

This Opinion is Not a
Precedent of the TTAB

Mailed: January 30, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Deus Vult LLC
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Serial No. 87186211
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Joseph T. Leone of Dewitt Ross & Stevens SC,
for Deus Vult LLC.

Jason Paul Blair, Trademark Examining Attorney, Law Office 104,
Zachary Cromer, Managing Attorney.

—
Before Cataldo, Bergsman, and Wolfson,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Deus Vult LLC (“Applicant”) seeks registration on the Supplemental Register of the designation COMBAT ROSARY (in standard characters, “Rosary” disclaimed) for “rosaries” in International Class 16.

The application was filed September 28, 2016 on the Principal Register, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use and first use in commerce of August 29, 2013. 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 wording is merely descriptive of “a rosary used in combat, designed after previous rosaries previously commissioned for combat, or replicas of the same.”¹ After the Examining Attorney issued a final descriptiveness refusal, Applicant filed a Request for Reconsideration, amending its application to the Supplemental Register.² The Examining Attorney refused registration on the Supplemental Register under Trademark Act Sections 23(c) and 45, 15 U.S.C. §§ 1091(c) and 1127, on the ground that COMBAT ROSARY is generic and thus incapable of distinguishing Applicant’s goods. After the Examining Attorney made the genericness refusal final, Applicant appealed to this Board and filed a Request for Reconsideration, which was denied.

Both Applicant and the Examining Attorney have filed briefs, and Applicant filed a reply brief.³ We affirm the refusal to register.

¹ July 17, 2017 Office Action. Citations to the briefs refer to TTABVUE, the Board’s online docketing system. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). Specifically, the number preceding “TTABVUE” corresponds to the docket entry number, and any number(s) following “TTABVUE” refer to the page number(s) of the docket entry where the cited materials appear. Citations to the examination record refer, to the downloadable .pdf version of the Trademark Office’s online Trademark Status and Document Retrieval system (TSDR), by document, date and page number.

² In its first and second Office Actions, the Examining Attorney failed to advise Applicant that the mark appeared to be generic and incapable of registration on the Supplemental Register; the better Office practice would have been to provide such an advisory.

³ We disregard the untimely evidence submitted for the first time with Applicant’s reply brief, as Exhibit A. Trademark Rule 2.142(d); *In re Petroglyph Games Inc.*, 91 USPQ2d 1332, 1334 (TTAB 2009) (applicant’s evidence, included for the first time with its reply brief, considered “manifestly untimely”).

I. Applicable Law

By amending its application to seek registration of COMBAT ROSARY on the Supplemental Register, Applicant has conceded that the term is merely descriptive. However, Applicant must show that COMBAT ROSARY is capable of distinguishing Applicant's goods from those of others. "Generic terms do not so qualify." *In re Emergency Alert Sols. Grp., LLC*, 122 USPQ2d 1088, 1089 (TTAB 2017); *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001) (generic terms "are by definition incapable of indicating a particular source of the goods or services"). A generic term "is the common descriptive name of a class of goods or services" and unregistrable on either the Principal or the Supplemental Register. *Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015) (citing *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)).

There is a two-part test used to determine whether a designation is generic: (1) what is the genus (class or category) of the goods or services at issue? and (2) does the relevant public understand the designation primarily to refer to that genus of goods or services? *Princeton Vanguard*, 114 USPQ2d at 1830 (citing *Marvin Ginn*, 228 USPQ at 530); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1462 (TTAB 2014).

II. What is the Genus of the Goods at Issue?

Our first task is to determine the proper genus of the goods at issue. In defining the genus, we commonly look to the identification of goods in the application. *See Reed*

Elsevier, 82 USPQ2d at 1380; *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) (a proper genericness inquiry focuses on the identification set forth in the application or certificate of registration); *In re Serial Podcast, LLC*, 126 USPQ2d 1061, 1063 (TTAB 2018) (proper genus generally is “set forth by the [identification of goods] in each subject application.”). The Examining Attorney contends that the proper genus is “rosaries,” the goods identified in Applicant’s application. Applicant argues that the proper genus is “prayer beads” because “a rosary is a specific type of prayer bead (a species within the genus ‘prayer beads’).”⁴

Implicit in Applicant’s argument is the supposition that by expanding the genus to “prayer beads,” i.e., any type of chains of beads or knots used for counting prayers, Applicant can avoid a genericness finding. But Applicant cannot circumvent a genericness finding on the assumption that the applied-for mark would be generic for rosaries but not the more general category of prayer beads. The Board must focus on the identified goods on which Applicant uses or intends to use its mark, even if such goods may be encompassed by a larger category. *Cf. In re Analog Devices Inc.*, 6 USPQ2d 1808, 1810 (TTAB 1988) (where a mark is generic for some but not all of the goods identified in an application, registration is properly refused for all of the goods).

To aid our determination of the proper genus, we may consider evidence of record showing the manner in which an applicant uses its mark. *In re Reed Elsevier Prop. Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007) (the Board, in order to define the proper genus of services, appropriately reviewed the applicant’s website to

⁴ 4 TTABVUE 6.

determine the context of the recitation of services in applicant's application); *In re Steelbuilding.com*, 75 USPQ2d 1420, 415 F.3d 1293, 1298 (Fed. Cir. 2005) (Federal Circuit interpreted the meaning of "computerized online retail services" in light of the actual use being made by the applicant on its web site).

Here, Applicant's specimen of use shows that Applicant identifies its product as a rosary, not as "prayer beads." Accordingly, "rosaries" accurately reflects the goods on which Applicant uses its applied-for mark; the category of goods is identifiable and adequately defined by the identification of goods in Applicant's application. There is no need to broaden the genus to include all types of chains of beads or knots used for counting prayers.

III. Who are the Relevant Purchasers?

The second part of the *Marvin Ginn* test is whether the term sought to be registered is understood by the relevant public primarily to refer to the genus of goods under consideration. "The relevant public for a genericness determination is the purchasing or consuming public for the identified goods." *Frito-Lay N. Am., Inc. v. Princeton Vanguard, LLC*, 124 USPQ2d 1184, 1187 (TTAB 2017) (citing *Magic Wand*, 19 USPQ2d at 1553); *Sheetz of Del., Inc. v. Doctor's Assocs. Inc.*, 108 USPQ2d 1341, 1351 (TTAB 2013). Applicant argues that "rosaries, by definition, are a Catholic sacramental (even if the description of goods does not explicitly say so)," 4 TTABVUE 7, and that the relevant public is "not everybody, but devout Catholics." *Id.* Although devout Catholics, as a subsection of consumers, may actually have a greater understanding and familiarity with the type of goods known as combat rosaries,

because there are no restrictions or limitations to the channels of trade or classes of consumers for the goods, the relevant public consists of those ordinary consumers who purchase rosaries regardless of their faith.

In its reply brief, Applicant acknowledges that “the relevant consumers includes everybody,” although Applicant argues that non-Christians and “all Christians of a Protestant denomination” would make no connection between the word “rosary” and “combat” because they do not pray the rosary.⁵ Applicant’s and the Examining Attorney’s submission of dictionary definitions for both terms refute Applicant’s argument. The words are common English terms whose meanings would be grasped by all relevant purchasers.

IV. What is the Meaning of COMBAT ROSARY to the Relevant Public?

We next turn to consider the meaning of the term COMBAT ROSARY. “Evidence of the public’s understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers and other publications.” *Royal Crown Co., Inc. v. The Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1046 (Fed. Cir. 2018) (citing *In re Merrill Lynch*, 4 USPQ2d at 1143); *see also In re Cordua Rest., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1634 (Fed. Cir. 2016); *Princeton Vanguard*, 114 USPQ2d at 1830; *In re Reed Elsevier*, 82 USPQ2d at 1380 (finding third-party websites competent sources for determining what the relevant public understands mark to mean).

⁵ 7 TTABVUE 2-3.

The Examining Attorney submitted numerous printouts from websites selling a rosary identified as a “combat rosary.” Several of the sites describe the combat rosary as a “pull chain rosary that was commissioned and procured by, believe it or not, the U.S. government and issued by the military, upon request, to soldiers serving in World War I. Some of these rosaries were also seen in WWII.”⁶ The majority of the websites are selling replicas of the originals. Applicant argues in its brief that “all of the hits showing “COMBAT ROSARY” branded rosaries are Applicant’s own goods.”⁷ This argument is unpersuasive. First, Applicant fails to support this claim with record evidence or a declaration or affidavit. Assertions in briefs are not recognized as evidence. *In re Simulations Publications, Inc.*, 521 F.2d 797, 187 USPQ 147, 148 (CCPA 1975); *In re Vesoyuzny Ordena Trudovogo Krasnogo Znameni*, 219 USPQ 69, 70 (TTAB 1983). Moreover, even if true, this presumed fact does not weaken the probative value of the Examining Attorney’s evidence. The websites do not mention Applicant or use the term as a source-identifier or trademark for Applicant’s goods. Rather, given the generic usages of the term in these websites, the public is unlikely to view the term “combat rosary” as a trademark.

⁶ At www.catholicgentleman.net, attached to November 27, 2017 Final Office Action at TSDR 35-36.

⁷ 4 TTABVUE 9. Applicant’s counsel argues that Father Richard Heilmann is Applicant’s sole shareholder; that Fr. Heilmann is also the sole proprietor of the Roman Catholic Gear website, which appears in Applicant’s Google search for “combat” as the only reference using “combat rosaries” (September 12, 2017 Response at TSDR 115); and that Fr. Heilmann markets the branded rosaries through his own as well as third-party websites, including “[a]ll of the “COMBAT ROSARY” branded rosaries shown in the [first Office Action].”⁴ TTABVUE 9.

The following examples of third-party websites illustrate the usage of COMBAT ROSARY in connection with rosaries:

- **Serviam Ministries**⁸



Description

Product Description

The Combat Rosary is built to last! **Built with love** by Wisconsin parishioners, the rosary is constructed with strong pull chain and unique jump locks for durability. The polished silver tone finish provides a very classic and refined look. Rosaries are packaged in a velvet pouch and a complete explanation of the rosary and medals used.

- **Leaflet Missal**⁹

⁸ At <https://www.serviamministries.com>, attached to January 6, 2017 Office Action at 13.

⁹ At <https://www.leafletonline.com>, attached to January 6, 2017 Office Action at 19-21.



The Combat Rosary

SKU: Z8352

Availability: In stock

Customer Rating: ★★★★★



- Adoro Ergo Sum¹⁰



World War One Combat Rosary

As hard as it might be to believe today, during the Great War the United States government produced and issued special "combat" rosaries for the spiritual welfare of Catholic soldiers. These rosaries were made to withstand the rugged reality of life in the trenches. Made of brass, washed in silver, and blued to darken the metal (to prevent them from making the soldiers easy targets) these rosaries were made to last. Instead of a traditional chain, the combat rosary featured a significantly stronger "pull chain" from which they are sometimes named.

¹⁰ At <http://adoroergosum.blogspot.com>, attached to January 6, 2017 Office Action at 23.

On the Adoro Ergo Sum website, the son of a veteran discusses his receiving an “original” combat rosary from his father. He notes, “While some companies, notably Church Militant, produce replicas of this fine rosary, I was lucky enough to receive an original 1916 military issue ‘combat rosary’ as a gift recently from my father.”¹¹

The Church Militant combat rosary is advertised on Amazon.com:¹²



Church Militant Combat Rosary - Gold Tone
★★★★★ • 4 customer reviews

Price: \$59.95 + \$4.65 shipping

Only 1 left in stock - order soon.
Get it as soon as July 20 - 25 when you choose Standard at checkout.
Ships from and sold by Queen of Angels Catholic Store.

- Sturdy! Based on WWII Full Chain Rosary
- Pardon Crucifix
- Miraculous Medal Center
- St. Benedict Medal Attached
- Regular Price \$49.99

New (1) from \$59.95 + \$4.65 shipping

Additional websites offer similar “combat rosaries”:

- Queen of Angel’s Catholic Store sells a bronze “Church Militant Combat Rosary”;¹³
- Solo Scientific Inc. sells an “Olive Wood Combat Rosary By Solo Scientific”;¹⁴

¹¹ *Id.* at 24.

¹² At <https://www.amazon.com/Church-Militant-Combat-Rosary>, attached to July 17, 2017 Office Action at 63.

¹³ At <https://www.goa.life>, attached to November 27, 2017 Final Office Action at 18.

¹⁴ At www.soloscientific.com, attached to November 27, 2017 Final Office Action at 20.

- FaithOnFireRosaries – sells a “wire combat rosary” that is “inspired by the U.S. government issued rosaries from WWI and WWII.”¹⁵ It also sells a “Baby Combat Wire Rosary”:¹⁶



Baby Combat Wire Rosar...
FaithOnFireRosari... \$25.00

Other websites refer to combat rosaries:

- The National Catholic Register, a blogging site, headlines “Swiss Guards Carry the ‘Combat Rosary’ Into Spiritual Battle.”¹⁷ The article begins:

Each year on May 6 about two-dozen Swiss Guards are sworn into service, pledging to protect and defend the Pope at all costs. This year the Commander of the Swiss Guards, Col Christoph Graf, highlighted the importance of the Rosary to the new recruits, holding aloft a ‘combat rosary’ that was donated to them by Father Richard Heilman, priest of the Diocese of Madison, Wisc.¹⁸

- Catholic Gentleman.net announced a give-away of Church Militant combat rosaries.¹⁹
- An article on ebay.com explains how to identify a “Genuine WW 1, USA Military Issued Rosary,” noting that the original military issued rosaries

¹⁵ At <https://www.etsy.com>, attached to November 27, 2017 Final Office Action at 26-27.

¹⁶ *Id.* at 26.

¹⁷ At <http://www.ncregister.com>, attached to November 27, 2017 Final Office Action at 22.

¹⁸ *Id.* at 22.

¹⁹ At <https://www.catholicgentleman.net>, attached to November 27, 2017 Final Office Action at 36.

are extremely rare, but that “high quality, commercial made reproductions” are now being produced:²⁰

They are called ‘Combat Rosaries’ (you can google them) and these brand new reproductions sell for \$35.00.

...

There are now 3 styles of Non-issued ‘pull chain’ rosaries that are made today, that resemble the Original Issued Military rosary.

...

3. The 3rd style is the Newest and is called the ‘Combat Rosary’, pictured [below] with the Pardon Crucifix and Miraculous center medal.”²¹



Based on the evidence, we find the term “combat rosary” will be readily understood by the relevant public as a military-issued rosary given to soldiers in combat during World Wars I and II, as well as replicas of these originals.

Applicant argues that “combat rosary” is not generic because the term “combat” is not generic: “[i]f the word ‘combat’ were generic to rosaries, somebody, somewhere, would actually use the phrase ‘combat’ as a generic noun in place of ‘rosary.’ That is,

²⁰ At <http://www.ebay.com>, attached to July 17, 2017 Office Action at 68-80.

²¹ *Id.* at 73-74.

there would be some evidence that the word ‘combat’ is used interchangeably with ‘rosary.’”²² Applicant misapprehends the nature of the genericness refusal. While it is true that the goods would not be called “combats,” for COMBAT ROSARY to be considered generic for rosaries, the adjective “combat” need not be interchangeable with the noun “rosary.” An adjective can be a generic term. *See Sheetz of Del., Inc. v. Doctor’s Assocs. Inc.*, 108 USPQ2d 1341, 1366 (TTAB 2013) (finding the adjective “footlong” generic in connection with sandwiches); *In re Cent. Sprinkler Co.*, 49 USPQ2d 1194, 1199 (TTAB 1998) (finding the adjective ATTIC to be generic for “automatic sprinklers for fire protection”; “applicant’s mark does not present the classic case of a generic noun, but rather a generic adjective”); *In re Reckitt & Colman, N. Am. Inc.*, 18 USPQ2d 1389 (TTAB 1991) (the expression “generic name for the goods or services” is not limited to noun forms but also includes “generic adjectives,” that is, adjectives which refer to a genus or species, category or class, of goods or services).

Applying these principles to the case at hand, the evidence clearly shows that “combat rosary” identifies a type of pull-chain, very sturdy rosary originally issued by the U.S. military and distributed during World Wars I and II to requesting soldiers, and replicas of these originals. The significance of “combat” is as a generic adjective for this type of rosary; thus COMBAT ROSARY is incapable of distinguishing the source of the goods. *In re Empire Tech.*, 123 USPQ2d 1544 (COFFEE FLOUR generic for flour made from coffee berries); *In re Demos*, 172

²² 4 TTABVUE 8.

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USPQ 408, 409 (TTAB 1971) (“CHAMPAGNE” merely names principal ingredient of applicant’s salad dressing and is unregistrable).

V. Conclusion

Taken as a whole, the evidence indicates that the relevant public would understand and use COMBAT ROSARY primarily as the name for a type of rosary. Accordingly, the term is generic “and should be freely available for use by competitors.” *In re Cent. Sprinkler Co.*, 49 USPQ2d at 1199. *See generally In re Cordua Rests.*, 118 USPQ2d at 1635; *Marvin Ginn*, 228 USPQ at 530; *In re 1800Mattress.com*, 92 USPQ2d at 1685.

Decision:

The refusal to register Applicant’s mark on the Supplemental Register is affirmed.