

**This Opinion is Not a
Precedent of the TTAB**

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United States Patent and Trademark Office
Trademark Trial and Appeal Board

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In re Fawad Motiwala dba California Hub

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Serial No. 85108655

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Thomas D. Foster of TDFoster - Intellectual Property Law for Fawad Motiwala dba California Hub.

Kathryn E. Coward, Trademark Examining Attorney, Law Office 115 (John T. Lincoski, Managing Attorney).

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Before Zervas, Lykos and Gorowitz, Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Fawad Motiwala dba California Hub (“applicant”) filed an application to register the mark DENIM & DENIM in standard character format for, as amended, “men's, women's and children's clothing made from denim, namely, pants, shirts, hooded sweat shirts” in International Class 25.¹ During *ex parte* prosecution of the application, applicant filed an amendment seeking registration on the Supplemental Register.

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¹ Application Serial No. 85108655, filed August 16, 2010, alleging a bona fide intent to use the mark in commerce pursuant to Section 1(b) of the Trademark Act. On November 19, 2011, applicant filed an acceptable amendment to allege use claiming June 30, 2010 as the date of first use anywhere and in commerce.

The Trademark Examining Attorney has refused registration of the mark under Section 23(c) of the Trademark Act, 15 U.S.C. § 1091(c), on the ground that the proposed mark is generic and therefore incapable of registration on the Supplemental Register. Upon final refusal of registration, applicant filed a request for reconsideration and timely appeal. Both applicant and the examining attorney filed briefs. For the reasons discussed herein, the Board affirms the refusal to register.

A mark is a generic name if it refers to the class or category of goods and/or services on or in connection with which it is used. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), *citing H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986) (“*Marvin Ginn*”). The test for determining whether a mark is generic is its primary significance to the relevant public. Section 14(3) of the Trademark Act; *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999) (“*American Fertility Society*”); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991) (“*Magic Wand*”); and *H. Marvin Ginn, supra*. Making this determination “involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?” *Marvin Ginn*, 228 USPQ at 530. Competent sources to show the relevant purchasing public's understanding of a contested term include purchaser testimony, consumer surveys,

dictionary definitions, trade journals, newspapers and other publications. *In re Dial-A-Mattress Operating Corp.*, *supra*; *In re Bed & Breakfast Registry*, 791 F.2d 157, 160, 229 USPQ 818, 819 (Fed. Cir. 1986).

The United States Patent and Trademark Office (“USPTO”) has the burden of establishing by clear evidence that a mark is generic and, thus, unregistrable. *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). *See also In re American Fertility Society, supra*; and *Magic Wand Inc. v. RDB Inc., supra*. “Doubt on the issue of genericness is resolved in favor of the applicant.” *In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1437 (TTAB 2005).

We begin by finding that the genus at issue in this case is adequately defined by applicant's identification of goods -- “men's, women's and children's clothing made from denim, namely, pants, shirts, hooded sweat shirts” – or in other words, denim clothing. *See Magic Wand*, 19 USPQ2d at 1552 (“[A] proper genericness inquiry focuses on the description of [goods or] services set forth in the [application or] certificate of registration”). *See e.g., In re Trek 2000 Int’l Ltd.*, 97 USPQ2d 1106, 1112 (TTAB 2010). We further find that the “relevant public” consists of purchasers of clothing.

Applicant and the examining attorney dispute whether the designation DENIM & DENIM is a compound term or a unitary phrase. Resolving this issue is critical to this case because it affects the type of evidence the USPTO may rely upon to satisfy its burden of proof. In cases where the proposed mark

is a compound term (in other words a combination of two or more terms), the evidence of record must show that each of the constituent words is generic, and that each word retains its generic meaning when combined such that the composite formed is generic and does not create a different, non-generic meaning. See *In re Gould Paper Corp.*, 834 F.2d 1017, 1018-19, 5 USPQ2d 1110, 1111-12 (Fed. Cir. 1987) (holding that the compound term “SCREENWIPE” is generic as applied to wipes for cleaning monitor screens). By contrast, in instances “where the proposed mark is a phrase (such as “Society for Reproductive Medicine”), the [B]oard “cannot simply cite definitions and generic uses of the constituent terms of a mark;” it must conduct an inquiry into “the meaning of the disputed phrase as a whole.” *American Fertility Society*, 51 USPQ2d at 1836.

In this instance, we find that the mark is a compound word term analyzed as per the standards set forth in *In re Gould, supra*. Applicant’s mark consists of the same word “denim” repeated twice and joined by an ampersand. “The number of terms in the designation does not determine whether the designation constitutes a unitary phrase or merely a repeating word, for, as shown above, even two words have been held to constitute a unitary phrase. Rather, the critical factor is that the two or more words serve to modify each other and enhance the meaning of the composite, which is something that does not occur merely by repeating a word.” *In re Tires, Tires, Tires, Inc.*, 94 USPQ2d 1153, 1156 (TTAB 2009). We therefore conclude that applicant’s

mark DENIM & DENIM constitutes a compound word mark, not a unitary phrase.

With this in mind, we must now ascertain whether the designation DENIM & DENIM is understood by the relevant purchasing public as primarily referring to denim clothing. Applicant contends that the relevant public understands the term “denim” as referring to a type of fabric and not as identifying the genus of denim clothing. As such, applicant maintains that its proposed mark DENIM & DENIM would be generic for goods identified as “bolts of twilled cloth” (in other words, the dictionary definition of the word “denim”) or generic if the mark were DENIM PANTS & DENIM PANTS or DENIMS.

Applicant’s arguments are unpersuasive. It is well established that the generic name of an ingredient of the goods is incapable of identifying and distinguishing their source and is thus unregistrable on either the Principal or Supplemental Register. *See e.g., In re Hask Toiletries, Inc.*, 223 USPQ 1254, 1255 (TTAB 1984) (HENNA ‘N’ PLACENTA incapable of registration on the Supplemental Register for hair conditioner). As identified and confirmed by applicant during *ex parte* prosecution, applicant’s pants, shirts, and hooded sweat shirts are comprised of denim. The record evidence shows that it is common for such clothing items to be made from denim material. Specifically, the word “denim” is defined as “a firm durable twilled usually cotton fabric woven with colored warp and white filling threads.” Definition of “denim” from www.merriamwebster.com (December 12, 2011 Office Action). Further,

the examining attorney submitted evidence obtained from third-party Internet retail websites and blogs illustrating that the word “denim” is a common term used to describe clothing made from this type of fabric. See for example excerpts from <http://truereligionjeans.com> showing women’s, men’s and children’s denim shirts (December 12, 2011 Office Action); www.gap.com showing men’s, women’s and children’s denim pants (July 11, 2012 Office Action); www.shoppacsun.com showing men’s and women’s denim pants (July 11, 2012 Office Action); and www.denimblog.com “Designer Jean Reviews” (July 11, 2012 Office Action). This evidence confirms that the term “denim” is used to identify denim clothing items such as pants and shirts and not just the fabric used to manufacture the clothing.

Applicant argues that the addition of the ampersand and repetition of the word “denim” in its proposed mark signal “what it means to be an American;” in other words, that denim clothing represents a long American tradition in fashion. Applicant’s Brief, pp. 5-6. We disagree. The fact that the term “denim” is repeated and separated by an ampersand does not obviate the generic significance of the mark. For instance, in the case of *In re Tires, Tires, Tires, Inc.*, 94 USPQ2d at 1155, the Board found generic the proposed mark TIRES, TIRES, TIRES for “retail tire stores” reasoning that “[t]here is no valid reason to require an examining attorney to demonstrate that a designation composed solely of a repeating word has been used by others, when the examining attorney has demonstrated that the repeated term is generic and that

the repetition does not result in a designation with a different meaning.” The underlying logic of that case applies here as well.

Applicant also contends that its proposed mark DENIM & DENIM “has a dichotomy of meanings similar to the mark SUGAR & SPICE,” arguing that the mark “is a catchy enigmatic phrase that calls to mind the sophistication, quality, and trustworthiness of a long list of American companies that have been named using the convention of adjoining two founding members’ last names with the ampersand” such as Johnson & Johnson and Proctor & Gamble. Applicant’s Brief, p. 4. We are not persuaded. Applicant failed to introduce any evidence that prospective consumers would perceive the word “denim” as a surname rather than the name for a type of clothing. In addition, applicant did not submit any evidence to support its argument about naming conventions for U.S. companies. Thus, based on the record before us, we cannot find that the mark DENIM & DENIM has another meaning or significance other than identifying the genus of applicant’s goods.

Decision: The refusal to register is affirmed.