

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

Mailed: May 14, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

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In re Global Mining Holding Company LLC

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Serial No. 85669303

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Michael L. Dever of Buchanan Ingersoll & Rooney PC for Global Mining Com-
pany LLC.

Simon Teng, Trademark Examining Attorney, Law Office 105 (Thomas G.
Howell, Managing Attorney).

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Before Bucher, Cataldo and Lykos, Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On July 5, 2012, Global Mining Company LLC (“applicant”) filed an appli-
cation to register the mark GLOBAL MINING HOLDING COMPANY, LLC in
standard character format for, as amended, “mining extraction of coal” in In-
ternational Class 37.¹ Applicant has disclaimed the wording “Mining Holding
Company, LLC” apart from the mark as shown.

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¹ Application Serial No. 85669303 filed under Section 1(b) of the Trademark Act, al-
leging a *bona fide* intent to use the mark in commerce.

The Trademark Examining Attorney has refused registration of the mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the mark is merely descriptive of applicant's services. In light of applicant's disclaimer, the sole issue before us is whether the term "Global," as used in the mark GLOBAL MINING HOLDING COMPANY, LLC, is merely descriptive of the identified services.

Section 2(e)(1) of the Lanham Act precludes registration of a mark that, when applied to the goods or services of the applicant, is merely descriptive of them. 15 U.S.C. § 1052(e)(1) (2006). "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 Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012), quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007). Evidence that a term is merely descriptive to the relevant purchasing public "may be obtained from any competent source, such as dictionaries, newspapers, or surveys." *In re Bayer*, 82 USPQ2d at 1831, quoting *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986). In addition, third-party registrations featuring *the same or similar services as applicant's services* are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on a showing of acquired distinctiveness, or registered on the Supplemental Register. See *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833

F.2d 1560, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006).

In support of the refusal, the examining attorney submitted a dictionary definition of the word “global” obtained from the online version of *Collins* dictionary (www.collinsdictionary.com). The *Collins* dictionary, while in the English language, is published in Glasgow, Scotland and therefore pertains to varieties of English spoken in Scotland. In the absence of evidence of exposure to U.S. consumers, it is of little or no probative value. Clearly, the examining attorney had access to dictionaries of the English language as spoken and written in the United States, and could have made such entries of record, but failed to do so.

The examining attorney also submitted third-party registrations for marks including the word GLOBAL where, as argued by the examining attorney, the word is disclaimed for the identical *class* of services as the applicant. They are as follows:

Registration No. 3593987 for “construction planning and consultancy services for fertilizer and sulphur remelting facilities, fertilizers and terminal and storage facilities, and fertilizer and sulphur transload, container and bagging facilitates” in International Class 37;

Registration No. 3760021 for “construction services, namely, construction of clean rooms” in International Class 37;

Registration No. 3722079 for “Construction, maintenance and renovation of property” in International Class 37;

Registration No. 3901441 for “Maintenance and repair of computer hardware” in International Class 37;

Registration No. 3927220 for “Real estate development; real estate site selection; construction, maintenance and renovation of property; construction management” in International Class 37.

The examining attorney’s reasoning is fundamentally flawed, and reflects a misunderstanding regarding the type of evidence necessary to show that a proposed mark is merely descriptive. While the services identified in these third-party registrations fall in the same *international class*, this is insufficient to show descriptiveness. The determination of whether a term is descriptive is made in relation to the goods or services, not international class. The classification of goods and services by the U.S. Patent and Trademark Office is a purely administrative determination; one cannot conclude that because a term is disclaimed in a particular class, it is descriptive of all services falling within that class. Moreover, these third-party registrations identify services which are not only different from applicant’s “mining extraction of coal” services, but entirely unrelated. In the event there exist third-party registrations comprised of marks containing the word GLOBAL disclaimed for “mining extraction of coal” or similar or related services, they are not of record here and therefore cannot be considered.

Equally disconcerting, of the remaining third-party registrations made of record by the examining attorney, four are registered under either Section 44(e) or Section 66(a) of the Trademark Act (Registration Nos. 3529691, 4113534, 4263035, and 4270201), and therefore cannot be considered as being

probative of exposure to U.S. consumers through use in commerce. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). In addition, two of the registrations have been cancelled (Registration Nos. 3179798 and 3254876), and one of the registrations (Registration No. 2798318) was cancelled for the services identified in International Class 37. These registrations also cannot be considered. *See Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“[A] cancelled registration does not provide constructive notice of anything.”).

We are now left with the examining attorney’s request in his appeal brief to take judicial notice of the definition of “global” from the online dictionary entitled “dictionaryreference.com” which is derived from the 2013 print edition of the *Random House Dictionary*. The request is granted insofar as the Board may take judicial notice of dictionary definitions available in print format. *See In re Thomas White Int’l Ltd*, 106 USPQ2d 1158, 1160 n.1 (TTAB 2013) (judicial notice taken from dictionary existing in print format); *In re Future Ads LLC*, 103 USPQ2d 1571, 1572 (TTAB 2012) (judicial notice taken of definition from online dictionary stating it was from a specified print dictionary). Nonetheless, we cannot find that applicant’s mark is merely descriptive based on a single judicially noticed dictionary definition in the absence of corroborating evidence showing descriptive use of the term in connection with

applicant's services.² That is to say, the evidentiary record before us is entirely too sparse. Furthermore, to affirm the examining attorney's refusal to register based solely upon such evidence would be fundamentally unfair to applicant who had no opportunity to submit rebuttal evidence or present arguments addressing such evidence used as an adverse inference prior to appeal.

We therefore are compelled to find that on the record before us, the Office has failed to satisfy its burden of proof. We hasten to add that on a different record, the result may have been otherwise.

Decision: The refusal to register the mark as merely descriptive under Section 2(e)(1) is reversed.

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Bucher, Administrative Trademark Judge, dissenting:

My colleagues are correct – this record, unfortunately, is “entirely too sparse.” Furthermore, if a panel of this Board remains in doubt on an extremely close case under § 2(e)(1), we should be most reluctant to have our determination turn on a “single judicially-noticed dictionary definition” – especially if attached for the first time to an examining attorney's appeal brief, or noticed *sua sponte* by the Board.

² The dissent states that applicant reproduced the definition of “global” in its Request for Reconsideration. Applicant merely copied the definition and hyperlink in its Request for Reconsideration. Providing a web address or hyperlink to internet materials is insufficient to make the associated web pages of record. *In re Powermat Inc.*, 105 USPQ2d 1789, 1791 (TTAB 2013).

However, in this case, applicant itself reproduced the following dictionary definition in its Request for Reconsideration of October 22, 2013:

“The on-line dictionary www.dictionary.reference.com defines “global” as follows: 1. pertaining to the whole world; worldwide; universal:”³

In the interest of reaching the correct legal result to the sole question before us, I fail to see the unfairness to applicant should we tie our holding to this slender reed. In fact, given these circumstances, the majority explicitly granted the examining attorney’s request to take judicial notice of this entry. What my colleagues evidently found a bridge too far was acknowledging the ordinary meaning of this frequently-used and generally-understood English language word in the context of this composite mark. I would argue that the word “global” goes with the word “mining” as it does with the word “warming” – in both cases meaning “worldwide.” Other large mining companies around the world likely assume, with good reason, that they could freely choose such a descriptive tagline to designate that their global entity is in the business of mineral extraction.

Yet the majority agrees with applicant that the word “Global” is the distinctive portion of this mark carrying the larger composite to registration, and holds to that position in spite of the fact that the Office has treated this term in so many earlier applications for registration consistent with the one dic-

³ The examining attorney attached a copy of this complete entry to his appeal brief, showing this entry was actually derived from a print edition of the *RANDOM HOUSE DICTIONARY*.

tionary definition proffered by applicant and by the examining attorney.

Hence, I would affirm this refusal under Section 2(e)(1) of the Lanham Act.