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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85834316
Applicant	Magnesita Refractories Company
Applied for Mark	MAGNESITA
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APPLICANT'S REPLY BRIEF

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ARGUMENT

Applicant Magnesita Refractories Company respectfully submits the following reply brief in response to the Examining Attorney's Appeal Brief dated November 19, 2015, which suggests that applicant's claim of acquired distinctiveness under Section 2(f) is insufficient and even if the "evidence is substantial and sufficient enough to support a Section 2(f) claim of acquired distinctiveness," "the Section 2(f) claim fails because the proposed mark is generic as applied to the applicant's goods." Applicant respectfully disagrees with the Examining Attorney's conclusions since the Examining Attorney has improperly weighed the significance of Applicant's evidence of acquired distinctiveness and misinterprets Applicant's goods and services, the relevant public, and components of refractory products and services in determining the genericness of the mark.

A. THE EXAMINING ATTORNEY HAS BASED THE INSUFFICIENCY OF THE SECTION 2(F) CLAIM ON A MISUNDERSTANDING OF APPLICANT'S GOODS AND SERVICES

The Examining Attorney on pages 3-5 of the Examining Attorney's Appeal Brief suggests that the Section 2(f) claim is insufficient "[d]ue to the highly descriptive nature of the proposed mark, MAGNESITA." Applicant, however, submits that the purchasing public would have understood that the mark "MAGNESITA" is not highly descriptive of Applicant's goods and services, but is at most merely descriptive and, therefore, the Director should accept as *prima facie* evidence that the mark has become distinctive with proof of substantially exclusive and continuous use for more than five years.

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Specifically, the Examining Attorney fails to appreciate that the amount and character of such evidence depends on the facts of each case, which necessarily varies, depending upon the degree of descriptiveness involved, and becomes progressively greater as the descriptiveness of the term increases. *See In re Mine Safety Appliances Co.*, 66 U.S.P.Q.2d 1694 * 3 (TTAB 2002) (non-precedential) (*citing Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988)); *In re Whitetail Inst. Of North America, Inc.*, 2014 WL 1390517 * 2 (TTAB 2014) (non-precedential).

Instead of merely concluding that the proposed mark is “highly descriptive,” as suggested by the Examining Attorney on page 4 of the Examining Attorney’s Appeal Brief, Applicant submits that the Examining Attorney erred by not establishing whether the mark is highly descriptive by initially determining whether the mark immediately tells prospective customers about the features of the applicant’s goods and services, and then whether the record has a sufficient number of references to establish that the mark is highly descriptive. *See In re Greek Gourmet, Inc.*, 2000 WL 1720159 * 2 (TTAB 2000) (non-precedential); *see also In re the Kyjen Company, Inc.*, 2012 WL 1424429 * 6 (TTAB 2012) (non-precedential), *In re Whitetail Inst. Of North America, Inc.*, 2014 WL 1390517 * 3.

In this case, the Examining Attorney has not provided the necessary evidence to establish that the mark “MAGNESITA” is highly descriptive of Applicant’s goods and services by immediately telling prospective customers about the features of Applicant’s goods and services, as evidenced by a sufficient number of references, but is instead improperly narrowing Applicant’s goods and services to refractory products and services related to magnesite and magnesia.

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For example, the category of goods and services at issue is refractory products and information services, where the goods are “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,” while the services are “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.”

As evidenced by a third party website excerpt about Applicant, “The Company benefits from some of the largest and highest quality reserves of dolomite, magnesite, and talc in the world. Magnesita also has other mineral deposits, including chromite and several clays through Brazil. The Company is able to use 80% (by volume) of its own raw materials in the production of refractories.” *See* page 6 of the Final Office Action in the TSDR dated November 10, 2014. Further, the types of products Applicant produces include: 1) Bricks and Shapes of: Alumina, Alumina Mag Carbon/Mag, Alumina Carbon, Alumina Silicon Carbide, Bottom Pour, Doloma/Magnesia Doloma- fired and cured, Magnesia Carbon, Magnesia Chrome, Magnesia Spinel, and Pre-cast and –basic and alumina and 2) Bulk Refractories of: Castables – basic and alumina, Coatings, Dry Vibratables, Gunning Mixes, Mortars, Plastics, Ramming Mix, and Taphole Mix (at page 7 of the Final Office Action in the TSDR dated November 10, 2014). In other words, Applicant submits that the prospective customers would understand that Applicant’s

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goods and services are related to various products and services having at least alumina, carbon, silicon, and magnesia.

On the other hand, the Examining Attorney has only provided evidence that the English translation of "MAGNESITA" is "magnesite" or "magnesia" and that magnesite and magnesia can be one of several components in refractory products and that one use of magnesia and magnesite is for refractory products. For example, while the Examining Attorney has established magnesia can be used as a component of the goods sold on various websites, e.g. refractory brick, lining, etc., the Examining Attorney has also established that other materials can be used for such refractory products. For instance, as seen in the printed web-page for Vitcas provided by the Examining Attorney on July 13, 2015, the refractory mortars are high alumina refractories, e.g., 44-88% Al_2O_3 with varying concentrations of iron oxide, Fe_2O_3 (at pages 7-9 of the Request for Reconsideration Denied in the TSDR). Similarly, as seen in the printed web-page for Zircoa, the refractory backup primarily includes custom granular Zirconium Oxide in unstabilized (pure) form or stabilized (combined) with yttrium oxide, magnesium oxide, or calcium oxide for structural stability (at page 14 of the Request for Reconsideration Denied in the TSDR). Additionally, while the Examining Attorney has provided evidence that magnesite and magnesia can be used for refractories, the Examining Attorney has also established that magnesite and magnesia can also be used for polycrystalline ceramics, electrical insulation, pharmaceuticals and cosmetics, paper manufacture, etc. (at pages 6-7 of the Office action dated March 26, 2014). In other words, the purchasing public would understand that while magnesite or magnesia can be used in refractory products, not only can magnesite and magnesia be used for other purposes, the refractory products

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themselves are not necessarily composed of magnesite or magnesia, but can instead be primarily composed of alumina, silica, or zirconium.

In fact, the Examining Attorney has not provided any evidence that magnesite, magnesia, or the mark "MAGNESITA" would immediately tell prospective customers that Applicant's goods and services are related 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 "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," respectively. Rather, as evidenced by the declaration filed May 6, 2015, Applicant has not found any instance where the mark "MAGNESITA" was used to describe the refractory product, but rather, only observed the generic terms "castable refractories," "precast refractory shapes," "mortar," "castable," "fire brick," and "refractory brick" as being used to describe the refractory products and information services. *See In re Greek Gourmet, Inc.*, 2000 WL 1720159 * 2 (non-precedential) ("Thus, if it were the case that the mark GREEK GOURMET was highly descriptive, if not generic, as contended by the Examining Attorney, then it is hard to understand how there were fewer than 70 references to this term during a time span of nearly 30 years. The most plausible answer is that this term is not highly descriptive, but rather is, as contended by applicant, simply merely descriptive.")

Therefore, Applicant submits that since the Examining Attorney has not provided any evidence that the terms magnesia, and magnesite, let alone the mark "MAGNESITA" have been

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used by anyone, let alone, by competitors, to immediately describe to prospective customers refractory products and information services, the mark "MAGNESITA" cannot be highly descriptive of the recited products or services, and is at most merely descriptive.

In view of the merely descriptive nature of the mark "MAGNESITA," Applicant submits that the Examining Attorney erred in suggesting that the Section 2(f) claim of acquired distinctiveness is insufficient, since the Examining Attorney should have accepted as *prima facie* evidence that the mark has become distinctive with proof of substantially exclusive and continuous use.

Specifically, the Examining Attorney should have accepted the declarations filed September 23, 2014 and May 6, 2015 as *prima facie* evidence that the mark has acquired distinctiveness based on, at least, the more than five years of exclusive and continuous use of the mark "MAGNESITA." The Declaration of Gross Sales establishes that the mark "MAGNESITA" has been used in association with the sale of refractory products in excess of US \$103,000,000 in 2010, in excess of US \$200,000,000 in 2011, in excess of US \$200,000,000 in 2012, in excess of US \$230,000,000 in 2013, and in excess of \$220,000,000 in 2014. Moreover, Applicant has exclusively and continuously used the mark "MAGNESITA" in commerce since 2008. That is, Applicant has almost sold 1 billion dollars of refractory products during this period under the mark "MAGNESITA," which clearly establishes that the mark "MAGNESITA" indicates that Applicant is the source of the goods and services.

Therefore, similar to this Board's holding in *In re J.T. Posey Co.*, where the Board held that "in view of the facts that (i) there is no dictionary definition for "skin sleeve," (ii) with numerous competitors in the field of medical protective fabric skin coverings for wound

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prevention, there is vague evidence in a website advertisement of only one competitor using the term, and (iii) there are only three academic articles referencing the term “skin sleeves,” we find that SKINSLEEVES is not so highly descriptive that its registrability under Section 2(f) may not be determined on the basis of Applicant’s declaration of substantially exclusive and continuous use since 2004,” this Board should hold that since there is no evidence that the terms magnesite, magnesia, let along the mark “MAGNESITA” is used to describe refractory products or services even in view of the numerous competitors in the field, Applicant’s declaration of substantially exclusive and continuous use should allow registrability under Section 2(f). *In re J.T. Posey Co.*, 2015 WL 5170955 * 14 (TTAB 2015) (non-precedential).

For at least this reason, Applicant submits that the Examining Attorney has improperly weighed the evidence for the claim of acquired distinctiveness to determine Applicant’s claim of acquired distinctiveness as being insufficient, and the reversal of the Examining Attorney’s refusal is requested.

**B. THE EXAMINING ATTORNEY ERRED IN DETERMINING
GENERICNESS OF THE MARK BY MISCHARACTERIZING THE
RELEVANT PUBLIC.**

The Examining Attorney on page 6 of the Examining Attorney’s Appeal Brief maintains the erroneous characterizing of the relevant public as only large-scale industrial consumers. Specifically, the Examining Attorney points to the article submitted by the Applicant that Magnesita controls 70% of the steel refractories market and 80% of the cement refractories market and the fact that the quantity of sales of the refractory product is in “metric tons.”

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As discussed by the Court of Appeals for the Federal Circuit (“CAFC”), however, the relevant public is limited to actual or potential purchasers of the goods or services. *Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 641 (Fed. Cir. 1991). In making this determination, the TTAB should look at the identification of goods to determine the potential or actual customers. *Id.* at 641.

In so doing, instead of relying on Applicant’s business and sales, the Examining Attorney still continues to err in making its genericness determination by not relying on the definition of goods and services of the present application to determine the actual or potential customers of the identified goods. Applicant submits that since the relevant public for a genericness determination is the ***actual or potential purchaser*** of the goods or services, the relevant public in this case is any actual or potential purchaser of refractory products or information services, which in this case is the general public. *See Magic Wand, Inc.*, 940 F.2d at 641. As is clear from the plain reading of the identification of goods in Class 19 “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 services in Class 37 “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 refractory products and information services are not limited to a particular group of customers, but to ***any actual or potential purchaser***. In other words, since any doubt on the issue of genericness is resolved in favor of the applicant, the relevant public in this genericness determination is the general public, because the general public actually or potentially purchases

the refractory products and information services. *See In re Interfashion U.S.A., Inc.*, 2006 WL 3147914 * 3 (TTAB 2006).

C. THE EXAMINING ATTORNEY INCORRECTLY MISCHARACTERIZES APPLICANT'S GOODS AND SERVICES IN MAKING A GENERICNESS DETERMINATION

The Examining Attorney on page 7 of the Examining Attorney's Appeal Brief suggests that 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 services. The Examining Attorney then suggests that since different chemical dictionaries suggest that the primary use of the goods are for metallurgical furnace products, "it is clear that applicant's proposed mark is generic for applicant's refractory goods and services."

Even assuming, but not admitting, that the relevant public is in fact large industrial consumers, as suggested by the Examining Attorney, Applicant submits that in determining the second step of the genericness determination, the court must determine whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question. *See H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 U.S.P.Q. 528 (Fed. Cir. 1986); *see also* TMEP § 1209.01(c).

As an initial matter, Applicant submits that the Examining Attorney has not established that magnesia or magnesite, let alone the mark "MAGNESITA," is a primary component in all refractory products or that magnesia or magnesite is only used as refractory products. Rather, as clearly seen in the evidence of record, refractory products can be made from a number of different materials, including calcia, yttria, magnesia, silica, and alumina. For instance, as seen in the

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printed web-page for Vitcas provided by the Examining Attorney on July 13, 2015, the refractory mortars are high alumina refractories, e.g., 44-88% Al_2O_3 with varying concentrations of iron oxide, Fe_2O_3 (at pages 7-8 of the Request for Reconsideration Denied in the TSDR). Similarly, as seen in the printed web-page for Zircoa, the refractory backup primarily includes custom granular Zirconium Oxide in unstabilized (pure) form or stabilized (combined) with yttrium oxide, magnesium oxide, or calcium oxide for structural stability (at pages 14-16 of the Request for Reconsideration Denied in the TSDR). Additionally, while the Examining Attorney has provided evidence that magnesite and magnesia can be used for refractories, the Examining Attorney has also established that magnesite and magnesia can also be used for polycrystalline ceramics, electrical insulation, pharmaceuticals and cosmetics, paper manufacture, etc. (at pages 6-7 of the Office Action dated March 26, 2014).

Moreover, Applicant submits that Applicant's products include: 1) Bricks and Shapes of: Alumina, Alumina Mag Carbon/Mag, Alumina Carbon, Alumina Silicon Carbide, Bottom Pour, Doloma/Magnesia Doloma- fired and cured, Magnesia Carbon, Magnesia Chrome, Magnesia Spinel, and Pre-cast and –basic and alumina and 2) Bulk Refractories of: Castables – basic and alumina, Coatings, Dry Vibratables, Gunning Mixes, Mortars, Plastics, Ramming Mix, and Taphole Mix (page 7 of the Final Office Action in the TSDR dated November 10, 2014).

That is, while 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, in this case, the Examining Attorney has failed to establish that magnesite, magnesia, or let alone the mark "MAGNESITA" is a key component in refractory products, let alone, a key component in Applicant's goods and services in the present application.

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Nevertheless, Applicant submits that the test for genericness is not whether any ingredient may be generic for the goods and services, but rather, whether the relevant public would *primarily* use or understand the term sought to be protected to refer to the genus of goods and services in question. *See H. Marvin Ginn Corp.*, 782 F.2d at 991.

In this case, Applicant submits that the Examining Attorney has not provided record evidence that establishes that magnesite, magnesia, or the term "MAGNESITA" is used by the relevant public to *primarily refer* to the class of refractory products and information services claimed by Applicant. Rather, the Examining Attorney only predominantly relies on the fact that since magnesia or magnesite is used in refractory products, "it is clear that magnesite or magnesia is an important component in refractory products" to determine that the mark "MAGNESITA" is generic. As discussed above, however, the relevant public would have understood that refractory products are not limited to only products containing magnesite or magnesia, but also include different materials, including calcia, yttria, silica, and alumina. In so doing, Applicant argued on page 14 of the Applicant's Brief of September 21, 2015 that the relevant public uses the terms "castable refractories," "precast refractory shapes," "mortar," "castable," "fire brick," and "refractory brick" as the generic terms for various refractory products and information services, but does not use magnesite, magnesia, or the mark "MAGNESITA" to refer to such refractory products, which the Examining Attorney disregards and does not take into account. For example, Allied Mineral Products refers to its products as "refractory products," "castable refractories," and "precast refractory shapes." (Dec. ¶ 4) (Declaration filed with the Request for Reconsideration of May 6, 2015). Similarly, BNZ Materials, Inc. uses the generic term "insulating firebrick, (Dec. ¶

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7), while Fire Brick Engineers Company uses the generic terms “refractory products” and “fire brick.” (Dec. ¶ 12).

In other words, while the Examining Attorney has established that other competitors use magnesite or magnesia as an ingredient or component, in some of their refractory products, the Examining Attorney has not provided any evidence that the relevant public, let alone competitors, use magnesite, magnesia, or the mark “MAGNESITA” to *primarily refer* to any of the competitors’ refractory products or services. *See In re Minnetonka, Inc.*, 3 USPQ2d 1711, 1987 WL 124303 * 3 (TTAB 1987) (“This body of evidence is persuasive, and the Examining Attorney does not claim otherwise, to show that there exists a fairly substantial number of competitors in the business of selling liquid hand soap; that none of these competitors uses the term ‘soft soap’ descriptively, generically or otherwise in connection with its product.”)

In fact, the Examining Attorney is failing to appreciate that Applicant’s goods and services are not magnesia or magnesite, but rather the goods are “refractory products not made primarily of metal” and services for “providing information via a global computer network on the use of refractory products,” where magnesite is a compound in Class 1 and not in Class 19 or 37.

That is, Applicant does not observe the necessary clear evidence that establishes that the relevant public uses or understands the terms magnesia and magnesite, let alone the term “MAGNESITA,” to *primarily refer* to the refractory brick or lining, i.e., the record lacks clear evidence that shows that the terms magnesia, magnesite, or “MAGNESITA” are generic and *primarily refer* to the refractory brick or lining being sold.

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Since the Examining Attorney has failed to establish by clear evidence that the mark "MAGNESITA" is generic for the identified goods and services, the reversal of the Examining Attorney's genericness determination is requested.

CONCLUSION

Applicant respectfully submits that the application should be approved for registration on the Principal Register because the mark "MAGNESITA" is not generic for the recited goods in the present application and has acquired distinctiveness. Applicant respectfully requests that this Board reverse the refusal of registration.

Respectfully submitted,

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