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Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Nanomech, Inc.

Serial No. 85602143

J. Charles Dougherty of Wright Lindsey & Jennings LLP for Nanomech, Inc.

Karen Bracey, Trademark Examining Attorney, Law Office 116 (Michael W. Baird, Managing Attorney).

Before Seeherman, Bucher and Cataldo,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Nanomech, Inc. (“Applicant”) filed an application to register as a mark
on the Principal Register the term

nSert₁

(in standard characters) for “machine tools for the cutting of materials,
namely, coated substrates manufactured using nanotechnology” in
International Class 7.¹

¹ Application Serial No. 85602143, filed April 19, 2012, based upon applicant’s
assertion of its bona fide intent to use the mark in commerce.

The Trademark Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant's proposed mark, when used in connection with Applicant's goods, is merely descriptive thereof, namely, that "inserts" are a key feature of cutting tools and that nSert would be immediately understood as a novel spelling or misspelling of "insert.". When the refusal was made final, Applicant appealed. Applicant and the Examining Attorney filed briefs.

Mere Descriptiveness

A mark is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *In re Chamber of Commerce of the United States of America*, 675 F.3d 1297, 102 USPQ2d 1217 (Fed. Cir. 2012); *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828 (Fed. Cir. 2007); and *In re Abcor Development*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). A mark need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; rather, it is sufficient that the mark describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

It is further settled that whether a mark is merely descriptive is determined not in the abstract, but in relation to the goods or services for

which registration is sought, the context in which it is being used on or in connection with the goods or services, and the possible significance that the mark would have to the average purchaser of the goods or services because of the manner of its use. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). “The question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them.” *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002).

In support of her position that the applied-for mark merely describes the identified goods, the Examining Attorney submitted screenshots from Applicant’s Internet website (nanomech.biz/products), excerpted below (emphasis added):

NanoMech
Making atoms work harder and smarter.™
TuffTek®

NanoMech’s award winning technologies include the patented and patent-pending TuffTek® extreme wear resistant coating products lines which provide a breakthrough increase in performance never achieved before. TuffTek® enhanced **nSert**® tools can improve tool life 300-1000% or more compared to conventional processes. The combination of exceptional wear resistance and unsurpassed toughness brings TuffTek® **nSert**® cutting tools performance beyond any other cutting **insert** presently on the market. ...²

² August 13, 2012 Office Action.

The Examining Attorney further made of record with her Office Actions evidence from commercial and informational Internet websites in which the term “insert” is used in relation to machine tools used for cutting materials. The following examples are illustrative (emphasis added):

(business.com)

Business.com Buy Smarter

Cutting Tool **Inserts** Key Terms

Familiarize yourself with cutting tool **inserts** terminology

Cutting tools are important for any manufacturing company, as the quality of products depends upon the properties of cutting tools. A cutting tool **insert** is a small part attached to cutting tools that can be replaced after pre-defined operation time.

If you want to buy cutting tool **inserts**, you will need to be conversant with certain terms that indicate specifications, types or materials for cutting tool **inserts**. This guide will introduce you to some technical terms, such as hardness, cold or hot forming, cutting speed and cermet.

Hardness

Selection of a cutting tool **insert** depends upon the hardness of the component material. ...

Cold or hot forming.

As the name indicates, a cold forming (or cold working) process is a metal forming operation carried out at room temperature. ... While buying a cutting tool **insert**, you will need to specify whether you want to use it for a cold or hot forming operation.

Cutting speed

Cutting speed can be defined as the relative speed between the cutting tool **insert** edge and component material just ahead of this cutting edge.

Tool steel

Once you understand the different specifications, you must learn about various types of materials for cutting tool **inserts**. Tool steel includes a typical variety of plain carbon steel and alloy steel materials that are suitable for cutting tools and **inserts**.

CBN (Cubic Boron Nitride)

CBN is ceramic material that is very useful for manufacturing cutting tool inserts. CBN inserts have applications in high speed cutting operations.

Cermet

Cermet is another popular tool insert material. It is a composite material of metal and ceramic constituents produced by different processes, such as agglomeration, sintering and spray drying.³

(globalspec.com)

Cutting Tool Inserts Information

Cutting tool inserts are replaceable attachments for cutting tools that typically contain the actual cutting edge. Cutting tool inserts applications include boring, construction, cutoff and parting, drilling, grooving, hobbing, milling, mining, sawing, shearing and cutting, tapping, threading, turning and brake motor turning.

Cutting tool inserts can have many different geometries. Round or circular inserts are used in applications such as button mills or in radius groove turning. ... A diamond insert is a four-sided insert with two acute angles used for material removal. Triangle inserts have a triangular shape....⁴

(ctemag.com)

Small-Scale Thinking

“Nanotechnology” has been a buzzword in a variety of industries for some time now. But what does it mean when it comes to coating materials for cutting tools, and what’s the current state of nanostructured tool coatings?

Defining nanoscale might be a good place to start. A consensus defines nanoscale as features on the order of 100 nanometers or smaller (a nanometer is one billionth of a meter).

For cutting tool coatings, however, it’s not that simple. Although feature sizes of nanocoating materials certainly fit the

³ *Id.*

⁴ March 6, 2013 Office Action.

100mm or smaller scale, development of new coating processes and materials is producing tools for difficult machining applications that, in some cases, can far exceed the performance of conventional tools in both life and machining capability. ...

Swiss Tek's Bartos, however, sees a wider application for nanocoatings. He said they are a significant step toward the mythical universal coating material that would improve tool life and productivity in all types of machining applications. "What everybody wants in a coating is a silver bullet – a single coating that can be applied to milling and drilling tools, turning inserts, carbide and HSS substrates, and works well in every application," he said.⁵

(green.tmcnet.com)

Nanomech (Applicant) Wins 2012 Innovator of the Year Award from Leading Nanotechnology Trade Organization

NanoMech, an international material science company and leader in nanotechnology innovation, is pleased to announce that the NanoBusiness Commercialization Association (NanoBCA) has selected it for the 2012 Top Emerging Nano Innovators Award. ...

Dr. Ajay P. Malshe, the CTO of NanoMech said, "In 2012 NanoMech commercialized two nano-engineered product platforms never achieved before. TurboTuff is a nano-inspired industrial lubricant which reduces friction (to near zero) and wear of mechanical parts by orders of magnitude allowing hundreds of percent enhancements in wear reduction in machines, vehicles, and components such as valves, gears and much more. These performance increases also produce incredible energy savings. Our second nanotechnology platform of products is TuffTek coated cutting tool inserts and wear parts made of carbides, metals and ceramics. ...⁶

(ehow.com)

Definition of Milling Machine Cutting Tools
Insert Cutters

⁵ *Id.*

⁶ *Id.*

Insert cutters are similar to end mills but are constructed of multiple removable inserts that are held in place by a screw or retention clip on a tool's shaft. The individual inserts are often coated with carbide for long life and have different shapes as well as radii for various operations. Insert cutters are often run on a mill without the need for coolant as the insert is capable of deflecting and dissipating the heat itself.⁷

The Examining Attorney also made of record screenshots from commercial Internet websites offering for sale machine tool “inserts” of various types.⁸ These websites include:

mesatool.com – carbide inserts of various shapes;

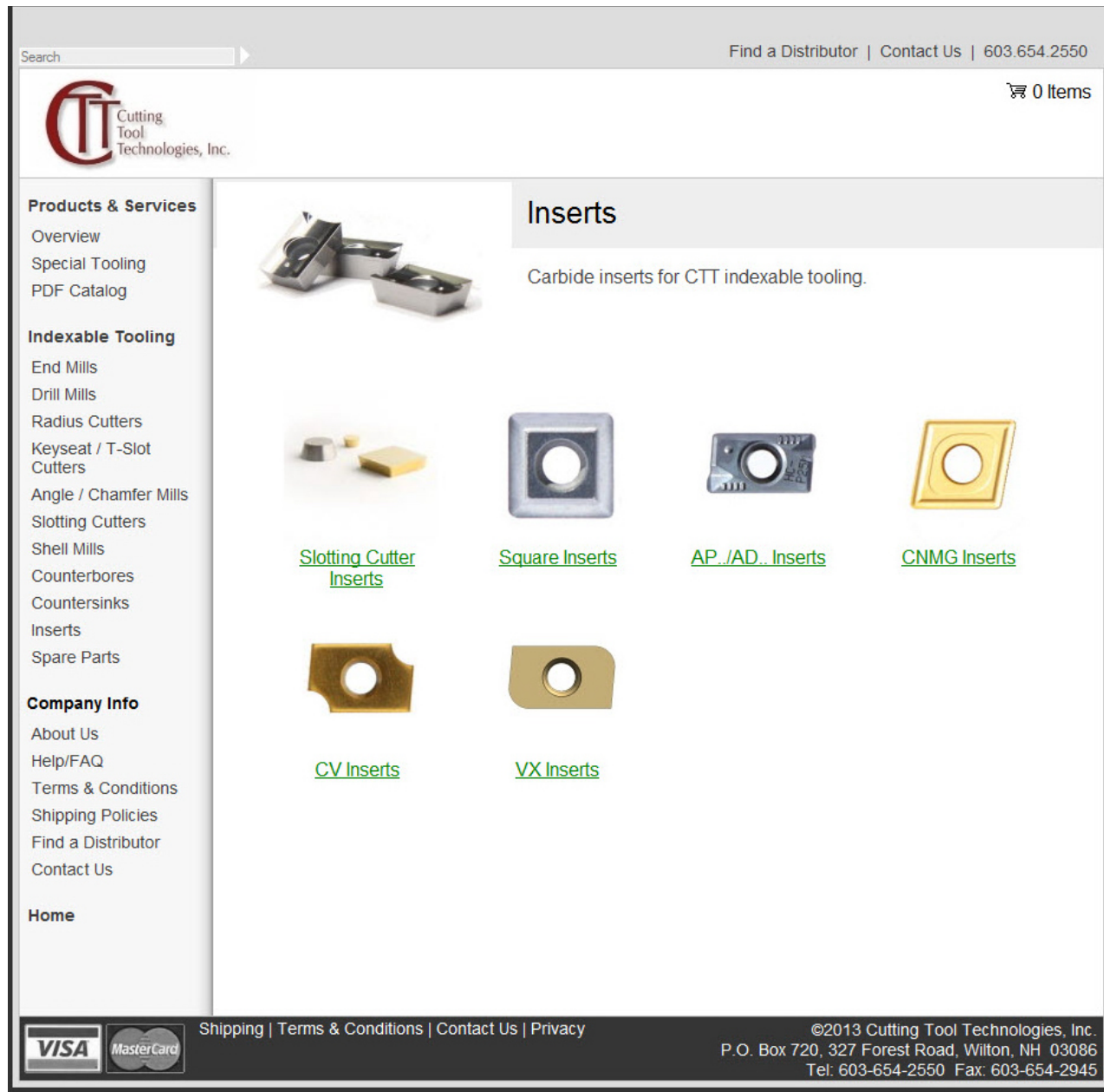
boltonhardware.com – turning inserts of various materials and shapes;

wttool.com – ceramic and carbide inserts of various shapes; and

(cuttingtooltech.com) – carbide inserts of various shapes, as displayed below.

⁷ Examining Attorney's September 30, 2013 Office Action.

⁸ *Id.*



Applicant, while conceding that “insert” merely describes its goods, nonetheless argues that the letter “n” at the beginning of its mark is widely understood to indicate the term “nanotechnology” and that its nSert mark is a double entendre suggesting that the identified goods are produced using nanotechnology. In support of its arguments in favor of registration,

Applicant made of record a screenshot from the Internet website (nist.gov) of the National Institute of Standards and Technology (NIST) indicating that “n” is the prefix symbol for “nano.”⁹ Applicant further made of record screenshots from websites (nano.gov, hp.com and n-tec.com) explaining the nature of nanotechnology that are largely cumulative of evidence made of record by the Examining Attorney and discussed above.¹⁰ Finally, Applicant submitted copies of the following third-party registrations, all on the Principal Register, consisting in part of the letter “N” as a prefix denoting goods that incorporate nanotechnology in whole or in part:¹¹

Reg. No. 2889757 for the mark NPOINT for, *inter alia*, piezoelectric actuators, micro and nano-positioning stages, and controllers and parts therefor;

Reg. No. 3145730 for the mark NTERA for, *inter alia*, providing technical information in the fields of nanotechnology, information in the field of nanotechnology, information technology development of nanotechnology, licensing of intellectual property in the field of nanotechnology, and information and scientific research and development advice services in the field of nanotechnology;

Reg. No. 3324888 for the mark NSILVER,
Reg. No. 3352624 for the mark NCLEAR,
Reg. No. 3939916 for the mark NAERO and
Reg. No. 3427102 for the mark NHALO
all owned by the same entity for, *inter alia*, machines and machine tools for use in chemical, physical, optical and mechanical processes and production in the field of functional coatings and nanotechnology, namely, atomic layer deposition reactors, computer software and instruments used in

⁹ Applicant’s September 6, 2013 Request for Reconsideration.

¹⁰ *Id.*

¹¹ *Id.*

controlling, regulating processes and machines in the field of functional surfaces and nanotechnology;

Reg. No. 3359974 for the mark NAMBITION for, *inter alia*, computer hardware and software for laboratory research in the field of nanotechnology;

Reg. Nos. 4019526 and 4176549 owned by the same entity for the following mark



for, respectively,
research, development and testing in the field of nanosurfaced medical implants and nano-structured biomaterials; and
dental and medical implants made with nanosurfaced and nano-structured materials and made primarily with artificial materials.

Based upon the evidence of record, we find that the Examining Attorney has made a *prima facie* case that the applied-for mark is descriptive as used in connection with Applicant's goods. Specifically, the word "insert" clearly and unambiguously describes a significant feature of Applicant's "machine tools for the cutting of materials, namely, coated substrates manufactured using nanotechnology," i.e., a replaceable attachment containing the cutting edge of machine tools. Indeed, Applicant's own Internet advertisements for its goods under the involved mark utilize the term "inserts" to describe this key feature or characteristic thereof, and Applicant has conceded that this term describes its goods.

We similarly are persuaded that Applicant's mark is a double entendre. As discussed above, an "insert" is a key component of a machine cutting tool. However, Applicant's mark **nSert** further suggests an additional feature of Applicant's goods, namely, that they are "manufactured using nanotechnology." Evidence submitted by Applicant demonstrates that the "n" prefix is understood to denote "nano-," and that cutting tool inserts are manufactured using nanotechnology. Further, the third-party evidence submitted by Applicant, in which "N" is used as part of marks for goods and services in the field of nanotechnology, indicates that "N" suggests this meaning. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987) (third-party registrations are relevant to show how language is used). As a result, consumers seeing the separated "n" in Applicant's mark will view it as suggesting "nanotechnology." The Examining Attorney, while arguing¹² that "applicant has not shown the wording "nSert" has an alternative meaning," did not present any evidence to cast doubt upon the prefix "n" being perceived as denoting nanotechnology. As a result, we find that consumers will view the involved mark as having more than one connotation. *See In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968); *In re Tea and Sympathy, Inc.*, 88 USPQ2d 1062 (TTAB 2008); *In re Simmons Co.*, 189 USPQ 352 (TTAB 1976); and *In re Del. Punch Co.*, 186 USPQ 63 (TTAB 1975). In short,

¹² Brief, unnumbered p. 7.

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because of the stylization of the **nSert** mark, the consuming public will perceive it as a double entendre.

Decision: The refusal of registration is reversed.