

THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Holophane Corporation**

Serial No. 74/031,427

Maria Franek Angileri of Brooks & Cushman, P.C. for
Holophane Corporation.

Thomas W. Wellington, Trademark Examining Attorney, Law
Office 104.

Before Cissel, Seeherman and Hohein, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On December 12, 1995, applicant filed an application to register the mark "GLASWERKS" on the Principal Register for "electric lighting fixtures." The application was based on applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with the goods identified in the application.

The Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act on the ground that the mark sought to be registered is merely descriptive of the goods with which applicant intends to use it. The Examining Attorney argued that the proposed trademark is the equivalent of the word "glassworks," which is used to describe a business which manufactures glass fixtures. In that glass fixtures may be used for lighting purposes, the Examining Attorney concluded that the proposed mark is merely descriptive of the electric lighting fixtures with which applicant intends to use it.

Submitted in support of the refusal were excerpts retrieved from the Nexis® automated database of articles published in a newspaper and a magazine. The newspaper article refers to a person who designs light fixtures and custom glass work, and the magazine article appears to be a footnote concerning the source of products shown in a photo. The note indicates that custom lighting fixtures were provided by one entity and metal and glass work by another.

Applicant responded to the refusal to register with argument that the proposed mark is at most suggestive, rather than merely descriptive of the goods set forth in the application.

The Examining Attorney was not persuaded to withdraw the refusal to register, however. The second Office Action pointed out that the English equivalent of the mark is generic for both companies that produce works of glass and for works of glass. Submitted as additional support for the refusal to register were copies of entries from Webster's New World German Dictionary indicating that an English translation of the proposed mark is "glass company."

Also submitted by the Examining Attorney with the second Office Action were additional excerpts retrieved from the Nexis® database in an attempt to establish that electric lighting fixtures are produced in glass works. Careful analysis, however, reveals that many of these excerpts do no such thing. For example, one notes that a company "also designs light fixtures and custom glass work." Another describes the "Clear Glass Works" as a company which "fabricates custom fixtures and finishes for buildings." The fixtures are not identified as electric lighting fixtures, though. Other examples include the following: "Vistosi had an outstanding display of colored brown glass works, with several of them using halogen fixtures."; "Albers here is seen in more dramatic light with his early glass works."; "The truly amazing lighting

design and the glass works feed on one another to make for a tremendous show."; "And unlike strained (sic) glass work, Mondrian's art generates its own light."; "His focus has been on creating unique lighting and glass work"; "Thomas Edison, the founder of General Electric, formed a cooperative adventure with Corning Glass Works to produce incandescent light bulbs."; and "there's airiness and glow when light hits her glass work."

Only two of the excerpts cited by the Examining Attorney support the contention that glass works have ever produced electric lighting fixtures. An article from the December 6, 1992 edition of the San Diego Union Tribune discussed a hanging light fixture from the Venini glass works, and an article from The Economist newspaper in 1993 indicated that a light fixture was made by "Corey Glassworks." Although a number of the excerpts submitted by the Examining Attorney show the use of "glass works" to refer to works of art made of glass, the above-referenced two excerpts are the only evidence linking electric lighting fixtures to glass companies.

In addition to the submission of additional evidence in support of the refusal to register, the second Office Action required applicant to submit an English translation

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of the mark to the effect that "GLASWERKS" means "glass company" or "glass works."

Responsive to the second Office Action, applicant amended the application to include the statement that the English translation of "GLASWERKS" is "glass company" or "glass work[s]." Applicant also presented more argument on the issue of mere descriptiveness.

On July 29, 1997, the Examining Attorney's third Office Action made final the refusal to register under Section 2(e)(1) of the Act.

On January 26, 1998, applicant filed a timely Notice of Appeal to the Trademark Trial and Appeal Board. Both applicant and the Examining Attorney submitted briefs to the Board. Applicant attached to its brief copies of several third-party registrations of marks which incorporate the term "glass" and/or a variant of the term. Each registration lists, inter alia, lighting fixtures as goods with which the mark is alleged to be used.

The evidence concerning third-party registrations submitted by applicant with its appeal brief would ordinarily not be considered because of its untimely submission under Trademark Rule 2.142(d). In this case, however, we have considered the third-party registrations because the Examining Attorney did not object to them, and

in fact, argued in his brief that they do not support the conclusion urged by applicant.

Applicant did not request an oral hearing. Accordingly, we have resolved this appeal based on consideration of the written arguments and the evidence presented in the application file.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Lanham Act, if it forthwith conveys an immediate idea of a significant ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). The descriptive information concerning the goods must be communicated by the mark with some degree of particularity or specificity. *In re Box Innards, Inc.*, 181 USPQ 412 (TTAB 1973). However, if the descriptive significance can only be determined after the exercise of additional thought, multi-step reasoning, speculation or surmise, the mark is not merely descriptive within the meaning of the Act.

In the instant case, the record does not support the conclusion that the term sought to be registered

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immediately conveys, with any particularity, significant information about the nature or characteristics of the goods specified in the application. As noted above, the evidence linking production of electric lighting fixtures to glass companies or glass works is de minimis. The record does not contain a sufficient basis for us to conclude that prospective purchasers of these goods would attach significance to the fact that such products were produced by a glass company or glass works. To reach such a conclusion would require some additional thought process or imagination, and if this is required, the mark may be suggestive of the goods, but is not merely descriptive of them.

In summary, the evidence of record in this application does not establish that the mark immediately and forthwith conveys, with any degree of particularity, information about a significant characteristic or feature of these goods. Any doubt on this issue would necessarily have to be resolved in favor of the applicant. In re Aid Laboratories, Inc., 221 USPQ 1215 (TTAB 1983).

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Accordingly, the refusal to register under Section 2(e)(1) of the Act is reversed, and the application will proceed to publication.

R. F. Cissel

E. J. Seeherman

G. D. Hohein
Administrative Trademark Judges,
Trademark Trial and Appeal Board

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