This Opinion is not a
Precedent of the TTAB

Hearing: March 15, 2016 Mailed: May 17, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Magnesita Refractories Company

Serial Nos. 77873477, 85834316[1]

Thomas J. Moore of Bacon & Thomas PLLC,
for Magnesita Refractories Company.

Dawn Feldman Lehker, Trademark Examining Attorney, Law Office 111,
Robert L. Lorenzo, Managing Attorney.

Before Quinn, Kuhlke and Lykos,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Magnesita Refractories Company ("Applicant") seeks registration of the word MAGNESITA as a standard character mark.

Application Serial No. 77873477

In Application Serial No. 77873477, Applicant seeks to register the applied-for matter for:

[1] In view of the common issues present in these appeals, the appeals were consolidated for the hearing and the Board is deciding them in this single decision. Citations to the record and briefs are to Application Serial No. 77873477 unless otherwise noted.

> 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, in International Class 19; and
>
> Providing information via a global computer network on constructing, maintaining, and repairing refractory apparatus using refractory products, in International Class 37.

The Application was filed on November 19, 2009 under Section 1(b) of the Trademark Act based on a *bona fide* intention to use the applied-for matter in commerce. The Application includes the following translation statement: The English translation of "MAGNESITA" is "magnesia" or "magnesite."

The Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that the applied-for matter is merely descriptive of Applicant's goods and services. After the Examining Attorney issued a final refusal, on June 13, 2011, Applicant filed an Amendment to Allege Use and a Request for Reconsideration. In addition, on September 30, 2013, Applicant amended its application to seek registration under Section 2(f), 15 U.S.C. § 1052(f), based on acquired distinctiveness. The Examining Attorney continued to refuse registration based on mere descriptiveness under Section 2(e)(1), indicating the showing under Section 2(f) was insufficient. On March 29, 2014, Applicant filed a Request for Reconsideration and an amendment to the Supplemental Register. The Examining Attorney accepted the amendment to the Supplemental Register for the services in International Class 37, but refused registration on the Supplemental Register for the goods in International Class 19 under Section 23(c), 15 U.S.C. §

1091(c), of the Trademark Act on the ground that MAGNESITA is generic for those goods.

Thus, the only issue remaining for determination by the Board in Application Serial No. 77873477 is whether MAGNESITA is generic for the goods listed in Class 19 and therefore unregistrable on the Supplemental Register.[2]

Application Serial No. 85834316

In Application Serial No. 85834316, Applicant seeks to register the applied-for matter 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, in International Class 19; 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, in International Class 37.

This application was filed on January 28, 2013, under Section 1(a) of the Trademark Act based on an allegation of first use and use in commerce on October 1, 2010. During prosecution of the application Applicant amended its date of first use to October, 2008. The Application includes the following translation statement: The

[2] Regardless of the outcome of this decision, Applicant's services in Application Serial No. 77873477 in International Class 37 will go forward for registration on the Supplemental Register.

English translation of "MAGNESITA" in the mark is "MAGNESITE" or "MAGNESIA."

The Trademark Examining Attorney initially refused registration of Applicant's applied-for matter under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant's applied-for matter is merely descriptive for the goods and services. In response to the refusal Applicant asserted acquired distinctiveness under Section 2(f). The Examining Attorney continued the refusal of mere descriptiveness, asserting that the applied-for matter is highly descriptive and the Section 2(f) showing was insufficient. In the November 10, 2014 Office action, the Examining Attorney refused registration as to the goods in Class 19 on the ground that the applied-for matter is generic or highly descriptive for such goods and as to the services in Class 37 that the applied-for matter is highly descriptive and the showing under Section 2(f) is insufficient to establish acquired distinctiveness.

Thus, the remaining issues for the Board to determine in Application Serial No. 85834316 are (1) whether MAGNESITA is generic for the goods in Class 19 or in the alternative merely descriptive and the 2(f) showing is insufficient, and (2) whether MAGNESITA is merely descriptive for the services in Class 37 and the 2(f) showing is insufficient.

When the refusals in both applications were made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the requests for reconsideration, the appeals were resumed and briefs were filed. We affirm the refusals to register.

Standard of review

As a preliminary matter, Applicant argues that the Board's "standard of review should be reconsidered in view of the Supreme Court's decision the case *B&B Hardware, Inc. v. Hargis Industries, Inc.*, [135 S. Ct. 1293, 113 USPQ2d 204 (2015)]," and that the burden of persuasion should be on the Examining Attorney. 9 TTABVUE 14 (App. Serial No. 85834316). We first point out that this is an *ex parte* appeal not *inter partes* litigation, which was the subject matter of the Court's decision in *B&B Hardware v. Hargis*. *See In re Cordua Restaurants, Inc.*, ___ F.3d ___, ___ USPQ2d ___ n.2 (Fed. Cir. May 13, 2016) ("The [Supreme] Court held that issue preclusion did apply to a TTAB decision in an *inter partes* opposition proceeding, noting that the procedures there resembled the procedures of a district court. … But there is no suggestion in *B&B Hardware* that an examiner's decision to register a mark or to refuse registration satisfies the traditional requirements of issue preclusion.").

In any event, the burden always has and continues to fall on the USPTO. It is the burden of the USPTO to establish a *prima facie* case for its refusals, which may be rebutted by an applicant. In the case of establishing genericness, 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 Hotels.com*, 573 F.3d 1300, 91 USPQ2d 1532, 1533 (Fed. Cir. 2009). In the case of establishing acquired distinctiveness, the burden again falls on the USPTO to establish that the applied-for matter is merely descriptive, unless conceded by an applicant by not preserving its arguments based on inherent distinctiveness when amending to assert acquired

distinctiveness. *In re Pacer Technology*, 338 F.3d 1348, 67 USPQ2d 1629, 1630 (Fed. Cir. 2007) ("It is well established that the PTO has the burden to establish a *prima facie* case of no inherent distinctiveness."). Further, "[o]nce the PTO sets forth a sufficient *prima facie* case, the burden shifts to the applicant to come forward with evidence to rebut the *prima facie* case." *Id.* at 1631. If an applicant rebuts a mere descriptiveness refusal by seeking registration based on acquired distinctiveness, it is applicant's burden to establish a *prima facie* case of acquired distinctiveness. *See Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). Applicant does not point to any language in the *B & B Hardware* decision or elsewhere that shifts the burden of persuasion on the issue of acquired distinctiveness in an *ex parte* appeal from Applicant to the Examining Attorney. We observe that because acquired distinctiveness serves as a rebuttal to a mere descriptiveness refusal, the burden appropriately resides with Applicant. As a result, we find that it remains Applicant's burden of demonstrating that a proposed mark has acquired distinctiveness under Section 2(f).[3] *Yamaha*, 6 USPQ2d at 1001.

Is MAGNESITA generic for the applied-for goods?

A generic term "is the common descriptive name of a class of goods or services." *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015) (quoting *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*,

[3] We further observe that acquired distinctiveness of a designation under Section 2(f) is not a "static target," and an adverse decision by the Board on the issue of acquired distinctiveness does not preclude an applicant from the opportunity to later show that its proposed mark has acquired distinctiveness under Section 2(f) at a future date on a different record.

782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)). Because generic terms "are by definition incapable of indicating a particular source of the goods or services," they cannot be registered as trademarks. *Id.* (quoting *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001)). "The critical issue in genericness cases is 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." *Id.* (quoting *Marvin Ginn*, 228 USPQ at 530). 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. *See also Princeton Vanguard*, 114 USPQ2d at 1829 ("there is only one legal standard for genericness: the two-part test set forth in *Marvin Ginn*"). "An inquiry into the public's understanding of a mark requires consideration of the mark as a whole." *Id*. at 1831 (quoting *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005)). 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. *Id*. at 1830; *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986).

In an *ex parte* appeal, as noted above the USPTO must establish by clear evidence that a mark is generic and, thus, unregistrable. *In re Hotels.com*, 91 USPQ2d at 1533; *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987); *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed.

Cir. 1987). "Doubt on the issue of genericness is resolved in favor of the applicant." *In re DNI Holdings Ltd.*, 77 USPQ2d 1432, 1437 (TTAB 2005).

We begin by finding that the genus at issue in this case is adequately defined by Applicant's identification of goods, "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"; "and pre-cast refractory shapes" ("refractory products"). *See Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) ("[A] proper genericness inquiry focuses on the description of [goods or] services set forth in the [application or] certificate of registration"). We further find that the "relevant public" consists of the public at large, namely, ordinary consumers who purchase such refractory products, which, as the record shows, ranges from retail purchasers of household products to industrial purchasers for commercial operations. We note that the record evidence reveals that Applicant's customers are industrial operators, although the identification of goods is not so limited.

We turn then to determine whether MAGNESITA is understood by the relevant purchasing public as primarily referring to refractory products. In starting our analysis, we note that the foreign equivalent of a generic English term is no more registrable than the English term itself. "Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine genericness, descriptiveness, as well as similarity of connotation in order to ascertain confusing similarity with English word marks." *Palm Bay Imps. Inc. v. Veuve Clicquot*

Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005) (citations omitted); *In re Sambado & Son Inc.*, 45 USPQ2d 1312, 1315 (TTAB 1997) (FRUTTA FRESCA is equivalent to "fresh fruit" and thus generic and unregistrable for goods including "fresh fruits"). *See also Cordua Rests., Inc.*, ___ USPQ2d ___. The doctrine is not an absolute rule, however, and is subject to several limitations. It does not apply to words from dead or obscure languages, *In re Spirits Int'l N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1491 (Fed. Cir. 2009) (citing 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:34 (4th ed. 2009)), and caution is indicated when the foreign term and the English to which it is compared are not exact synonyms, *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983). As a general principle, the doctrine of foreign equivalents is limited to situations in which an American consumer is likely to "stop and translate" the foreign words into their English equivalent. *Palm Bay*, 73 USPQ2d at 1696 (quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976). The ordinary American purchaser includes "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.*, 90 USPQ2d at 1492.

The record includes translations for MAGNESITA from three languages. In Italian the English equivalent is MAGNESIA. In Spanish and Portuguese the English equivalent is MAGNESITE.[4]

[4] March 18, 2010 Response p. 1. *See also* A PORTUGUESE-ENGLISH DICTIONARY (1958) March 27, 2014 Office action p. 23; Spanish Dictionary (www.spanishdict.com) February 27, 2013 Office action p. 2 (App. Serial No. 85834316).

We find it appropriate to apply the doctrine of foreign equivalents in this case. There is no evidence of record suggesting that the translation in this application is inaccurate, that MAGNESITA is so obscure it would not be easily recognized and translated by Spanish, Portuguese or Italian speakers in the U.S. marketplace, or that it is an idiom which is not equivalent to its direct English translation. Also, there can be no doubt that Spanish, Portuguese and Italian are common, modern languages.[5] *See Cordua Rests., Inc.*, ___ USPQ2d ___ ("Because 'churrasco' is a common word in Spanish and Portuguese and because the '191 Application itself concedes that 'churrascos' means 'barbecue,' the PTO would have been justified in translating 'churrascos' into 'barbecue' and subsequently determining whether the term 'barbecue' is generic when applied to restaurant services."). Purchasers of refractory products familiar with Spanish, Portuguese or Italian are likely to "stop and translate" MAGNESITA when encountering it used in connection with refractory products. We, therefore, find Applicant's mark to be equivalent to the English words "magnesite" and "magnesia" for purposes of determining genericness.

Applicant is described on its website as follows:

> Magnesita is the most integrated refractory industry in the world … Over 70% of the raw material used in production is taken from its own mines.[6]

[5] Spanish is widely spoken in the United States. See Spanish.about.com ("a new analysis of information gathered during the 2000 U.S. Census shows that nearly one out of five Americans speak a language other than English at home - and the vast majority of them speak Spanish."). November 5, 2010 Office action p. 8-9 and www.wikipedia.org ("Spanish is the second most-common language in the United States after English.") *Id.* at 11.

[6] February 22, 2013 Response p. 2.

In addition, the Examining Attorney submitted an excerpt from The Refractories Institute that includes the following information about Applicant:

> Magnesita Refratários S.A. … is a vertically integrated refractory producer supplying the steel, cement and various other industries. In addition, the Company exports some of its raw materials, DBM (Dead Burned Magnesia), and refractories to a wide range of countries. … The Company benefits from some of the largest and highest quality reserves of dolomite, magnesite and talc in the world. … Types of Products: Bricks and Shapes: … Magnesia Carbon, Magnesia Chrome, Magnesia Spinel[7]

The record includes the following definitions, descriptions of and use for "magnesite" and "magnesia":

> Magnesite: a mineral $MgCO_3$ that consists of magnesium carbonate, that is isomorphous with siderite and calcite, and that is used chiefly in making refractories and magnesia;[8]
>
> Magnesite uses include: refractory bricks, cement;[9]
>
> Magnesite – Magnesium Carbonate $MgCO_3$ … Uses … Dead-burned magnesia –DBM Sinter magnesia Basic refractories … Magnesium chloride - Cement Ceramics and refractories;[10]
>
> Peter W. Harben, Inc. showing magnesite and magnesia as a mineral used for refractories;[11]
>
> Similar to the production of lime, magnesite can be burned in the presence of charcoal to produce MgO, otherwise

[7] February 27, 2013 Office action pp. 12-13 (App. Serial No. 85834316).

[8] MERRIAM-WEBSTER UNABRIDGED DICTIONARY (2014), June 4, 2014 Response p. 2 (App. Serial No. 85834316).

[9] geology.com March 30, 2010 Office Action p. 2.

[10] mineralszone.com March 30, 2010 Office action at 6-8.

[11] peterharben.com March 30, 2010 Office action at 9.

known as periclase. Such periclase is an important product in refractory materials;[12]

Magnesite – noun a mineral, magnesium carbonate, $MgCO_3$, having a characteristic conchoidal fracture and usually occurring in white masses.;[13]

Magnesite is used as a refractory material, a catalyst and filler in the production of synthetic rubber, and a material in the preparation of magnesium chemicals and fertilizers;[14]

When heated to 1400-1500 ˚C, pure magnesite will be "dead burnt," containing less than 0.5% carbon dioxide. This is used as a refractory in the metallurgical industry;[15]

The Clay Brick & Product Manufacturing industry comprises establishments primarily engaged in manufacturing … fabricated nonclay refractories such as graphite, magnesite, silica, or alumina crucibles … ;[16]

What is Magnesia? Magnesia is a term used to describe various products from magnesium-rich sources. … The two most important magnesium minerals are magnesite ($MgCO_3$) and brucite ($Mv(OH)_2$). Magnesite is the most common source of magnesia and serves many important industrial applications. … The two most commercially important magnesia products are dead-burned magnesia and caustic-calcined magnesia. … Dead-burned magnesia, also known as refractory magnesia, is produced from the heating of magnesite or magnesium hydroxide and is the primary component in refractory materials. The refractory industry is the greatest consumer of magnesium compounds, overall. Refractory materials are nonmetallic substances which are extremely heat resistant and are of great industrial value as the linings in furnaces, kilns, and

[12] wikipedia.org March 30, 2010 Office action at 15.

[13] Dictionary.reference.com based on RANDOM HOUSE DICTIONARY (2010) November 5, 2010 Office action p. 2.

[14] Dictionary.reference.com November 5, 2010 Office action p. 3.

[15] Proquest (proquest.umi.com) May 27, 2011 Office action p. 4.

[16] Proquest (proquest.umi.com) May 27, 2011 Office action p. 5.

reactors. The steel industry, for instance, is the largest user of refractory magnesia;[17]

Magnesia. Magnesium oxide that has been specially processed. … magnesite. . … The term magnesite is loosely used as a synonym for magnesia as are also the terms caustic-calcined magnesite, dead-burned magnesite, and synthetic magnesite. … Use: To make the various grades of magnesium oxide, to produce carbon dioxide, refractory. … magnesite, dead-burned … MgO. The granular product obtained by burning (firing) magnesite or other substances convertible to magnesia upon heating above 1450C long enough to form granules suitable for use as a refractory (ASMT). Use: Refractories, as grains or basic brick, the latter especially in open hearth furnaces for steel, furnaces for nonferrous metal smelting, and in cement and other kilns;[18]

Dead-burned magnesia from magnesite, seawater, or well and like brines is used as a principal constituent in metallurgical furnace refractory products;[19]

Magnesite. A white to bluish-gray mineral used in the manufacture of bricks for basic refractory furnace linings and as an ore of magnesium;[20]

Magnesia refractory … Heat- and corrosion-resistant material made of magnesium oxide; used in cement or brick form to line high-temperature process vessels or furnaces;[21]

---

[17] Industrial Minerals Association North America (ima-na.org) January 9, 2012 p. 5-6.

[18] HAWLEY'S CONDENSED CHEMICAL DICTIONARY (14th ed. 2001) March 27, 2014 Office action pp. 2-5.

[19] CONCISE ENCYCLOPEDIA OF CHEMICAL TECHNOLOGY VOL. 2 (5th ed. 2007) March 27, 2014 Office action p. 7.

[20] MATERIALS HANDBOOK (14th ed. 1997) March 27, 2014 Office action p. 11.

[21] DICTIONARY OF MATERIALS SCIENCE (2003) March 27, 2014 Office action p. 15.

> The oxides of aluminum (alumina), silicon (silica) and magnesium (magnesia) are the most important materials used in the manufacturing of refractories.[22]

Given its importance as a refractory material it is not surprising to find it used in naming various products. In the following examples "magnesite" and "magnesia" are used in naming a type of brick:

> Magnesia brick … Refractory brick produced from sintering or melting magnesia (s. Magnesia). Additional references: Basic lining Limestone Magnesia-chrome brickMagnesia brickMagnesite massLining … Magnesite mass Refractory mass produced from sintering or melting magnesia (s. Magnesia). Additional references: MagnesiteMagnesia brick, Magnesia-chrome brick Refractory materials Lining;[23]

> High grade DBM [dead burned magnesia] and EFM [electro fused magnesia] are used mainly in bricks/shapes to produce the following refractories: Magnesia carbon bricks, magnesia bricks, magnesia chrome bricks, magnesia spinel bricks, magnesia dolomite bricks, magnesia carbon alumina bricks;[24]

> RHI Basic bricks … Magnesite bricks RHI's objective is to increase your profitability. We do so by achieving a long service life with a high-quality selection of RHI refractory bricks. The right products to withstand severe conditions in alternative fuel fired cement kilns. … Top-grade magnesia spinel bricks … Magnesia chromite bricks.[25]

---

[22] Wikipedia (wikipedia.org) July 18, 2014 Office action p. 10.

[23] Foundry Lexicon (www.giessereilexikon.com) July 18, 2014 Office action pp. 3-4.

[24] ISPAT Guru (ispatguru.com) February 26, 2015 Office action p. 4.

[25] RHI (www.rhi-ag.com) November 10, 2014 Office action p. 2 (App. Serial No. 85834316).

The record also includes examples of other companies using the words "magnesite" or "magnesia" in connection with refractory products:

> Zircoa … Refractory Backup (Thermal Insulation) Extend the life of your furnace, and maintain tighter control over your furnace temperatures with Zircoa's pre-sintered grog refractory backup, Zircoa Backup 1859 –partially stabilized with magnesia and calcia. … Burner blocks are engineered to withstand high temperatures and the contaminants present in fuel oil, while providing the added resistance to corrosion. Either Calcia, Ytria or Magnesia stabilized Zirconium Oxide compositions will satisfy your unique requirements and extend burner block life to more than one year.;[26]
>
> Fire Brick Engineers Company … Refractory Brick Products … Brick by Resco, An American Owned Refractory Company … LadleMax AMG is an 80% alumina brick containing magnesia, antioxidants, and graphite. … This product is recommended for ladle bottoms and barrels of steel shops making aluminum-killed steels. … LadleMax AMG 90 SL is similar to AMG 90, but contains a higher quantity of magnesia for improved slag resistance.;[27]
>
> Minerals Technologies … Ferrocon SGS series, sprayable coating material is a proven performer for tundish wear lining. … It can be sprayed on any refractory surface up to 80˚C, which enables the steelmaker to utilize residual heat … Ferrocon Tundish Boards are designed and manufactured both in magnesite and silica compositions to match specific steel production needs. … FILLMIX 85T is a magnesite based moldable water-free mix for tundish coating.;[28]

[26] Zircoa (www.zircoa.com) February 26, 2015 Office action pp. 7-8.

[27] Fire Brick Engineers (www.firebrickengineers.com) February 26, 2015 Office action pp. 14 15.

[28] Minerals Tech (www.mineralstech.com) February 26, 2015 Office action pp. 18-20.

> Mt. Savage Firebrick … Tech Data Fireclay … Typical Chemical Analysis … Magnesium Oxide (MgO) .89;[29]
>
> Harbison Walker Refractories Company … Guidon … Classification: Burned Fused Grain Magnesite – Chrome Brick;[30]
>
> Plibrico Company LLC … Product Description A high alumina, magnesium aluminate spinel enriched, low cement castable. Vibration cast only.;[31]
>
> Morgan ThermalCeramics … Triangle 95C Magnesia … Description A high purity cast magnesia … Applications Induction melting crucibles for special alloy applications.;[32]
>
> Refractories Dead Burnt Magnesite/Fused Magnesite … This [sic] products are used in: Refractory Industry for manufacture of Basic Refractory Bricks … ;[33]
>
> Grecian Magnesite … New refractory fused magnesia product under the "PyrMag" brand, launched by Grecian Magnesite … for ever demanding, high-end refractory applications. … .[34]

There is no dispute and the record makes clear that magnesite and magnesia are the names of elements used in refractory products, including refractory bricks. Moreover, the record shows magnesite and magnesia are significant aspects of the refractory products. *See Cordua Rests. Inc.*, ___ USPQ2d ___ (quoting 2 McCarthy §12:23) ("A generic name of goods may also be a generic name of the services of selling

[29] Technical Data Sheet February 26, 2015 Office action p. 25.

[30] Technical Data Sheet February 26, 2015 Office action p. 26.

[31] Technical Data Sheet February 26, 2015 Office action p. 27.

[32] Technical Data Sheet February 26, 2015 Office action p. 28.

[33] Hindustan Produce Company (www.hindustanproduceco.com) November 10, 2014 Office action p. 5 (App. Serial No. 85834316).

[34] Grecian Magnesite (www.grecianmagnesite.com) November 10, 2014 Office action p. 8 (App. Serial No. 85834316).

or designing those goods."); *In re Hask Toiletries, Inc.*, 223 USPQ 1254 (TTAB 1984) (HENNA 'N' PLACENTA for hair conditioner, "designation accurately describes the two key elements of the product to which applied, invests these generic terms with no special or new significance or different commercial impression to support a finding of trademark 'capability'"). Significantly, the record includes examples where magnesite or magnesia are used to name or refer to a type of refractory brick (*e.g.*, magnesite brick, magnesia-chrome brick). Based on this evidence we have no doubt that potential purchasers familiar with Spanish, Portuguese or Italian would understand MAGNESITA to refer, at minimum, to a type of refractory brick, *i.e.*, a magnesite brick. *In re Central Sprinkler Co.*, 49 USPQ2d 1194 (TTAB 1998) (ATTIC generic for sprinklers because consumers would understand it to refer to a category of sprinklers). If the proposed mark is held generic for any of the goods identified in a class of an involved application, registration is properly refused. *See In re Analog Devices, Inc.*, 6 USPQ2d 1808, 1810 (TTAB 1988), *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989) (unpublished); and *In re Quick-Print Copy Shop, Inc.*, 205 USPQ 505, 507. *See also Cordua, Rests, Inc.*, ___ USPQ2d ___ ("[A] term is generic of the relevant public understands the term to refer to part of the claimed genus of goods or services, even if the public does not understand the term to refer to the broad genus as a whole.").

Applicant argues that other names are used for refractory products but that does not make this one less generic because "any term that the relevant public understands to refer to the genus … is generic." *In re 1800Mattress.com IP LLC*, 586

F.3d 1359, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009). Moreover, simply because magnesite is generic for a mineral does not mean it cannot be generic for other goods.[35] In view of our findings, we hold that MAGNESITA is generic for the Class 19 goods.

Has MAGNESITA acquired distinctiveness?

We turn to the remaining issues in Application Serial No. 85834316, *i.e.*, whether the showing of acquired distinctiveness is sufficient to allow for registration of the merely descriptive term MAGNESITA for the goods or services.[36]

As noted above, in response to the mere descriptiveness refusals, Applicant submitted declarations asserting acquired distinctiveness. "[W]here registration was initially sought on the basis of distinctiveness, subsequent reliance by the applicant on Section 2(f) assumes that the mark has been shown or conceded to be merely descriptive." *Yamaha*, 6 USPQ2d at 1001. Accordingly, Applicant's claim of acquired distinctiveness is a concession that the mark is merely descriptive. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1233 (TTAB 2014), *aff'd*, *Cordua, Rests, Inc.*, ___ USPQ2d ___. Moreover, Applicant has the burden to establish a *prima facie* case of acquired distinctiveness. *Yamaha*, 6 USPQ2d at 1006.

[35] In support of its position that MAGNESITA is not generic, Applicant submitted evidence that it found no use of the term MAGNESITA on English language websites. This is not surprising or probative given it is not an English word.

[36] In view of our finding that the applied-for matter is generic for the goods in International Class 19, the refusal of registration must be affirmed. But for completeness we address the alternative issue of whether Applicant's proposed mark is merely descriptive and if it has acquired distinctiveness for those goods.

The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *See Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34, 39 (CCPA 1970). Where a mark is highly descriptive, more evidence is required. *See, e.g., In re Steelbuilding.com,* 75 USPQ2d at 1420 ("[T]he applicant's burden of showing acquired distinctiveness increases with the level of descriptiveness; a more descriptive term requires more evidence of secondary meaning."); *In re Bongrain Int'l Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990). Based on the evidence discussed above, we find that Applicant's mark is highly descriptive as used in connection with its goods and services.

In support of its assertion of acquired distinctiveness in Application Serial No. 85834315, Applicant submitted:[37] (1) a declaration by Applicant's outside counsel Thomas J. Moore, attesting to substantial and exclusive use since October 1, 2010;[38] (2) a Canadian registration for the mark MAGNESITA;[39] (3) a declaration by Kelly L. Myers, Applicant's General Counsel, attesting to gross sales between 2010 and

[37] Prior to seeking amendment to the Supplemental Register, Applicant submitted similar evidence in Application Serial No. 77873477: (1) a printout of its website showing its use (February 22, 2013 Response p. 2); (2) its International Registration No. 1050641 for the mark magnesita (February 22, 2013 Response p. 3); (3) a declaration by Kelly L. Myers, Applicant's General Counsel, attesting to substantially exclusive and continuous use in commerce in the United States "at least as early as October 1, 2010" for the goods and "at least as early as May 5, 2011" for the services (September 30, 2013 Response p. 2); (4) a Canadian registration for the mark MAGNESITA (March 14, 2014 Response p. 2); (5) an article from the trade publication *Industrial Minerals* showing Applicant's date of first use dating back to October, 2008 (March 14, 2014 Response p. 4); and (6) a declaration by Kelly L. Myers, attesting to gross sales between 2010 and 2012 (March 14, 2014 Response p. 6).

[38] March 6, 2014 Response p. 4 (App. Serial No. 85834316).

[39] March 6, 2014 Response p. 2 (App. Serial No. 85834316).

2012;[40] (4) an article from the trade publication *Industrial Minerals* showing Applicant's date of first use dating back to October 2008;[41] (5) a declaration by Kelly L. Myers attesting to gross sales in 2014;[42] and (6) a declaration by Thomas J. Moore attesting to Internet searches showing no third-party use of MAGNESITA for refractory products.[43]

While we *may* accept as *prima facie* evidence that a mark has become distinctive, "proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made," 15 U.S.C. § 1052(f), because the mark is highly descriptive the statement of five years use alone is not sufficient.[44] Evidence of acquired distinctiveness can include the length of use of the mark, advertising expenditures, sales, survey evidence, and affidavits of customers asserting source-indicating recognition.

Despite the substantial gross annual sales, and length of use, there is no evidence of the extent to which the public perceives the term MAGNESITA as indicating source

---

[40] September 23, 2014 Response p. 2 (App. Serial No. 85834316).

[41] May 6, 2015 Response p. 2 (App. Serial No. 85834316).

[42] May 6, 2015 Response p. 4 (App. Serial No. 85834316).

[43] May 6, 2015 Response pp. 5-48 (App. Serial No. 85834316). A similar declaration with attached exhibits was submitted in Application Serial No. 77873477 for the purpose of showing no generic use of the term MAGNESITA as referenced *infra*. December 17, 2014 Response pp. 2-45.

[44] We note the actual declaration does not attest to five years use prior to the date of the declaration; however, we apply Applicant's later assertions regarding its earlier date of first use to its assertion of substantially exclusive use, which calculates to five and a half years in Application Serial No. 85834316.

in Applicant.[45] *In re Noon Hour Food Prods., Inc.*, 88 USPQ2d 1172 (TTAB 2008) (despite almost one hundred years of use and cancelled seventy-year old registration for BOND-OST for cheese, evidence insufficient to establish acquired distinctiveness of highly descriptive mark); *Target Brands, Inc. v. Shaun N.G. Hughes*, 85 USPQ2d 1676, 1681 (TTAB 2007) (sales alone without context not sufficient to establish acquired distinctiveness); *In re Candy Bouquet International, Inc.*, 73 USPQ2d 1883, 1889 (TTAB 2004) (sales and length of use not sufficient to establish acquired distinctiveness for highly descriptive term). *See also In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately $85 million, and annual advertising expenditures in excess of $10 million, not sufficient to establish acquired distinctiveness in view of highly descriptive nature of mark).

In view thereof, based on the totality of the evidence we find that Applicant has not established that MAGNESITA has acquired distinctiveness as a mark for either the refractory goods or the services of "providing information via a global computer network on constructing, maintaining, and repairing refractory apparatus using refractory products" or "providing information via a global computer network on the use of refractory products to construct, maintain and repair refractory apparatus

[45] We note that while Trademark Rule 2.41(a) allows for reliance on prior registrations to prove acquired distinctiveness, the Rule only encompasses prior registrations on the United States Principal Register and does not extend to foreign or international registrations. *Cf. In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1835 (Fed. Cir. 2007) ("[E]vidence of registration of ASPIRINA in another country is of little value to our analysis of its entitlement to protection in the United States and we cannot say it overcomes the substantial evidence that otherwise supports the Board's decision in this case.").

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."

Summary

In summary, the applied-for matter is generic for refractory products in International Class 19 in Application Serial Nos. 77873477 and 85834316, and in the alternative in Application Serial No. 85834316 it is highly descriptive of the refractory products and the showing for acquired distinctiveness is insufficient. In addition, the applied-for matter is highly descriptive of the services in International Class 37 and the showing for acquired distinctiveness is insufficient in Application Serial No. 85834316.

Decision: The refusals to register Applicant's proposed mark are affirmed in each application. Application Serial No. 85834316 is refused registration in both classes. The goods in International Class 19 in Application Serial No. 77873477 will be deleted and the application will be forwarded for registration of the services in Class 37 on the Supplemental Register.