page, which consumers can and do encounter in the marketplace. See www.tateho-chemical.com/mgo/puremag.html, attached to Office Action dated July 6, 2013. Applicant's own web

page details applicant's "high purity magnesium oxide," which is over 99.99% pure magnesium oxide (MgO) (the material "hardly contains impurities"). *Id.*

In addition, applicant argues that "telescoping descriptive terms . . . can result in a non-descriptive composite mark sufficiently distinctive to support registration." *See* Brief at 8. However, a "telescoped mark," which consists of two or more words combined to create a single word that shares letters, is merely descriptive or generic if the individual words are descriptive or generic and if the words retain their descriptive or generic meaning within the telescoped mark. *See In re Omaha Nat'l Corp.*, 819 F.2d 1117, 1118, 2 USPQ2d 1859, 1860 (Fed. Cir. 1987) (holding FIRSTIER merely descriptive of banking services); *In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1083 (TTAB 2010) (holding NANDRIVE, a telescoped mark of the generic term "nand drive," generic for electronic integrated circuits, including flash memory drives); TMEP §§1209.01(c)(i), 1209.03(d).

As is supported by the evidence of record, the term "PURE" refers to the high level of purity of applicant's magnesium products. In fact, applicant's own website confirms that its goods are more than 99.99 percent magnesium oxide and that such goods "hardly contain[] impurities." Clearly, consumers encountering the mark PUREMAG in the context of high purity magnesium products would understand the mark to convey information about those products.

Thus, as used in connection with the identified goods, the applied-for mark "PUREMAG" merely describes features of applicant's goods to the extent that applicant provides high-purity magnesium products..

CONCLUSION

For the reasons noted above, the examining attorney respectfully submits that applicant's proposed mark, PUREMAG is merely descriptive of features and qualities of certain of applicant's goods.

Accordingly, the examining attorney respectfully requests that the Board affirm the refusal to register under Section 2(e)(1) of the Trademark Act.

Respectfully submitted,

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