

This Opinion is not a Precedent of the TTAB

Mailed: May 29, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re X-Calibur Construction Chemisty Inc.
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Serial No. 86072819
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Matthew H. Swyers of The Trademark Company PLLC for X-Calibur Construction Chemisty Inc.

Allison P. Schrody, Trademark Examining Attorney, Law Office 115, John Lincoski, Managing Attorney.

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Before Zervas, Wolfson, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

X-Calibur Construction Chemisty Inc. (“Applicant”) has filed an application for registration on the Principal Register of the mark CASTFLOOR in standard characters for “Cement and resin based flooring materials used in buildings; liquid based flooring materials used in buildings, namely, epoxy flooring,” in International Class 19.¹

¹ Application Serial No. 86072819 was filed on September 24, 2013 under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), stating a date of first use anywhere and first use in commerce of January 1, 2010.

The Trademark Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant's mark merely describes the identified goods. When the refusal was made final, Applicant appealed. Applicant and the Examining Attorney have filed briefs.

Section 2(e)(1) of the Trademark Act provides for the refusal of registration of "a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them." 15 U.S.C. § 1052(e)(1). A term is merely descriptive of goods within the meaning of Section 2(e)(1) if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the services. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *see also, In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). Whether a mark is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, we evaluate whether someone who knows what the goods are will understand the mark to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). A mark need not immediately convey an idea of each and every specific feature of the goods in order to be considered merely descriptive; it is enough if it describes one significant attribute, function or property of the services. *See In re Gyulay*, 3 USPQ2d at 1010;

In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982); *In re MBAAssociates*, 180 USPQ 338 (TTAB 1973). Moreover, the mark need not describe all of the identified goods. Rather, a descriptiveness refusal is proper with respect to all of the identified goods in an International Class if the mark is descriptive of any of the goods in that class. *In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005). The determination that a mark is merely descriptive is a finding of fact and must be based upon substantial evidence. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007).

It is the Examining Attorney's burden to show, *prima facie*, that a term is merely descriptive of an applicant's goods or services. *In re Gyulay*, 3 USPQ2d at 1010; *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2052 (TTAB 2012). If such a showing is made, the burden of rebuttal shifts to Applicant.

The Examining Attorney argues that Applicant's mark is a combination of the words "cast" and "floor," which are descriptive with respect to the goods, and that, when combined, both words "retain their descriptive meaning in relation to the goods," resulting in "a composite mark that is itself descriptive and not registrable."² The Examining Attorney has made of record the following relevant dictionary definitions:

cast

VERB: To form (liquid metal, for example) into a particular shape by pouring into a mold.

...

² Examining attorney's brief, 6 TTABVUE 3-4.

NOUN: The act of pouring molten material into a mold.

...

Something formed by this means: *The sculpture was a bronze cast.*

floor

NOUN: The surface of a room on which one stands.³

The Examining Attorney argues that “Applicant’s flooring materials are ‘cast’ or poured into a defined area as a liquid, and then harden to create a ‘floor.’”⁴ The Examining Attorney supports this argument with an internet web page of Applicant, which describes the installation of Applicant’s Castfloor Duo product as follows:

[It] is created by combining two very similar RAL colors when pouring and applying, then simply trowel finishing.⁵

Although this description of Applicant’s goods confirms that pouring is an aspect of creating the floor with Applicant’s goods, neither this explanation nor anything else on the submitted web page clearly refers to a casting process as defined in the dictionary entries of record. The description of how a trowel is used in shaping the floor does not appear to be consistent with a casting process.

The Examining Attorney appears to contend that the word CAST, as used in Applicant’s mark, modifies the word FLOOR, describing a floor that is made by a casting process or by the use of a cast. However, the Examining Attorney has not submitted any dictionary definitions of “cast” that explain the use of “cast” as an adjective or other form of modifier for a noun like “floor.” We cannot derive the

³ Definitions from <education.yahoo.com>, Office Action of January 14, 2014 at 6-7; 9.

⁴ Examining Attorney’s brief, 6 TTABVUE 5.

⁵ Office Action of August 11, 2014 at 7.

meaning proposed by the Examining Attorney from the dictionary definitions alone. (Applicant also has submitted definitions of “cast” from <dictionary.com>,⁶ but most of them have no relevance to the Applicant’s field of goods. The only adjectival meaning of “cast” that is given relates to the position of a lying horse or other animal. It appears, however, that Applicant has submitted only a small selection of the many definitions included in the dictionary entry, which appear to number at least 76.)

The Examining Attorney contends further that the mark merely describes the goods because the goods “are used to create what is known in the flooring industry as ‘cast floors.’” In support of this argument, the Examining Attorney has submitted a number of third-party websites that make use of the expression “cast floor”;⁷ however, all of them appear to originate in foreign countries, including the Netherlands, United Arab Emirates, Ireland and Lithuania. Many are written in nonidiomatic English. Even though the websites are in English, they are not good evidence of the way in which the expression “cast floor” would be understood by customers in the United States.

These websites could possibly be useful to demonstrate the nature of the goods at issue. For this purpose, however, they fall short. The following passages are among the most illuminating explanations of the goods:

Natural Stone Carpets cast floors are self-levelling floor systems composed of high-quality binding agent and inert fillers. The basic cast floor provides a smooth and polished

⁶ Applicant’s response of July 11, 2014 at 21-23.

⁷ *Id.* at 8-36; Office Action of January 14, 2014 at 11-15.

finish in standard layers of approx. 1 mm and up. Natural Stone Carpets cast floor systems offer a fluid-tight finish.⁸

Classification of the cast floor systems:

Thin coating-Layer thickness up to 1 mm The coating material usually contains two components based upon epoxy or polyurethane resin. Following thorough mixture the materials are ready for use. The primer is first applied using a roller or a wiper in order to seal the surface and involved the adhesion to the infrastructure. This is the preliminary stage of each system following which the main layer is applied (in one or two moves). The composition of the material determines the chemical and mechanical resistance as well as whether the finish is matte or polished.⁹

Cast Flooring is the most commonly used construction term for industrial coatings made of polymeric materials based on epoxy, polyurethane, and other metilmacacri polymer binders.

You can lay different colored libations floor, smooth or rough surface of the dielectric or antistatic.

The self-leveling properties of the molding floor forms a maximum equal to the surface without seams, holes, cracks.

The coating is completely ready for operation within 5-7 days after the spillage.¹⁰

Although we note some references to a pouring process (“libations” and “spillage”), we also see much that seems inconsistent with a casting process, such as references to the goods as “coatings” and references to “application” of the flooring material in

⁸ <naturalstonecarpets.ie>, Office Action of August 11, 2014 at 29.

⁹ <epolac.com>, *id.* at 13.

¹⁰ <betogrindis.lt>, *id.* at 24.

“layer[s].” Overall, these materials are too equivocal to persuade us that “cast” is a term that describes the method by which Applicant’s goods are used to make a floor.

Although the evidence of record begins to suggest that it might be appropriate to use the expression “cast floor” to describe a floor that is formed by pouring liquid flooring material into a mold where it will harden, the evidence is insufficient to show that relevant customers would interpret Applicant’s mark in this way.

We find that the Examining Attorney has not met her burden of establishing, *prima facie*, that Applicant’s mark is merely descriptive of the goods.¹¹

Decision: The refusal to register is reversed.

WOLFSON, Administrative Trademark Judge, concurring:

I concur in the Board’s decision to reverse the refusal to register Applicant’s mark CASTFLOOR for flooring materials. However, I believe it is likely that prospective consumers of poured flooring materials such as Applicant’s will recognize from the English-language websites submitted into evidence that “cast floor” is used generically in the countries of origin of the website owners.¹² Yet as there is no

¹¹ We observe nonetheless that on a different record, such as might be adduced by a competitor in an opposition proceeding, we might reach a different conclusion.

¹² Additional examples of such usage may be found attached to the Examining Attorney’s Office Action dated August 11, 2014 (emphasis added):

At www.flowresin.com: “These are just some of the many qualities that make a self-leveling epoxy or polyurethane **cast floor** into the ideal floor.”

At www.intercontinental.nl: “IncoPower is a collective term for our new, extensive line of high-quality coatings, **cast floors** and trowelled floors....”; “Where the IncoCoat provides an insufficient solution, use a two-component epoxy **cast floor** from IncoFloat....”; “The two-component epoxy **cast floors** are mainly laid in halls used for industrial activities,

evidence in the record to show how U.S. companies describe similar goods, it is speculation to conclude that consumers in the United States would believe “cast floor” is descriptive (or generic) for the goods. They may instead perceive the expression simply as a translation from a non-English native language term into an English equivalent. Further, the nature of the goods makes it unlikely that consumers will purchase them from vendors outside of the United States and more likely that consumers would simply view the foreign websites as providing general information about the goods. *See In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1050 (TTAB 2006) (consumers are more likely to focus on Internet retailers that can easily ship items or make them available for pick up in store location convenient to purchaser). These reasons cast doubt on the impact of the foreign websites’ use of “cast floor” on “the perceptions of the relevant public in this country.” *In re Men’s Int’l Professional Tennis Council*, 1 USPQ2d 1917, 1918-19 (TTAB 1986). As we must on the question of mere descriptiveness of a mark, I resolve such doubt in Applicant’s favor. *In re The Stroh Brewery Co.*, 34 USPQ2d 1796, 1797 (TTAB 1994).

workshops, warehouses, storage facilities, garages, factories, production plants and DIY stores.”

At www.betongrindis.lt: “**Cast Flooring** is the most commonly used construction term for industrial coatings made of polymeric materials based on epoxy polyurethane and other ... binders.” “On the **cast floor** do [sic] not reproduce bacteria and micro-organisms”