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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Calera Corporation

Serial No. 77409087

Bret Field of Bozicevic, Field & Francis LLP for Calera Corporation.

Frank J. Lattuca, Trademark Examining Attorney, Law Office 109 (Dan Vavonese, Managing Attorney)

Before Bucher, Kuhlke and Bergsman, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Calera Corporation, applicant, has filed an application to register the standard character mark GREEN CEMENT on the Principal Register for goods ultimately identified as "non-metallic construction materials, namely mineral-based cementitious materials in the nature of portland, hydraulic, white, masonry, plastic, stucco, and oil well cement, other mineral-based cementitious materials; supplementary cementitious materials, namely

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pozzolanic materials, blast furnace slag, coal clinker and fly ash; non-metallic construction materials, namely cement mixes and patches, concrete, mortar, stone, aggregate, sand, non-metallic mosaic, non-metallic floor and roofing tiles, non-agricultural lime, non-rubber plaster, gypsum, gravel, brick; asphalt; building materials made from concrete, namely, blocks bricks, stones, walls, conduits, ducts, pavers, posts, pedestals for use as a building material, beams, partitions for use as walls, barriers of concrete for use as a building material, pipes, panels, architectural columns, monuments, concrete containers for holding a liquid, concrete street curbs, concrete fences, concrete beams, and concrete planks" in International Class 19. The application was filed on February 28, 2008, under Section 1(b) of the Trademark Act, 15 U.S.C. §1052(b), alleging a bona fide intention to use the proposed mark in commerce.

The examining attorney has refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark is merely descriptive of its goods. The examining attorney argues that "[applicant's] goods are ... specifically made in a way that is more environmentally friendly than normal. ... [a]s such, the mark as a whole is clearly descriptive of

the applicant's goods-namely environmentally friendly cement." Br. p. 4.

Applicant has appealed the final refusal and both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

The issue before us is whether the term GREEN CEMENT is merely descriptive of applicant's cement and cement-related goods. "A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used." *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007). See also *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004); and *In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant ingredient, quality, characteristic, function, feature, purpose or use of the goods or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *Bayer*, 82 USPQ2d at 1831. See also *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). Finally, “[t]he examining attorney has the burden to establish that a mark is merely descriptive.” *Bayer*, 82 USPQ2d at 1831.

In support of his position that the proposed mark is merely descriptive, the examining attorney cited to applicant’s response wherein applicant confirmed that its goods are “...produced using processes that emit low level carbon dioxide by-products as compared to standard processes...” and “...will be made in a way that reduces their carbon footprint.” Br. p. 4, quoting, App. Response (March 13, 2009). The examining attorney submitted the following dictionary definitions for the individual words in the proposed mark:

Green 12. environmentally sound or beneficial:
green computers.

Cement 1. any of various calcined mixtures of clay and limestone, usually mixed with water and sand, gravel, etc., to form concrete, that are used as a building material.

www.dictionary.com. based on the Random House Unabridged Dictionary (2006).

The examining attorney also submitted various webpages that include references to the term "green cement" (emphasis added):

Constantz says he has invented a **green cement** that could eliminate the huge amounts of carbon dioxide spewed into the atmosphere by the manufacturers for the everyday cement used in concrete for buildings, roadways and bridges. His vision of eliminating a large source of the world's greenhouse CO2 has gained traction with both investors and environmentalists. ... Constantz takes that exhaust gas and bubbles it through seawater pumped from across the highway. The chemical process creates the key ingredient for his **green cement** and allows him to sequester a half ton of carbon dioxide from the smokestacks in every ton of cement he makes. (www.sfgate.com San Francisco Chronicle website September 2, 2008);

Green cement company to jump into building market CalStar Cement says it will tackle one of the unrecognized sources of greenhouse gases: cement. The company, which is still operating in stealth mode, hopes to later this year unveil its plans for bringing a high-quality cement to market that requires far less energy to manufacture than the conventional stuff, according to sources close to the company. Consuming less energy directly results in fewer greenhouse gas emissions. ... Green-building materials invariably cost more than the conventional counterparts, but over time will drop as volumes increase, say advocates. ... Foundation partners have spoken about their investments in **green cement** but have yet to mention the name publicly or list the company on its Web site. (<http://news.cnet.com>);

Green cement maker Hycrete raises \$15M Hycrete, a Carlstadt, New Jersey-based **green cement** maker has nabbed \$15 million in third round funding led by Mohr Davidow Ventures. ... Unlike conventional products, it does not use harmful chemicals like volatile organic compounds and can safely be recycled and re-used. (<http://venturebeat.com>); and

Green Cement Plants Could Mean Cleaner Air and Lower Costs Economic pressure from local cities helps clean up smoky kilns. ... Two years after the North Texas Clean Air Steering Committee recommended city councils in the region provide incentives for the use of "**green cement**" in construction projects, Dallas, Fort Worth, Arlington and Plano. (www.dallasobserver.com).

Finally, the examining attorney submitted several third-party registrations where the word "green" is disclaimed or registered based on a showing of acquired distinctiveness under Section 2(f) of the Trademark Act. Third-party registrations can be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade or industry. In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987); and In re Box Solutions Corp., 79 USPQ2d 1953, 1955 (TTAB 2006). See, e.g., Reg. No. 3557959 for the mark GREEN COTTAGE SMART. EFFICIENT. HEALTHY for pre-fabricated homes sold in kit form, "green cottage" disclaimed.¹ However, we hasten to add that "[t]he

¹ Two of the registrations referenced by the examining attorney have since been cancelled under Section 8 of the Trademark Act and, as such, are no longer of probative value. See Reg. No. 2729669 for the mark GREEN ASPHALT with design for use in connection with asphalt "Green Asphalt" disclaimed; and Reg. No.

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Board must decide each case on its own merits." In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Based on the evidence of record, the examining attorney has clearly established prima facie that the term GREEN CEMENT is merely descriptive of applicant's identified goods which consist of environmentally-beneficial cement products. First, the individual terms that comprise the proposed mark are each descriptive of the goods. The term GREEN indicates that the product is environmentally beneficial. There simply can be no dispute today that the term green, ubiquitously used as an adjective with any good or service, will be perceived as an indicator that the good or service is environmentally friendly. The third-party registrations submitted by the examining attorney where the word "green" is routinely disclaimed simply reflect what has already been documented in the dictionary. See In re Manco, Inc., 24 USPQ2d 1938 (TTAB 1992) (THINK GREEN merely informational phrase encouraging environmental awareness). The term CEMENT is the name of the goods, i.e., cement. Further, when the individual components are combined as GREEN CEMENT there is

2676745 for the mark CDS "GREEN" STONE for a variety of stone goods, "green" and "stone" disclaimed.

nothing unique or incongruous about the combination such that it is not merely descriptive. A cement that is made in a way to reduce its carbon footprint, a significant breakthrough, is environmentally beneficial, i.e., green. Consumers immediately would understand that GREEN CEMENT is referring to environmentally-beneficial cement and cement-related building materials. Nothing is left to the imagination that the term GREEN CEMENT is referring to environmentally-beneficial cement.

Applicant states that its goods:

...include concrete and cement that is produced using processes whereby CO₂ is a reactant and no CO₂ is given off as a by-product. ... [Applicant argues that g]iven these varied and narrowly defined goods, [a]pplicant's potential customers cannot discern the purpose or function of the goods from the trademark alone. Instead, they must use a multi-stage reasoning process to first even realize that the mark refers to aggregates produced in an environmentally sound manner, and then to understand the exact nature of [a]pplicant's technology. The leap from (a) a unique phrase involving a combination of the ambiguous term 'CEMENT' and the slang term 'GREEN' to (b) highly specialized mortar aggregates (and the unique technological process by which [a]pplicant produces them), is certainly not an automatic one, and requires imagination, thought and perception to bridge the gap.

Br. p. 5-6.

Applicant's goods include cement, therefore, there is nothing "ambiguous" about the word cement in applicant's proposed mark GREEN CEMENT. Further, applicant is not

applying to register a mark for a "process" but rather for goods and the term green, which means "environmentally beneficial" directly, and without need of imagination or thought, describes a significant feature of these goods.

Applicant also argues that there are:

...abundant meanings associated with the adjective 'green' (at least twenty (20)), consumers must necessarily exercise mature thought or follow a multi-stage reasoning process in order to determine what product characteristics the term GREEN CEMENT refers to. For example, it is not clear whether the cement of Applicant's goods is: 1) freshly set and not completely hardened; 2) green in color; 3) newly manufactured or poured; 4) covered in foliage; or 5) environmentally beneficial.

Br. p. 8.

The fact that "green" has other meanings in other contexts is not relevant; we are constrained to make our analysis within the context of the identified goods. Thus, while the term green is a word with numerous meanings, when used in combination with applicant's goods, cement with a smaller carbon footprint, the meaning is clear, namely, environmentally-beneficial cement.² This is not a circumstance where the different meanings would all relate

² With respect to applicant's arguments, there is nothing in the record that demonstrates that consumers would perceive the term GREEN CEMENT as meaning freshly poured cement, cement covered in foliage or even cement colored green. The evidence overwhelmingly points to the meaning "environmentally beneficial" when GREEN is used with CEMENT for cement with a low carbon footprint.

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to the identified goods, which could create an incongruity or a mental pause.

In addition, applicant argues that its proposed mark "is not a common term in [a]pplicant's field. Applicant's mark is certainly not a term of art in the industry and, [to] the best of applicant's knowledge, is not used by any other entity in its field ... [and] ... [t]here is no competitive need to use [a]pplicant's mark in connection with the goods identified in the application." Br. p. 9-12. As discussed above, the meaning of GREEN CEMENT in the context of cement, and more specifically environmentally-beneficial cement, would be clear to relevant purchasers. Moreover, it is well settled that even if applicant is the first and only user of this term, that alone cannot "alter the basic descriptive significance of the term and bestow trademark rights therein." In re Gould, 173 USPQ 243, 245 (TTAB 1972). See also In re Sun Microsystems, Inc., 59 USPQ2d 1084, 1087 (TTAB 2001).

We are persuaded that when applied to applicant's cement and cementitious goods, GREEN CEMENT immediately describes, without need for conjecture or speculation, a significant feature of the goods, namely that they consist of environmentally-beneficial cement. As applicant correctly notes, in determining whether applicant's mark is

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merely descriptive or suggestive we resolve doubt in favor of the applicant. In re Shutts, 217 USPQ 363, 365 (TTAB 1983). In this case, we have no such doubt.

Decision: The refusal to register under Section 2(e)(1) is affirmed.