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AUG 28, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Outokumpu Mintec Oy**

Serial No. 74/541,686

Joseph J. Orlando and Fernanda M. Fiordalisi of **Buckman and Archer** for **Outokumpu Mintec Oy**.

Richard G. Cole, Trademark Examining Attorney, Law Office 104
(**Sidney I. Moskowitz**, Managing Attorney).

Before **Sams**, **Hohein** and **Hairston**, Administrative Trademark
Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

An application has been filed by Outokumpu Mintec Oy to register the designation "CERAMEC" as a trademark for "capillary filter machines used for dewatering of slurries in the processing and mining industries and in coal technology."¹

Registration has been finally refused under Section 23 of the Trademark Act, 15 U.S.C. §1091, on the basis that the

¹ Ser. No. 74/541,686, filed on June 21, 1994, which alleges a date of first use anywhere of September 1990 and a date of first use in commerce of March 1991. Although registration was originally sought on the Principal Register, applicant amended the application to the Supplemental Register on May 30, 1995 in response to an initial refusal on the ground of mere descriptiveness under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

designation "CERAMEC" is the phonetic equivalent of the generic term "CERAMIC" and hence is not capable of distinguishing applicant's goods.²

Applicant has appealed. Briefs have been filed,³ but an oral hearing was not requested. We affirm the refusal to register.

² In his initial refusal to register the designation "CERAMEC" on the Supplemental Register, the Examining Attorney indicated that "the term is *so highly descriptive* of a component of the goods as to constitute a term which is not capable of serving to identify and distinguish applicant's goods from the [like] goods of others" (*emphasis added*). Similarly, although the language "so highly descriptive" does not appear in his final refusal, the Examining Attorney states in his appeal brief that because the designation "CERAMEC" is "the phonetic equivalent ... of 'ceramic', a very common component of industrial and commercial filters," it "is *so highly descriptive* of the goods (or of a component of such goods) that it is not capable of serving in the manner of a trademark to identify and distinguish the goods of the applicant from [the] like goods of others" (*emphasis added*). Nevertheless, as applicant, citing *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992), correctly points out in its brief, such a "refusal to register a mark ... effectively amount[s] to a holding of genericness." The refusal to register has accordingly been so construed. *See, e.g.*, *In re Reckitt & Colman, North America Inc.*, 18 USPQ2d 1389, 1391 (TTAB 1991).

³ Applicant, with its appeal brief, has attached copies of certain dictionary excerpts, including a definition of the word "ceramic" from the Merriam-Webster's Collegiate Dictionary (10th ed.) at 187 which lists such word as an adjective meaning "of or relating to the manufacture of any product (as earthenware, porcelain, or brick) made essentially from a nonmetallic mineral (as clay) by firing at a high temperature; also : of or relating to such a product". Applicant also attached to its brief copies of registrations of the designation "CERAMEC" for its goods which it has obtained in eight different foreign countries. However, all of such evidentiary materials, having been submitted for the first time on appeal, are untimely under Trademark Rule 2.142(d). Moreover, even though the Examining Attorney has raised no such objection thereto, neither has he discussed or otherwise treated the attachments to applicant's brief as being of record. *Compare* *In re Nuclear Research Corp.*, 16 USPQ2d 1316, 1317 (TTAB 1990) at n. 2. Nevertheless, inasmuch as it is settled that the Board may properly take judicial notice of dictionary definitions, we have considered the definitions appended to applicant's brief for whatever probative value such evidence may have. *See, e.g.*, *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). We have not considered, however,

Applicant, noting that whether a term is generic is a question of fact which is determined from the viewpoint of the relevant purchasing public, asserts that the Examining Attorney's statement in the initial Office action that "ceramic materials are clearly a component of the porous material [in applicant's goods] and thus [are] a component of the filtration machines themselves" is "without a factual basis" since nothing in the identification of its goods "makes any mention of 'ceramic materials'" and its specimens of use (which constitute photographs of its capillary filter machines) likewise "do not indicate that 'ceramic materials' are a component of the goods." Similarly, applicant maintains that the Examining Attorney's contention in his second Office action that the term "ceramic" designates "a common type of material used in filtering apparatus" lacks any "factual basis". Applicant consequently insists that "it is clear that the Examining Attorney has not provided any evidence that the public's understanding of the term is that it is generic as applied to applicant's goods" and thus "has not put forth a prima facie case that the mark herein sought to be registered is generic" (underlining in original).

However, as the Examining Attorney mentions in his brief, such issue "has been raised in the record" and applicant, prior to filing its brief, did "not dispute [the Examining

the copies of foreign registrations issued to applicant since, even if the submission of such evidence had been timely, the foreign registrations are simply irrelevant and immaterial to the issue in this proceeding, which is not merely whether the designation "CERAMEC" is registrable but, instead, whether it is capable of distinguishing applicant's goods and thus is eligible for registration on the Supplemental Register.

Attorney's] position that ceramic material is in fact a component part of the [applicant's] goods." Specifically, we observe that in response to the statement by the Examining Attorney in his final refusal that, in light of the genericness of the term "ceramic," prospective purchasers of applicant's goods "will immediately conclude that 'Ceramec' is either a deliberate misspelling of 'ceramic', the primary component of the filters, or, in the alternative, may not even notice the slight discrepancy at all!," applicant merely stated in its request for reconsideration that:

The goods identified in the application ... do not indicate that a component thereof are ceramic materials. The goods originally identified were "filtration machines and discs made from sintered porous material" as used therein. The described discs are not specified to be of ceramic material. It is applicant's contention that materials other than ceramics can be used in the identified filtration machines.

It is obvious from a careful reading of applicant's remarks that, notwithstanding the fact that the words "ceramic" or "ceramics" are not used in the identification of applicant's "capillary filter machines," applicant has notably failed to state explicitly whether such goods may also utilize ceramic materials or ceramics, just as they may use other porous substances, as filtration means. As the Examining Attorney carefully pointed out in his response to the request for reconsideration, whether applicant's particular goods can actually use materials other than ceramics in its capillary

filter machines "is not particularly relevant for two obvious reasons":

The first is that applicant nowhere in the application denies that its filtration machines do in fact utilize a ceramic filtering material as a primary component thereof. The second reason is that EVEN IF THEY DO NOT utilize a ceramic based filter means, the purchaser, upon seeing the mark, will immediately and readily presume that the goods do in fact utilize such a type of filter. Otherwise, why would the applicant choose such a name when "ceramic" is probably the most popular and widely used filter material in use?

Absent a categorical denial by applicant that capillary filter machines, of the kinds which are used for dewatering of slurries in the processing and mining industries and in coal technology, do not utilize ceramics or ceramic materials as a means of filtration, it is fair to assume in this instance that, in light of applicant's equivocal comments, such goods do indeed employ ceramic filter means. Clearly, if "materials other than ceramics can be used in the identified filtration machines," then by necessary implication applicant's goods can also use ceramics as their filtration means.

Furthermore, we judicially notice, for example, that The Random House Dictionary of the English Language (2d ed. 1987) contains the following relevant definitions:

"**ceramic**," which at 338 is listed as an adjective which means "1. ... of or pertaining to products made from clay and similar materials, as pottery and brick, or to their manufacture ..." and as a noun meaning "2. ceramic material";

"**ceramics**," which at 338 is set forth as a noun which connotes "1. ... the art or technology of making objects of clay and

similar materials treated by firing. 2. ... articles of earthenware, porcelain, etc."; and

"**filter**," which at 718 is defined, inter alia, as "1. ... any substance, as cloth, paper, porous porcelain, or a layer of charcoal or sand through which liquid or gas is passed to remove suspended impurities or to recover solids. 2. any device, as a tank or tube, containing such a substance for filtering."

Applicant's broad identification of goods clearly encompasses capillary filter machines of the type which, as the above definitions indicate, may utilize ceramic material as a filter element. Thus, irrespective of whether applicant's particular goods may actually employ other filtration means, its capillary filter machines, as broadly identified in its application, must be deemed to include those which are suitable or designed for use of ceramic material as a filter or filtering element. Capillary filter machines, as the specimen photographs of applicant's goods reveal, plainly are tank-like devices which, in light of the above-noted definition of the word "filter," would naturally be understood or referred to in the trade as ceramic filters when the substance utilized as their filter element or filtration means is a ceramic material. The term "ceramic" accordingly is generic with respect to capillary filter machines with a ceramic filtration medium.

The remaining issue to be determined is whether the designation "CERAMEC" would be regarded as a misspelling, and

hence the phonetic equivalent, of the generic term "ceramic".⁴ Applicant argues in this respect that because the syllables "MEC" and "MIC" in the respective terms "CERAMEC" and "CERAMIC" are "pronounced substantially differently," they are not phonetic equivalents. Applicant also contends that, even though such terms differ only in the letters "E" and "I," such letters "look substantially different one from the other and are unlikely to be mistaken one for the other."

The Examining Attorney urges, however, that when viewed in the context, as shown by the specimens of use, in which the designation "CERAMEC" is actually used, those in the filtration industry will recognize such designation as a mere misspelling, and hence the phonetic equivalent, of the generic term "CERAMIC". In particular, the Examining Attorney asserts that (underlining in original):

The filtration industry has long recognized the inherent attributes of ceramics as a superior filtering medium for numerous reasons, and the question thus becomes whether the use of a word, from a foreign applicant, which utilizes a very subtle misspelling of "ceramic" will be recognized as meaning "ceramic" as that term is widely recognized in the industry, or whether they will assume that it is a completely different (and arbitrary) term which means something quite different (thereby rendering it clearly registrable). The Examiner is clearly of the opinion that

⁴ We note that in reply to the Examining Attorney's inquiry, applicant (a Finnish corporation) stated in its response to the initial refusal to register the designation "CERAMEC" on the Supplemental Register that:

The word "ceramec" is not the Finnish spelling for the word "ceramic" which instead is "keraaminen". Thus, "ceramec" is a coined word, although it resembles somewhat the word "ceramic".

the latter scenario is simply not at all a reasonable one.

Looking first at the specimens of record, it can be seen that printed on the end of one of the filter machines in question is the term "CERAMEC FILTER". In other words, "CERAMEC" does not appear by itself, but as appearing to modify the generic term "Filter" as other parties in the field might write out "ceramic filter" following or beneath a trademark used on their goods. Indeed, because of the designation "CB-15" directly under "CERAMEC FILTERS", the normal reaction would be for prospective purchasers to assume "CB-15" is a trademark perhaps, and that "CERAMEC FILTER" is the generic name of the goods. Thus the Examiner concludes that [since] ... the viewpoint of the relevant purchasing public is the test of determining genericness as applicant has stressed in its brief, the Examiner must conclude that, based on the record and the specimens therein, the relevant public WOULD assume the term is ... in fact generic ... with respect to applicant's filtering machines which presumably contain[,] at least in part, some ceramic components.

Finally, the applicant seeks to make a distinction of the normal spelling of "ceramic" and applicant's spelling of its mark, and emphasizes that the two would be pronounced differently because the penultimate letters in each word are different. Such is not likely since in many words in the English language the "e" sound and the "i" sound are pronounced in the same way. Moreover, it is important to note that applicant is a foreign entity, and under such circumstances it would not be unreasonable to assume that prospective purchasers would assume that in Finnish the word "ceramic" is actually spelled "ceramec".

With respect to the standard for registrability, it is well settled that a designation must be capable of serving as an indicator of source in order for it to be registrable on the Supplemental Register. Whether a designation has the capacity

necessary for registration on the Supplemental Register is determined by considering the meaning thereof as applied to the goods or services, the context in which it is used on the specimens filed with the application, and the likely reaction thereto by the average customer upon encountering the designation in the marketplace. See *In re Cosmetic Factory, Inc.*, 208 USPQ 443, 447 (TTAB 1980). "The test is not whether the mark is already distinctive of the applicant's goods [or services], but whether it is capable of becoming so." *In re Bush Brothers & Co.*, 884 F.2d 569, 12 USPQ2d 1058, 1059 (Fed. Cir. 1989), *citing* *In re Simmons Co.*, 278 F.2d 517, 126 USPQ 52, 53 (CCPA 1960). A generic designation, as noted in *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 728 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986), is incapable of registration on either the Principal Register or the Supplemental Register.

We agree with the Examining Attorney that, as shown by the manner of its use in the specimens of record, the designation "CERAMEC" would be perceived as an obvious misspelling of the generic word "CERAMIC." The designation "CERAMEC" is used as part of the generic phrase "CERAMEC FILTER," with the terms "CERAMEC" and "FILTER" appearing on applicant's goods in exactly the same size and style of lettering. Clearly, the commercial impression projected by such phrase is that of a "CERAMIC FILTER" and is not that of a mark or model indication, such as "CB-15," which also appears on applicant's goods directly below the phrase "CERAMEC FILTER". Moreover, while the syllables "MEC" and "MIC" alone may look and sound somewhat different, when used as part of

the terms "CERAMEC" or "CERAMIC," such syllables would be nearly identically pronounced and thus the former would be perceived as simply a misspelling of the latter. Consequently, because the designation "CERAMEC" is plainly the phonetic equivalent of the generic term "CERAMIC," it is incapable of distinguishing applicant's capillary filter machines for the dewatering of slurries in the processing and mining industries and in coal technology. See, e.g., 2 J. McCarthy, McCarthy on Trademarks & Unfair Competition (4th ed. 1998) §12:38 and cases cited therein at nn. 2-9.

Decision: The refusal under Section 23 is affirmed.

J. D. Sams

G. D. Hohein

P. T. Hairston
Administrative Trademark Judges,
Trademark Trial and Appeal Board