

From: Feldman-Lehker, Dawn

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Subject: U.S. TRADEMARK APPLICATION NO. 85834316 - MAGNESITA - MAGN6029/TJM - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 85834316

MARK: MAGNESITA



CORRESPONDENT ADDRESS:

THOMAS J MOORE

BACON & THOMAS PLLC

625 SLATERS LN FL 4

ALEXANDRIA, VA 22314-1169

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

APPLICANT: Magnesita Refractories Company

CORRESPONDENT'S REFERENCE/DOCKET NO:

MAGN6029/TJM

CORRESPONDENT E-MAIL ADDRESS:

mail@baconthomas.com

EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

In this case the applicant appeals the Trademark Examining Attorney's Final Refusal under Section 2(e)(1) of the Trademark Act as merely descriptive of the proposed mark, MAGNESITA, for "refractory products not primarily of metal, namely, refractory bricks, refractory mixes for patching, lining or repairing high temperature apparatus and repairing the lining for furnaces, refractory furnace patching and repair mixes; and pre-cast refractory shapes" and for "providing information via a global computer network on the use of refractory products to construct, maintain and repair refractory apparatus using refractory products; and providing information via a global computer network on the use of mechanical equipment and computer models to construct, maintain and repair refractory installations." The applicant also appeals a Final Refusal of the applicant's claim of acquired distinctiveness under Section 2(f) of the Trademark Act.

The examining attorney respectfully requests that the Board affirm the refusal to register the proposed mark.

STATEMENT OF THE CASE

On January 28, 2013, the applicant filed an application for the mark, MAGNESITA for "refractory products not primarily of metal, namely, refractory bricks, refractory mixes for patching, lining or repairing high temperature apparatus and repairing the lining for furnaces, refractory furnace patching and repair mixes; and pre-cast refractory shapes" and for "providing information via a global computer network on the use of refractory products to construct, maintain and repair refractory apparatus using refractory products; and providing information via a global computer network on the use of mechanical equipment and computer models to construct, maintain and repair refractory installations."

On February 27, 2013, the examining attorney issued an office action refusing the proposed mark under Section 2(e)(1) as merely descriptive and required a translation of MAGNESITA. On August 14, 2013, the applicant responded to the refusal to register and amended the application with the translation of MAGNESITA AS “magnesite” or “magnesia.”

On September 9, 2013, the examining attorney issued a Final Refusal under Section 2(e)(1) of the Trademark Act because the mark is merely descriptive as applied to the applicant’s goods and services. On March 6, 2014, the applicant responded to the Final Refusal by claiming that the proposed mark had acquired distinctiveness, based on evidence alone, under Section 2(f) of the Trademark Act. The applicant’s only evidence of acquired distinctiveness was a Canadian Registration. On March 26, 2014, the examining attorney withdrew the Final Refusal to refuse the applicant’s insufficient Section 2(f) claim of acquired distinctiveness.

On September 23, 2014, the applicant responded to the examining attorney’s refusal of the applicant’s Section 2(f) claim of acquired distinctiveness. On November 10, 2014, the examining attorney issued a Final Refusal of the Section 2(f) claim because the mark is generic as applied to the applicant’s goods and related services.

On May 6, 2015, the applicant filed a request for reconsideration of the Final Refusal of the applicant’s Section 2(f) claim of acquired distinctiveness. On July 13, 2015, the examining attorney denied the applicant’s request for reconsideration.

ISSUES ON APPEAL

Whether the proposed mark, MAGNESITA, has been properly refused registration under Section 2(f) as generic in connection with the goods and services in the application under Section 2(e)(1); 15 U.S.C. §1052(e)(1).

ARGUMENTS

Section 2(f) Claim Is An Admission That the Mark Is Descriptive

The examining attorney initially refused registration under Section 2(e)(1) and the applicant responded by amending the application to assert a claim of acquired distinctiveness under Section 2(f). According to TMEP §1212.02(b) a claim of distinctiveness under §2(f), whether made in the application as filed or in a subsequent amendment, may be construed as conceding that the matter to which it pertains is not inherently distinctive and, thus, not registrable on the Principal Register absent proof of acquired distinctiveness. See *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) (“Where an applicant seeks registration on the basis of Section 2(f), the mark’s descriptiveness is a nonissue; an applicant’s reliance on Section 2(f) during prosecution presumes that the mark is descriptive.”). For the purposes of establishing that the subject matter is not inherently distinctive, the examining attorney may rely on this concession alone. Once an applicant has claimed that matter has acquired distinctiveness under §2(f), the issue to be determined is not whether the matter is inherently distinctive but, rather, whether it has acquired distinctiveness.

See, e.g., *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1577, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *In re Cabot Corp.*, 15 USPQ2d 1224, 1229 (TTAB 1990); *In re Prof’l Learning Ctrs., Inc.*, 230 USPQ 70, 71 (TTAB 1986); *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984).

Section 2(f) Claim Insufficient

As an initial matter, the applicant's claim of acquired distinctiveness under Section 2(f) is insufficient. The applicant initially asserted a claim of acquired distinctiveness under Section 2(f) in its March 6, 2014 response. The only evidence of acquired distinctiveness submitted with that response was a Canadian registration. After the examining attorney's initial refusal of the Section 2(f) claim, the applicant responded by submitting sales figures for the three and a half years the applicant had been operating in the United States. No other evidence of acquired distinctiveness was submitted.

As was discussed in the examining attorney's office action dated March 26, 2014, there are several factors to be weighed when examining evidence of acquired distinctiveness based on extrinsic evidence: (1) length and exclusivity of use of the mark in the United States by applicant; (2) the type, expense, and amount of advertising of the mark in the United States; and (3) applicant's efforts in the United States to associate the mark with the source of the goods and/or services, such as unsolicited media coverage and consumer studies. See *In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005); *Bd. of Trs. v. Pitts, Jr.*, 107 USPQ2d 2001, 2016 (TTAB 2013). A showing of acquired distinctiveness need not consider all these factors, and no single factor is determinative. In *re Steelbuilding.com*, 415 F.3d at 1300, 75 USPQ2d at 1424; see TMEP §§1212.06 et seq. The USPTO will decide each case on its own merits.

As was discussed above, at the time of the applicant's initial claim of acquired distinctiveness, the applicant had only been operating in the United States for three and a half years. The applicant did not submit any evidence of the marketing and advertising programs in the United States. The applicant did not outline any efforts it made to associate the mark with any of its goods or services listed in the application, nor did it outline its advertising and promotional expenditures. In the request for

reconsideration dated May 6, 2015, the applicant did submit another year of sales figures and an article written about the applicant that appeared in a trade magazine.

Due to the highly descriptive nature of the proposed mark, MAGNESITA, in relation to “refractory products not primarily of metal, namely, refractory bricks, refractory mixes for patching, lining or repairing high temperature apparatus and repairing the lining for furnaces, refractory furnace patching and repair mixes; and pre-cast refractory shapes” and for “providing information via a global computer network on the use of refractory products to construct, maintain and repair refractory apparatus using refractory products; and providing information via a global computer network on the use of mechanical equipment and computer models to construct, maintain and repair refractory installations,” the Section 2(f) claim is insufficient.

In the event that the Board finds as a preliminary matter that the applicant’s evidence is substantial and sufficient enough to support a Section 2(f) claim of acquired distinctiveness, the examining attorney submits that the Section 2(f) claim fails because the proposed mark is generic as applied to the applicant’s goods.¹

Proposed Mark Is Generic for the Refractory Products

And Related Information Services

Generic terms require refusal because they are common names that the relevant purchasing public understands primarily as describing the genus of the applicant’s goods or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344, 57 USPQ 2d 1807, 1810 (Fed. Cir. 2001);

¹ A discussion of the sufficiency of the Section 2(f) claim with respect to the services in International Class 37 was never reached because of the paltry nature of the evidence submitted with the applicant’s responses.

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). See TMEP §1209.01(c). Generic terms, by definition incapable of indicating source, are the antithesis of trademarks, and can never attain trademark status. *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1569, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987); see TMEP §1209.01(c). Refusal is required because registering generic terms “would grant the owner of [a] mark a monopoly, since a competitor could not describe the goods as they are. *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d at 1569, 4 USPQ2d at 1142.

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?

In re 1800Mattress.com IP, LLC, 586 F.3d 1359, 1363, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009) (quoting *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)); TMEP §1209.01(c)(i).

Regarding the first part of the inquiry, the genus of the goods and/or services is often defined by an applicant's identification of goods and/or services. See *In re Country Music Ass'n*, 100 USPQ2d 1824, 1827-28 (TTAB 2011) (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 640, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991)).

In this case, the identification, and thus the genus, is “Refractory products not made primarily of metal, namely, refractory bricks, refractory mixes for patching, lining or repairing high temperature apparatus and repairing the lining for furnaces, refractory furnace patching and repair mixes”. This application also includes services for “providing information via a global computer network on the use of refractory products to construct, maintain and repair refractory apparatus using refractory products; and providing information via a global computer network on the use of mechanical equipment and computer models to construct, maintain and repair refractory installations.”²

Regarding the second part of the inquiry, the relevant public is the purchasing or consuming public for the identified goods and/or services. *Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1952 (TTAB 2014) (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d at 640, 19 USPQ2d at 1553). In this case, the relevant public is large industrial operations that require large scale refractory apparatus.

Determining whether an applied-for mark is generic turns on if “the relevant public primarily uses or understands the mark to refer to the category or [genus] of goods [and/or services] in question.” *In re Nordic Naturals, Inc.*, 755 F.3d 1340, 1342, 111 USPQ2d 1495, 1497 (Fed. Cir. 2014); see *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); TMEP §1209.01(c). In such a determination, the “relevant public” represents the purchasing or consuming public for the identified goods and/or services. *Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1952 (TTAB 2014) (citing *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 640, 19 USPQ2d 1551, 1553 (Fed. Cir. 1991)).

The applicant states that the examining attorney has not demonstrated that the relevant purchasing public for the applicant's goods and services is large-scale industrial consumers. The examining attorney points to the article submitted by the applicant (Applicant's Request for Reconsideration, May 6, 2015, page 2) that discusses the fact that in Brazil, Magnesita controls 70% of the steel refractories market and 80% of the cement refractories market. Steel and cement refractories are not the general public consumers. They are large scale industrial consumers. Moreover, the applicant's declaration discusses sales of the refractory products in "metric tons, " which also points to large scale industry. The applicant does not state that it only offers its goods and services to industrial customers; however, the article states that the applicant is attempting to expand its customer base by acquiring the German company. The article also discusses the large scale expansion into other parts of the world the applicant hopes to achieve through the acquisition of the German company.

Key Component of the Goods And Services

As discussed above, the applicant' goods are "refractory bricks, refractory mixes for patching, lining or repairing high temperature apparatus and repairing the lining for furnaces, refractory furnace patching and repair mixes; and pre-cast refractory shapes." The applicant states that the examining attorney is erroneous in her assertion that because magnesia or magnesite is a component of the applicant's goods, the term is generic when used in connection with the goods.

The name of an ingredient, a key aspect, a central focus or feature, or a main characteristic of goods and/or services may be generic for those goods and/or services. *See In re Hotels.com LP*, 573 F.3d 1300, 1304, 91 USPQ2d 1532, 1535 (Fed. Cir. 2009) (affirming the Trademark Trial and Appeal Board's holding of HOTELS.COM as generic for travel agency services, namely, making reservations and bookings for temporary lodging, and providing information about temporary lodging); *In re Meridian Rack &*

Pinion, 114 USPQ2d 1462, 1465-66 (TTAB 2015) (holding BUYAUTOPARTS.COM generic for on-line retail store services featuring auto parts); *In re Tires, Tires, Tires, Inc.*, 94 USPQ2d 1153, 1157 (TTAB 2009) (holding TIRES TIRES TIRES generic for retail tire store services); *In re Cent. Sprinkler Co.*, 49 USPQ2d 1194, 1199 (TTAB 1998) (holding ATTIC generic for automatic sprinklers for fire protection used primarily in attics); TMEP §§1209.01(c) *et seq.*; *see also In re Northland Aluminum Prods. Inc.*, 777 F.2d 1556, 1559-60, 227 USPQ 961, 963-64 (Fed. Cir. 1985) (holding BUNDT generic for cake mix); *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895, 1900 (TTAB 2001) (holding RUSSIANART generic for art dealership services); *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 292, 1 USPQ2d 1364, 1365 (3d Cir. 1986) (holding CHOCOLATE FUDGE generic for diet sodas). Thus, a term does not need to be the name of a specific product and/or service to be found generic. *See In re Eddie Z's Blinds & Drapery, Inc.*, 74 USPQ2d 1037, 1042 (TTAB 2005) (holding BLINDSANDDRAPERY.COM generic for online retail store services featuring blinds, draperies, and other wall coverings); *In re Candy Bouquet Int'l, Inc.*, 73 USPQ2d 1883, 1888 (TTAB 2004) (holding CANDY BOUQUET generic for "retail, mail, and computer order services in the field of gift packages of candy"); *In re Ricci-Italian Silversmiths, Inc.*, 16 USPQ2d 1727, 1729-30 (TTAB 1990) (holding ART DECO generic for flatware); *In re Hask Toiletries, Inc.*, 223 USPQ 1254, 1255 (TTAB 1984) (holding HENNA 'N' PLACENTA generic for hair conditioner).

In the office action dated March 26, 2015, the examining attorney attached excerpts from different chemical dictionaries. On page 2 of that office actions is a page from *Hawley's Condensed Chemical Dictionary, Fourteenth Ed.*, ©2001, that define magnesnia, magnesite and dead-burned magnesite. The dictionary states that magnesite is often used as a synonym for magnesnia. The dictionary also states that dead burned magnesite is suitable as a refractory. In the *Concise Encyclopedia of Chemical Technology, Firth Ed., vol 2*, ©2007, (Office Action dated March 26, 2014, page 7) magnesium oxide is discussed as the principle commercial forms of magnesnia. The primary uses of the goods are for metallurgical furnace products. The applicant's clients include many steel refractories.

On page 11 of the same office action, the *Materials Handbook, Fourteenth Ed*, © 1997, states that magnesite is used in the manufacture of bricks for basic refractory furnace linings. Finally, on page 15 of the March 26, 2014, office action, the *McGraw-Hill Dictionary of Materials Science*, © 2003, defines magnesia refractory as heat and corrosion resistant material made of magnesium oxide used in cement or brick form to line high-temperature process vessels or furnaces. In the article attached to the applicant's May 6, 2015, request for reconsideration on page 2, the first line of the article refers to the applicant as a leading Brazilian magnesite producer.

It is possible that not every product produced by the applicant contains magnesite; however, it is clear that magnesite or magnesia is an important component in refractory products. The applicant's goods are refractory products. The applicant attempted to amend the application to proceed under Section 2(f), which is an acknowledgement that the proposed mark MAGNESITA describes the goods. The applicant's goods are made with magnesia or magnesite. It should be noted that the article submitted by the applicant (Applicant's Request for Reconsideration, May 6, 2015, page 2) discusses the fact that it is "Brazil's leading magnesite producer" and it has acquired a German "refractories group, gaining a global customer base and raw material supply. (emphasis supplied) In fact, the applicant touts "[there will be] no other company like ours in the refractory industry." The applicant will offer "a range of magnesite . . . products to its combined customer base . . ." (emphasis supplied) Therefore, contrary to applicant's assertion, it is clear that applicant's proposed mark is generic for applicant's refractory goods and services.

Translation of Foreign Wording

Under the doctrine of foreign equivalents, a mark that consists of or comprises a word or words from a modern foreign language will be translated into English to determine genericness. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005); see *In re Sambado & Son Inc.*, 45 USPQ2d 1312, 1315 (TTAB 1997); TMEP §1209.03(g).

The doctrine is applied when it is likely that an ordinary American purchaser would “stop and translate” the foreign term into its English equivalent. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d at 1377, 73 USPQ2d at 1696 (quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976)); cf. TMEP §1207.01(b)(vi)(A). The ordinary American purchaser refers to “all American purchasers, including those proficient in a non-English language who would ordinarily be expected to translate words into English.” *In re Spirits Int’l, N.V.*, 563 F.3d 1347, 1352, 90 USPQ2d 1489, 1492 (Fed. Cir. 2009); see *In re Thomas*, 79 USPQ2d 1021, 1024 (TTAB 2006) (citing J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* §23:36 (4th ed., rev. 2006), which states “[t]he test is whether, to those American buyers familiar with the [modern] foreign language, the word would denote its English equivalent.”).

Generally, the doctrine is applied when the English translation is a literal and exact translation of the foreign wording. See *In re Oriental Daily News, Inc.*, 230 USPQ 637, 638 (TTAB 1986); *In re Zazzara*, 156 USPQ 348, 348 (TTAB 1967); TMEP §1209.03(g).

In the applicant's response to the first office action dated August 14, 2013, the applicant amended the application to include the translation of MAGNESITA as "magnesite" or "magnesia." The examining attorney has also included translations of MAGNESITA as "magnesite" or "magnesia" from Spanish or Portuguese. The translations are attachments to the office action dated February 27, 2013. Common, modern languages include Spanish, French, Italian, German, Chinese, Japanese, Russian, Polish, Hungarian, Serbian and Yiddish. *See, e.g., Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845, 129 USPQ 411 (C.C.P.A. 1961) (Hungarian); *In re Aquamar, Inc.*, 115 USPQ2d 1122 (TTAB 2015) (Spanish); *In re Tokutake Indus. Co.*, 87 USPQ2d 1697 (TTAB 2008) (Japanese); *In re Joint-Stock Co. "Baik,"* 80 USPQ2d 1305 (TTAB 2006) (Russian); *In re Oriental Daily News, Ltd.*, 230 USPQ 637 (TTAB 1986) (Chinese); *In re Ithaca Indus., Inc.*, 230 USPQ 702 (TTAB 1986) (Italian); *In re Jos. Schlitz Brewing Co.*, 223 USPQ 45 (TTAB 1983) (German); *In re Westbrae Natural Foods, Inc.*, 211 USPQ 642 (TTAB 1981) (Japanese); *In re Optica Int'l*, 196 USPQ 775 (TTAB 1977) (French); *In re Bagel Nosh, Inc.*, 193 USPQ 316 (TTAB 1976) (Yiddish); *In re Hag Aktiengesellschaft*, 155 USPQ 598 (TTAB 1967) (Serbian); *In re New Yorker Cheese Co.*, 130 USPQ 120 (TTAB 1961) (Polish).

In the applicant's request for reconsideration dated May 6, 2015, the applicant attached copies of various websites for refractory products. The applicant's attorney conducted a search of many websites featuring refractory products. The applicant's attorney attached a declaration

attesting to the fact that he conducted a search for the term MAGNESITA on all these websites and did not find the term MAGNESITA on any of these websites. The websites attached are all English language websites. The examining attorney submits that even though the word MAGNESITA is not found on the English language websites provided by the applicant or in English language dictionaries, this is not probative. That is because the foreign equivalent of a merely descriptive English word is no more registrable than the English word itself. “[A] word taken from a well-known foreign modern language, which is, itself, descriptive of a product, will be so considered when it is attempted to be registered as a trade-mark in the United States for the same product. *In re N. Paper Mills*, 64 F.2d 998, 1002, 17 USPQ 492, 493 (C.C.P.A. 1933) See *In re Tokutake Indus. Co.*, 87 USPQ2d 1697 (TTAB 2008) (AYUMI and its Japanese-character equivalent held merely descriptive for footwear where the evidence, including applicant’s own admissions, indicated that the primary meaning of applicant’s mark is “walking”); *In re Oriental Daily News, Inc.*, 230 USPQ 637 (TTAB 1986) (Chinese characters that mean ORIENTAL DAILY NEWS held merely descriptive of newspapers); *In re Geo. A. Hormel & Co.*, 227 USPQ 813 (TTAB 1985) (SAPORITO, an Italian word meaning “tasty,” held merely descriptive because it describes a desirable characteristic of applicant’s dry sausage).

Furthermore, the examining attorney conducted her own search of those same websites for the term “magnesite” or “magnesia.” The results are attached to the denial of the request for reconsideration, dated July, 13, 2015. The examining attorney searched these terms in connection with specific products listed on the websites provided by the applicant. Magnesium Oxide, Magnesia and Magnesite are used interchangeably. (Examining Attorney’s Denial of the Request for Reconsideration, July 13, 2015, page 7) Many of the product information sheets list magnesium oxide as a component of the refractory bricks or other refractory product.

As was discussed in the Denial of the Request for Reconsideration, July 13, 2015, none of the websites list “magnesita” as a component of any of the goods. All of these websites are English language websites; therefore, a Portuguese or Spanish language term would not be expected on any of these websites. However, magnesium oxide, magnesite and magnesia do appear on the product specifications sheets for a variety of the refractory products listed on these websites.

For example, the Zicoa.com website may not have “magnesita” listed as an input in its refractory products. However, the website does state that magnesia is a component in its Zircoa backup products. On the website Firebrickengineers.com, “magnesita” is not mentioned but magnesia is mentioned as a component of its Ladlemax products. The Mineraltec.com website does not list “magnesita” as a component of any of the goods but MgO the chemical symbol for magnesium oxide is listed as a component of the applicant’s goods. (See Denial of the Request for Reconsideration, July 13, 2015, pages 11-28)

Meanwhile, the applicant attached many websites that are not relevant to this application. For example, the applicant also attached excerpts of websites from Wal-Mart®, Home Depot® and Lowe’s®, which are large retailers that sell thousands of different product to the general public. These retailers sell one or two refractory products for residential use. However, the applicant is a large scale industrial supplier of refractory products to the steel and cement industries, among other industries. The applicant has also attached other websites that are tangentially related to refractory products, such as a company that tests “thermal process verification, thermo-analytical instruments and materials testing services” for refractory products.

The applicant's mark, MAGNESITA, translates to magnesite or magnesia, which is a component of the applicant's refractory products in International Class 19. The proposed mark is also generic for the provision of information via global computer network on the use of refractory products to construct, maintain, and repair refractory apparatus using refractory products and the provision of information via global computer network on the use of mechanical equipment and computer models to construct, maintain, and repair refractory installations in International Class 37 because the services relate to magnesite or magnesia as components of the refractory products. Therefore, it is appropriate to translate the proposed mark into English because MAGNESITA translates to magnesite or magnesia from Portuguese and Spanish, which are considered modern languages.

CONCLUSION

The proposed mark, MAGNESITA, means magnesite or magnesia in English. The examining attorney has demonstrated that magnesite or magnesia is a common component in refractory products which are the applicant's goods. As such the proposed mark is generic for the applicant's goods and the related information services regarding such products.

Furthermore, even if the proposed mark is not considered generic for the applicant's goods and services, the applicant has not met the burden of showing the mark has acquired distinctiveness under Section 2(f) because the evidence submitted is insufficient. The examining attorney respectfully requests that the Board affirm the refusal to register the proposed mark under Section 2(e)(1).

Respectfully submitted,

/Dawn Feldman Lehker/

Trademark Examining Attorney

Law Office 111

U.S. Patent and Trademark Office

(571)272-9381

dawn.feldman-lehker@uspto.gov

Robert L. Lorenzo

Managing Attorney

Law Office 111