

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: April 17, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

—
Eureka Chemical Company

v.

Kellsport Industries Inc.

—
Opposition No. 91274117

—
Sabrina A. Larson of Coblentz Patch Duffy & Bass LLP,
for Eureka Chemical Company.

Todd Wengrovsky of Law Offices of Todd Wengrovsky PLLC,
for Kellsport Industries Inc.

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Before, Lynch, Acting Deputy Chief Administrative Trademark Judge, and
Kuhlke and Cohen, Administrative Trademark Judges.

Opinion by Cohen, Administrative Trademark Judge:

Applicant, Kellsport Industries Inc., seeks to register the standard character mark WOOLWAX on the Principal Register, with a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, for “corrosion inhibitors in the nature of a coating; rust preventatives in the nature of a coating” in International Class 2 and “all purpose

lubricants” in International Class 4 (the “Application”).¹ Applicant’s claim of acquired distinctiveness is based solely on a declaration of at least five years of continuous and substantially exclusive use prior to making the statement.

Opposer, Eureka Chemical Company, opposes registration of the Application on the grounds that the proposed mark is generic for the identified goods, or in the alternative, highly descriptive without acquired distinctiveness; that Applicant committed fraud on the Office during the prosecution of the Application; and that Applicant fraudulently uses the registration symbol.²

Applicant denies the salient allegations in the notice of opposition.³

The case is fully briefed. We sustain the opposition on the ground that the proposed mark WOOLWAX is merely descriptive and has not acquired

¹ Application Serial No. 90570365 was filed March 10, 2021 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging November 1, 2013, as the date of first use anywhere and date of first use in commerce.

² 1 TTABVUE. In this decision, citations to the prosecution record refer to the .pdf version of that entry in the TSDR system. *See, e.g., In re Seminole Tribe of Fla.*, Serial No. 87890892, 2023 WL 3751113, at *1 n.1 (TTAB 2023). When we cite to the inter partes record, we refer to TTABVUE, the Board’s docketing system, by docket entry and page number (e.g., 38 TTABVUE 14).

As part of an internal Board pilot citation program on possibly broadening acceptable forms of legal citation in Board cases, this opinion varies from the citation form recommended in the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 101.03 (June 2023). This opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals only by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For opinions of the Board, this opinion employs citation to the Westlaw (WL) database. Only precedential decisions are cited. Until further notice, however, practitioners should continue to adhere to the practice set forth in TBMP § 101.03.

³ 6 TTABVUE.

distinctiveness as a source indicator for Applicant's goods under Section 2(f) of the Trademark Act.⁴

I. The Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the Application.⁵ The parties introduced the following testimony and evidence listed below.

A. Opposer's Testimony and Evidence

Opposer submitted a Notice of Reliance⁶ which includes:

- portions of the Application file history;
- Applicant's prior application for WOOLWAX;
- various Internet articles, dictionary definitions, Applicant's website, third-party websites; and
- portions of Applicant's responses to Opposer interrogatories, requests for admission, and document requests.

Opposer also submitted the testimony of its Vice President, Jeff Wilson with exhibits.⁷

⁴ We do not reach Opposer's remaining claims, namely, that the proposed mark is generic, that Applicant committed fraud during the prosecution of the Application or that Applicant fraudulently uses the registration symbol. *See Azeka Bldg. Corp. v. Azeka*, Opposition No. 91218679, 2017 WL 2391862, at *1 (TTAB 2017) (the Board has "discretion to decide only those claims necessary to enter judgment and dispose of the case") (quoting *Multisorb Tech., Inc. v. Pactive Corp.*, Cancellation No. 92054730, 2013 WL 6979641, at *2 (TTAB 2013)).

⁵ For this reason, it was unnecessary for Opposer to submit the Application file under Notice of Reliance. 20 TTABVUE.

⁶ 19 TTABVUE. Opposer also filed a notice of errata correcting Exhibit 20. 21 TTABVUE.

⁷ 18 TTABVUE.

B. Applicant's Evidence

Applicant submitted a Notice of Reliance⁸ which includes:

- Applicant's answers and amended answers to Opposer's interrogatories, responses to Opposer's requests for production and requests for admission; and
- Opposer's answers to Applicant's interrogatories and requests for production.

II. Evidentiary Issues

A. Opposer's Objections

As detailed below, Opposer has filed numerous objections to Applicant's evidence, asking that we give it no consideration. Applicant has not responded to these objections.

1. Applicant's Notice of Reliance

Opposer objects to Applicant's Notice of Reliance and the attached evidence for Applicant's failure to "cite the relevance of any specific documents, instead purporting to add one statement of relevance that lists all issues in the proceeding as applying to all the documents in its Notice of Reliance."⁹

Applicant's "broad statement of relevance fails to comply with Trademark Rule 2.122(g) in that it does not associate the exhibit with a specific fact or a particular element of the claim of likelihood of confusion or defense." *Icon Health & Fitness v. Eifit LLC*, Opposition No. 91264393, 2022 WL 1056277, at *3 (TTAB 2022) (citing

⁸ 20 TTABVUE.

⁹ 22 TTABVUE 11.

FUJIFILM SonoSite, Inc. v. Sonoscape Co., Opposition No. 91201727, 2014 WL 3051308, at *3 (TTAB 2014) (notice of reliance should associate materials with specific likelihood of confusion factor). Notwithstanding, “[t]he failure to properly ‘indicate generally the relevance of the material being offered,’ ... is an evidentiary defect that can be cured by the propounding party as soon as it is raised by any adverse party, without reopening the testimony period of the propounding party.” *Icon Health & Fitness*, 2022 WL 1056277, at *3 (quoting *Safer, Inc. v. OMS Inv., Inc.*, Opposition No. 91176445, 2010 WL 985355, at *10 (TTAB 2010)). “As a general rule, [procedural] objections that are curable must be seasonably raised, or they will be deemed waived.” *Moke Am. LLC v. Moke USA, LLC*, Opposition No. 91233014, 2020 WL 1937891, at *5 (TTAB 2020) (quoting *Nahshin v. Prod. Source Int’l, LLC*, Cancellation No. 92051140, 2013 WL 6040375, at *2 (TTAB 2013)), *rev’d [on other grounds]*, No. 3:20-cv-00400-DJN-EWH, 2023 WL 3232601 (E.D. Va. May 3, 2023); *see also Icon Health & Fitness*, 2022 WL 1056277, at *7. A procedural objection to a notice of reliance, such as Opposer’s claim that Applicant did not adequately specify the relevance of the materials submitted under its Notice of Reliance, should be raised promptly, preferably by a motion to strike the notice of reliance if the defect is one that can be cured. *See generally* TBMP § 707.02(b) and cases cited therein.

Opposer waited until submitting its main brief to object to Applicant’s Notice of Reliance on the ground that it does not specify the relevance of the referenced materials. Opposer’s objection is thus untimely and we deem it waived.

2. Applicant's Discovery Responses

Opposer objects to Applicant's introduction of all of Applicants' responses to Opposer's interrogatories and requests for admission.¹⁰ As asserted by Opposer,¹¹ while the responding party may introduce under a notice of reliance any other answers to interrogatories, or any other admissions, which should in fairness be considered so as to make not misleading what was offered by the receiving or inquiring party, the responding party must explain in writing why it needs to rely on the additional written discovery responses. Trademark Rule 2.120(k)(5), 37 C.F.R. § 2.120(k)(5). Absent such a written statement, which Applicant did not provide in this case, the Board, in its discretion, may refuse to consider the additional written disclosures or responses. *Id.*

Still, a party's submission of its own discovery responses may have limited probative value. *See e.g., Daniel J. Quirk, Inc. v. Village Car Co.*, Cancellation No. 92057667, 2016 WL 6136609, at *5 (TTAB 2016) (citing CHARLES A. WRIGHT, ARTHUR R. MILLER ET AL., 8B FED. PRAC. & PROC. CIV. § 2180 (3d ed., Apr. 2023) ("Older cases said that a party could not ordinarily introduce his or her own answers to an opponent's interrogatories, since they would be self-serving statements. ... But a more correct explanation would be that a party's own statements are hearsay when offered by the party to prove the truth of the matter asserted, and that they fall within no recognized hearsay exception.")); *Fid. & Deposit Co. of Md. v. Hudson United Bank*,

¹⁰ *Id.*

¹¹ *Id.*

653 F.2d 766, 777 (3d Cir. 1981) (trier of fact has discretion as to weight to give to an interrogatory response). On this record, we find that permitting and considering the remainder of Applicant's discovery responses presents a more complete and fair record. We thus consider Applicant's responses to Opposer's interrogatories and requests for admission submitted with Applicant's Notice of Reliance.¹² We consider Applicant's responses to Opposer's interrogatories and requests for admission for whatever probative value they may have.

3. Opposer's Document Production

Opposer also objects to Applicant's Exhibit H to the Notice of Reliance which is entitled "Opposer's Responses to Requests for Production dated June 10, 2022 and document production."¹³ Opposer argues that Applicant only makes a "passing reference to introducing Opposer's 'document production'"¹⁴ without attaching any documents produced by Opposer and thus, Applicant has not properly introduced any documents produced by Opposer.¹⁵

A party that has obtained documents from another party through disclosure or under Fed. R. Civ. P. 34 may not make the produced documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under 37 C.F.R. § 2.122(e) (as official records; or as printed publications, such as books and periodicals, available to the general public in libraries or of general

¹² 20 TTABVUE.

¹³ *Id.* at 12.

¹⁴ *Id.*

¹⁵ *Id.*

circulation among members of the public or that segment of the public which is relevant under an issue in the proceeding; or Internet documents); or unless the documents have been authenticated by an admission or stipulation from the producing party. Notwithstanding, written responses to requests for production of documents introduced through a notice of reliance are admissible solely for the purpose of showing that a party has stated that there are no responsive documents, as Opposer did in certain of its responses. *See City Nat'l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, Cancellation No. 92050730, 2013 WL 3168094, at *6 n.10 (TTAB 2013); *ShutEmDown Sports Inc. v. Lacy*, Cancellation No. 92049692, 2012 WL 684464, at *2 n.7 (TTAB 2012).

We thus consider Opposer's written responses that there are no responsive documents to certain of Applicant's requests for production of documents, but have not considered Opposer's additional statements contained therein, which are not properly of record. *See McGowen Precision Barrels, LLC v. Proof Rsch., Inc.*, Cancellation No. 92067618, 2021 WL 2138663, at *3 n.6 (TTAB 2021) (written responses to requests for production of documents introduced through a notice of reliance are admissible solely for the purpose of showing that a party has stated that there are no responsive documents).

B. Additional Issue

Opposer included various exhibits with its notice of opposition.¹⁶ While a plaintiff may attach exhibits to its pleading, except for current status and title copies of a plaintiff's pleaded registration, exhibits attached to a pleading are not evidence on behalf of the party to whose pleading they are attached unless they are thereafter, during the time for taking testimony, properly identified and introduced in evidence as exhibits. Trademark Rule 2.122(c), 37 C.F.R. § 2.122(c); *see Baseball Am. Inc. v. Powerplay Sports Ltd.*, Opposition Nos. 91120166 and 91120978, 2004 WL 1942057, at *2 n.6 (TTAB 2004) (exhibits to pleading not evidence of record); *Hard Rock Café Int'l (USA) Inc. v. Elsea*, Serial No. 74593528, 2000 WL 1279457, at *7 (TTAB 2000) (brief may not be used as a vehicle for introduction of evidence). The exhibits attached to Opposer's notice of opposition are therefore given no consideration unless otherwise properly made of record during Opposer's trial period.

III. Entitlement to a Statutory Cause of Action

Applicant does not dispute Opposer's entitlement. Notwithstanding, a plaintiff's entitlement to a statutory cause of action for opposing registration of an application is a necessary element in every opposition proceeding. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1303-05 (Fed. Cir. 2020); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 1372 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 128 n.4 (2014)). Opposer may oppose registration of the Application if Opposer's interests fall within the zone of interests

¹⁶ 1 TTABVUE.

protected by the statute, and Opposer has a reasonable belief in damage that is proximately caused by registration of the Application. *Corcamore*, 978 F.3d at 1301; *Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, Cancellation No. 92070340, 2020 WL 6938378, at *1 (TTAB 2020).

When challenging a term as generic or descriptive, a “zone of interest” encompasses any legitimate commercial interest in the use of the applied-for marks. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 1275 (Fed. Cir. 2014) (a plaintiff must have a “legitimate commercial interest sufficient to confer standing.”). “[A] plaintiff need only show that it is engaged in the ... sale of the same or related goods as those listed in the defendant’s involved application or registration and that the product in question is one which could be produced in the normal expansion of plaintiff’s business; that is, that plaintiff has a real interest in the proceeding because it is one who has a present or prospective right to use the term descriptively in its business.” *Poly-Am., L.P. v. Ill. Tool Works Inc.*, Cancellation No. 92056833, 2017 WL 4687981, at *4 (TTAB 2017) (quoting *Binney & Smith Inc. v. Magic Marker Indus., Inc.*, Serial No. 73027234, 1984 WL 63077, at *7 (TTAB 1984)); *see Kellogg Co. v. Gen Mills Inc.*, Opposition No. 91125884, 2007 WL 499921, at *1 (TTAB 2007). Such an opposer “is required only to be in a position to have a right to use the mark in question.” *Poly-Am.*, 2017 WL 4687981, at *4 (citing *Ritchie v. Simpson*, 170 F.3d 1092, 1094 (Fed. Cir. 1999)).

Opposer’s Vice President, Jeff Wilson, testifies that the company has used the terms “lanolin’ and ‘wool wax’ since the 1940s on its FLUID FILM labels and

literature”;¹⁷ that Opposer’s website explains that “FLUID FILM® is formulated from specially processed wool-wax ... to provide corrosion control, penetration, metal wetting and water displacement”;¹⁸ and that “[i]t is imperative that consumers know what our product is made from and that we are able to identify wool wax.”¹⁹ Mr. Wilson further testifies that Applicant for over fifteen years “until approximately 2019 [Applicant] was a distributor for Opposer’s FLUID FILM product as well as of other corrosion preventives. ... [Opposer’s] FLUID FILM product has always contained the ingredient wool wax and has always been described as containing wool wax, including during the period of over 15 years that [Applicant] served as a distributor for the product”;²⁰ that during Applicant’s time as a distributor, it “created a competing product to Fluid Film that it called ‘Woolwax’, which is also a corrosion prevention, rust inhibitor product”;²¹ and that Applicant and Opposer “are direct competitors in connection with these products.”²² Applicant does not dispute this testimony.

This testimony is sufficient to prove that Opposer, as a competitor of Applicant, is entitled to a statutory cause of action. *See, e.g., Books on Tape, Inc. v. Booktape Corp.*, 836 F.2d 519, 520 (Fed. Cir. 1987) (finding competitor has [entitlement] standing

¹⁷ 18 TTABVUE 3.

¹⁸ *Id.*

¹⁹ *Id.* at 4.

²⁰ 18 TTABVUE 6 at ¶11.

²¹ *Id.* at 6 at ¶12.

²² *Id.*

because it has an interest in the outcome beyond that of the general public); *Peterson v. Awshucks SC, LLC*, Cancellation No. 92066957, 2020 WL 7888976, at *7 (TTAB 2020) (entitlement to a statutory cause of action found where petitioner and respondent are competitors).

IV. Descriptiveness and Acquired Distinctiveness

In an opposition, “the opposer has the initial burden to establish prima facie that the applicant did not satisfy the acquired distinctiveness requirement of Section 2(f).” *Target Brands, Inc. v. Hughes*, Opposition No. 91163556, 2007 WL 4287253, at *4 (TTAB 2007) (quoting *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1577 (Fed. Cir. 1988)). “If the opposer does present its prima facie case challenging the sufficiency of applicant’s proof of acquired distinctiveness, the applicant may then find it necessary to present additional evidence and argument to rebut or overcome the opposer’s showing....” *Id.* For acquired distinctiveness, which “serves as an exception to a rejection,” *Yamaha Int’l Corp.*, 840 F.2d at 1580, Applicant has the “final burden ... of going forward with evidence to ... establish acquired distinctiveness by at least a preponderance of the evidence,” *id.* at 1579 (internal quotation marks omitted). “[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.” *Real Foods Pty Ltd. v. Frito-Lay N. Am. Inc.*, 906 F.3d 965, 972 (Fed. Cir. 2018) (quoting *In re Steelbuilding.com*, 415 F.3d 1293, 1300 (Fed. Cir. 2005)); *Target Brands*, 2007 WL 4287253, at *4.

As noted, Applicant seeks registration with a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), which operates as a concession of the descriptiveness²³ of WOOLWAX for the applied-for goods. *See Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 1358 (Fed. Cir. 2009); *Yamaha Int'l*, 840 F.2d at 1577; *Mini Melts, Inc. v. Reckitt Benckiser LLC*, Serial Nos. 78814088 and 78814106, 2016 WL 3915987, at *17 (TTAB 2016); *Target Brands*, 2007 WL 4287253, at *4. Therefore, we find unavailing Applicant's arguments that WOOLWAX is not descriptive because it "does not directly or immediately indicate to the consumer what the exact products at issue are"²⁴ and that "[a]lthough the presence of 'WAX' in the mark may suggest that the product is a coating of some kind, 'WOOL' offers no suggestion to the prospective customer, and the resulting mark does not describe the goods in the eyes of the consuming public,"²⁵

Given the Section 2(f) claim in the Application, the issues before us are twofold: whether Applicant's proposed mark is so highly descriptive of the goods that Applicant is subject to a higher burden of proof to demonstrate acquired distinctiveness, and whether Applicant has met that burden. Thus, we must first

²³ "A term is deemed to be merely descriptive of goods or services, 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 goods or services." *In re Zuma Array Ltd.*, Serial No. 79288888, 2022 WL 3282655, at *3 (TTAB 2022) (internal quotations and citations omitted). "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 goods." *Id.* (quoting *In re Fat Boys Water Sports LLC*, Serial No. 86490930, 2016 WL 3915986, *2 (TTAB 2016) (internal citation omitted).

²⁴ 23 TTABVUE 8.

²⁵ *Id.*

determine the degree of descriptiveness. *See Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 1369 (Fed. Cir. 2018); *Target Brands*, 2007 WL 4287253, at *4.

A. WOOLWAX is Highly Descriptive

Opposer argues that wool wax, “the wax secreted by the sebaceous glands of sheep,”²⁶ is synonymous with lanolin²⁷ and is highly descriptive of Applicant’s goods, if not generic. In support, Opposer submits third-party websites, online dictionary and encyclopedia definitions for woolwax and lanolin, including (bold emphasis added):

- THE ENCYCLOPEDIA BRITANNICA defines lanolin as “purified form of wool grease or **wool wax** (sometimes erroneously called wool fat), used either alone or with soft paraffin or lard or other fat as a base for ointments, emollients, skin foods, salves, superfatted soaps, and fur dressing”;²⁸
- THE NATIONAL LIBRARY OF MEDICINE describes lanolin as “a yellow fat obtained from sheep’s wool ... also called **wool wax** or wool grease”;²⁹
- A WIKTIONARY.COM entry regarding “**wool wax**” defines the terms as “lanolin” and notes the synonyms are “wool fat” and “wool grease”;³⁰
- A WIKIPEDIA.COM entry about lanolin reads: “Lanolin, ... also called wool yolk, **wool wax** or wool grease, is a wax secreted by the sebaceous glands of wool-bearing animals”;³¹

²⁶ 22 TTABVUE 20.

²⁷ *Id.* at 28.

²⁸ BRITANNICA.COM, 19 TTABVUE 127.

²⁹ PUBCHEM.NCBI.MLM.NIH.GOV, *id.* at 131.

³⁰ WIKTIONARY.COM, *id.* at 177.

³¹ WIKIPEDIA.COM, *id.* at 179. We take into account the fact that Wiktionary and Wikipedia are open content sources and are therefore not as reliable as traditional dictionaries. *See In re IP Carrier Consulting Grp.*, Serial Nos. 78542726 and 78542734, 2007 WL 1751192, at *4 (TTAB 2007) (“Our consideration of Wikipedia evidence is with the recognition of the limitations inherent with Wikipedia (e.g., that anyone can edit it and submit intentionally false or erroneous information.”).

- An article from DOSE-RESPONSE: AN INTERNATIONAL JOURNAL entitled “**Wool Wax** Extraction From Washing Effluent and Effect on *Olea europea* Germination and Growth” which reads, in part, “Wool is the fiber that protects and covers the body of some animals such as sheep and camels. Sheep wool was used by humans since 4,000 BC. The original fiber is usually dirty with three different compounds, the animal grease, secreted by the sebaceous glands and usually called **wool wax** ...”;³²
- An article from SKIN PHARMACOLOGY AND PHYSIOLOGY entitled “Solvent-Extracted **Wool Wax**: Thermotropic Properties and Skin Efficacy” which reads, in part, “**Wool wax** is a soft, yellow, waxy substance that is secreted by the sebaceous glands of sheep. The purpose of **wool wax** is to waterproof and protect the wool ... Lanolin is a smelly, pale-yellow, natural oil that can be described as the wax obtained from the wool of sheep ... **Wool wax** is secreted from the skin of sheep ...”;³³
- An article on OVERDRIVEONLINE.COM discusses various lubricant products describing one of them as a “nonhazardous, nontoxic **woolwax** lanolin formula won’t freeze in harsh weather conditions and retains its lubricating characteristics”;³⁴
- An article entitled “Beyond WD-40: Lubes for the Home Shop” discussing various lubricants which reads “Sheep’s wool is the source of one of the most useful natural lubricants, called **woolwax** or lanolin”;³⁵
- An article entitled “The Lanolin-**Wool Wax** Alcohol Update” which reads “That substance, **wool wax**, derived from the sebaceous glands of sheep was found to be an outstanding emollient”;³⁶
- A protectant, PFC Protection First Class, which is described as “BERKEBILE 2+2® PROTECTION FIRST CLASS ... The unique lanolin (**Wool Wax**) based formula ... gives long lasting protection from rust and corrosion by covering the metal with a clear wax film ... Excellent vehicle undercoating... Long Term Lubrication”;³⁷ and

³² *Id.* at 45.

³³ *Id.* at 52.

³⁴ 21 TTABVUE 21.

³⁵ HACKADAY.COM, 19 TTABVUE 262.

³⁶ CONSULTANT360.COM, *id.* at 306.

³⁷ BERKEBILEOIL.COM, *id.* at 232.

- An article from LANOLIN.COM which describes the industrial use of lanolin and reads “Over the centuries, people have discovered that the valuable qualities of **wool wax** can be used for a variety of technical applications, such as lubricants or protective preparations for ferrous metals ... Lanolin is an important component of a broad range of industrial applications, and is a powerful rust preventative with excellent protective properties for ferrous metals.”³⁸

Opposer also asserts that it orders “its products from abroad,”³⁹ submitting a 2021 purchase order from Hodt Korrosionsschutz GmbH in Germany which lists the substance purchased by Opposer as “Woolwax fatty acids, 85 drums of 180kg”;⁴⁰ and a 2022 delivery order and invoice from CT Customs Broker in California which describes Opposer’s imported items as ‘WOOLWAX FATTY ACIDS.’⁴¹

“Whether a mark is merely descriptive or not is ‘determined from the viewpoint of the relevant purchasing public.’” *In re Stereotaxis, Inc.*, 429 F.3d 1039, 1043 (Fed. Cir. 2005) (quoting *In re Bed & Breakfast Registry*, 791 F.2d 157, 160 (Fed. Cir. 1986)). The Application contains no consumer restrictions in the identification of goods and Applicant has not otherwise identified who the relevant consumer may be. *See In re Omniome, Inc.*, Serial No. 87661190, 2019 WL 7596207, at *7 (TTAB 2019) (although Applicant did not define the relevant consumers, consumers determined from identification of goods in application and industry articles made of record). We note, however, that the specimen submitted with the Application includes proposed uses of

³⁸ LANOLIN.COM, *id.* at 390.

³⁹ 22 TTABVUE 16.

⁴⁰ 18 TTABVUE 52.

⁴¹ *Id.* at 54-56.

the applied-for goods which reads: “Woolwax® is ... used in highly corrosive marine and automotive environments ... in the aircraft and manufacturing industries as well as for home maintenance”;⁴² and “Woolwax® is ideal for almost any application that requires long term corrosion protection or lubrication. Some things that people use Woolwax® for:” and then lists: vehicle undercoating, battery terminals, tractor, heavy machinery, boat trailers, chains of all types, garage door tracks, hinges, lawn mowers, snow throwers, locks.⁴³ The specimen then continues that “Almost anything that has a moving metal part can be lubricated and protected with Woolwax®.”⁴⁴ Based on the record before us, we find the relevant consumers are people interested in corrosion inhibitors in the nature of a coating; rust preventatives in the nature of a coating; and all purpose lubricants. This includes ordinary members of the general public.

As all this evidence shows, wool wax is at least highly descriptive. Consumers encountering the proposed mark WOOLWAX will clearly understand that, in the context of Applicant’s goods, the mark refers to coatings and lubricants made of wool wax.

Applicant’s own use further supports this finding. Applicant’s specimen and website describe its goods as a product that “is formulated to be thicker than any other lanolin based undercoating product”;⁴⁵ and “**Note:** WOOLWAX® contains more

⁴² March 10, 2021 Specimen at TSDR 8.

⁴³ *Id.* at 9-10.

⁴⁴ *Id.* at 10.

⁴⁵ March 10, 2021 TEAS Plus New Application at TSDR 5; WOOLWAXUSA.COM, 19 TTABVUE 214.

raw woolwax (lanolin) than any competitive product.”⁴⁶ The specimen submitted with the Application additionally reads “Woolwax® is formulated from woolwax (lanolin), highly refined petroleum oils and selected agents to provide corrosion control, penetration, lubrication and water displacement.”⁴⁷ In the “FAQs” section of Applicant’s website, it asks the question “What is the difference between Woolwax® and other lanolin film type products” and answers that “Woolwax® is made from lanolin/woolgrease.”⁴⁸ Opposer further notes that it accessed a blogpost entitled “Car & Truck Undercoating” from the section “Blog Home” on an additional website of Applicant’s,⁴⁹ where Applicant promotes use of its WOOLWAX branded goods for corrosion protection and describes the goods as “Woolwax® is made from lanolin. Also known as wool grease, wool fat, woolwax. Lanolin comes from sheep’s wool.”⁵⁰ Indeed, Applicant admits that “the presence of ‘WAX’ in the mark may suggest that the product is a coating of some kind.”⁵¹

In view of all this evidence, we find the terms composing Applicant’s proposed mark, WOOL and WAX, individually and when combined as WOOLWAX are at the very least highly descriptive of Applicant’s goods. *See, e.g., In re Uman Diagnostics AB*, Serial No. 88960633, 2023 WL 2039689, at *21 (TTAB 2023) (finding NF-LIGHT

⁴⁶ *Id.* at 5; WoolwaxUSA.com, *id.* at 215.

⁴⁷ *Id.* at 11.

⁴⁸ WoolwaxUSA.com, *id.* at 186.

⁴⁹ *Id.* at 11.

⁵⁰ KELLSPORTPRODUCTS.COM, *id.* at 432.

⁵¹ 23 TTABVUE 8.

“at the very least highly descriptive” of biological specimen analysis kits); *Fat Boys Water Sports*, 2016 WL 3915986, *6 (combination of descriptive terms does not “convey[] any distinctive source-identifying impression contrary to the descriptiveness of the individual parts”). It is evident that a significant attribute of Applicant’s coatings and lubricants is that they are made of the ingredient wool wax.

Having determined that WOOLWAX is at least highly descriptive as used in connection with Applicant’s goods, we now turn to the sufficiency of the evidence in support of Applicant’s claim of acquired distinctiveness.

B. Acquired Distinctiveness

When proposed marks are highly descriptive, a statement of use for at least five years, or even longer, is generally insufficient to show acquired distinctiveness. *See In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1332, 1337 (Fed. Cir 2015) (“[p]articularly for a mark that is as highly descriptive like FISH FRY PRODUCTS, the Board was within its discretion not to accept Louisiana Fish Fry’s alleged five years of substantially exclusive and continuous use as prima facie evidence of acquired distinctiveness.”).

The Federal Circuit set out factors to consider in assessing whether a mark has acquired distinctiveness, stating as follows:

[T]he considerations to be assessed in determining whether a mark has acquired secondary meaning can be described by the following six factors: (1) association of the trade[mark] with a particular source by actual purchasers (typically measured by customer surveys); (2) length, degree, and exclusivity of use; (3) amount and manner of advertising; (4) amount of sales and number of customers; (5) intentional copying; and (6) unsolicited media coverage of the product embodying the mark.

Converse, Inc. v. Int’l Trade Comm’n, 909 F.3d 1110, 1120 (Fed. Cir. 2018). On this list, no single factor is determinative and “[a]ll six factors are to be weighed together in determining the existence of secondary meaning.” *In re Guaranteed Rate, Inc.*, Serial Nos. 87054820 and 87054849, 2020 WL 4383820, at *3 (TTAB 2020) (quoting *Converse*, 909 F.3d at 1120); *In re Tires, Tires, Tires Inc.*, Serial No. 77091459, 2009 WL 4075360, at *6 (TTAB 2009).

Applicant relies on its responses to Opposer’s discovery requests regarding its “advertising expenditures, sales success, and length of use,”⁵² invoking *Converse* factors 2, 3 and 4 to support that WOOLWAX has acquired distinctiveness for Applicant’s goods.

We first address Applicant’s argument and evidence regarding its length of use. Applicant argues that it “has had substantial usage of WOOLWAX as a trademark for particular products since 2013”;⁵³ that its “channels of distribution of products bearing Applicant’s mark have been diverse, and have included wholesale, retail, Internet online, trade show advertising, online advertising, and the distribution of a variety of promotional products, all of which were throughout the entire United States over a ten-year period.”⁵⁴ Applicant’s evidence regarding its date of first use is a table provided in response to Opposer’s interrogatory no. 3 asking the date of first use for each good for which WOOLWAX was used which we reproduce below:

⁵² 23 TTABVUE 10.

⁵³ 23 TTABVUE 9; *see* 20 TTABVUE 18.

⁵⁴ 23 TTABVUE 9; *see* 20 TTABVUE 23.

	<u>Date of 1st use</u>	<u>Retail</u>	<u>Markup</u>
Automotive Undercoating	2013	\$10 - \$229	25% - 40%
Spray Guns	2013	\$45 - \$90	25% - 40%
T shirts	2013	\$6	0%
Sweatshirts	2013	\$10	0%
Floor mats	2017	0	
Calendars	2014	0	
Popsockets	2022	0	
Trade show bags	2017	0	
Plastic Mugs	2015	0	
Flyers	2013	0	
Keychains	2014	0	

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This table provides a date of first use of 2013 for WOOLWAX for “Automotive Undercoatings” which could be categorized as “corrosion inhibitors in the nature of a coating; rust preventatives in the nature of a coating” in Class 2 but none of the remaining goods appear to fall within the category of “all purpose lubricants” in Class 4. Regardless, this evidence has little probative value of acquired distinctiveness. This evidence indicates that Applicant began use of WOOLWAX on certain goods as of certain years but fails to address the length of use and whether it has been ongoing, the extent of that use, whether use was exclusive or the impact that use may have had on consumers of Applicant’s goods.

Even if we assume Applicant has had ongoing use of WOOLWAX for all its applied-for goods since 2013, standing alone, that length of time is not persuasive

⁵⁵ 20 TTABVUE 13.

given the highly descriptive nature of WOOLWAX. *See, e.g., Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, Cancellation No. 92050879, 2013 WL 5407315, at *19 (TTAB 2013) (finding 21 years of continuous use alone insufficient to establish acquired distinctiveness of highly descriptive phrase ANNAPOLIS TOURS); *In re Packaging Specialists, Inc.*, Serial No. 73250697, 1984 WL 63099, at *3 (TTAB 1984) (deeming use of PACKAGING SPECIALISTS, INC. for 16 years “a substantial period but not necessarily conclusive or persuasive on the Section 2(f) showing”). We must consider the length of Applicant’s use in connection with other evidence of how consumers perceive Applicant’s proposed mark. *See In re GJ & AM, LLC*, Serial No. 86858003, 2021 WL 2374670, at *20 (TTAB 2021).

Applicant offered further evidence in support of its acquired distinctiveness claim, specifically, its promotional efforts and sales. Applicant argues, supported by its responses to Opposer’s interrogatories, that its “promotional products bearing the mark have included trade show bags, key chains, floor mats, and calendars, and all such items have been widely distributed by Applicant for well over five years”;⁵⁶ and those channels of distribution include “wholesale, retail, Internet online, trade show advertising, online advertising and the distribution of a variety of promotional products, all of which were throughout the entire United States over a ten-year period.”⁵⁷ Applicant continues that its advertising materials have included “Google

⁵⁶ 23 TTABVUE 9; *see* 20 TTABVUE 24.

⁵⁷ *Id.*; *see id.* at 22-23.

Ads, Facebook ads, Amazon ads, and flyers” over a period of over five years;⁵⁸ and that its “anticipated advertising and marketing expenses, including commissions, are approximately \$56,000 annually.”⁵⁹ In interrogatory no. 2, Opposer asks Applicant to “IDENTIFY all of the goods and/or services with which the WOOLWAX MARK has been used or is currently being used by YOU.”⁶⁰ In response, Applicant answered “Automotive Undercoating, Spray Guns, T-shirts, Sweat shirts, floor mats, calendars, pop sockets, trade show bags, plastic mugs, flyers, keychains.”⁶¹ Thereafter, in response to Opposer’s interrogatory no. 12 asking the monthly revenues generated by sales of the goods and/or services identified in response to interrogatory no. 2, Applicant responded that its “[t]he monthly average is \$116,000.”⁶²

Applicant’s evidence regarding its advertising and marketing expenditures is “anticipated” not actual expenses but even if the expenses were actual, we have no information regarding how these expenditures resulted in the exposure of Applicant’s proposed mark to consumers. Indeed, Applicant has not proffered any examples of its advertising and marketing efforts. There is also no evidence about how many or how often Applicant’s advertisements appeared in the various mediums and channels, or how many consumers were or may have been exposed to its advertising. In sum, there is no evidence regarding the impact or extent of the advertising or marketing efforts.

⁵⁸ 23 TTABVUE 9; *see* 20 TTABVUE 24.

⁵⁹ 23 TTABVUE 9; *see* 20 TTABVUE 19.

⁶⁰ 20 TTABVUE 17.

⁶¹ *Id.* at 18.

⁶² *Id.* at 22; *see* 23 TTABVUE 10.

Without further information as to the nature, kind, and extent of its advertising and marketing expenditures or context, Applicant's statements are of little probative value. *Mini Melts*, 2016 WL 3915987, at *19 (probative value of sales revenue figures quantified as doses sold is diminished by the fact that the amount is just a raw number without context as to applicant's market share or whether this amount is significant in the industry).

Applicant's evidence regarding its monthly revenue is vague, giving no specific timeframe or specific goods. We have no indication if its revenue of \$116,000 is for every month since 2013, whether this revenue reflects more recent sales only, or whether the revenue could be for some undisclosed range in time. Further, the revenue is not broken down by product so we have no way of knowing if the revenue is limited to the applied-for goods or the broader range of goods on which Applicant has used the mark, according to its answer to interrogatory no. 3.⁶³

Even if we assume monthly sales of \$116,000 from 2013 to date are for the applied-for goods only, "Applicant's sales and advertising figures, without any context in the trade, are not so impressive as to support a finding that Applicant's highly descriptive [proposed mark WOOLWAX] has acquired distinctiveness." *GJ & AM*, 2021 WL 2374670, at *21. "[W]e cannot accurately gauge Applicant's level of success without additional evidence as to Applicant's market share or how [WOOLWAX] ranks in terms of sales in the trade." *Id.*; see *Mini Melts*, 2016 WL 3915987, at *19 (probative value of sales revenue figures quantified as doses sold is diminished by the fact that

⁶³ 20 TTABVUE 19.

the amount is just a raw number without context as to the applicant's market share or whether this amount is significant in the industry); *cf. Omaha Steaks Int'l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1320 (Fed. Cir. 2018) ("contextual evidence of the type[s] of advertisements and promotions it uses to gain sales" provided); *Target Brands*, 2007 WL 4287253, at *6 (stating that it is difficult to accurately gauge the level of success in the relevant industry based on sales figures alone, in the absence of additional information such as market share). Further, the raw numbers, although showing a certain level of success of Applicant's endeavors, do not necessarily evidence consumers' recognition of the proposed mark as a source indicator. *See In re Boston Beer Co. L.P.*, 198 F.3d 1370, 1373 (Fed. Cir. 1999); *Mini Melts*, 2016 WL 3915987, at *19. Applicant's sales may simply reflect the popularity of its goods, rather than recognition of its applied-for mark. *See Target Brands*, 2007 WL 4287253, at *6 n.6.

Given the highly descriptive nature of Applicant's proposed mark, Applicant is obliged to adduce a great deal more evidence to meet its burden of proof. *See, e.g., In re Crystal Geyser Water Co.*, Serial No. 76201270, 2007 WL 1591082, at *5 (TTAB 2007) (holding applicant's evidence of acquired distinctiveness, including a claim of use since 1990, sales of more than 7,650,000,000 units of its goods, and extensive display of its mark CRYSTAL GEYSER ALPINE SPRING WATER on advertising and delivery trucks and promotional paraphernalia, insufficient to establish that the highly descriptive phrase ALPINE SPRING WATER had acquired distinctiveness for applicant's bottled spring water). Considering the *Converse* factors for which there is

evidence, we find that Applicant has failed to meet its burden of showing that the highly descriptive proposed mark WOOLWAX has acquired distinctiveness. *See GJ & AM*, 2021 WL 2374670, at *22. Applicant has not established that “in the minds of the public, the primary significance of [WOOLWAX] is to identify the source of the product rather than the product itself.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1379 (Fed. Cir. 2012).

V. Conclusion

After considering all the evidence of record, we find that Applicant has failed to establish that the highly descriptive proposed mark WOOLWAX has acquired distinctiveness as a source-indicator for its goods, “corrosion inhibitors in the nature of a coating; rust preventatives in the nature of a coating” and “all purpose lubricants.”

Decision: We sustain the opposition to register WOOLWAX on the ground that it is merely descriptive and has not acquired distinctiveness.