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Subject: U.S. TRADEMARK APPLICATION NO. 79137917 - NIPPON ELECTRIC GLASS - 08279.1699US - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 79137917

MARK: NIPPON ELECTRIC GLASS



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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: Nippon Electric Glass Co., Ltd.

CORRESPONDENT'S REFERENCE/DOCKET NO:

08279.1699US

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EXAMINING ATTORNEY'S APPEAL BRIEF

INTERNATIONAL REGISTRATION NO. 1180257

INTRODUCTION

The applicant has appealed the trademark examining attorney's refusal to register the proposed trademark NIPPON ELECTRIC GLASS for a variety of goods without a disclaimer of ELECTRIC in International Classes 001, 011, 019, and 021 and a disclaimer of GLASS that is not limited to a particular class.

FACTS

On February 4, 2013, applicant filed an application under Section 66(a) to register the mark NIPPON ELECTRIC GLASS for a variety of goods in International Classes 001, 006, 007, 009, 010, 011, 017, 019, 020, 021, 022, 023, and 024. In an Office action issued November 18, 2013, the examining attorney refused registration under Section 2(e)(2) of the Trademark Act, required that applicant amend the identification of goods, and issued a significance inquiry. In a response submitted on May 19, 2014 applicant argued against the Section 2(e)(2) refusal, submitted amendments to the identification of goods, disclaimed GLASS, submitted a Section 2(f) claim, and stated that the term NIPPON had no significance.

In an Office action issued July 9, 2014, the refusal under Section 2(e)(2) was withdrawn, based on the claim of acquired distinctiveness and the disclaimer of GLASS. Applicant's amended identification was partially acceptable, and the requirement was maintained and continued as to unacceptable wording in International Classes 009, 010, 011, and 021. Further, applicant was at this time required to disclaim ELECTRIC in International Classes 001, 009, 011, 017, 019, and 021. In a response dated November 5, 2014, applicant amended the identification of goods and did not address the disclaimer requirement. Applicant then submitted a second response on November 13, 2014 containing arguments against the disclaimer requirement. On December 11, 2014, a final Office action was sent wherein the

disclaimer requirement was withdrawn as to International Class 009 but made final as to International Classes 001, 011, 017, 019, and 021. The requirement for an acceptable identification of goods was also made final as to International Classes 009, 011, and 021.

On May 15, 2015, applicant submitted a request for reconsideration containing arguments against the requirement for a disclaimer of ELECTRIC and the amendment of the identification of goods. In its request, applicant also stated "please delete the disclaimer currently of record." Applicant then submitted an additional response on July 8, 2015, containing amendments to the identification of goods. As the requirement for a disclaimer of GLASS had not previously been made final, because applicant had agreed to the requirement contained in a non-final action, on August 20, 2015 the examining attorney issued a subsequent final regarding the requirement to disclaim GLASS and the word ELECTRIC in International Classes 001, 011, 019 and 021.

ARGUMENT

THE WORD "GLASS" AND THE WORD "ELECTRIC" IN INTERNATIONAL CLASSES 001, 011, 019 AND 021 ARE GENERIC DESIGNATORS FOR APPLICANT'S GOODS AND MUST BE DISCLAIMED.

Applicant must disclaim the wording "GLASS" and the word "ELECTRIC" in International Classes 001, 011, 019 and 021 because it is a generic designation for applicant's goods and/or services and is thus an unregistrable component of the mark. See 15 U.S.C. §§1052(e)(1), 1056(a); *In re Am. Inst. of Certified Pub. Accountants*, 65 USPQ2d 1972, 1981-85 (TTAB 2003); TMEP §§1212.02(e), 1213.03(b).

Determining whether a mark is generic requires a two-step inquiry:

- (1) What is the genus of goods and/or services at issue?
- (2) Does the relevant public understand the designation primarily to refer to that genus of goods and/or services?

H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986); *In re Meridian Rack & Pinion*, 114 USPQ2d 1462, 1463 (TTAB 2015) (citing *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 1363, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009)); TMEP §1209.01(c)(i).

Regarding the first part of the inquiry, the genus of goods and/or services is often defined by an applicant's identification of goods and/or services. *In re Meridian Rack & Pinion*, 114 USPQ2d at 1463 (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 640, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991)).

In this case, the application identifies the goods as a variety of goods containing or made of glass, which adequately defines the genus at issue. As evidence, applicant's identification of goods makes repeated reference to glass goods. As examples, and not an exhaustive list, see the following goods:

- "Chemicals containing glass for use in industry" in International Class 001;

- “Loading and unloading pallets of metal for use in the manufacture of glassware” in International Class 006;
- “Crystallized glass transport devices, namely, conveyors for use in the manufacture or processing of crystallized glass” in International Class 007;
- “Infrared-ray absorbing glass, not for building” in International Class 009;
- “Glass syringes for medical purposes” in International Class 010;
- “Glass windows sold as a part of stoves” in International Class 011;
- “Glass fiber materials for insulation” in International Class 017;
- “Building glass” in International Class 019;
- “Furniture using radiation shield glass, namely, single-leaf screens, folding screens and partitions” in International Class 020;
- “Glass, unworked or semi-worked, namely, glass substrates, glass tubes, glass for exhaust tubes, and sealing glass, all for liquid crystal displays, plasma displays, field-emission displays, organic electroluminescence displays, inorganic electroluminescence displays, flat-panel displays and other panel displays” in International Class 021;
- “Glass fibers for textile use” in International Class 022;
- “Fiberglass thread and yarn, for textile use” in International Class 023;
- “Fiberglass felts and non-woven fabrics” in International Class 024.

As shown by the applicant’s identification of goods; the term GLASS is generic for the types of goods offered by the applicant. Further, the evidence attached to the previous Office actions showed that the term GLASS is generic for applicant’s type of goods. For example, the attachment from applicant’s “About Us” specified that the LCD glass business is applicant’s “core area of activity” and referenced applicant’s plans to strengthen its “core display glass business” and to expand its “non-display glass

business.” See August 20, 2015 Office action, first attachment screen capture from www.neg.co.jp. This webpage also makes repeated reference to the different types of glass products offered by the applicant. On that same website under “Products,” also attached to the August 20, 2015 Office action, the applicant refers to its “High-Tech glass” and describes the common uses, such as household appliances and building materials. Applicant’s Wikipedia page, also attached to the August 20, 2015 Office action, describes the types of goods offered by the applicant, many of which are glass. These screen captures, taken together with applicant’s identification of goods, clearly show that the term GLASS is generic for the goods offered by applicant and must be disclaimed.

Turning to the term “ELECTRIC,” the applicant’s identification of goods identifies the goods as a variety of goods that are electric or for use with electric goods, which adequately defines the genus at issue. As examples, and not an exhaustive list, please see the following goods:

- “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 or powdery coating” in International Class 001;
- “Electric lamps” in International Class 011;
- “Building glass used for internal walls of electric furnaces for burning electronic component” in International Class 019;
- “Glass used for electric wires and cables” in International Class 021.

As shown by applicant's identification of goods, "electric" is a common feature or characteristic of many of the applicant's goods. The term "electric" is defined as something that works by electricity, used for carrying electricity, or relating to electricity. See July 9, 2014 Office action attachment from www.macmillandictionary.com as evidence of the term's meaning. The relevant consumer would understand the term "electric" to refer primarily to the genus because the applicant's goods are electric or for use as a component of electric goods. Applicant's website makes reference to the electric nature of the goods and that applicant's glass is used in electronic and electric goods. Considering the above, the term ELECTRIC is generic for the genus of the goods and must be disclaimed.

Applicant has made a Section 2(f) claim in connection with the applied-for mark. Even if the mark is registrable under Section 2(f), the unregistrable components must be disclaimed. See *In re Creative Goldsmiths of Wash., Inc.*, 229 USPQ 766, 768 (TTAB 1986) ("[W]e conclude that it is within the discretion of an Examining Attorney to require the disclaimer of an unregistrable component (such as a common descriptive, or generic, name) of a composite mark sought to be registered on the Principal Register under the provisions of Section 2(f)."). In this case, GLASS must be disclaimed in all classes and ELECTRIC in the specified classes, because they are unregistrable components of an otherwise registrable mark. They immediately identify features of the goods (such as being made of glass, or being electrically-operated) and do not function as an identifier of source.

Regarding the second part of the inquiry, the relevant public is the purchasing or consuming public for the identified goods and/or services. See *Sheetz of Del., Inc. v. Doctor's Assocs. Inc.*, 108 USPQ2d 1341, 1351 (TTAB 2013) (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d at 640, 19 USPQ2d at 1553). In 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. The examining attorney has previously attached evidence from applicant's website and www.wikipedia.org that shows the wording "GLASS" in the applicant's mark means the type of goods offered by the applicant and thus the relevant public would understand this designation to refer primarily to the genus of goods because applicant's goods are glass, glass machines, or comprised of glass. Further, the term "ELECTRIC" in the applied-for mark means the type of goods offered by the applicant and thus the relevant public would understand this designation to refer primarily to the genus of goods because applicant's goods are electric. The examining attorney has also previously attached third party websites that refer to electric privacy glass. When all of the previously attached evidence is taken together, the term "GLASS" in all classes must be disclaimed and the term "ELECTRIC" must be disclaimed in the specified classes.

All generic names of a product or service are not registrable and belong in the public domain for competitors to use. *See In re Women's Publ'g Co.*, 23 USPQ2d 1876, 1877 (TTAB 1992) (citing *In re Sun Oil Co.*, 426 F.2d 401, 404, 165 USPQ 718, 719 (C.C.P.A. 1970) (Rich, J., concurring)). The disclaimer of unregistrable matter does not affect the appearance of the mark; that is, a disclaimer does not physically remove the disclaimed matter from the mark. *See Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 978, 144 USPQ 433, 433 (C.C.P.A. 1965); TMEP §1213.

The applicant argues that the examining attorney has not considered the evidence of acquired distinctiveness. The examining attorney respectfully disagrees. The applicant's evidence of acquired distinctiveness was considered, and as a result, the Section 2(e)(2) refusal was withdrawn.

The applicant argues that the examining attorney has conceded that the mark is a registrable phrase. The examining attorney disagrees with applicant's characterization of the examining attorney's statement. The applicant is not being required to disclaim the phrase ELECTRIC GLASS in every class.

Rather, the applicant is required to disclaim GLASS for all classes and ELECTRIC in specified classes, because the term ELECTRIC is not generic for all classes of goods.

CONCLUSION

For the reasons set forth above, the trademark examining attorney respectfully requests that the requirement for a disclaimer of "ELECTRIC" in International Classes 001, 011, 019 and 021 and a disclaimer of "GLASS" be affirmed.

Respectfully submitted,

/Shannon Twohig/

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