

THIS OPINION  
IS NOT A PRECEDENT  
OF THE TTAB

Mailed: June 21, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Rheinzink GmbH & Co., KG*

*v.*

*Western States Decking, Inc.*  
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Cancellation No. 92059862  
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Karl F. Milde, Jr. of Eckert Seamans Cherin & Mellott LLC  
for Rheinzink GmbH & Co., KG

Erin C. Bray of Lee Lee & Associates PC  
for Western States Decking, Inc.  
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Before Quinn, Ritchie and Pollogeorgis,  
Administrative Trademark Judges.

Opinion by Pollogeorgis, Administrative Trademark Judge:

Western States Decking, Inc. (“Respondent”) owns a registration on the  
Supplemental Register for the mark PATINA, in standard characters, for

“Metal roofing; Metal roofing panels; Metal roofing tiles; Metal tiles for walls, ceilings” in International Class 6.<sup>1</sup>

Rheinzink GmbH & Co., KG (“Petitioner”) filed a petition (as amended) to cancel Respondent’s registration on the following grounds: (1) the PATINA mark is generic for the goods identified in the registration; (2) the PATINA mark is incapable of indicating source inasmuch as it fails to function as a trademark; and, in the alternative, (3) likelihood of confusion with Petitioner’s pleaded common law mark PATINA LINE and Petitioner’s registered mark RHEINZINK-PREPATINA, used together in the sale of a variety of metal goods and services.<sup>2</sup>

In its answer to the amended petition to cancel, Respondent denied most of the salient allegations.<sup>3</sup> Respondent, however, did admit the following: (1) that Respondent, by its attorney JungJin Lee, Esq., wrote a letter to Petitioner’s U.S. subsidiary RHEINZINK America, Inc., dated July 25, 2014, demanding that Petitioner cease and desist using the expression “THE PATINA LINE” in Petitioner’s advertising; (2) that Petitioner’s “PATINA LINE” designation includes a variety of metal surfaces; (3) that Respondent claimed that Petitioner’s use of the “THE PATINA LINE” infringed its rights in the mark of Respondent’s registration on the Supplemental Register for “PATINA” (Registration No. 4,408,887); that Respondent alleged that “THE PATINA

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<sup>1</sup> Registration No. 4408887, registered on September 24, 2013, claiming June 1, 2013 as both the date of first use and the date of first use in commerce.

<sup>2</sup> 25 TTABVUE. *See also* PREPATINA, discussed in fn 7, *infra*.

<sup>3</sup> 26 TTABVUE.

LINE” and “PATINA” were confusingly similar and likely to cause confusion among consumers, “especially in combination with goods that are [alleged to be] identical or associated with the goods described in [Respondent’s] trademark registration; (4) that Registration No. 4408887 on the Supplemental Register is for the word “PATINA” as used in connection with “Metal roofing; Metal roofing panels; Metal roofing tiles; Metal tiles for walls, ceilings;” (5) that Respondent cannot claim a use date earlier than June 1, 2013 of its subject PATINA mark; and (6) that Petitioner is the owner of Registration No. 4303432 for the mark RHEINZINK-PREPATINA.<sup>4</sup>

Additionally, Respondent asserted five affirmative defenses.<sup>5</sup> We construe Respondent’s Affirmative Defense Nos. 1-4 as mere amplifications of the denials in its answer. *See Order of Songs of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995). With regard to Respondent’s Affirmative Defense No. 5, i.e., Petitioner lacks standing, we note that “lack of standing” is not an affirmative defense. Standing is an element of Petitioner’s claims. Petitioner must prove standing as part of its case. *See Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1637 (TTAB 2011).

#### *I. The Record*

The record includes the pleadings and, pursuant to Trademark Rule 2.122(b), Respondent’s subject registration.

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<sup>4</sup> 26 TTABVUE 5-6, and 11.

<sup>5</sup> 26 TTABVUE 15.

Petitioner has submitted the following evidence:

Petitioner's Notice of Reliance ("NOR") No. 1 consisting of (i) Respondent's answers to Petitioner's First Set of Interrogatories Nos. 3, 5, 6 and 9, and Exhibits 3 and 8 attached thereto; (ii) Respondent's answers to Petitioner's Second Set of Interrogatories Nos. 14, 18, 19, 22, 23 and 27, including Respondent's supplemental responses thereto; and (iii) Respondent's answers to Petitioner's First Set of Requests for Admission Nos. 1, 2, 3, 4, 7, 8, 9 and 12, including Respondent's supplemental responses thereto;<sup>6</sup>

Petitioner's NOR No. 2 consisting of status and title copies of Petitioner's U.S. Registrations for the marks REHINZINK-PREPATINA and PREPATINA;<sup>7</sup>

Petitioner's NOR No. 3 consisting of status and title copies of three third-party registrations that include the term PATINA as part of the registered mark and which provide a disclaimer of said term;<sup>8</sup>

Petitioner's NOR No. 4 consisting of copies of printed publications from newspapers, periodicals and journals downloaded from Lexis-Nexis.com purportedly showing generic use of the term PATINA by persons in the relevant trade and the general public for metal goods having a desirable, aged, weathered appearance;<sup>9</sup>

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<sup>6</sup> 36 TTABVUE. Although Petitioner, as identified on the cover sheet of its notice of reliance, has indicated that it is relying on certain responses provided by Respondent, Petitioner nonetheless submitted Respondent's responses to all of Petitioner's written discovery. Notwithstanding, the Board only deems the responses specifically identified and relied upon by Petitioner to be relevant. Moreover, the Board notes that Petitioner failed to indicate generally the relevance of these discovery responses to the issues in this proceeding, as required by Trademark Rule 2.122(g). However, since Respondent did not object to Petitioner's notice of reliance on this ground, such an objection is deemed waived.

<sup>7</sup> 37 TTABVUE. The Board notes that Petitioner did not plead ownership of the registered mark PREPATINA in its amended petition to cancel. *See* 25 TTABVUE. However, since Respondent did not object to the submission of this unpleaded registration and because Respondent addressed this mark in its brief, *see* 66 TTABVUE 62-63, we consider the unpleaded registration to have been tried by implied consent pursuant to Fed. R. Civ. P. 15(b), and that Petitioner's amended petition to cancel is deemed amended to conform to the evidence.

<sup>8</sup> 38 TTABVUE.

<sup>9</sup> 39 TTABVUE.

Petitioner's NOR No. 5 consisting of copies of printed publications from newspapers, periodicals and journals downloaded from the NEXIS computerized library purportedly showing that the generic use of the term PATINA by persons in the relevant trade and the general public is not restricted to a green or blue patina, but that patina metals have a range of colors;<sup>10</sup>

Petitioner's NOR No. 6 consisting of copies of printed publications from newspapers, periodicals and journals downloaded from the NEXIS computerized library purportedly showing generic use of the term PATINA by persons in the relevant trade and the general public for metals where the patina is induced or coated or painted on the metal, and for the synthetic treatment of metal, whether by chemical process or coating or painting, that create the desirable weathered appearance;<sup>11</sup>

Petitioner's NOR No. 7 consisting of a status and title copy of a third-party registration for the mark VARI-COOL purportedly used by Respondent as a mark for coatings and/or paints for application on metal goods;<sup>12</sup>

Testimony Deposition of Charles McGowan, president of Rheinzink America, Petitioner's U.S. subsidiary, with Exhibits 1-12, 14-15 (confidential information redacted);<sup>13</sup>

Testimony Deposition of Charles McGowan, with Exhibit 13 (filed under seal as confidential);<sup>14</sup>

Testimony Deposition of John F. Metzger, paralegal employed by Petitioner's counsel's law firm, with Exhibits 1-50;<sup>15</sup>

Supplemental Testimony Deposition of John F. Metzger, with Exhibits 51-71;<sup>16</sup>

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<sup>10</sup> 40 TTABVUE.

<sup>11</sup> 41 TTABVUE.

<sup>12</sup> 42 TTABVUE.

<sup>13</sup> 50 TTABVUE.

<sup>14</sup> 51 TTABVUE.

<sup>15</sup> 44 TTABVUE.

<sup>16</sup> 49 TTABVUE.

Expert Testimony Deposition of Todd Miller, with Exhibits 1-6;<sup>17</sup>

Expert Testimony Deposition of Robert Haddock, with Exhibits 1-6;<sup>18</sup> and

Expert Testimony Deposition of Brian D. McHugh, with Exhibits 1-3.<sup>19</sup>

Respondent did not submit any testimony. Respondent, however, did submit an amended notice of reliance (filed September 23, 2016)<sup>20</sup> that provides the following evidence: (1) status and title copies of Registration Nos. 4408887,<sup>21</sup> 4211538, 4385806 and 4622810 owned by Respondent (Exhibits A, S, T and U); (2) Respondent's responses and/or amended responses to Petitioner's First Set of Interrogatories, including documentary Exhibits 3, 4, and 8 (Exhibit B), First Set of Requests for Admissions (Exhibit C), Respondent's responses to Petitioner's Second Set of Interrogatories (Exhibit D), and Respondent's amended responses to Petitioner's Second Set of Interrogatories (Exhibit E), which Respondent indicates should be considered as to make not misleading responses previously provided by Petitioner; (3) printouts from Respondent's websites (Exhibits F and G); (4) dictionary definitions of the terms PATINA (Exhibit H), VINTAGE (Exhibit L) and RUST (Exhibit M); (5) an entry from the Encyclopedia Britannica regarding the term "patina" (Exhibit K); (6) articles

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<sup>17</sup> 53-54 TTABVUE.

<sup>18</sup> 52 TTABUVE.

<sup>19</sup> 43 TTABVUE.

<sup>20</sup> 59 TTABVUE.

<sup>21</sup> Respondent's Registration No. 4408887 for the mark PATINA is the subject registration to this proceeding and is automatically of record under Trademark Rule 2.122(b). Accordingly, Respondent's submission of a status and title copy of this registration under a notice of reliance was unnecessary.

downloaded from the internet (Exhibits I and J); and (7) copies of third-party registrations for the marks PATINAFORMA, PATINA HOME, PATINA, and VINTAGE. (Exhibits N-R.).

*II. Evidentiary Issue – Petitioner’s Motion to Strike Respondent’s Notice of Reliance*

On August 12, 2016, Respondent filed its original notice of reliance.<sup>22</sup> On August 24, 2016, Petitioner filed a motion to strike all the evidence in Exhibit B, including Exhibits 1-8 attached thereto, and Exhibits C, D and E of Respondent’s original notice of reliance on the ground that these exhibits do not comply with the Board’s procedural requirements for the submission of interrogatory and admission responses under Trademark Rule 2.120(j)(5). Additionally, Petitioner sought to strike the documentary exhibits to Exhibit B on the ground that these exhibits consist of documents produced by Respondent in response to Petitioner’s First Requests for Production of Documents, and as such may not be made of record by notice of reliance alone. Petitioner also moved to strike all of the evidence in Exhibits G, I, and J for failure to comply with the Board’s procedural requirements for submission of Internet materials as set forth in *Safer Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1037-40 (TTAB 2010). Finally, Petitioner moved to strike all of the evidence in Exhibits S, T, and U for failure to comply with the Board’s procedural requirements for submission of third-party registrations as set forth in Trademark Rule 2.122(e).

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<sup>22</sup> 55 TTABVue.

On September 23, 2016, during the pendency of Petitioner's motion to strike, Respondent filed an amended notice of reliance.<sup>23</sup> By order dated October 20, 2016 (and corrected on October 24, 2016), the Board, *inter alia*, struck Exhibits G, I and H from Respondent's amended notice of reliance<sup>24</sup> and deferred consideration of Petitioner's motion to strike Exhibits B-E, including Exhibits 3, 4, and 8 to Exhibit B, of Respondent's amended notice of reliance.<sup>25</sup>

We now turn to Petitioner's motion to strike as it solely relates to Exhibits B-E (including Exhibits 3, 4, and 8 attached to Exhibit B) submitted with Respondent's amended notice of reliance. As noted above, Exhibits B-E consist of Respondent's responses to all of Petitioner's written discovery. Exhibits 3, 4, and 8 attached to Exhibit B consist of documents produced by Respondent in response to Petitioner's document requests. In its amended notice of reliance, Respondent states that the Board should consider all the exhibits, which in fairness should be considered as to make not misleading what responses were

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<sup>23</sup> Respondent's amended notice of reliance includes the same exhibits as submitted with its original notice of reliance, except to the extent that only Exhibits 3, 4 and 8 are now submitted with Exhibit B.

<sup>24</sup> In light of this order, the Board has given no consideration to Respondent's Exhibits G, I, and J in our determination herein.

<sup>25</sup> In its reply brief in support of its motion to strike, Petitioner maintained its objections to Exhibits B-E and G, I and J submitted with Respondent's amended notice of reliance but did not argue that Respondent's amended notice of reliance remained deficient with respect to the third-party registrations submitted as Exhibits S-U. During the telephone conference with the Board held on October 6, 2016 concerning the merits of Petitioner's motion, Petitioner confirmed that it no longer objected to Exhibits S-U. *See* 62 TTABVUE 2. Accordingly, the Board deems Petitioner's motion to strike as moot with regard to Exhibits S-U submitted with Respondent's amended notice of reliance.



previously offered by Petitioner.<sup>26</sup> Respondent also states that since Petitioner included Exhibit 8 in its own notice of reliance which was produced in response to Petitioner's Interrogatory Request No. 4, Respondent's written response to Interrogatory No. 4 should be considered.<sup>27</sup> Respondent also states in its amended notice of reliance that Respondent's responses to Petitioner's Interrogatories 7 and 8 are related to Respondent's awareness of Petitioner's use of "The Patina Line" and ownership of its "RHEINZINK-Prepatina" registration, including Exhibit 4 which is made part of the answer to Interrogatory 7 and that its response to Petitioner's Interrogatory No. 10 relates to Respondent's use or non-use of the term "patina" in any generic sense.<sup>28</sup>

A party may not make its own discovery responses of record except to the extent necessary to make not misleading the discovery responses submitted by the inquiring party. Trademark Rule 2.120(k)(5). To the extent a disclosing or responding party does submit additional discovery responses under a notice of reliance for the purpose of not to make misleading responses submitted by the inquiring party, such notice must be supported by a written statement explaining why the disclosing or responding party needs to rely upon each of the additional discovery responses listed in the disclosing or responding party's notice. *Id.*

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<sup>26</sup> 59 TTABVue 2.

<sup>27</sup> *Id.*

<sup>28</sup> *Id.*

We first turn to Exhibits 3, 4, and 8 to Exhibit B submitted by Respondent in its amended notice of reliance. As noted above, these exhibits consist of documents produced by Respondent in response to Petitioner's document requests. Documents responsive to document requests may not be submitted by notice of reliance alone by the disclosing party. *See* Trademark Rules 2.120(k) and 2.122(g). Accordingly, Petitioner's motion to strike is granted with respect to Exhibits 3, 4, and 8 to Exhibit B of Respondent's amended notice of reliance.

With regard to Exhibit C (Respondent's responses to Petitioner's First Set of Requests for Admission), Exhibit D (Respondent's responses to Petitioner's Second Set of Interrogatories), and Exhibit E (Respondent's amended responses to Petitioner's Second Set of Interrogatories), we find that although Respondent has requested that the Board consider all the responses contained in Exhibits C-E, Respondent nonetheless failed to explain specifically why it needs to rely upon each of these additional discovery responses so as not to make misleading the responses submitted by Petitioner in its notice of reliance. Accordingly, Petitioner's motion to strike Exhibits C, D and E submitted with Respondent's amended notice of reliance is granted and said exhibits will be given no consideration.

We finally turn to Respondent's Exhibit B which consists of all of Respondent's responses to Petitioner's First Set of Interrogatories. We are persuaded by Respondent's argument that the Board should consider Respondent's written response to Petitioner's Interrogatory No. 4 since

Petitioner submitted Respondent's Exhibit 8 which was produced in response to Interrogatory No. 4. In view thereof, Petitioner's motion to strike Respondent's written response to Petitioner's Interrogatory No. 4 contained in Exhibit B is denied. With regard to the remaining responses to Petitioner's First Set of Interrogatories, including responses to Interrogatories 7, 8 and 10, Respondent has failed to explain specifically why it needs to rely upon each of these additional discovery responses so as not to make misleading the responses submitted by Petitioner in its notice of reliance. Accordingly, Petitioner's motion to strike is granted with regard to all the written responses contained in Exhibit B, except for Respondent's response to Interrogatory No. 4.

As a final matter, we additionally note that Respondent attached copies of portions of the evidentiary record, previously submitted with its amended notice of reliance, to its appeal brief. Because this evidence is already of record to the extent indicated herein, its re-submission with Respondent's brief was unnecessary. *See ITC Ent. Group Ltd. v. Nintendo of America Inc.*, 45 USPQ2d 2021, 2022-23 (TTAB 1998) (submission of duplicative papers is a waste of time and resources, and is a burden upon the Board).

Parties to Board cases occasionally seem to labor under the misapprehension that attaching previously-filed evidence to a brief and citing to the attachments, rather than to the original submissions, is a courtesy or a convenience to the Board. It is neither. The entire record is readily available to the panel. Because we must determine whether such attachments are properly

of record, citing to the attachments requires us to examine the attachments and then attempt to locate the same evidence in the record developed during prosecution of the application, requiring more time and effort than would have been necessary if citations were directly to the prosecution history. Therefore, Respondent should refrain from this practice in any future Board cases. *See* TBMP 704.05(b) (June 2017); *Life Zone, Inc. v. Middleman Group, Inc.*, 87 USPQ2d 1953, 1955 n.4 (TTAB 2008) (attaching previously-filed evidence to a brief is neither a courtesy nor a convenience to the Board).

### *III. Standing*

Standing is a threshold issue that must be proven by the plaintiff in every *inter partes* case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015). Our primary reviewing court, the U.S. Court of Appeals for the Federal Circuit, has enunciated a liberal threshold for determining standing, namely that a plaintiff must demonstrate that it possesses a “real interest” in a proceeding beyond that of a mere intermeddler, and “a reasonable basis for his belief of damage.” *Empresa Cubana Del Tabaco* 111 USPQ2d at 1062 (citing *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)). A “real interest” is a “direct and personal stake” in the outcome of the proceeding. *Ritchie v. Simpson*, 50 USPQ2d at 1026.

The record shows that Rheinzink America is a “daughter company” or “subsidiary” of Petitioner.<sup>29</sup> In the United States, Petitioner’s products, including metal cladding for roofing and walls, which are part of the “Patina Line” of products, are marketed and sold by Rheinzink America under license from Petitioner.<sup>30</sup> Petitioner uses the “Patina Line” designation in connection with goods sold under its registered “RHEINZINK-Prepatina” and “prePATINA” marks.”<sup>31</sup> The record further demonstrates that Respondent has objected, by means of a cease-and-desist letter, to Rheinzink America’s use of the designation THE PATINA LINE on the ground that it purportedly causes a likelihood of confusion with Respondent’s PATINA mark. These facts are sufficient to demonstrate that Petitioner, as parent corporation of Rheinzink America and/or licensor of its pleaded marks, has a real interest in this proceeding and therefore has standing.<sup>32</sup> *See Universal Oil Products Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 174 USPQ 458 (CCPA 1972) (parent corporation has standing to protect the interests of its wholly owned subsidiary inasmuch as damage to the subsidiary will naturally lead to financial injury of the parent company); *Compuclean Marketing and Design v. Bershire Products Inc.*, 1 USPQ2d 1323, 1325 (TTAB 1986) (owner and licensor of a mark establishes the commercial nexus for standing in a Board proceeding). *See also*

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<sup>29</sup> McGowan Dep. 6:21-7:5, 50 TTABUVE 8-9.

<sup>30</sup> *Id.*, 7:6-8:18, 50 TTABVUE 9-10; *Id.* Exhibit 3, ¶¶ 6-15, and Exhibits C and D thereto, 50 TTABVUE 91-94, 106-135.

<sup>31</sup> *Id.*, 7:6-8:18, 50 TTABVUE 9-10.

<sup>32</sup> We further note that Respondent does not contest Petitioner’s standing.

*Miller v. Miller*, 105 USPQ2d 1615, 1619 (TTAB 2013) (determining that the cease and desist letters applicant sent to opposer “provide[d] additional evidence that opposer has business interests that have been affected, i.e., a real interest in the proceeding, and thus, has standing.”).

#### IV. Genericness

Section 14 of the Trademark Act provides:

A petition to cancel a registration of a mark... may... be filed...

(3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered. ... If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.

15 U.S.C. § 1064(3).

A mark is a generic name if it refers to the class or category of goods and/or services on or in connection with which it is used. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), *citing H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986) (“*Marvin Ginn*”). The test for determining whether a mark is generic is its primary significance to the relevant public. Trademark Act § 14(3); *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551

(Fed. Cir. 1991); and *Marvin Ginn, supra*. 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. Our primary reviewing court has stated that a party charging genericness must prove its claim by a preponderance of the evidence.<sup>33</sup> *Princeton Vanguard LLC v. Frito-Lay N. Am., Inc.*, 796 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015) (“In an opposition or cancellation proceeding, the opposer or petitioner bears the burden of proving genericness by a preponderance of the evidence.”) (*citing Magic Wand Inc.*, 19 USPQ2d at 1554); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d, 1750, 1761 (TTAB 2013), *aff’d*, 565 Fed. Appx. 900 (Fed. Cir. 2014)).

#### The Genus of Goods

As noted above, our first task under *Marvin Ginn* is to determine, based on the evidence of record, the genus of Respondent's goods. We find that the identification of goods properly sets forth the genus of goods. *See Magic Wand Inc.*, 19 USPQ2d at 1552 (“[A] proper genericness inquiry focuses on the description of [goods] set forth in the certificate of registration.”). Accordingly, we find that the genus of goods at issue in this case is adequately defined by Respondent’s identification of goods, namely, “metal roofing; metal roofing panels; metal roofing tiles; metal tiles for walls, ceilings.”

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<sup>33</sup> Respondent’s contention that Petitioner must prove its genericness claim by “clear and convincing” evidence, *see* Respondent’s Brief, p. 6, 66 TTABVue 64, is incorrect.

Although Respondent concedes that the genus of goods is that as identified by the goods in its subject registration, Respondent nonetheless argues that because the goods, as identified, could include metal goods without patina, the term cannot be generic for all the goods identified in its subject registration.<sup>34</sup> Respondent's argument is unavailing. It is settled law that genericness may be found for a term that is generic of a category or class of products where some but not all of the goods identified fall within that category. *In re Analog Inc.*, 6 USPQ2d 1808, 1810 (TTAB 1988), *aff'd*, unpublished at 10 USPQ2d 1979 (Fed. Cir. 1989) (ANALOG DEVICES found to be generic for at least some of the category of goods in the identification). Thus, if Petitioner can prove that the term PATINA is generic for a subset of the goods as described in Respondent's subject registration, then it can prevail on this claim. *Haas Outdoors Inc. v. Jordan Outdoor Enterprises Ltd.*, 72 USPQ2d 1282 (TTAB 2004).

#### The Relevant Public

The second part of the genericness test is whether the relevant public understands the designation primarily to refer to that class of goods. The relevant public for a genericness determination is the purchasing or consuming public for the identified goods. *Magic Wand Inc.*, 19 USPQ2d at 1553. Respondent contends that the relevant public is comprised primarily of professional building contractors, or individuals experienced in general

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<sup>34</sup> Respondent's Brief, p. 9, 66 TTABVUE 67.



contracting.<sup>35</sup> Respondent's construction of the relevant public is too limiting. Because there are no restrictions or limitations to the channels of trade or classes of consumers for the goods identified in Respondent's subject registration, the relevant consuming public comprises both industry professionals, as well as non-professional consumers, who purchase metal roofing, metal roofing panels, metal roofing tiles, and metal tiles for walls and ceilings.

#### Public Perception

With this in mind, we now consider whether the primary significance of the designation PATINA is understood by the relevant purchasing public to refer to the class or category of goods identified in Respondent's registration. Evidence of the relevant public's understanding of a term may be obtained from any competent source, including consumer surveys, dictionary definitions, newspapers and other publications. *In re Reed Elsevier*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007). “[E]vidence of competitors’ use of particular words as the name of their goods or services is, of course, persuasive evidence that those words would be perceived by purchasers as a generic designation for the goods and services.” *Continental Airlines, Inc. v. United Air Lines, Inc.*, 53 USPQ2d 1385, 1395 (TTAB 1999).

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<sup>35</sup> 65 TTABVUE 68.

## 1. Dictionary Definition

Petitioner has submitted the following dictionary definition from the Oxford English dictionary for the term “patina”:<sup>36</sup>

The term “patina” is defined as “a thin coating or layer; *spec.* an incrustation on the surface of metal or stone usually as a result of an extended period of weathering or burial, or as a green or bluish green film produced naturally or artificially by oxidation on the surface of bronze and copper consisting mainly of basic copper sulfate.”

## 2. Third-Party Uses

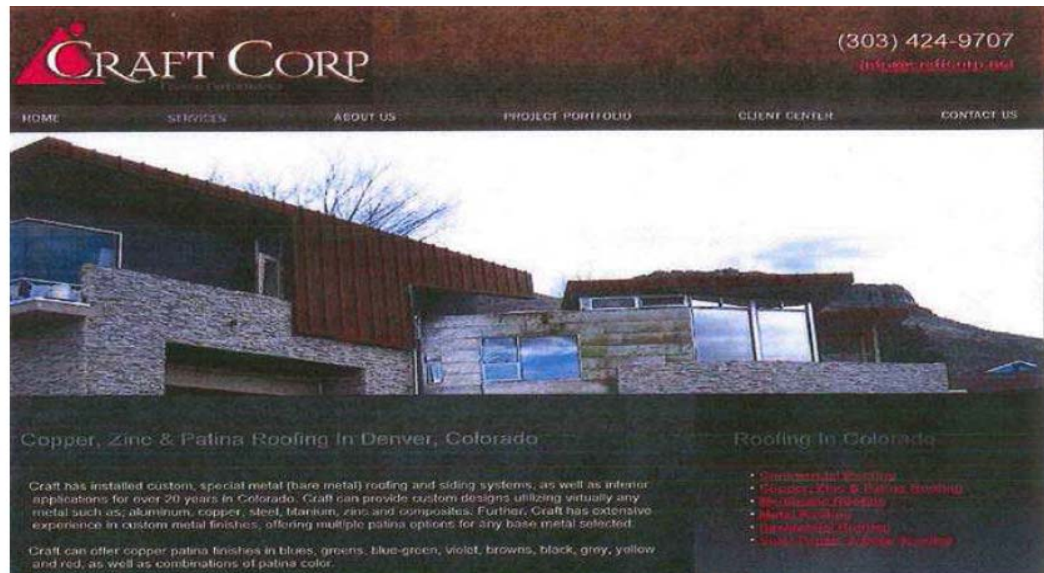
Petitioner submitted evidence of third-party uses of the term “patina” used in association with various metal roofing and tiles. Identified below is a non-exhaustive list of such third-party uses:



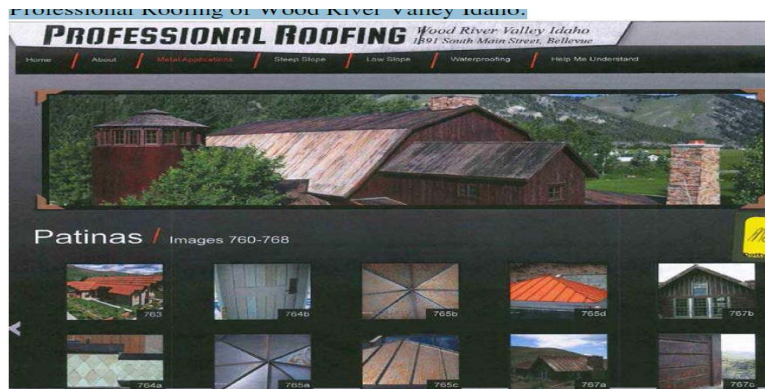
37

<sup>36</sup> McHugh Dep. 9:11-19, 43 TTABVUE 11; *Id.* Exhibit 2, ¶ 6, 43 TTABVUE 38, 59-61.

<sup>37</sup> Miller Dep., Exh. 2 at Attachment A, 53 TTABVUE 114.



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Patina Metals advertises “[s]tructural steel products” which include “metal decking” and “exposed architectural canopies” on its website: “Whether you are considering iron, brass, stainless steel, copper, nickel, aluminum, or any combination...**Patina** can adorn your home with the style and security...commensurate with the quality and esteem of your unique home.”<sup>40</sup>

Pacific Metal Roofing, Inc. offers “Antique **Patina**” and “**Patina Green**” metal roofing and metal siding goods.<sup>41</sup>

Forms + Surfaces lists its “Bonded Metal” line of architectural surfaces, which include products for wall cladding systems, as

<sup>38</sup> Metzger Dep., Exh. 3 at Exhibit S, 27 TTABVUE 34.

<sup>39</sup> Metzger Supp. Dep., Exh. 60-61, 49 TTABVUE 97-99.

<sup>40</sup> *Id.* Exhibit 28, 47 TTABVUE 125-127.

<sup>41</sup> Miller Dep. Exhibit 2 at Attachment B, 53 TTABVUE 171, 175.

being available in different “colors & **patinas**” and advises that “[s]elections are defined by three basic parameters: color + patina + pattern” with “Natural and Dark Patinas provid[ing] rich surface contrast.” When ordering, purchasers are instructed to “please indicate material, pattern, **patina** and quantity.”<sup>42</sup>

The Garland Company, Inc. has a press release regarding a roofing project that states: “The 24-gauge, 16-inch natural **patina** Galvalume® panels were then installed . . . allowing for unlimited thermal movement and watertight protection.”<sup>43</sup>

Heyco Metals/CopperPlus has a “Frequently Asked Questions” page on its website regarding the patination process of the company’s CopperPlus products, where it is asked and answered: “How long does it take for the copper to **patina**? The same length of time it takes for monolithic Copper to **patina**.”<sup>44</sup>

Roofs Inc. advertises that its zinc roofing product “creates a barrier called **patina** that prevents it from corrosion and wear. This **patina** finish is truly an incredible protector from the elements as it changes with time and is not a static surface like paint that only chips and wears with time.”<sup>45</sup>

Whirlwind Steel Building & Components offers “**Patina** Green” metal roofing systems.”<sup>46</sup>

Fine Metal Roof Tech advertises its “Chemical Patina Services for Copper Roofs, Walls, and Copper Roof Accessories” with the statement that “if your goal is to kick-start the patinating process and get all the beauty for less than the cost of factory-made, ‘**acquired patina**’ materials, we have your solution! ‘**Applied patina**’ . . . is intentionally administered, chemically-induced **copper patina**.”<sup>47</sup>

Alchemy Lights advertises “**Patina** Colors & Metals” on its website: “Since ancient times, craftspeople have used the

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<sup>42</sup> Metzger Dep. 60:24-64:25, 67:22-70:9, 44 TTABVUE 62-66, 69-72; *Id.* Exhibits 21-24, 47 TTABVUE 98-101, 105-108, 112-3, 119.

<sup>43</sup> Miller Dep. Exhibit 2 at Attachment B, 54 TTABVUE 33.

<sup>44</sup> *Id.*, Exhibit 2 at Attachment B, 53 TTABVUE 197.

<sup>45</sup> *Id.*, Exhibit 2 at Attachment B, 53 TTABVUE 150.

<sup>46</sup> *Id.*, Exhibit 2 at Attachment B, 54 TTABUVE 36.

<sup>47</sup> Miller Dep. Exhibit 2 at Attachment B thereto, 53 TTABVUE 163-167.

corrosive property of metal to produce aesthetically pleasing color on it [*sic*] surface – sometimes resorting to burying or exposing metal for many years to achieve the desired **patina**.”<sup>48</sup>

Umicore Building Products’ VM company has a webpage instructing its customers regarding the optimal method for achieving a **patina** on the company’s titanium zinc roofing and cladding products: “It is therefore important that the surfaces of the VMZINC are ventilated so that there is a sufficient supply of CO<sub>2</sub> to allow the formation of the protective **patina**.”<sup>49</sup>

MAZMET Metal Products offers “**Patina Green**” and “**Tropical Patina**” metal roofing.<sup>50</sup>

Vogler Metalwork & Design advertises on its website: “[W]e have vast experience when it comes to metal finishing and **patina**. We use a layered approach to our patinas and finishes . . . Our complete library of **patina** samples (sanded, weathered, antique, distressed) is far too vast to include on this page . . . These are simply the most commonly requested finish options for copper, zinc, steel, bronze, brass, or even pewter.”<sup>51</sup>

Sur-Fin Chemical Corporation offers “Metal Finishing **Patina** Products,” and its listing of “**PATINAS FOR STEEL/IRON**” shows over ten different color options.<sup>52</sup>

AllSouth Pre-Engineered Components, LLC (APEC) offers “**Natural Patina**” metal roofing and structural building components.<sup>53</sup>

McElroy Metal offers “**Patina Green**” metal roofing goods.<sup>54</sup>

Consolidated Systems, Inc. (CSI) offers “**Natural Patina**” painted metal architectural systems.<sup>55</sup>

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<sup>48</sup> Metzger Dep. 87:24-90:18, 44 TTABVUE 89-92; *Id.* Exhibit 32, 48 TTABVUE 16-19.

<sup>49</sup> Miller Dep. Exhibit 2 at Attachment B, 53 TTABVUE 146.

<sup>50</sup> *Id.* Exhibit 2 at Attachment A, 53 TTABVUE 116-117.

<sup>51</sup> Metzger Dep. 91:12-95:2, 44 TTABVUE 93-97; *Id.* Exhibit 33, 48 TTABVUE 22- 26.

<sup>52</sup> *Id.*, 113:20-115:20, 44 TTABVUE 115-117; *Id.* Exhibit 41, 48 TTABVUE 58-62.

<sup>53</sup> Miller Dep. Exhibit 2 at Attachment B, 54 TTABVUE 34-35.

<sup>54</sup> *Id.*, Exhibit 2, ¶ 10 and Attachment A, 53 TTABVUE 84-85, 121-123.

<sup>55</sup> *Id.*, Exhibit 2 at Attachment B, 54 TTABVUE 48.

Firestone-UNA-CLAD Metal Roofing Systems offers “**Tropical Patina**” metal roofing.<sup>56</sup>

METL-Span offers “**Natural Patina**,” “**Antique Patina**” and “**Bronze Patina**” insulated roof and wall panels.<sup>57</sup>

Thompson Architectural Metals Company (TAMCO) offers “**Patina Green**” metal roofing.<sup>58</sup>

### 3. Newspapers and Publications

Petitioner also submitted a significant number of newspaper articles and publications that evidence that the term “patina” is widely understood and widely used by the relevant trade and public to identify architectural metals, including the metal goods identified in Respondent’s registration, having a desirable, aged appearance, regardless of any specific color and whether that appearance is naturally or synthetically created. Identified below is a non-exhaustive list of excerpts from such publications:

2007 trade publication Coil Coating Corner: “While white and cream used to be mainstays of most coaters, multi-colored copper **patina** patterns and wood grain patterns now are being used for metal roof panels.”<sup>59</sup>

December 21, 2009 newspaper article: “Once the copper was on, two coats of chemical **patina** were painstakingly applied to give the dome a green, aged appearance.”<sup>60</sup>

September 5, 2010 newspaper article: “The winery’s details are so meticulous that the corrugated metal siding on humbler buildings

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<sup>56</sup> *Id.*, Exhibit 2 at Attachment B, 53 TTABVUE 192.

<sup>57</sup> *Id.*, Exhibit 2 at Attachment B, 54 TTABVUE 3-10.

<sup>58</sup> *Id.*, Exhibit 2 at Attachment B, 54 TTABVUE 43-44.

<sup>59</sup> Haddock Dep. 42:11-25, 52 TTABVUE 44; *Id.* Exhibit 3, ¶ 27(d), 52 TTABVUE 105.

<sup>60</sup> 41 TTABVUE 65; Elona Weston, *Rita-Damaged Court’s Dome Returns to Former Glory*, Associated Press, Dec. 21, 2009; p. 1, eighth paragraph.

has a four-coat **patina** to blend in with the reclaimed redwood that frames it.”<sup>61</sup>

November 3, 2011 press release: “Situ Studio, providing design development consultation . . . commissioned LuminOre to fabricate the panels and apply LuminOre Composite Nickel and Silver™ alloy, creating a surface of real metal. Twenty-four foam panels were coated in a polyurethane resin and covered in metal, then finished with hand-worked **patina**.”<sup>62</sup>

September 15, 2014 newspaper article: “The interior finishes and lighting were specifically designed to showcase the artwork and architectural detailing, and on the outside the zinc panels incorporated with the floor-to-ceiling glass will turn a gray-blue **patina** color over time.”<sup>63</sup>

November 22, 2014 newspaper article: “‘The simplicity and clarity of both of our projects was driven by their budgets,’ said Jennifer Yoos, a principal at VJAA who worked on the [architecture] firm’s winning designs for the Walker Library ... To save money on the library, VJAA . . . covered the outside of the new building in stainless steel roofing tiles that were dipped into a bronzing **patina** that looked like a custom finish. ‘It was an inexpensive way of making them look more refined,’ Yoos said.”<sup>64</sup>

April 1, 2015 newspaper article: “The new dome will initially be as shiny as a new penny, but will gradually weather to a green **patina** like the current dome. . . . The current slate roof will be replaced by a standing-seam metal roof and will be colored a

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<sup>61</sup> 41 TTABVUE 69; John King, *Napa’s Go-To Architect for Understated Drama*, S.F. Chron., Sept. 5, 2010, at A1; p. 1, second paragraph.

<sup>62</sup> 41 TTABVUE 82; *LuminOre® Composite Metal Transforms Exterior of New Dorchester Hotel in London’s Mayfair District*, Marketwire, Nov. 3, 2011, available at <http://www.marketwired.com/press-release/luminore-composite-metal-transforms-exterior-new-dorchester-hotel-londons-mayfair-district-1581900.htm>; p. 1, third and fourth paragraphs.

<sup>63</sup> 40 TTABVUE 159; *Hall Office Park Announces Two New Tenants*, Frisco Enterprise (Texas), Sept. 15, 2014; p. 1, fifth paragraph.

<sup>64</sup> 41 TTABVUE 120; Mary Abbe, *STREETSCAPES: Minnesota Architecture’s Best-Of*, Star Trib. (Minneapolis), Nov. 22, 2014, at 1E; p. 2, third and fourth paragraph.

shade of green similar to the color of the **patina** the tower dome will eventually acquire.”<sup>65</sup>

May 24, 2015 newspaper article: “Corrugated metal paneling, with a **patina** that matches the restaurant’s color scheme, is reminiscent of Thai villages, where tin is still used as roofing.”<sup>66</sup>

July 12, 2015 newspaper article: “Its wealth of dormers and Doric columns is only upstaged by a widow’s walk stationed atop a properly patina-ed copper roof. ...That mint-green **patina** is also related to other shades of green, such as the dollar savings returned on a long-life span with low maintenance.”<sup>67</sup>

May 24, 2007 newspaper article: “Copper is gorgeous, and with the **patina** that comes with time and wear, gets even more gorgeous. Zinc ages to a blue-gray **patina**, or, with regular polishing, can remain silver.”<sup>68</sup>

August 24, 2009 newspaper article: “The cylindrical exterior walls are made from a special corrugated steel called Cor-Ten, which is designed to ‘weather’ by developing a superficial coat of rust, giving it a shiny, burnt-orange **patina**.”<sup>69</sup>

October 3, 2010 newspaper article: “And the architects partly clad the new wing in pre-weathered zinc panels that will, over time, take on a gray **patina**.”<sup>70</sup>

April 20, 2013 newspaper article: “Durable and rustproof, zinc weathers to an attractive matte gray color, which has a modern appeal, yet stands the test of time, says Gary Davis, spokesman

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<sup>65</sup> 39 TTABVUE 10; John Barnhart, *Bell Tower Renovation to Start Soon*, Bedford Bull. (Virginia), Apr. 1, 2015; p. 2, seventh and ninth paragraphs.

<sup>66</sup> 40 TTABVUE 161; Allison McCarthy, *A Trip Home with the Chefs*, S.F. Chron., May 24, 2015, at J6; p. 1, second paragraph.

<sup>67</sup> 39 TTABVUE 16; Barbara Bowers, *Almost a Resort*, The Key West Citizen, July 12, 2015, at 1D; p. 1, sixth through eighth paragraphs.

<sup>68</sup> 40 TTABVUE 121; Melissa Hebert, *Countering Dull with Cool in the Kitchen*, Plain Dealer (Cleveland), May 24, 2007, at F1; p. 2, sixth paragraph.

<sup>69</sup> 41 TTABVUE 63; Tim Knauss, *Let the Sun Shine on: Cornell Students Try Out Competitive Solar House at State Fair*, The Post-Standard (Syracuse, NY), Aug. 24, 2009, at A4; p. 2, third paragraph.

<sup>70</sup> 40 TTABVUE 130; Dixie Reid, *The Frame: New Building Takes Cues from the Old*, Sacramento Bee, Oct. 3, 2010; p. 1, fifth paragraph.



for A. Zahner Co., a 115-year old metal fabricator for architectural buildings throughout the world and based in Kanas City, Mo.” . . . ‘Zinc’s **patina** achieves a warm natural gray hue that has a noble, understated quality to it.’ . . . For homeowners who don’t want to wait for zinc to gather a honed **patina** naturally, manufacturers also offer pre-weathered zinc . . .”<sup>71</sup>

May 3, 2014 newspaper article: “The two-level home was the first residential dwelling to be made out of Bethlehem weathering steel, a type of steel that gains a warm brown **patina** as it ages. Because it was the first, the home was featured in Bethlehem Steel’s 1965 company calendar.”<sup>72</sup>

August 10, 2014 newspaper article: “Visitors who drive up the winding driveway are greeted by a patio that includes siding made of ipe wood and steel panels that have oxidized to a reddish-brown **patina**.”<sup>73</sup>

July 1, 2015 newspaper article: “Shielding the cantina and outdoor kitchen from the sun’s rays towers stands [sic] a umbrella-like roof fashioned from Corten steel, the **patina** of the corrugated roof playing off the glint from the sparkling pool.”<sup>74</sup>

July 21, 2015 newspaper article: “Construction of the \$1.1 billion Minnesota Vikings stadium is shifting . . . The U.S. Bank sign was hoisted into place on the eastern zinc wall, a silvery logo set against a shiny black wall that will soften into a gray **patina** over time.”<sup>75</sup>

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<sup>71</sup> 40 TTABVUE 150-151; Mary G. Pepitone, *Zinc Shows its Mettle in Architecture*, The Repository (Canton, OH), Apr. 20, 2013, at 14F; p. 1, first and fourth paragraph and p. 2, third paragraph.

<sup>72</sup> 40 TTABVUE 96-97; Kathy Orton, *A Perfect Perch for Scenic Views on Gibson Island*, Wash. Post, May 3, 2014, at T27; pp. 1-2, last paragraph.

<sup>73</sup> 40 TTABVUE 98; “*Dream House*” Cast in Concrete Listed for \$1.6M, Kalamazoo Gazette, Aug. 10, 2014; p.1, fifth paragraph.

<sup>74</sup> 39 TTABVUE 14; *Contemporary Carmel Compound Overlooks Monterey Bay*, S.F. Chron., July 1, 2015, at S4; p. 2, second paragraph.

<sup>75</sup> 40 TTABVUE 167-168; Rochelle Olson, *And to Top It Off . . .*, Star Trib., July 21, 2015, at 1A; p. 2, second paragraph.

July 25, 2015 newspaper article: “The guest cottage . . . wears a copper roof of a **patina** that mimics the blue-free sky, the Cassina Group [real estate] agents say.”<sup>76</sup>

September 5, 2015 newspaper article: “Architect Studio Hillier selected copper for the building’s façade . . . [which] was installed as mill-finish copper, which means that the ‘raw’ red copper surface will go through a long process of patination. Within weeks of installation, the project had already begun to darken in areas, and within a year, the whole building had a deep, bluish-brown **patina**.”<sup>77</sup>

March 18, 2016 newspaper article: “The roof will be clad in long, thin panels of zinc chemically treated to achieve a gritty, matte, auburn-hued **patina**.”<sup>78</sup>

#### 4. Respondent’s Use

The evidence of record shows the manner in which Respondent itself uses the term “patina” in a generic manner. Respondent on its website markets “PAINTED COPPER ROOFING” product as “Painted Panels That Look Like **Patina’d** Copper. HUGE Cost Savings When Compared To Copper.”<sup>79</sup> The same website offers: PRE-PAINTED METAL THAT LOOKS LIKE **PATINA’D** COPPER.”<sup>80</sup> The evidence also includes an invoice provided by Respondent dated June 14, 2013 showing the sale of a product referred to as “7/8” Corrugated, 24 Gauge, Exterior --> **Patina** Paint Finish, Interior”<sup>81</sup>

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<sup>76</sup> 40 TTABVUE 170; Jim Parker, The Post & Courier (Charleston, SC), July 25, 2015, at F18; p. 2, third paragraph.

<sup>77</sup> 40 TTABVUE 111; *Convention Center Garners Copper Award*, The Irving Rambler (Texas), Sept. 5, 2015, at 8; p. 1, third paragraph.

<sup>78</sup> 41 TTABVUE 139; Mary Louise Schumacher, *Arena Design Inspires Both Cheers, Boos*, Milwaukee J. Sentinel, at A1; p. 2, fourteenth full paragraph.

<sup>79</sup> Exhibit F, 59 TTABVUE 73.

<sup>80</sup> *Id.*, 59 TTABVUE 72.

<sup>81</sup> 36 TTABVUE 14.

## 5. Expert Testimony

Petitioner submitted the un rebutted expert testimony of Todd Miller, president of Isaiah Industries, a manufacturer of metal roofing for residential and light commercial applications since 1994.<sup>82</sup> Mr. Miller has worked in the metal construction product industry since the mid-1980s, and has served as chair of the Metal Construction Association, a trade association of metal roof and wall panel manufacturers and suppliers to the industry.<sup>83</sup> When asked his opinion as an expert as to what the term “patina” refers to, Mr. Miller testified:

Patina really refers to a look and almost a[n] emotional feeling associated with that look. But in technical terms, it refers to discoloration on the surface of metal. And that discoloration can happen in one or any of three different ways. Again, it really goes beyond that. I find patina to be a very emotional and evocative word that just means something to people when they just hear it.<sup>84</sup>

Consumers and tradespeople alike have used and do and will use the word “Patina” . . . Within the metal roofing industry, most manufacturers have colors or color series designed to look like aging copper, steel, or zinc; purchasers of these products will usually use “Patina” generically to reference what they are seeking.<sup>85</sup>

In expanding on his expert opinion that the term “patina” cannot serve to refer to any particular product or any particular manufacturer’s architectural metal product, Mr. Miller testified:

[T]he word patina, again, is commonly used . . . [a]nd it can refer to a huge spectrum of color change, either natural or induced, that

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<sup>82</sup> Miller Dep. 7:21-8:11, 53 TTABVUE 9-10.

<sup>83</sup> *Id.* 12:12-13:13, 53 TTABVUE 14-15.

<sup>84</sup> *Id.* 21:25-22:8, 53 TTABVUE 23-24.

<sup>85</sup> *Id.* Exhibit 2, ¶ 27, 53 TTABVUE 90.

can take place on the surface of virtually any type of metal. So I don't know how you would ever narrow that down and take it out of the culture or take it out of vocabulary to the point of where it just referred to one particular product, or one particular look or one particular in this case manufacturer.<sup>86</sup>

Petitioner also submitted the un rebutted expert testimony of Dr. Brian D. McHugh, an Associate Professor of Linguistics at Temple University who has taught linguistics for more than 25 years and is a noted expert in his field.<sup>87</sup> Dr. McHugh received his bachelor's degree in linguistics from Yale University and a doctorate degree in linguistics from the University of California, Los Angeles. Dr. McHugh testified, among other things, that the literal definition of "patina" encompasses metal building products, such as the goods identified in Respondent's registration, which have a patina or are coated or painted to have the appearance of a patina.<sup>88</sup> Dr. McHugh also testified that there is no suitable alternative word for "patina" to connote the warmth and pleasing appearance of architectural metal products that have a patina appearance.<sup>89</sup> Additionally, Dr. McHugh testified without contradiction:

I concluded that given that the research done by most lexicographers, the makers of dictionaries, is today not limited to literature but also based on everyday word usage, that it's safe to say that the general public would understand and use the noun "patina" in a generic sense in connection with metal architectural elements rather than associating it with a particular company or a particular company's product.<sup>90</sup>

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<sup>86</sup> *Id.* 58:7-59:2, 53 TTABVUE 60-61.

<sup>87</sup> McHugh Expert Testimony Dep. 6:11-7-2, 43 TTABVUE 8-9.

<sup>88</sup> *Id.* 17:15-19:4, 43 TTABVUE 19-21.

<sup>89</sup> *Id.* 13:18-17:10, 43 TTABVUE 15-19; *Id.* Exhibit 2, ¶ 10, 43 TTABVUE 39-41.

<sup>90</sup> *Id.* 13:3-17, 43 TTABVUE 15.

V. *Analysis*

Respondent contends that its subject registration for the mark PATINA registered on the Supplemental register should be afforded a strong statutory presumption of validity.<sup>91</sup> A registration on the Supplemental Register, however, is not entitled to any statutory presumptions under Section 7(b) of the Trademark Act. 15 U.S.C. § 1094; *Nazon v. Ghiorse*, 119 USPQ2d 1178, 1181-82 (TTAB 2016) (a Supplemental Register registration cannot “be considered as evidence of a proprietary right in the registered mark.”); *see also In re Federated Department Stores, Inc.*, 3 USPQ2d 1541 (TTAB 1987) (a Supplemental Register registration is evidence of nothing more than the fact that the registration issued on the date printed thereon).

Respondent also argues that, since the USPTO allowed its mark to register on the Supplemental Register, its PATINA mark is capable of serving as an indicator of source of Respondent’s goods.<sup>92</sup> Respondent’s argument is unavailing. While it is true that in order for a term to be registered on the Supplemental Register it must be capable of serving as an indicator of source, the Board is not bound by the Examining Attorney’s determination to approve the issuance of a registration of Respondent’s PATINA mark on the

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<sup>91</sup> Respondent’s Brief, p. 7, 66 TTABVUE 65. In support of its contention, Respondent relies on the following three cases: *Anti-Monopoly, Inc. v. General Mills Fun Grp., Inc.*, 684 F.2d 1316, 1319 (9th Cir. 1982); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 14 (2d Cir. 1976); and *Interstate Net Bank v. Netbank*, 221 F. Supp. 2d 513, 517-518 (D.N.J. 2002). These cases, however, address challenges to the validity of marks registered on the Principal Register and, therefore, are inapposite to our analysis herein.

<sup>92</sup> Respondent’s Brief, p. 4, 66 TTABVUE 62.

Supplemental Register, particularly since the Examining Attorney did not have the benefit of the evidence of record before the Board in this matter. *See In re Cordua Rest. Inc.*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016) (citing *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Additionally, Respondent maintains that “a mixture of evidence” indicates that its registered PATINA mark is not generic for its identified goods, citing to *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 4 U.S.P.Q.2d 1141 (Fed. Cir. 1987).

The cited precedent, an appeal from a refusal of registration on the Principal Register, refers to a “mixture of usages” where the relevant public was found to sometimes use the alleged mark to identify the applicant as the source of the services and at other times to use it generically. *Merrill Lynch*, 4 U.S.P.Q.2d at 1143. Here, Respondent has offered no evidence that the relevant public ever uses “patina” to refer to goods from any single source, and particularly only to Respondent’s goods. There is no record evidence of a “mixture of usages.” Respondent’s citation to its use of “PATINA” on its own webpage, particularly where there is no testimony of record to establish anything about the webpage, such as when it was available to be viewed, whether it was viewed, and by who if anyone, does not support the contention that such use would result in any segment of the relevant public using or perceiving the term “patina” as a source identifier for Respondent’s goods.

Finally, while Respondent does not dispute that the term PATINA is used within the industry to describe a blue-green layer of corrosion that develops on the surface of copper or bronze when it is exposed to sulfur and oxide compounds, or to a synthetic coating process used to resemble this effect, Respondent nonetheless argues that its metal panels are not coated by patina, as defined above, nor are they even intended to appear to have a patina, as traditionally defined by the industry and, therefore, its PATINA mark cannot be considered generic for its identified goods.<sup>93</sup> Respondent's argument is unavailing. Respondent contradicts its argument when it admits in its trial brief that "...the specific goods offered by Respondent at this time under its 'Patina' mark appear to have a feature or characteristic similar to the natural oxidizing effect which occurs in some metals as a result of exposure to weather ...."<sup>94</sup> Moreover, even assuming Respondent's identified goods are not coated by patina or intended to appear to have patina appearance, this does not detract from a finding that the term "patina" is generic for metal roofing and metal tiles if the evidence of record so demonstrates.

#### VI. *Decision*

We have carefully considered all of the evidence and arguments submitted by the parties on the issue of genericness, including those that we have not specifically discussed. Based on the evidence of record we have no doubt that

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<sup>93</sup> Respondent's Brief, pp. 12-13, 66 TTABVUE 70-71.

<sup>94</sup> *Id.* at p. 8, 66 TTABVUE 66.

potential purchasers would understand PATINA to refer, at a minimum, to a type of metal roofing or metal tile. *In re Central Sprinkler Co.*, 49 USPQ2d 1194 (TTAB 1998) (ATTIC generic for sprinklers because consumers would understand it to refer to a category of sprinklers). As our reviewing court has held, if “a term is generic if the relevant public understands the term to refer to part of the claimed genus of goods or services, even if the public does not understand the term to refer to the broad genus as a whole.” *See In re Cordua Rests., Inc.*, 118 USPQ2d at 1638. Here, the evidence clearly demonstrates that the term “patina” is generic for metal roofing and metal tiles even though the public understands the term to refer to a particular sub-group or type of metal roofing or metal tile rather than to all metal roofing or metal tiles.

We therefore conclude that Petitioner has demonstrated, by a preponderance of the evidence, that PATINA is the generic name of the goods identified in Respondent's registration within the meaning of Section 14(3) of the Trademark Act. In view of our determination on the issue of genericness, we do not reach Petitioner's separate claim that the PATINA mark is incapable of indicating source inasmuch as it fails to function as a trademark or the alternative claim of likelihood of confusion under Section 2(d) of the Trademark Act.

**Decision:** The petition for cancellation on the ground that the registered mark is the generic name of the goods for which it is registered is GRANTED, and Respondent's registration will be cancelled in due course.