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

Proceeding	79137917
Applicant	Nippon Electric Glass Co., Ltd.
Applied for Mark	NIPPON ELECTRIC GLASS
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Serial No.: 79/137917  
Mark: NIPPON ELECTRIC GLASS  
Applicant: Nippon Electric Glass Co., Ltd.  
Examining Attorney: Shannon Twohig  
Law Office 105

**EX PARTE APPEAL**

**APPLICANT'S BRIEF**

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**I. INTRODUCTION**

Applicant hereby appeals to the Trademark Trial and Appeal Board (the “Board”) from the final decision of the Trademark Examining Attorney regarding the registration of the mark NIPPON ELECTRIC GLASS, serial number 79/137,917. In the First Final Office Action dated December 11, 2014 and repeated in the Second Final Office Action dated August 20, 2015, the Examiner maintained the requirement that Applicant disclaim “electric” as a generic term for Applicant’s goods in International Class 001, 011, 017, 019, and 021. Applicant requests reversal of the Examiner’s requirement that “electric” be disclaimed as generic in these classes because: (1) the Examiner has not met her burden of proof; (2) the phrase “electric glass” is registrable as part of a unitary phrase ELECTRIC GLASS, and therefore the disclaimer of the individual components of the phrase is improper; (3) “electric glass” has acquired distinctiveness as part of the mark NIPPON ELECTRIC GLASS; and (4) any doubt should be resolved in Applicant’s favor.

**II. DESCRIPTION OF THE RECORD**

Due to the complicated nature of this case, we have taken the liberty to discuss the prosecution history below.

**A. PROSECUTION HISTORY**

The application (Ser. No. 79/137917) for registration of NIPPON ELECTRIC GLASS has a filing date of February 4, 2013, and was initially refused in an Office Action under Trademark Act Section 2(e)(2) on November 14, 2013, as being primarily geographically descriptive of the origin of applicant’s goods and/or services as NIPPON is the Japanese name for the country Japan and the wording ELECTRIC GLASS is descriptive of Applicant’s goods and does not overcome the geographic significance of NIPPON. The Office Action requested

that the word “GLASS” be disclaimed as a generic term and required further clarification for certain goods considered indefinite in International Class 001, 006, 007, 009, 010, 011, 017, 019, 020, 021, 022, 023, and 024. No disclaimer was requested for the word “electric”.

Applicant filed a Response to the First Office Action on May 19, 2014 providing evidence that the mark NIPPON ELECTRIC GLASS was not primarily geographically descriptive and submitted a verified statement of Applicant's substantially exclusive and continuous use of NIPPON ELECTRIC GLASS in the US commerce since 1984. In addition, Applicant submitted extrinsic evidence that NIPPON ELECTRIC GLASS had acquired distinctiveness due to its long-term use in the United States. Applicant agreed to disclaim the word “Glass”. Applicant also clarified its goods in International Class 001, 006, 007, 009, 010, 011, 019, 020, 021, 022, 023 and 024.

A Second Office Action was issued on July 9, 2014, withdrawing the geographic descriptiveness refusal based upon Section 2(e)(2) and accepting the amended identification of goods in International Classes 001, 006, 007, 017, 019, 020, 022, 023 and 024. The Trademark Office accepted in-part the amendments in International Classes 009, 010, 011 and 021 and maintained the further clarification requirement of the goods in class 009, 010, 011, and 021. Furthermore, the Second Office Action newly declared that the word ELECTRIC was generic under Section 2(e)(1) for the goods in International Classes 001, 009, 011, 017, 019 and 021 and must be disclaimed for those goods.

On November 5, 2014, Applicant submitted further clarification for the goods in International Class 009, 010, 011, and 021. On November 13, 2014, Applicant submitted an argument that the Trademark Office had not made a clear showing that the word ELECTRIC was generic for the goods in class 001, 009, 011, 017, 019, and 021 and requested a withdrawal of the disclaimer requirement for the word “electric”.

A First Final Office Action was issued on December 11, 2014, accepting Applicant's amendment to International Class 010 and making final certain clarification requirements in International Classes 009, 011, and 021. The disclaimer requirement of ELECTRIC as to International Class 009 was withdrawn but maintained and made final as to International Classes 001, 011, 017, 019, and 021.

Applicant filed a Notice of Appeal and a Request for Reconsideration of the First Final Office Action on May 15, 2015 providing case law as evidence that the Trademark Office had not met its burden of proving that ELECTRIC was generic for the goods in International Class 001, 011, 017, 019, and 021. Furthermore, Applicant argued that the phrase ELECTRIC GLASS is a unitary phrase and that "electric" should not be disclaimed. Applicant also revoked the disclaimer of the word "glass".<sup>1</sup> Applicant amended the goods in Class 009, 011 and 021.

On July 8, 2015, Applicant submitted a voluntary amendment to change "glass ferrules" to "glass ferrules for fiber optic connectors".

A Second Final Action was issued on August 20, 2015, wherein the identification of goods was found acceptable. However, the Second Final Office Action maintained its disclaimer requirement of GLASS as being generic of all goods and upheld the partial disclaimer requirement for ELECTRIC as generic in classes 001, 011, 019 and 021. Class 017 was not mentioned. The Examining Attorney clarified that the Applicant was not required to disclaim the phrase ELECTRIC GLASS but that ELECTRIC and GLASS were to be disclaimed separately.

Applicant inquired into the appropriateness of this Second Final Action by phone and email as Applicant believed the appeal should be resumed and the matter returned to the TTAB. The Examining Attorney explained her reasoning for sending a Second Final Action as follows:

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<sup>1</sup> Applicant has revoked its disclaimer of "glass" as it believes it was improper of the Examining Attorney to require a disclaimer of "glass" as "electric glass" is considered part of a unitary phrase.

“[i]t is a subsequent final because a final refusal had not been previously issued for ‘glass’ (because the disclaimer was submitted prior to a final action being necessary).”

On September 16, 2015, the Board issued an order resuming the appeal and setting the due date for the Applicant's brief 60 days from the mailing date therein. The only issue being appealed is whether the disclaimer requirement of the word ELECTRIC based on genericness was erroneous.

**B. EXAMINING ATTORNEY'S EVIDENCE**

**1. July 9, 2014 Second Office Action**

The evidence attached to the Office Action consisted of a print-out of a definition from the online *Macmillan Dictionary* for the word “electric”. TSDR, p. 2.

**2. December 11, 2014 1<sup>st</sup> Final Office Action**

The evidence attached to the Office Action consisted of a print-out from the online *American Heritage* dictionary for the term “electrical”. TSDR, p. 2.

**3. August 20, 2015, 2<sup>nd</sup> Final Office Action**

The evidence attached to the Office Action consisted of (1) print-outs from Applicant's webpage, TSDR pp. 2-7, (2) a Wikipedia page for Nippon Electric Glass allegedly showing that the word GLASS in the applied for mark means the type of goods offered by the applicant, TSDR, pp. 8-11, and (3) a website screen capture of a third party webpage that refers to “switchable privacy glass” to allegedly show the word “electric” identifies the type of goods offered by the applicant. TSDR, pp. 12-15.

**C. APPLICANT'S EVIDENCE**

**1. May 19, 2014, Response to First Office Action**

Applicant submitted evidence that NIPPON ELECTRIC GLASS was not primarily geographically descriptive and that NIPPON ELECTRIC GLASS had acquired distinctiveness.

Exhibit 1 - Excerpt from Applicant's US visa and Applicant's US incorporation documents dating back to 1984, TSDR, pp. 14-21;  
Exhibit 2 - Applicant's Webpage and Business development history, TSDR, pp. 22-33;  
Exhibit 3 - Applicant's US sales in from 2009 to 2013 in Yen, TSDR, pp. 34-36;  
Exhibit 4 - Applicant's Advertising Expenses 2006 – 2012 in Yen, TSDR pp. 37-38;  
Exhibit 5 - Applicant's Invoices and Labels for Glass Fibers, TSDR, pp. 39-61;  
Exhibit 6 - Applicant's Product Packaging, TSDR, pp. 62-67;  
Exhibit 7 – Applicant's Catalogs, TSDR pp. 68 - 136;  
Exhibit 8 – Declaration of Acquired Distinctiveness of NIPPON ELECTRIC GLASS by Applicant, TSDR, pp. 137-142;  
Exhibit 9 – Applicant's Presence at US Exhibitions, TSDR, pp. 143-150;  
and  
Exhibit 13 – Newspaper Articles about Applicant's Market Share, TSDR pp. 191-199.

**2. November 13, 2014 Response to Second Office Action**

Applicant submitted arguments and case law that the Office Action had failed to submit sufficient evidence that the purchasing public readily understands the word ELECTRIC to identify the applied-for goods.

**3. May 15, 2015, Request for Reconsideration**

Applicant submitted cases as evidence that the Examining Attorney has failed to make a strong showing based on clear evidence that ELECTRIC is generic for the applied-for goods in the specified classes. Applicant argued that ELECTRIC GLASS is part of a unitary phrase. Exhibit C shows online

printouts from the online *Merriam-Webster* and *Oxford* dictionaries showing that “electric glass” is not recognized and is not defined. TSDR, p. 11-20.

### III. ARGUMENT

#### A. LEGAL STANDARD

The basic test to determine whether a mark is generic is:

*Determining whether a mark is generic therefore involves a two-step inquiry: First, what is the genus of the goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?*

*H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 228 U.S.P.Q. 528, 530 (Fed. Cir. 1986); *See also* TMEP §1209.01(c)(i).

The Examining Attorney has the burden of proving a mark is generic by clear evidence. “A strong showing is required when the Office seeks to establish that a term is generic, not descriptive, for specific goods or services to which the applicant has attached it.” *In re K-T Zoe Furniture, Inc.*, 29 U.S.P.Q.2d 1787, 1788 (Fed. Cir. 1994). “Clear evidence” is equivalent to “clear and convincing” evidence. *See In re Hotels.com, L.P.*, 91 U.S.P.Q.2d 1532, 1534 (Fed. Cir. 2009).

A unitary mark is a mark with multiple elements that create a single and distinct commercial impression separate and apart from the meaning of its constituent elements. *Dena Corp. v. Belvedere International Inc.*, 21 U.S.P.Q.2d 1047, 1052 (Fed. Cir. 1991).

“[A] mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services.” TMEP §1209.01(b).

“A term which is descriptive ... may, through usage by one producer with reference to his product, acquire a special significance so that to the consuming public the word has come to mean

that the product is produced by that particular manufacturer.” TMEP § 1212 *citing* 1 Nims, *Unfair Competition and Trademarks* at §37 (1947).

## **B. ANALYSIS**

### **1. THE EXAMINING ATTORNEY DOES NOT PRESENT SUFFICIENT EVIDENCE TO SUPPORT A FINDING THAT “ELECTRIC” IS GENERIC FOR APPLICANT’S GOODS IN INTERNATIONAL CLASS 001, 011, 017, 019 AND 021.**

#### **a. The Examiner Must Meet Her Burden by Presenting Clear Evidence**

The Applicant respectfully disagrees with the Examining Attorney’s requirement that “electric” be disclaimed because the Examining Attorney has failed to make a substantial showing that the term “electric” is in fact generic for those goods, i.e., the Examining Attorney has not provided “clear evidence” that the public primarily understands the term “electric” to be generic for Applicant’s goods in each of the above classes. *See In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, (stating that the burden is with the Patent and Trademark Office to make a substantial showing based on clear evidence of generic use).

The parties agree that the Board must apply a two-part test to determine whether “electric” is generic as applied to these goods: “First, what is the genus of goods and/or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public to refer to that genus of goods and/or services?” *In re 1800Mattress.com IP, LLC*, 92 U.S.P.Q.2d 1682, 1684 (Fed. Cir. 2009) (*quoting H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 228 U.S.P.Q. 528, 530 (Fed. Cir. 1986)); TMEP §1209.01(c)(i). *See* the Office Action dated July 9, 2015 and the Request for Reconsideration dated May 15, 2015.

With regard to the first prong of the test, the genus, in situations with many goods and services, is determined by considering the central focus of Applicant’s goods. *In re ActiveVideo Networks, Inc.*, 111 U.S.P.Q.2d 1581, 1601 (TTAB 2014) (determining the genus by distilling the

essence of Applicant's 4 classes without "the confusion of a verbose recitation of the entire listing of goods and services.") In this case, Applicant's goods refer to a wide variety of goods which may or may not have anything to do with the word "electric". The fact that some of the goods mention the term electric is a red herring. The central focus of Applicant's goods is not "electric". For example, Applicant's goods: "Chemicals in powder or paste form, used for forming dielectric layers on electric parts and electronic parts" in International Class 001; "glass covers for electric heaters" in class 011; "electrical insulating materials containing glass" in Class 017; "Building glass used for internal walls of electric furnaces for burning electronic component" in Class 019; and "Glass used for electric wires and cables" in Class 021, contain the word "electric" in their description but the word "electric" is not the genus for those goods.

As for the second prong, the Examining Attorney must show by clear evidence that the public primarily understands the term "electric" to be the generic term for the genus of the above goods. *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 4 U.S.P.Q.2d at 1143. The Office has the burden of proving genericness by clear evidence of the public's understanding thereof. *Id.* Evidence of the public's understanding of a term may be obtained from "any competent source, such as consumer surveys, dictionaries, newspapers and other publications." *In re Northland Alum. Prods, Inc.*, 227 U.S.P.Q. 961, 963 (Fed. Cir. 1985).

The Examining Attorney has failed to provide clear evidence that the general public understands the word "electric" to be the generic term for the essence of the goods in International Class 001, 011, 017, 019 and 021. Instead the Examining Attorney appears to be making a descriptiveness rejection under the guise of a generic rejection. For example, the word "electric" arguably may describe the ingredient, feature, function, or characteristic of some of the goods listed in International Class 01, 011, 017, 019 and 021, but it does not refer to the genus of those goods. The Federal Circuit has pointed out that a mark that is "not literally a genus or class name"

but that describes the class is not generic but descriptive. *In re Dial-A-Mattress Operating Corp.*, 57 U.S.P.Q.2d 1807, 1811 (Fed. Cir. 2001) (citing *H. Marvin Ginn Corp.*, 228 U.S.P.Q. at 530). See also *In re Northland Alum. Prods., Inc.*, 227 U.S.P.Q. at 963 (differentiating a “mark that is merely descriptive, but not the common name of the goods”). “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 Bayer Aktiengesellschaft*, 82 U.S.P.Q.2d 1828, 1831 (Fed. Cir. 2007).

**b. Two Dictionary Definitions Are Not Enough to Show Clear Evidence of Genericness of ELECTRIC in This Case**

The only evidence submitted by the Examining Attorney to prove genericness of the term “electric” for Applicant’s goods has been one dictionary definition of the term “electric” from the *MacMillan Dictionary* (see the Second Office Action dated July 9, 2014, TSDR, p. 2) and another of the term “electrical” from *The American Heritage* dictionary (see the First Final Office Action dated December 11, 2014, TSDR, p. 2 ).<sup>2</sup> The *MacMillan Dictionary* defines “electric” as an adjective meaning “working by electricity”, “used for carrying electricity”, or “relating to electricity”.<sup>3</sup> Applicant submits that the dictionary definitions in this case do not comprise “clear evidence” of how the relevant public primarily views and uses the term “electric.” The Board has found dictionary definitions inconclusive as evidence of genericness because it would endow editors “with the power to destroy trademarks, merely by defining them generically.” *In re Minnetonka, Inc.*, 212 U.S.P.Q. 772, 778 (TTAB 1981). When considering whether the term “new look” was descriptive of cigarettes, the Board stated that dictionary definitions may be problematic because “dictionary

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<sup>2</sup> In the 2<sup>nd</sup> Final Office Action, the Examining Attorney offered print-outs of Applicant’s own website and a Wikipedia article entitled Nippon Electric Glass to show that the relevant public would understand the word “glass” to be generic for Applicant’s goods. The Examining Attorney also submitted a third party website screen capture that she claimed referred to electric privacy glass. However, we do not see that term mentioned anywhere on the documents submitted. Instead we see “switchable privacy glass” which does not mention “electric.”

<sup>3</sup> We will not address the dictionary definition of “electrical” as that is not the word at issue.

definitions may not always reflect a term's meaning to those persons who purchase the particular product concerned." *R.J. Reynolds Tobacco Co. v. Brown & Williamson Tobacco Corp.*, 226 U.S.P.Q. 169, 171 (TTAB 1985). The Federal Circuit has warned the Board against relying exclusively on dictionary definitions to determine genericness: "The Board cannot simply cite definitions and generic uses of the constituent terms of a mark, or in this case, a phrase within the mark, in lieu of conducting an inquiry into the meaning of the disputed phrase as a whole to hold a mark, or a phrase within the mark, generic." *In re American Fertility Society*, 51 U.S.P.Q.2d 1832, 1836 (Fed. Cir. 1999). The word "electric" is an adjective. As such it is used to describe characteristics and functions of nouns but has not been proven by clear evidence to be understood by the public as referring to the genus of Applicant's goods.

**c. The Public Does Not Understand "Electric" to be a Generic Term for Goods in International Class 001, 011, 017, 019 and 021**

In the Second Final Office Action, the Examining Attorney lists the following goods from the subject Application which feature "electric" as a characteristic or feature of Applicant's goods and cites this as the reason "electric" must be disclaimed as generic:

- "chemicals used for forming dielectric layers on electric and electronic components, forming ribs for pixels located inside of a display panel, forming coated layers, binding metallic powder, binding powdery coating" in IC 001;
- "Electric lamps" in IC 011;
- "Building glass used for internal walls of electric furnaces for burning electronic component" In IC 019 and
- "glass used for electrical wires and cables" in Class 021.

However, the Examining Attorney has conducted absolutely no inquiry into the public's understanding of the term "electric" as generic for these goods. Instead the Examining Attorney has made conclusive statements, such as: "[i]n this case, the relevant public comprises ordinary consumers who purchase applicant's goods, because there are no restrictions or limitations to the

channels of trade or classes of consumers.” *See* Second Final Office Action, dated Aug. 20, 2015. As explained above, the only evidence offered by the Examining Attorney to support how the public understands the term “electric” has been two dictionary definitions. The Board has cautioned the Trademark Office against establishing public perception of a mark with dictionary definitions. “Even knowing full well what applicant’s goods are, the dictionary meanings are not enough to establish that the public views this term as the common name for the goods.” *In re Homes & Land Publishing Corp.*, 24 U.S.P.Q.2d 1717, 1718 (TTAB 1992) (finding dictionary meanings not enough to establish the public viewed the mark RENTAL GUIDE as generic for real estate listing magazines for rental properties). In the classes for which the disclaimer for “electric” is requested, the Examining Attorney has not offered any compelling evidence to show that the public considers the term “electric” to be the generic term for Applicant’s goods.

Applicant submits the Trademark Office cannot conclude from the evidence presented by the Examining Attorney that the word ELECTRIC would be perceived by the relevant public primarily as a generic term for applicant's goods. In a close case, any doubt whatsoever on the matter must be resolved in applicant's favor. *In re Waverly, Inc.* 27 U.S.P.Q.2d 1620, 1624 (TTAB 1993).

## **2. ELECTRIC GLASS IS REGISTRABLE A UNITARY PHRASE**

### **a. Disclaimer of Unitary Mark’s Subparts is Improper**

By the Examining Attorney’s own admission, “ELECTRIC GLASS” is part of a registrable phrase for all of the goods in the subject application for the mark NIPPON ELECTRIC GLASS.<sup>4</sup> Thus, the phrase “electric glass” means something other than its component parts “electric” and “glass”, as the Examining Attorney has required the disclaimer of each component part as being

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<sup>4</sup> See the Second Final Office Action dated 8-20-2015 where the Examining Attorney states “The applicant is not being required to disclaim the phrase ‘electric glass.’ Rather, the requirement is for a disclaimer of ELECTRIC in specified classes and GLASS in all classes.”

generic.<sup>5</sup> It is clear from the record that ELECTRIC GLASS is a unitary phrase as the Examining Attorney has essentially admitted that ELECTRIC GLASS creates a distinct commercial impression separate and apart from the terms “electric” and “glass.” It is for this reason why the phrase ELECTRIC GLASS is not rejected as a descriptive or generic phrase for the Applicant's goods.

A unitary mark is where multiple elements in a mark create a single and distinct commercial impression apart from the meaning of its constituent parts. *Dena Corp. v. Belvedere International Inc.*, 21 U.S.P.Q.2d 1047, 1052 (Fed. Cir. 1991). The elements in a unitary mark are considered so integrated or merged that they cannot be regarded as separate elements, and it is obvious that no claim is made other than to the entire mark. *In re Kraft, Inc.*, 218 U.S.P.Q. 571, 573 (TTAB 1983). The words in a unitary mark function as a unit “with each relating to the other rather than directly to the goods.” *Id.* Applicant submits that individual words “ELECTRIC” and “GLASS” are combined to create a unitary phrase and are so integrated they are not regarded as separate elements by consumers.

Furthermore, if two or more terms are combined in a mark to create an incongruity or result in a bizarre unitary whole, the mark is considered unitary and no disclaimer of its non-distinctive parts is necessary. TMEP §1213.05(d). Applicant submits that the term “Electric Glass” is incongruous as the average consumer fully understands that glass is not electric. In fact, glass is a very poor conductor of electricity. It is for this reason that glass makes a good insulator. A search for the term “electric glass” generated no results in the *Merriam Webster* and *Oxford* online dictionaries. See Request for Reconsideration, August 20, 2015, Exhibit C, TSDR, pp. 12-15. Applicant submits that the term “ELECTRIC GLASS” is a unitary expression which has become distinctive of Applicant's goods.

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<sup>5</sup> Applicant has revoked its disclaimer of the word “glass” in its Request for Reconsideration dated May 15, 2015.

When a composite mark is unitary in nature, no disclaimer is required. *In re Kraft, Inc.*, 218 U.S.P.Q. at 572-573 (finding the disclaimer of “light” to be unnecessary because the mark ‘LIGHT N’ LIVELY’ is a unitary expression which has become distinctive as applied to Applicant’s goods). Just as the descriptive nature of the word “LIGHT” is lost in the mark LIGHT N’ LIVELY, Applicant submits that the descriptive nature of the word “electric” is lost in the phrase ELECTRIC GLASS as a whole. The words have become merged and have become distinctive of Applicant’s goods. Consumers will not go through the mental process of breaking the phrase ELECTRIC GLASS into its component parts just as the Board found that consumers will not go through the process of parsing apart LIGHT N’ LIVELY. *Id.* When descriptive words together form a unitary phrase, the individual words should not be disclaimed. For example, the Board held the mark NUT CRUST BAKE was a unitary phrase. As such, “[s]ince all of the wording which comprises the mark describe a function, ingredient, and/or resultant use thereof, [the Board is] of the opinion that the descriptive nature of this unitary mark should be considered in its entirety rather than by requiring disclaimers of any portion thereof.” *See In re Diamond Walnut Grower’s Inc.*, 183 U.S.P.Q. 63 (TTAB 1974) (holding that the entire combination of words “NUT CRUST BAKE” for seasoned coating mix is unitary such that disclaimer of “crust” is improper). Likewise, Applicant submits ELECTRIC should be considered part of the unitary phrase ELECTRIC GLASS and not be disclaimed on its own.

**b. Purchasers Have Come to Recognize ELECTRIC GLASS as a Unitary Phrase**

In considering whether a mark is unitary, the Board should consider how the average purchaser encounters the mark under normal marketing conditions and the reaction the purchaser has to the mark. For example, in *In re Magic Muffler Service*, 184 U.S.P.Q. 125, 126 (TTAB 1974), the Board looked to the specimen filed with the Application to determine how consumers encounter the

mark. Applicant's mark was filed under § 66(a) so there is no specimen. Instead Applicant has submitted photos of its product packaging, catalogs and website showing how the consumer encounters the mark NIPPON ELECTRIC GLASS. *See* Response to First Office Action, May 19, 2014, Exhibit 6, TSDR, p. 62-67; Exhibit 7, TSDR, p. 68 – 136 and Exhibit 2, TSDR p. p. 22-33. The following is how Applicant's mark appears on its product packaging, catalogs and website:



As shown in the evidence submitted, the words ELECTRIC GLASS function as a unit. Consumers will not break ELECTRIC GLASS into its component parts “electric” and “glass”. Instead consumers regard ELECTRIC GLASS as a unitary phrase. The word “electric” and “glass” always appear together, and not separately as “electric” or “glass”. *See In re J.R. Carlson Laboratories, Inc.*, 183 USPQ 509, 511 (TTAB 1974) (recognizing that consumers will call for applicant's product as E GEM notwithstanding the descriptive significance of the letter “E”).

**c. The Examining Attorney Has Not Properly Considered the Evidence Submitted by Applicant in Support of Acquired Distinctiveness<sup>6</sup>**

As stated above, the word “electric” is part of a unitary phrase and should not be analyzed apart from the mark as a whole. If the phrase ELECTRIC GLASS is not considered inherently distinctive, it has in the alternative, acquired distinctiveness. To establish that a mark is registrable under section 2(f), the Applicant may rely on any appropriate evidence tending to show that the mark distinguishes the Applicant's goods. 37 C.F.R. §2.41(a); TMEP §1212.03. It well-established that Applicant need present a prima facie case of acquired distinctiveness, rather than conclusive evidence, to be entitled to registration, TMEP §1212.01, and that five years' use in commerce may be accepted as prima facie evidence that the mark has acquired distinctiveness. TMEP §1212.05.

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<sup>6</sup> The Examining Attorney made the disclaimer requirement of “electric” based on “electric” being generic. No descriptiveness refusal was made.

In this case, the mark was originally rejected as being primarily geographically descriptive. However, Applicant overcame this rejection by providing substantial evidence regarding the distinctive nature of its NIPPON ELECTRIC GLASS trademark. Applicant's General Manager of the Intellectual Property Division, Mr. Hiromichi Umemura provided a sworn declaration attesting to Applicant's sales in the United States dating back to the 1980s and its exclusive and continuous use of NIPPON ELECTRIC GLASS for at least the past 5 years immediately before the date of the statement. *See* Declaration of Hiromichi Umemura in Response to First Office Action, May 19, 2014, Exhibit 8 ("Umemura Dec.") at ¶¶ 3-5 TSDR, pp. 137-142. Mr. Umemura also attests to Applicant's mark being well-known in the United States. *Id.* at ¶ 4. In addition to the sworn declaration, Applicant also submitted exhibits detailing the efforts undertaken by Applicant to create market awareness of its mark, including numerous catalogs distributed in the US, product packaging bearing the mark NIPPON ELECTRIC GLASS, websites for Nippon Electric Glass in English and for its US affiliate Nippon Electric Glass America, Inc., and exhibiting at key industry tradeshows in the US. *Id.* at Exhibits, 2, 6, 7, and 9, TSDR, pp. 22-33, 62-67, 69-136 and 143-150. In the past 5 years, various newspaper articles have reported that NIPPON ELECTRIC GLASS is within the top 3 glass manufacturers in the world. *Id.* at TSDR, p. 1 and Exhibit 13, TSDR, pp. 191-199.

Applicant set up a US representative office over 30 years ago in 1984. *Id.* at Exhibit 8 ¶ 3, TSDR, pp. 137-142. Due to the expansion of its operation in the United States, Applicant incorporated its US representative office in 1989 into a wholly owned subsidiary. *Id.* Applicant has consistently used its NIPPON ELECTRIC GLASS mark in association with goods sold in the United States since that date and at least the five years before the signed declaration. *Id.* at ¶ 5. According to a Wikipedia page dedicated to NIPPON ELECTRIC GLASS, Applicant has a 20%

market share of the worlds’ glass for liquid crystal displays. *See* Second Final Office Action, August 20, 2015, TSDR, p. 8.

NIPPON ELECTRIC GLASS is used in association with all of Applicant’s goods, as evidenced by the large number of goods in the application, and appears on all Of Applicant’s product packaging. *See* Response to First Office Action, May 19, 2015, Exhibit 8, ¶ 5, TSDR, pp. 137-142 and Exhibit 6, TSDR pp. 62-67. Applicant has had significant sales of its NIPPON ELECTRIC GLASS products to the United States. The following is a chart showing the sales amount in export from Applicant to the United States from 2009 to 2013.

**Table 1: Applicant’s Sales Amount In Export to the US from 2009 - 2013**

Year	2009	2010	2011	2012	2013
Sales amount (million Yen)	1,307	377	461	417	282
Sales amount in USD	\$10,765,232	\$3,105,057	\$3,796,937	\$3,4234,603	\$2,322,681

*See Id.* at TSDR, pp. 34-36.<sup>7</sup>

<sup>7</sup> The USD figures in Table 1 and 2 were calculated based on the exchange rate of Yen to USD on Oct. 25, 2015.

The following is a chart showing sales amounts in the US of Applicant’s affiliated companies including Nippon Electric Glass America, Inc.

**Table 2: Applicant and its Affiliated Companies’ US Sales from 2009 - 2013**

Year	2009	2010	2011	2012	2013
Sales amount (million Yen)	2,063	3,720	4,931	5,784	5,627
Sales amount in USD	\$16,992,766	\$30,641,614	\$40,616,613	\$47,642,462	\$46,349,313

*See Id.*, TSDR, pp. 34-36.

Applicant submits ELECTRRIC GLASS is a unitary phrase, and therefore the individual components “electric” and “glass” should not be parsed out and separately disclaimed. Instead, NIPPON ELECTRIC GLASS should be analyzed the way the public encounters the mark. And, by virtue of over 30 years of use in the United States, NIPPON ELECTRIC GLASS has become distinctive as an indicator of source for Applicant’s goods in Class 001, 011, 017, 019 and 021 such that the word “electric” does not need to be disclaimed apart from the mark shown above.

**3. Doubt is resolved in Applicant’s behalf.**

Applicant requests that any doubt regarding the genericness of “electric” should be resolved in Applicant’s behalf. *In re Conductive Sys., Inc.*, 220 U.S.P.Q. 84 (T.T.A.B. 1983); *In re Aid Labs., Inc.*, 221 U.S.P.Q. 1215, 1216 (T.T.A.B. 1984) (holding that doubt regarding whether a particular term is descriptive should be resolved in the applicant’s favor); *In re Bel Paese Sales Co.*, 1 U.S.P.Q.2d 1233, 1235 (T.T.A.B. 1986) (electing to resolve doubt by publishing the application and allowing third parties to challenge the mark in an opposition); *In re Merrill Lynch, Pierce, Fenner &*

*Smith, Inc.*, 828 F.2d 1567, 1571 (Fed. Cir. 1987) (stating that reasonable doubt should be resolved in favor of the applicant); *In re Gourmet Bakers*, 173 U.S.P.Q. 565 (TTAB 1972) (finding that doubt in the matter is best resolved in applicant's behalf on the theory that third parties believing they will be damaged are better suited to challenge the mark in an ex parte proceeding).

### **CONCLUSION**

The relevant factors indicate that the term ELECTRIC (1) is not generic; (2) is considered registrable as part of a unitary phrase “electric glass”; (3) has acquired distinctiveness as part of the mark NIPPON ELECTRIC GLASS; and (4) the rule of doubt dictates that any confusion should be resolved in favor of Applicant. For the foregoing reasons, Applicant respectfully requests that the Board grant this Ex Parte Appeal and allow for the registration of the NIPPON ELECTRIC GLASS without the disclaimer of the word “electric” apart from the mark as shown in International Classes Class 001, 011, 017, 019 and 021.

In the alternative, if the word “electric” is found by the Board to be generic, Applicant requests the Board to reopen prosecution and allow Applicant time to disclaim the word “electric” in International Class 001, 011, 017, 019 and 021 and the word “glass” in all classes in order to move the mark to publication. TMEP §1218.

Dated: November 16, 2015

Respectfully submitted,

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