

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: May 11, 2010

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Weeks Dye Works, Inc.  
v.  
Valdani, Inc.

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Cancellation No. 92049174

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Peggy S. Vincent of Walker Lambe Rhucy & Costley, PLLC for  
Weeks Dye Works, Inc.

Sam A. Binder of Synder & Associates LLP for Valdani, Inc.

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Before Quinn, Kuhlke and Cataldo, Administrative Trademark  
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Weeks Dye Works, Inc. has petitioned to cancel  
Registration No. 3245617 owned by Valdani, Inc. for the  
standard character mark THREE-STRAND FLOSS for "cotton  
thread and yarn" in International Class 23, issued on the  
Supplemental Register on May 22, 2007. The registration  
contains a disclaimer for the word "FLOSS."

As grounds for cancellation petitioner alleges that  
"[t]he number of strands in a piece of floss or yarn is

important information the consumer wants and needs when purchasing this product" and respondent's "mark, THREE-STRAND FLOSS, as applied to thread and floss or yarn is functional and merely descriptive [and] is not distinctive of [respondent's] goods in commerce." Petition ¶¶ 7, 9-10.

Respondent, in its answer, denies the salient allegations in the petition for cancellation.

**Accelerated Case Resolution (ACR)/The Record**

The parties stipulated to submission of evidence under notice of reliance and waived hearsay objections.<sup>1</sup>

By operation of Trademark Rule 2.122, 37 C.F.R. §2.122, the record in this case consists of the pleadings and the file of the involved registration. In addition, the record includes various documents, including excerpts from reference books, printed publications, third-party websites, punch needle kits, email and letter correspondence from designers and other manufacturers, and respondent's advertising, all submitted under notice of reliance.

As a preliminary matter and to clarify what is in issue in this case, the subject registration resides on the Supplemental Register; therefore, the question of whether

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<sup>1</sup> The Board commends the parties in their effort to streamline the proceeding. Such stipulations reduce the time and expense of Board litigation and are considered one variety of ACR. Additional information on this procedure is available on the United States Patent and Trademark Office (USPTO) website at [www.uspto.gov/web/offices/com/sol/notices/acrognoticerule.pdf](http://www.uspto.gov/web/offices/com/sol/notices/acrognoticerule.pdf).

the mark is descriptive is not relevant to the extent that descriptiveness does not prohibit such registration. All marks capable of distinguishing an applicant's goods or services, but otherwise unregistrable on the Principal Register, because, for example, they are merely descriptive, may be registered on the Supplemental Register. Section 23, 15 U.S.C. §1091. Generic, or otherwise non-distinctive incapable, matter may not be registered on the Supplemental Register. Therefore, the only issue to be decided is whether respondent's mark THREE-STRAND FLOSS is generic for floss made of three strands and as such unregistrable on the Supplemental Register.

Further, while the fact that the cited registration is on the Supplemental Register does not constitute an admission that the mark has not acquired distinctiveness, 15 U.S.C. 1095, by its amendment to the Supplemental Register respondent conceded that, at that time, its mark was merely descriptive and it is an implied admission that the registered term was descriptive at least at the time of the respondent's first use of the term. *Perma Ceram Enterprises Inc. v. Preco Industries, Ltd.*, 23 USPQ2d 1134 n.11 (TTAB 1992). See also *In Eddie Z's Blinds and Drapery Inc.*, 74 USPQ2d 1037, 1039 (TTAB 2005).

Finally, to be clear, while prosecuting its underlying application, respondent did not show acquired

distinctiveness and did not register under Section 2(f). Rather, the examining attorney found respondent's mark to be descriptive and allowed respondent to amend to the Supplemental Register and to withdraw its disclaimers of the words THREE and STRAND.<sup>2</sup>

### **Standing**

Petitioner has established that it is a competitor of respondent and uses the term "3 Strand Floss" and "Three Strand Floss" in connection with floss. Therefore, petitioner has shown a real interest in the outcome of this proceeding. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000) and *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999).

### **CLAIM OF GENERICNESS**

In order to prevail, petitioner must establish genericness by a preponderance of the evidence. *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991). The critical issue in determining genericness is whether members of the relevant public primarily use or understand the designation sought to be registered or that is already registered to refer to the genus or category of goods in question. See *H. Marvin Ginn Corp. v.*

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<sup>2</sup> This is not to say respondent's arguments regarding "secondary meaning" or "acquired distinctiveness" have absolutely no relevance, simply that such a showing is not required for a mark to be registrable on the Supplemental Register.

International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

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.

The genus or category of goods involved in this case comprises those goods set forth in the identification, namely, "cotton thread and yarn" which includes "floss." See e.g., respondent's specimen of use. Magic Wand, 19 USPQ2d at 1552. As respondent explains "[t]he reasons for applying for this trademark in both cotton and yarn was due to the fact that floss is considered by cross-stitchers and needlepointers thread, while knitters usually consider it yarn." App. Br. pp. 4-5.

The next question we must address is whether the relevant purchasers for the identified goods would understand THREE-STRAND FLOSS to refer to the genus. Because the goods are consumer items, the relevant purchasers would be the general public.

"Evidence of purchaser understanding may come from direct testimony of consumers, consumer surveys, dictionary listings, as well as newspapers and other publications." Magic Wand, 19 USPQ2d at 1553.

Petitioner argues that it is "the industry's common practice of stating the number of strands when referencing floss, whether in conjunction with the sale of floss, kits that use floss, or needles used with floss." Rebuttal Br. p. 7.

"Strand" is defined as:

1. A complex of fibers or filaments that have been twisted together to form a cable, rope, thread, or yarn.
2. a. A single filament, such as fiber or thread, or a woven or braided material.

The American Heritage Dictionary of the English Language (3<sup>rd</sup> ed. 1992).

The Complete Textile Glossary published by Celanese Acetate in 2001 provides the following definitions:

PLY: 1. The number of single yarns twisted together to form a plied yarn, or the number of plied yarns twisted together to form cord. 2. An individual yarn in a plied yarn or cord. 3. One of a number of layers of fabric ASTM. 4. The number of layers of fabric, as in a shirt collar, or of cord in a tire.

Strand: 1. A single fiber, filament, or monofilament. 2. An ordered assemblage of textile fibers having a high ratio of length to diameter and normally used as a unit; includes slivers, roving, single yarns, plies yarns, cords, braids, ropes, etc.

Petitioner submitted a letter from Stephen Mancuso, Vice President of Marketing for the DMC Corporation, a floss manufacturer, who explains that:

Regarding our discussion of 6 strand and 3 strand embroidery floss, we define the number of strands

in embroidery floss as the make-up of the thread. It refers to the construction of embroidery floss. Additionally, because design charts reference the number of strands required to stitch the project, referencing the number of strands that make-up a particular brand of floss is necessary so stitchers know how many strands to pull out and use. Please note, manufacturers of competitive 6-strand embroidery floss brands all use the words '6-strand' to describe their floss that is made up of 6 strands.

Pet. Rebuttal Exh. No. 8.

James K. Pridmore of D & K Technical Resources, LLC, in another letter submitted by petitioner, states that he has been in the textile industry for over thirty years and explains that "A six-strand cabled yarn made up of 2 ply 30 cotton count yarn would be written 30/2/6. In short this means that strand is a widely accepted term that indicates the number of plied ends twisted together to form a cabled yarn." Rebuttal Exh. No. 9.

Several of the exhibits show use of the same phrasing as the name of a type of thread, indicating the number of strands:

Purveyors of "gently overdyed 6-strand cotton embroidery floss called ... Exh. No. 4, [www.thegentleart.com](http://www.thegentleart.com);

Metallic No. 4, Four Strand Floss, 22 yd/20m ... Exh. No. 5, [www.sewingandcraftclub.com](http://www.sewingandcraftclub.com);

Crescent Colours ... 182 beautiful colors of six-stranded cotton embroidery floss, soft good coverage and dyelot consistent... Exh. No. 6, [www.crescentcolours.com](http://www.crescentcolours.com);

DMC six-strand embroidery floss is 100% long-staple cotton... Exh. No. 7, [crossstitch.about.com](http://crossstitch.about.com);

Anchor 6-Strand Embroidery Floss ... Turn shopping time into stitching time... receive 100 of their most popular colors of high-quality, long fiber, 6-strand floss, plus a color conversion chart... Exh. No. 10, [www.herrschners.com](http://www.herrschners.com);

Thread Options for Punch Needle Embroidery ... I get lots of calls asking what different threads I recommend for punch needle embroidery. I use Wildflower 100% cotton thread by Caron on most of my punch needle embroideries. I use it as is (do not separate the strands) in the 3-strand punch needle. It's variegated and I think the gradations in the thread make the embroidery piece more interesting. Other brands I recommend for 3-strand punching: DMC 6-strand floss - use 3 strands; Anchor 6-strand floss - use 3 strands; Valdani #8 - use as is; Sulky Blendables Thread - use as is... Exh. No. 11, [sew-be-it.biz/punch\\_needle\\_patterns.html](http://sew-be-it.biz/punch_needle_patterns.html);

This is one punch needle blanket in a series of 12 months created for our woolen sheep to be displayed throughout the year. For your convenience, 6 separate patterns are available with a color photo of months May-October...Use 3 strands of floss unless otherwise noted when punching. All floss used for the project was from DMC and from [www.weeksdiyeworks.com](http://www.weeksdiyeworks.com). Exh. No. 12;

See also Exh. No. 3 wherein a type of punch needle is identified by the type of thread based on the number of strands in the thread: "Russian punch 1,2,3,6 strands," [punchneedlemarketplace.com](http://punchneedlemarketplace.com).

It is undisputed that respondent uses THREE-STRAND FLOSS in connection with floss comprised of three strands. See, e.g., Pet. Rebuttal Exh. No. 1 ("NEW 3 Strand Hand Over-dyed Embroidery floss by Valdani ... Yes, you read that



Cancellation No. 92049174

correctly...finally an embroidery floss that already comes divided down to 3 strands!" [www.countrystitchesonline.com](http://www.countrystitchesonline.com)) and Exh. No. 2 ("Punchneedle 0592 Primitive Purple 3 Strand Cotton Floss Valdani 29yd ball Free Shipping" [snowflakememories.ecrater.com](http://snowflakememories.ecrater.com)).

Set forth below is the specimen of use submitted by respondent in support of its registration:



Below is an advertisement for respondent's three-strand floss.

**Born to be your favorite!**

www.valdani.com  
Toll-Free: 1.866.VALDANI

**MORE FUN!**

adorable balls with lots of yardage that will give you many hours of joy!

**THREE-STRAND FLOSS**  
made specially for you, only from Valdani!

**LESS WORK!**

Punchneedle Artists and Cross-Stitchers, get the hottest product on the market! Enjoy countless hours of fun with no more work dividing the strands. Comes in hundreds of wonderful shades of Solid, Hand-Dyed, Variegated and Hand-Overdyed Colors.

Resp. Exh. No. 3.

Underneath "Less Work!" it reads: "Punchneedle Artists and Cross-Stitchers, get the hottest product on the market! Enjoy countless hours of fun with no more work dividing the strands. Comes in hundreds of wonderful shades of Solid, Hand-Dyed Variegated and Hand-Overdyed Colors."

In an excerpt from the April 2007 issue of the magazine titled "American Patchwork and Quilting" respondent's product is referenced as follows:

Pull three strands of embroidery floss directly from the spool, thread your needle, and start sewing with Three-Strand Floss by Valdani Inc. Created to eliminate the need to separate strands in a skein, this floss comes in balls of 27 meters..." Resp. Exh. No. 7.

The essence of respondent's position is that the product marketed under THREE-STRAND FLOSS is new and the "phrase 'THREE-STRAND FLOSS' ... was never used before" and is associated with respondent. App. Br. p. 9. In addition, respondent argues that "ply" and "strand" are used interchangeably, presumably to support the proposition that the word "strand" is not necessary for others to use in that particular combination.

In support of its position, respondent submitted email correspondence from three individuals in the design end of the business. Relevant excerpts are set forth below:

Valdani has designed and created the new 3-ply floss balls and spools, named "Three-Strand Floss." It was introduced in early 2006. This

new product was created in response to the punch needle market's needs for designer and consumers. The[re] was no product in our market like this before. We have extensively marketed and sold this beautiful product ever since it was introduced, as "Three-Stranded Floss." ... All of my customers know that this thread is produced by Valdani. Many on them identify it with the company itself, calling it "the three-strand floss company". Exh. No. 14;

In preparation for the 2005 Market, I conducted a survey of both stitchery designers and consumers to determine if there was a market for 3-strand floss. ... In 2006, Three Strand Floss was introduced to the US Market. As a designer, I am responsible for 2 color collections that are part of Three Strand Floss. As a result of the introduction, Valdani is now known worldwide as the Three Strand Floss Company. Exh. No. 15; and

In early 2006 Valdani introduced their new 3-Ply floss balls and spools which is named "Three-Strand Floss". Until that time there was no product like it on the market. The colors are beautiful and the "Three-Strand Floss" is wonderful to work with. Valdani has become known as "the three-strand floss company". Exh. No. 16.

Respondent also submitted the top 10 results from a search for "three strand floss" on two search engines showing "three strand floss" in the same result as "Valdani."

The fact that the three-strand floss is a new product and respondent is the first to use "three-strand floss" in connection with floss is not dispositive. As stated in *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987) (citations omitted):

Generic terms, by definition incapable of indicating source, are the antithesis of trademarks, and can never attain trademark status. The reason is plain: To allow trademark protection for generic terms, i.e., names which describe the genus of goods being sold, even when these have become identified with a first user, would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.

See also In re National Shooting Sports Foundation, Inc., 219 USPQ 1018 (TTAB 1983) (SHOOTING, HUNTING, OUTDOOR TRADE SHOW AND CONFERENCE held apt descriptive name for conducting and arranging trade shows in the hunting, shooting, and outdoor sports products field).

Moreover, even if another word, such as "ply," is available for competitors to use in connection with their floss, the fact that another term is available for use by competitors does not transform a generic term into capable matter. Blinded Veterans Ass'n v. Blinded American Veterans Foundation, 872 F.2d 1035, 10 USPQ2d 1432, 1437 (D.C. Cir. 1989) ("A term need not be the sole designation of an article in order to be generic...").

Finally, respondent's efforts, as reflected in respondent's use and the emails from various designers, cannot transform incapable matter into a mark. "While it is always distressing to contemplate a situation in which money has been invested in a promotion in the mistaken belief that trademark rights of value are being created, merchants act at their peril in attempting, by advertising, to convert

common descriptive names, which belong to the public, to their own exclusive use. Even though they succeed in the creation of de facto secondary meaning, due to lack of competition or other happenstance, the law respecting registration will not give it any effect." *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845, 129 USPQ 411, 414 (CCPA 1961). See also *Blinded Veterans Ass'n v. Blinded American Veterans Foundation*, 10 USPQ2d at 1435 ("Because a generic term denotes the thing itself, it cannot be appropriated by one party from the public domain; it therefore is not afforded trademark protection even if it becomes associated with only one source."); *In re Mortgage Bankers Ass'n of America*, 226 USPQ 954 (TTAB 1985) (CERTIFIED MORTGAGE BANKER ("MORTGAGE BANKER" disclaimed) for "educational services, namely providing qualifying examinations, testing and grading in the field of real estate finance" held so highly descriptive as to be incapable of functioning as a mark notwithstanding evidence of acquired distinctiveness) and *In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219, 222 (TTAB 1984) (HALF PRICE BOOKS RECORDS MAGAZINES for retail book and record store services "is incapable of designating origin and any evidence of secondary meaning can only be viewed as 'de facto' in import and incapable of altering the inability

**Cancellation No. 92049174**

of the subject matter for registration to function as a service mark").

Based on this record, we find that it is common practice in the industry to refer to the genus of "cotton thread and yarn" by the number of strands in the product in the format with the number first followed by the words "strand" and "floss." In view thereof, the term THREE-STRAND FLOSS is generic for "cotton thread and yarn" and respondent may not lay claim to that particular arrangement of words.

In view of the above, petitioner has carried its burden of proof and respondent has not sufficiently rebutted that proof.

**Decision:** The petition to cancel Registration No. 3245617 is granted.