

This Opinion is Not a
Precedent of the TTAB

Mailed: August 10, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Liebherr-Werk Biberach GmbH
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Serial No. 79271097
—

B. Anna McCoy of McCoy Russell LLP,
for Liebherr-Werk Biberach GmbH.

John T. Billings, Trademark Examining Attorney, Law Office 113,
Myriah Habeeb, Managing Attorney.

—
Before Taylor, Kuczma and Hudis,
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

Liebherr-Werk Biberach GmbH (“Applicant”), pursuant to an application filed on June 3, 2019 under Trademark Act Section 66(a), 15 U.S.C. § 1141f(a),¹ seeks

¹ Application Serial No. 79271097 (the “’097 Application”) was filed as a Request for Extension of Protection (“RFEOP”) of International Registration No. 1496153 (the “’153 Int’l Registration”), pursuant to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (as amended on November 12, 2007) (the “Madrid Protocol”), implemented in the United States under Trademark Act Sections 60 -74, 15 U.S.C. §§ 1141-1141n. According to the details of the ’097 Application, the ’153 Int’l Registration was issued on June 3, 2019. This is the same date on which Applicant filed its international application resulting in the issuance of the ’153 Int’l Registration containing Applicant’s RFEOP of the FIBRE mark to the United States. See Madrid Protocol Article 3(4); Regulations under the Madrid Protocol (as in force on February 1, 2020), Rule 15.

registration on the Principal Register of the mark FIBRE (in standard characters) for
(as amended during briefing on appeal):²

Mixing machines of all kinds, in particular concrete mixing machines; conveyors being machines for the construction industry; fixed mountable and convertible concrete pumps in the nature of machines; concrete pumps being machines for mounting on chassis, vehicles and crawler tracks; concrete distribution booms, being parts of machines; truck-mounted concrete pumps; parts and fittings for the aforesaid goods, in particular chassis and crawler tracks; earth-moving machines of all kinds, in particular hydraulic excavators, rail-road excavators, wheel loaders, bulldozers, crawler loaders, cable excavators; material handling machines of all kinds, in particular, wood handling machines, namely, machines for lifting woods and logs, hydraulic shovel, telescopic loaders, stacker cranes; pipe layers, being parts and components of power-operated lifting and moving equipment; crawler conveyors;

² In its Brief, 4 TTABVUE 6-7, Applicant, without seeking leave or requesting remand, amended the identification of goods in the '097 Application, by deleting numerous goods, to read as shown above. In his Brief, 6 TTABVUE 2-3, the Examining Attorney appears to have accepted Applicant's amendment. However, the Examining Attorney's acceptance of the amendment did not resolve the substantive grounds for refusal considered on this appeal.

As a best practice, an applicant ... proposing an amendment to an application should propose the amendment as early as possible during prosecution. If that does not occur, then the Board strongly prefers that an applicant make such an amendment in a request for reconsideration filed soon after the issuance of a final Office action but prior to the applicant's deadline for filing a notice of appeal. ... If an applicant has missed that opportunity, then the next preferred alternative is to file a separately captioned request for remand and suspension of proceedings with the Board, ideally prior to the deadline for filing an appeal brief, so that the Board can make a prompt ruling on the request and the examining attorney does not have to draft a potentially unnecessary appeal brief. ... Embedded amendments in an appeal brief are not prohibited but they are discouraged because they may be inadvertently overlooked by the Board before the Examining Attorney files his or her brief; if noticed, they may needlessly delay the proceeding.

In re Ox Paperboard, LLC, 2020 USPQ2d 10878, at *1-2 (TTAB 2020).

Page references herein to the application record refer to the online database of the USPTO's Trademark Status & Document Retrieval ("TSDR") system. All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents in the USPTO TSDR Case Viewer. References to the briefs on appeal refer to the Board's TTABVUE docket system. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable.

crushers being machines; cranes of all kinds, in particular, rotating tower cranes, truck-mounted cranes, ship cranes, container cranes, mobile harbour cranes, crawler cranes, stacker cranes; hydraulic and electromechanical winches; belts for conveyors; parts and fittings for the aforesaid goods, in particular chassis, diesel engines for machines, exhaust gas treatment installations, diesel-hydraulic hybrid drive units; power tools and attachments, namely buckets in the nature of loader buckets for excavators, grippers in the nature of material handling machines for use in scrap, wood, and port handling, mechanical shovels; hydraulic quick-coupling systems for tool attachment, except for land vehicles; cabs being parts of cranes; telescopic wheel loaders; support systems for mobile cranes and truck-mounted concrete pumps in International Class 7.

The Trademark Examining Attorney refused registration of Applicant's mark under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), on the ground that the mark is merely descriptive of a feature of the goods.

When the refusal was made final, Applicant requested reconsideration. After the Examining Attorney denied the request for reconsideration, Applicant appealed to this Board. The appeal is fully briefed. We affirm the refusal to register.

I. Applicable Law on Mere Descriptiveness

A mark may not be registered on the Principal Register if, “when used on or in connection with the goods of the applicant[,]” the mark is “merely descriptive ... of them....” Trademark Act Section 2(e)(1). A mark is merely descriptive if it “consists merely of words descriptive of the qualities, ingredients or characteristics of the goods ... related to the mark.” *DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed.Cir.2004) (quoting *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543 (1920))).

The determination of whether a proposed mark is merely descriptive is made in relation to an applicant's goods, not in the abstract. *DuoProSS*, 103 USPQ2d at 1757. "The question is not whether someone presented with only the mark could guess what the goods ... are. Rather, the question is whether someone who knows what the goods ... are will understand the mark to convey information about them." *Id.* (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)). Determining the descriptiveness of a mark is done in relation to an applicant's goods, 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, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)).

"The line between a mark that is merely descriptive and may not be registered absent secondary meaning,³ and one that is suggestive and may be registered, is that a suggestive mark 'requires imagination, thought and perception to reach a conclusion as to the nature of the goods,' while a merely descriptive mark 'forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.'" *DuoProSS*, 103 USPQ2d at 1755 (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) (quoting *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 765 (2d Cir. 1976))).

³ Applicant did not request, in the alternative, to register its proposed mark on the Supplemental Register or on the Principal Register with a claim of acquired distinctiveness, i.e., "secondary meaning," under Trademark Act Section 2(f), 15 U.S.C. § 1052(f).

“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*, 71 USPQ2d at 1371 (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)). It is enough if a mark describes a single feature or attribute. *In re Chamber of Commerce*, 102 USPQ2d at 1219. Moreover, a mark does not need to be merely descriptive of all of the goods, or of each feature of the relevant goods, specified in an application. *In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Franklin Cnty. Historical Soc’y*, 104 USPQ2d 1085, 1089 (TTAB 2012). “A descriptiveness refusal is proper ‘if the mark is descriptive of any of the ... [goods] for which registration is sought.’” *In re Chamber of Commerce*, 102 USPQ2d at 1219 (quoting *In re Stereotaxis Inc.*, 429 F.3d 1039, 1040, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005)).

The fact that an applicant may be the first or only user of a merely descriptive designation does not necessarily render the word or term distinctive. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1514 (TTAB 2016); *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012). Further, the fact “[t]hat a term may have other [non-descriptive] meanings in different contexts is not controlling.” *Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, at *5 (TTAB 2019) (citing *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590, 1598 (TTAB 2018)).

Any competent source suffices to show the relevant purchasing public’s understanding of a contested term, including dictionary definitions, trade journals, newspapers and other publications, and consumer surveys. *In re Chamber of*

Commerce, 102 USPQ2d at 1219 (citing *In re Bayer*, 82 USPQ2d at 1831); *In re Stereotaxis, Inc.*, 77 USPQ2d at 1089 (citing *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986)), as well as “advertising material directed to the goods.” *In re Abcor*, 200 USPQ at 218. The public’s understanding of the term also may be obtained from websites and publications, and an applicant’s own specimens of use and any explanatory text included therein. *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1710 (Fed. Cir. 2017); *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

II. Examination of the Record on the Question of Mere Descriptiveness

In view of the above principles, we now review the record to determine the relevant purchasing public’s understanding of FIBRE with respect to the goods of interest. In this connection, Applicant and the Examining Attorney throughout most of the prosecution, and in their briefs on appeal, focused on the following goods identified in the Application: “cranes of all kinds, in particular, rotating tower cranes, truck-mounted cranes, ship cranes, container cranes, mobile harbour cranes, crawler cranes, stacker cranes” and “support systems for mobile cranes”. As noted above, if we find that FIBRE is merely descriptive for these goods, then the Trademark Act Section 2(e)(1) refusal is proper for the entire identification of goods in Class 7. *In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Stereotaxis* 77 USPQ2d at 1089.

A. The Relevant Purchasing Public

Whether a mark is merely descriptive or not is determined from the viewpoint of the relevant purchasing public. *In re Stereotaxis*, 77 USPQ2d at 1090; *In re Bed & Breakfast*, 229 USPQ at 819. In its Response to the first Office Action, Applicant

stated, inter alia, that it “manufactures machines including ... cranes for [the] construction industry.”⁴ We therefore consider the relevant purchasing public, for the identified goods on which Applicant and the Examining Attorney have concentrated, to be buyers of construction cranes – which include their support systems.

B. Definitions

The Examining Attorney made of record the following relevant definitions of FIBRE from COLLINS online dictionary:⁵

- a thin thread of a natural or artificial substance, especially one that is used to make cloth or rope.
- a type of cloth or other material that is made from or consists of threads.

Applicant made of record the following relevant definitions of FIBER from MERRIAM-WEBSTER online dictionary:⁶

- a thread or a structure or object resembling a thread.
- a slender and greatly elongated natural or synthetic filament (as of wool, cotton, asbestos, gold, glass, or rayon) typically capable of being spun into yarn.
- material made of fibers, especially : vulcanized fiber.
- an element that gives texture or substance.
- basic toughness : strength, fortitude.

Applicant recognizes that FIBRE and FIBER are alternative spellings for the same word.⁷

⁴ Response to Office Action of June 19, 2020, at TSDR 9.

⁵ Office Action of November 19, 2019, at TSDR 6.

⁶ Request for Reconsideration of November 30, 2020, at TSDR 33.

⁷ Response to Office Action of June 19, 2020, at TSDR 9.

C. Applicant's Online Advertising

The Examining Attorney and Applicant made of record pages from Applicant's website that contain the following passages (emphasis added):

- Liebherr presents a new Flat-Top series at Bauma, the construction machinery trade fair in Munich. Three of the eight units are equipped with **fibre rope** and therefore have '**fibre**' added to their product title. **Fibre rope** has a four times longer service life than steel rope and enables **fibre cranes** to work with a significantly higher load capacity. In addition, handling is noticeably easier compared to steel rope. ... Particular highlights of the new EC-B series are the 240 EC- 8 **Fibre** and 370 EC-B **Fibre cranes**. These are equipped with soLITE high-tensile **fibre rope** As well as the **fibre cranes** offering up to 20 percent more jib head load capacity when compared to cranes using steel rope, **fibre rope** also has a four times longer service life than steel rope. As the **fibre rope** only weighs around a fifth of steel rope, reeving the hoist rope is also significantly easier in terms of handling. In addition, maintenance is less complicated as the **fibre rope** doesn't need lubrication.⁸
- Liebherr and Teufelberger develop a high-strength **fibre rope** for crane operation: ... Together with ... Teufelberger Holding AG, Liebherr is developing a new type of high-strength **fibre rope** for hoisting operations. This project is based on a systematic cooperative venture ... [that includes] three Liebherr manufacturing plants for tower cranes, mobile and crawler cranes and maritime cranes. ... The high-strength **fibre rope** [was] developed after many years of collaborative work The use of high-strength **fibre ropes** offers huge potential. In comparison to steel ropes, the newly developed rope is significantly lighter and is more durable. ... The weight of the high-strength **fibre rope** is up to 80% less in comparison to a steel rope. ... Another advantage is the simplified assembly and disassembly of the crane thanks to the reduced weight of the rope. **Fibre ropes** can often be mounted on the crane by hand and without any reeving winches. ... The high-strength **fibre rope** ... is extremely wear-resistant and permits a high number of bending cycles. ... The **fibre rope** ... can cut in the lower layers repeatedly without causing damage. The winding pattern of the new **fibre rope** is comparable to the winding of a steel rope. If the lower layers are preloaded less than the upper layers, the new **fibre rope** behaves however more tolerant than the steel rope. ... Liebherr is currently testing the new high-strength **fibre rope**. ... The high-strength **fibre rope** will be launched on the market in two stages. Initially the steel ropes of tower cranes, mobile and crawler cranes, as well as maritime cranes, will be replaced with high-strength **fibre ropes**. In the second stage, with mobile cranes, for example, the weight saved at the hoist rope is used to

⁸ Office Action of July 12, 2020, at TSDR 8-9.

reinforce the supporting structure. This permits a further increase in the load capacity.⁹

- **Fibre tower cranes** from Liebherr deliver significantly easier handling of the hoist rope combined with higher lifting capacity. ... Liebherr has developed the **fibre crane** series featuring the soLITE® hoist rope ... The hoist rope on **fibre cranes** has similar lifting capacity values to a steel rope with the same diameter ... The soLITE® **fibre rope** also outscores steel ropes in terms of durability. ... The new **fibre rope** is much easier to handle for service technicians... Made of raw materials which have already proven themselves in many different fields, the result is a high-tensile **fibre rope** which satisfies the high demands of modern sites. ... The **fibre rope** has proven its worth over many hours of operation using thousands of metres of test rope. Construction machinery and accessories are part of building sites as they have to prove their value on them over long periods of time. That is why the **fibre cranes** have been tested extensively in field tests over a number of years.... The modern control system used on **fibre cranes** achieves faster hoist times with a load by adjusting the speed to the reduced weight. ... During the development of the **fibre rope**, special attention was given to ensuring that it was possible to identify when the rope needs replacement as easily as possible. ... A crane with a **fibre rope** will deliver reliable performance and outstanding handling for many years.¹⁰
- Particular highlights of the new EC-B series are the **Fibre cranes**. As well as the **fibre cranes** offering up to 20 percent more jib head load capacity when compared to cranes using steel rope, **fibre rope** also has a four times longer service life than steel rope.¹¹
- Liebherr Tower Cranes concludes test phase for its first high-tensile **fibre ropes**: Working with ... rope manufacturer, Teufelberger, Liebherr has developed a new type of high-tensile **fibre rope** for hoisting applications which will increase the lifting capacity.

The high-tensile **fibre rope** underwent a wide range of tests conducted by Liebherr.



[F]ibre rope not only weighs around one-fifth of a conventional steel rope, but also lasts four times as long and is significantly easier to handle. Field tests with tower cranes: High-tensile **fibre ropes** in various diameters have been undergoing field tests on eleven tower cranes ... since 2016. ... **[F]ibre ropes** can often be fitted on the crane by hand and without any auxiliary reeving

⁹ *Id.*, at TSDR 12-15.

¹⁰ *Id.*, at TSDR 38-41.

¹¹ Request for Reconsideration of November 30, 2020, at TSDR 51.

winches. The cleanliness and lack of maintenance required during operation received special praise as the **rope** does not require lubrication due to its plastic **fibres**. Tests confirm fourfold service life: The high-tensile **fibre rope** is extremely wear-resistant and can withstand a high number of bending cycles. It has fourfold the service life of a steel rope. ... Furthermore, the **fibre rope** can withstand multiple notches without suffering immediate damage. The winding pattern of the new **fibre rope** is similar to that of a steel rope. If the lower layers have less tension than the upper ones, however, the new **fibre rope** is more tolerant. ... To achieve the controlled wear of the **fibre rope**, Liebherr selected the time-tested Lebus winding system from the very outset of the development. A clean winding pattern on the cable drum minimises wear and thus extends service life. ... Liebherr will be launching its **fibre cranes** for sale from April 2019.¹²

- [Crane m]odels with **fibre rope** feature: more load capacity, longer service life and easier handling. ... Liebherr presents a new Flat-Top series at Bauma, the construction machinery trade fair in Munich. Three of the eight units are equipped with **fibre rope** and therefore have ‘**fibre**’ added to their product title. **Fiber rope** has a four times longer service life than steel rope and enables **fibre cranes** to work with a significantly higher load capacity. In addition, handling is noticeably easier compared to steel rope. ... The Bauma Innovation Award judges are impressed: The 370 EC-B 12 **Fibre** is among the finalists in the ‘machine’ category. ... **Fibre cranes** – models with **fibre rope** feature: Particular highlights of the new EC-B series are the 240 EC-B and 370 EC-B **Fibre** cranes. These are equipped with soLITE high-tensile **fibre rope**, which has been developed over a period of 10 years by Liebherr and the rope manufacturer Teufelberger. ... As well as the **fibre cranes** offering up to 20 percent more jib head load capacity when compared to cranes using steel rope, **fibre rope** also has a four times longer service life than steel rope. As the **fibre rope** only weighs around a fifth of steel rope, reeving the hoist rope is also significantly easier in terms of handling. In addition, maintenance is less complicated as the **fibre rope** doesn’t need lubrication.¹³

D. Media Usage

The Examining Attorney made of record online media articles in the crane and construction industry, reporting on Applicant’s crane products as well as those manufactured by competitors, which state the following (emphasis added):

¹² Denial of Reconsideration of December 22, 2020, at TSDR 4.

¹³ *Id.*, at 6.

- The first ever tower crane with **fibre rope** for Poland: A Liebherr 240EC-B10 **Fibre** has been dispatched and delivered to the Polish company Mazur Zurawie Sp. zo. o. When asked why he had opted for the **fibre rope** version of the crane, Mazur grins, “Because I wanted to be one of the firsts to own a **Fibre Crane**,” but then he also adds, “and because its performance fits in well with our fleet.” ... Mazur had already planned various jobs for his new **Fibre Crane** before taking it over.¹⁴
- Liebherr concludes test phase for its first high-tensile **fibre ropes**: Working with ... rope manufacturer, Teufelberger, Liebherr has developed a new type of high-tensile **fibre rope** for hoisting applications which will increase the lifting capacity. ... During the development project, more than 100 different **fibre rope** prototypes ... were developed. ... [T]he **fibre rope** not only weighs around one-fifth of a conventional steel rope, but also lasts four times as long and is significantly easier to handle. Operational safety is also guaranteed – the different wear states are clearly identifiable. High-tensile **fibre ropes** in various diameters have been undergoing field tests on eleven tower cranes ... since 2016. The benefits of the significantly lighter rope are particularly noticeable during the assembly and dismantling of the crane–auxiliary reeving winches. ... The cleanliness and lack of maintenance required during operation received special praise as the **rope** does not require lubrication due to its plastic **fibres**. ... The high-tensile **fibre rope** is extremely wear-resistant and can withstand a high number of bending cycles. It has fourfold the service life of a steel rope. This longer service life can reduce the number of rope changes. ... [T]he **fibre rope** can withstand multiple notches without suffering immediate damage. The winding pattern of the new **fibre rope** is similar to that of a steel rope. If the lower layers have less tension than the upper ones, however, the new fibre rope is more tolerant. ... To achieve the controlled wear of the **fibre rope**, Liebherr selected the time tested Lebus winding system from the very outset of the development. ... Next year at the Bauma in Munich, a new tower crane series will be launched featuring **fibre rope**. In other words, Liebherr will be launching its **fibre cranes** for sale from April 2019.¹⁵
- Liebherr and Teufelberger develop high-strength **fibre rope** for crane operation: Together with ... rope manufacturer Teufelberger ..., Liebherr is developing a new type of high-strength **fibre rope** for hoisting operations. ... The high-strength fibre rope ... is based on the vast experience of Liebherr in rope applications and winch technology for multilayer spooling and the in-depth know-how of Teufelberger in the development and manufacture of **fibre** and steel **ropes**. ... The use of high-strength **fibre ropes** offers huge potential. In comparison to steel ropes, the newly developed rope is significantly lighter and is more durable. ... In addition, the ropes no longer need to be lubricated.

¹⁴ TUNNELS & INFRASTRUCTURES, Office Action of July 12, 2020, at TSDR 17.

¹⁵ CRANE & HOIST, *Id.*, at TSDR 19-23.

... The **fibre rope** ... can cut in the lower layers repeatedly without causing damage. The winding pattern of the new **fibre rope** is comparable to the winding of a steel rope. If the lower layers are preloaded less than the upper layers, the new **fibre rope** behaves however more tolerant than the steel rope. ... In order to achieve controlled wear of the **fibre rope**, Liebherr relied on the proven Lebus spooling system. ... Liebherr is currently testing the new high-strength **fibre rope**.¹⁶

- MacGregor Completes first **fibre-rope** offshore crane: Cargotec subsidiary MacGregor says it has completed the construction of the first **fibre-rope** offshore crane to enter the market. According to the company, the new crane enables users to exploit its full lifting capacity in subsea operations because “**fibre-rope** weighs virtually nothing in the water.” ... The new offshore crane has a 150-tonne safe working load which it can fully use thanks to a special deepwater rope ..., the ... braided ... **fibre rope** which is based on a special ... **fibre grade** that helps reduce the tension required when bedding in the rope, as well as[] reducing internal heating and abrasion. ... In contrast to steel wire ropes, this special **fibre rope** does not add any additional load to the crane, regardless of the length of rope used during load handling operations.... The winch also has an open design for better rope cooling to further eliminate heating and degradation problems associated with on-load **fibre ropes** stored on winch drums. “We were able to present the finished crane to demonstrate how the shift from steel-rope to **fibre-rope** in offshore cranes is technologically possible and how the crane delivers substantial cost benefits to owners, particularly for deep-water projects. We strongly believe in the advantages that it will deliver to our customers.” ... The use of **fibre rope** wires versus steel rope wires will be one of the key topics of the Project Cargo Summit, a two-day international conference about the transport of large and heavy cargoes¹⁷
- **Fibre-rope** crane lifts heavier loads for less: A new **fibre-rope** crane dramatically expands depths to which loads can be lifted. **Fibre rope** weighs very little in water, meaning that regardless of the length of rope paid out, no additional load is experienced by the crane. Wire rope, on the other hand, is heavier and so as more rope is paid out, the permissible load in relation to depth is reduced. A **fibre-rope** crane with a safe working load capacity ... can replace a wire-rope crane with a safe working load capacity ... and can continue to lift loads at even greater depths. Further, as **fibre-rope** technology allows a crane to maximise full lifting capacity at any depths, a smaller crane and vessel can be used, enabling owners to bid on a wider range of contracts. And **fibre rope** lasts longer than wire, further enhancing savings. ... The [MacGregor] design team focused on the principal benefit of a **fibre-rope**

¹⁶ HEAVY EQUIPMENT GUIDE, *Id.*, at TSDR 24-28.

¹⁷ PROJECT CARGO JOURNAL, *Id.*, at TSDR 32-34.

crane being a smaller, lighter tool Installed on a smaller, lighter vessel. ... **Fibre-rope** allows vessels to do work that traditionally requires heavier vessels and machinery.¹⁸

- New **Fibre crane** headed to New Zealand: During last year’s Bauma [trade show], Liebherr launched a new flat-Top series [of cranes]. Three of the eight units are equipped with **fibre rope** and therefore have “**fibre**” added to their product title.” The first unit from the series is headed to Auckland, New Zealand. ... New Zealand construction business Hawkins is the first Liebherr customer in the southern hemisphere to order a **fibre crane**, a 370EC-B 12 Fibre. [“]The **Fibre cranes** allow us to get up to 20 percent more lifting capacity from the same structure ...” “There are other advantages of the **fibre rope** including the fact that it doesn’t need to be greased”¹⁹
- Progress on **fibre ropes** at WCTS: A development engineer at the heart of the development of synthetic **fibre ropes** for crane applications will give an update on current progress at the World Crane and Transport Summit (WCTS) in Amsterdam. [T]here was much discussion of the advantages of synthetic **fibre ropes** [The speaker will] be discussing the status of a number of efforts intended to address challenges involved in the use of **fibre ropes** on cranes and lifting in general. [The title of the] ... presentation ... [is] Closing the Knowledge Gaps for Synthetic **Fibre Crane Ropes**²⁰
- Teufelberger and ... Liebherr announce they have developed a new type of high-tensile **fibre rope** designed to increase lifting capacities. The new rope will debut on a new Liebherr tower crane series that will be launched at the Bauma show in March. ... During the development of the new **fibre rope** Liebherr says it tested more than 100 different prototypes These lab tests were followed by a series of field tests in which high-tensile **fibre ropes** ... used on 11 tower cranes Liebherr says the test results demonstrate that the new **fibre rope** weighs around one-fifth of a conventional steel rope, lasts four times as long, and is much easier to handle. ... Liebherr adds that the **rope’s fibres** do not require lubrication, so cleanliness is improved and the need for maintenance reduced. Liebherr reports that the high-tensile **fibre rope** is extremely wear-resistant and can withstand a high number of bending cycles. ... The winding pattern of the new **fibre rope** is similar to that of a steel rope To achieve the controlled wear of the **fibre rope**, Liebherr used a Lebus winding system throughout development.²¹

¹⁸ RIVIERA, *Id.*, at TSDR 35-37.

¹⁹ CRANES & LIFTING, Denial of Reconsideration of December 22, 2020, at TSDR 8.

²⁰ INTERNATIONAL CRANES AND SPECIALIZED TRANSPORT, *Id.*, at TSDR 10.

²¹ INTERNATIONAL CRANES AND SPECIALIZED TRANSPORT, *Id.*, at TSDR 11.

- Liebherr developing innovative fibre crane rope: Liebherr is working together with Teufelberger to develop high-strength **fibre rope** for use with cranes. This innovative rope will be suitable for use in tower cranes, mobile cranes and crawler cranes and Liebherr is carrying out field tests at present on a number of different cranes. ... The high-strength **fibre rope** is being developed after many years of collaborative work This is based on experience in rope applications and winch technology for multi-layer spooling and the development and manufacture of **fibre** and steel **ropes**. The partners say that high-strength **fibre ropes** offer potential in comparison to steel ropes, being lighter and more durable. Load capacities can be increased thanks to the 80% reduction in the weight of the rope The high-strength **fibre rope** is said to be wear-resistant and lasts longer than steel rope.²²
- One of the most groundbreaking changes to the industry at this year's Bauma will come from Liebherr's Biberach tower crane division, as the Company launches a new range of flat-tops [cranes] designed to use **fibre rope**. The new EC-B series includes eight cranes, three of which are designed for use with **fibre rope**. ... Particular highlights of the new EC-B series are the 240EC-B **Fibre** and 370EC-B **Fibre** cranes. These are equipped with soLITE high-tensile **fibre rope**, which has been developed by Teufelberger in cooperation with Liebherr.²³
- **Fibre rope** returns to the mainstream. The potential benefits of **fibre rope**, versus the steel wire rope routinely used in the industry, have for a long time been a focus for crane manufacturers and rope experts. ... [N]ew ropes that can largely be used in the same way as steel wire rope ... represent[] an important change in rope technology. ... [W]ith the launch of the ... guidelines ..., Safe Use of High Performance **Fibre Ropes** in Mobile Crane Applications, we've seen the conclusion of a process that marks the return of **fibre rope** to mainstream use in the lifting industry. ... [**F**]ibre rope is not so much a new technology as a very old one. Its introduction provides examples of the use of **fibre rope** in heavy lifting dating as far back as the pyramids. ... **Fibre rope** then is as much a 'proven' technology as any technology could be. For as long people have built and lifted or puled things, they've used **fibre rope** successfully. In recent years, in climbing and in offshore applications, **fibre rope** has found applications. ... It had not until recently been possible to spool **fibre rope** in the same way as steel wire rope. ... [S]tarting with Samson's launch of **fibre rope** on Manitowoc cranes (now offered for all cranes), and then with Teufelberger's development with Liebherr of its own approach to **fibre rope** construction, this technological issue looks to have been solved. ... [The guidance document] ... explains some of the key differences between **fibre rope** performance in a rope system, compared to steel wire rope. This includes

²² WORLD HIGHWAYS, *Id.*, at TSDR 12.

²³ CRANES TODAY, *Id.*, at TSDR 13.

guidance on the substitution of **fibre** for steel wire on existing cranes The guidelines ... note[] that, with different approaches to **fibre rope** already launched ... no single set of criteria is possible. ... As the crane industry continues to find new ways to increase capacity and optimize mobile cranes, **fibre rope** will clearly be a technology of interest.²⁴

- **Fiber-rope** crane can cut cost of deepwater lifts. MacGregor has finished constructing what it claims is the first ever **fiber-rope** offshore crane.²⁵
- **Fibre** the way forward. **Fibre rope** for cranes has been in development for 10 years or so but it is only recently that manufacturers have started to take it seriously with two **fibre rope** manufacturers – Samson and Teufelberger – working directly with Manitowoc and Liebherr to perfect their products for use in mobile and tower cranes. ... In North America Samson unveiled its K-100 synthetic rope three years ago which uses Dyneema synthetic **fibres** and can be for use with mobile cranes, while in the offshore sector MacGregor offers a 150 tonne fully heave compensated knuckle boom **fibre rope** crane developed in partnership with Parkburn Precision Handling Systems ... Liebherr has made the new **fibre rope** a core integral component in four of its new EC-B flat top tower crane range. ... It is hard to argue against the use of **fibre ropes** in cranes given the huge benefits they offer. The main advantage is of course weight It is said to have a service life roughly four times longer than for steel rope. ... The rope is also much easier to handle and can be fitted by hand without auxiliary reeving winches. ... Liebherr also says its **fibre rope** also allows the installation of a longer jib, rather than all the additional capacity.²⁶

E. Competitor Usage

The Examining Attorney also made of record competitors' use of the term FIBRE in the online promotion of their products (emphasis added):

- KONGSBERG: **Fibre Rope Crane (FRC)** – Our **fibre rope cranes** have a range of up to 400t, and are designed for continuous operation in a tough and corrosive offshore environment with focus on efficient and safe load handling. ... We offer a range of offshore cranes for up to 400 tonnes load using field proven **fibre rope** handling technology.²⁷
- ROLLS-ROYCE: Subsea **Fibre Rope Crane (FRC)** – The range of **fibre rope cranes** up to 400t combines our field-proven expertise in equipment employing

²⁴ CRANES TODAY, *Id.*, at TSDR 14.

²⁵ OFFSHORE, *Id.*, at TSDR 15

²⁶ VERTIKAL, *Id.*, at 16.

²⁷ Office Action of July 12, 2020, at TSDR 29-30.

braided **fibre ropes** in deepwater offshore operations with our offshore crane technology and control systems. **Fibre rope** cranes retain their full rated capacity down to maximum working depth, whereas a wire crane must be derated due to the weight of the steel wire. ... The ... braided **fibre rope** has approximately zero weight in water, whereas with wire the useful lift decreases with depth because of the suspended weight of the wire. Lower crane weight place less demand on ship stability, and also enables the option of using a smaller vessel for the same operation. ... **Fibre rope** handling is taken care of below decks, in a compact system using the Rolls-Royce cable traction control unit (CTCU), which as well as hauling in and paying out the main rope also provides efficient active heave compensation (AHC). Braided **fibre rope** can easily have new sections spliced in if a part of it is damaged or abraded, and the CTCU is designed to accommodate the increased local rope diameter at the splices. Splicing can be done on board in a few hours. The Rolls-Royce **fibre rope** management system is based on more than ten years of experience. This system monitors the condition of **fibre rope** in use, and manages replacements and inspections. ²⁸

III. Discussion and Analysis on the Question of Mere Descriptiveness

In the face of the above-discussed evidence that is of record, Applicant makes the following arguments:

- Competitors do not believe FIBRE immediately communicates to consumers that cranes or machinery use fibre rope.²⁹
- FIBRE on its own, without explanation or imagination, does not immediately describe any one ingredient, quality, characteristic, function, feature, purpose, or use of the applied-for goods. Instead, it requires explanation, imagination, or speculation to recognize a connection between FIBRE and the applied-for goods.³⁰
- There is at least one degree of separation, one mental leap, required for consumers to take the descriptive meaning attributed to FIBRE when they see FIBRE in connection with machinery and cranes, and there are other reasonable interpretations of FIBRE in connection with machinery and cranes which do not involve taking this mental leap.³¹

²⁸ *Id.*, at TSDR 47-48.

²⁹ Applicant's Brief, 4 TTABVUE 9-10; Applicant's Reply Brief, 7 TTABVUE 8.

³⁰ Applicant's Brief, 4 TTABVUE 10.

³¹ *Id.*, at 14.

- The only instances in which FIBRE is used to refer to cranes is in literature published by Applicant when referring to its cranes, or by third party industry media when referring to Applicant's cranes.³²
- FIBRE in connection with the applied-for goods does not immediately communicate that the cranes or machinery are equipped with fibre rope.³³

The record, when reviewed in its entirety, contradicts Applicant's arguments and supports our finding that FIBRE is merely descriptive of not just any component, but a key component of Applicant's goods described as: "cranes of all kinds, in particular, rotating tower cranes, truck-mounted cranes, ship cranes, container cranes, mobile harbour cranes, crawler cranes, stacker cranes" and "support systems for mobile cranes".

In this connection, we note Applicant made the following concessions in its briefs:

- Rope is a component of cranes.³⁴
- Fibre rope, is a specific type of rope that can be used with the goods recited in the subject application.³⁵
- The evidence of record shows competitors using FIBRE to describe rope, as in "fibre-rope," "fibre rope," "fibre-rope offshore crane," or "fibre rope cranes." Competitors say that their cranes have FIBRE ROPE.³⁶

The dictionary definitions provided by Applicant and the Examining Attorney from COLLINS and MERRIAM-WEBSTER denote that FIBRE, or its alternatively spelled term FIBER, is a thin thread used to make cloth or rope; or is cloth or other material

³² *Id.*, at 16.

³³ *Id.*, at 17.

³⁴ *Id.*, at 9.

³⁵ *Id.*, at 14.

³⁶ Applicant's Reply Brief, 7 TTABVUE 7-8.

made from threads. The MERRIAM-WEBSTER definitions also refer to an element that gives texture or substance; toughness, strength, fortitude. In the construction crane industry, the term FIBRE (or FIBER) takes on a different but related meaning.

Applicant's own online promotional materials discuss that "fibre rope," when used as part of a crane's hoist mechanism, has numerous attributes that are superior over steel or wire rope. These attributes include: longer service life, higher load capacity, easier handling, lighter weight, maintenance without the need for lubrication, and greater durability. Applicant's advertising content specially uses the term "fibre crane" to describe a crane fitted with "fibre rope." Industry articles note the same advantageous attributes of "fibre rope" over "steel rope" in a crane's hoist mechanism, and also refer to cranes fitted with "fibre rope" as "fibre cranes" or "fibre rope cranes." Applicant's competitors MacGregor, Kongsberg and Rolls-Royce also use these terms to describe their products.

As used by Applicant, the industry media and competitors, we find FIBRE merely describes certain qualities or characteristics of Applicant's crane products. *DuoProSS*, 103 USPQ2d at 1755 (A merely descriptive mark "consists merely of words descriptive of the qualities ... or characteristics of the goods ... related to the mark."). A target purchaser, such as a construction company seeking to buy a crane, who knows what Applicant's goods are will understand the proposed mark FIBRE to convey information about them. *Id.* As noted in Applicant's own online marketing copy, the fact that its crane products are equipped with fibre rope is the reason why

the term FIBRE was added to their product titles immediately following their alpha-numeric model designations.³⁷

We find that the Examining Attorney's refusal to register Applicant's proposed mark FIBRE, on the grounds of mere descriptiveness, was proper – even if the term does not describe the full scope and extent of Applicant's identified goods, *In re Oppedahl & Larson*, 71 USPQ2d at 1371, even though it describes only one significant function, attribute, or property of Applicant's goods, *In re Chamber of Commerce*, 102 USPQ2d at 1219, and even if it is not merely descriptive of all the goods identified in the Application. *In re Franklin Cnty.*, 104 USPQ2d at 1089. The refusal is proper because Applicant's proposed mark is merely descriptive of at least one or more of the goods (cranes and their support systems) for which registration is sought. *In re Stereotaxis*, 77 USPQ2d at 1089.

Decision

The refusal to register Applicant's FIBRE mark of Application Serial No. 79271097, pursuant to Trademark Act Section 2(e)(1), is affirmed.

³⁷ Applicant's website, Office Action of July 12, 2020, at TSDR 8-9.