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8/17/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hebert

Serial No. 75/174,612

David P. Cooper of Kolisch, Hartwell, Dickinson, McCormack & Heuser for Susan Hebert.

Raul F. Cordova, Trademark Examining Attorney, Law Office 114, (Conrad Wong, Acting Managing Attorney).

Before Seeherman, Hohein and Wendel, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Susan Hebert has filed an application to register the term "COBRE" as a trademark for "ornamental items, namely, copper vases, plates and bowls".¹

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the

¹ Ser. No. 75/174,612, filed on October 1, 1996, which alleges dates of first use of April 13, 1994.

basis that, when used in connection with applicant's goods, the term "COBRE," which the Examining Attorney maintains is Spanish for "copper," is at least merely descriptive of, if not generic for, such goods. In addition, while applicant, following a final refusal on the ground of mere descriptiveness, has claimed in the alternative that the term "COBRE" has acquired distinctiveness and is thus registrable pursuant to the provisions of Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), such claim has been finally refused as insufficient on the basis that the term "COBRE" is generic for applicant's goods² and hence is incapable of registration.³

² Such refusal was expressed in the Office action of September 3, 1999 as follows:

[A]pplicant's Trademark Act Section 2(f) submission is rejected as insufficient and because the mark is incapable of establishing a goods/source association because it is generic. This is also ... made FINAL. Trademark Act Section[s] 1 and 45.

Although applicant, in her initial brief, indicates that she "is aware of only the final refusals" under Section 2(e)(1) on the grounds of mere descriptiveness and genericness and is "unaware of any refusals under Section[s] 1 ... and 45," suffice it to say that reference to the latter two sections of the statute simply underscores the fact that a generic designation, because it names a product or product category, is unregistrable since it does not function as a mark which identifies and distinguishes the source of particular goods. More importantly, however, while it should be noted that, as set forth in *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 917 (TTAB 1983) at n. 2, the insufficiency of a showing pursuant to Section 2(f) is not a statutory basis for a refusal of registration on the Principal Register, the failure to make a sufficient showing of acquired distinctiveness precludes registration of terms which are otherwise barred by the "merely descriptive" prohibition of Section 2(e)(1). Furthermore, in the case of merely descriptive terms which

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusals to register on the grounds of mere descriptiveness and genericness.

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 Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-

are generic, no showing of acquired distinctiveness would suffice for purposes of registration on the Principal Register. See, e.g., *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 728 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986) and authority cited therein ["A generic term ... can never be registered as a trademark because such term is 'merely descriptive' within the meaning of Section 2(e)(1) and is incapable of acquiring de jure distinctiveness under Section 2(f). The generic name of a thing is in fact the ultimate in descriptiveness"]. Thus, applicant's alternative claim of acquired distinctiveness would not overcome a finding that the term "COBRE" is generic for applicant's goods so as to permit registration.

³ While the Examining Attorney, in his initial Office action, imposed a requirement that applicant "submit an English translation of all foreign wording in the mark," no further mention of such requirement was made until it was stated to be final in the same Office action in which the Examining Attorney, following applicant's notice of appeal and remand of the application for consideration of an accompanying request for reconsideration, made final his refusal to accept applicant's claim of acquired distinctiveness as being insufficient. Although applicant, in her initial brief, states that she "will amend its [sic] application to add the following sentence if the Board agrees with applicant that the Examining [A]ttorney's final refusal under Section 2(e)(1) is incorrect: The English translation of the Spanish term 'cobre' is 'copper,'" we find that the Examining Attorney has waived his requirement for such a translation. Accordingly, the requirement will not be given further consideration.

18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or aspect about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used or is to be used in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Consequently, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

It is also well established that, in the case of a generic term, the burden is on the Patent and Trademark Office to show the genericness of such term by "clear evidence" thereof. See, e.g., In re Merrill Lynch, Pierce, Fenner & Smith, Inc., supra at 1143. See also In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987). As to the standard for evaluating genericness, the Board in In re

Leatherman Tool Group Inc., 32 USPQ2d 1443, 1449 (TTAB 1994),
stated for example that:

The test for determining whether a designation is generic, as applied to the goods [or services] set forth in an application or registration, turns upon how the term is perceived by the relevant public. See *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552-53 (Fed. Cir. 1991) and cases cited therein at 1553. Such perception is the primary consideration in a determination of genericness. See *Loglan Institute Inc. v. Logical Language Group Inc.*, 962 F.2d 1038, 22 USPQ2d 1531, 1532 (Fed. Cir. 1992). As Section 14(3) of the Trademark Act, 15 U.S.C. §1064(3), makes clear, "[a] ... mark shall not be deemed to be the generic name of goods [or services] solely because such mark is also used as a name to identify a unique product [or service]"; instead, "[t]he primary significance of the ... mark to the relevant public rather than purchaser motivation shall be the test for determining whether the ... mark [is or] has become the generic name of the goods [or service] on or in connection with which it has been used." Consequently, if the designation sought to be registered is understood by the relevant public primarily to refer to the class or genus of goods [or services] at issue, the term is generic. See *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, [728 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)] Evidence of the relevant public's understanding of a term may be obtained from any competent source, including newspapers, magazines, dictionaries, catalogs and other publications. See *In re Northland Aluminum Products, Inc.*, 777 F.2d 1566, 227 USPQ 961, 963 (Fed. Cir. 1985).

Applicant argues that the term "COBRE is suggestive of the goods because some thought and/or imagination is required to understand the relationship between the Spanish word COBRE and applicant's copper hollowware." In particular, applicant insists that such term "leads the imagination of the average consumer to 'cobra'" and that, consequently, "[o]nly after some investigation will consumers make the attenuated connection between the sound of the mark COBRE and the word copper."

Applicant also contends that, under the doctrine of foreign equivalents, the term "COBRE" should not be translated into its English counterpart "because it does not compel the average American consumer familiar with Spanish to 'stop and translate'" such term. According to applicant:

Under the Doctrine of Foreign Equivalents, foreign words are translated into English to determine trademark registrability. However, the Doctrine of Foreign Equivalents is not a mechanical rule. There are foreign words in certain settings that even those familiar with the language will not translate. In re Tia Maria, Inc., 188 USPQ 524, 525-526 (TTAB 1975). Further, the descriptive effect of the word must be immediate; that is, the buyer must be compelled by the word mark to "stop and translate" the mark. No Nonsense Fashions Inc. v. Consolidated Foods Corp., 226 USPQ 502, 507 (TTAB 1985); In re Pan Tex Hotel Co., 190 USPQ 109 (TTAB 1976).

....

COBRE does not compel American copper hollowware consumers familiar with the

Spanish language to immediately stop and translate it in the marketplace. COBRE is not an extremely familiar word such as SELECTA, which was held equivalent to "select" by the TTAB in In re San Miguel Corporation, 229 USPQ 617 (TTAB 1986). Instead, to the average American consumer fluent in English and familiar with Spanish, COBRE causes "cobra" to come to mind before "copper". This extra step in thought processing is the type of "mental gymnastics" that make a mark suggestive. Airco, Inc. v. Air Products & Chemicals, Inc., 196 USPQ 832 (TTAB 1977).

In addition, while failing to offer any argument on the genericness issue in her main brief, applicant urges in her reply brief that the Examining Attorney has failed to carry his burden of proof inasmuch as his "only evidence that COBRE, in the pertinent marketplace, is generic for Applicant's copper hollowware are two instances in which he found use of COBRE in a descriptive sense for the name of a museum and for the name of a geographic region" in Mexico. Applicant asserts that such evidence, out of "the millions of pieces of information in the LEXIS/NEXIS database," is insufficient to establish that "COBRE is generic for consumers of Applicant's copper hollowware."

We agree with the Examining Attorney, however, that under the doctrine of foreign equivalents, the term "COBRE," which is Spanish for the English word "COPPER," is not only merely descriptive of applicant's goods, in that it immediately describes, without conjecture or speculation, that a significant

characteristic or feature of applicant's ornamental copper vases, plates and bowls is that they are made from copper, but such term is a generic designation for applicant's goods in that it names a category or class of ornamental hollowware, namely, items thereof which are made of copper. In support of this position, the Examining Attorney has made of record a definition from Cassell's Spanish English Dictionary (1986) at 43, which defines the Spanish term "cobre" as meaning "copper" in English, and a newspaper article, reproduced in pertinent part below (**emphasis added**), on a Mexican town and museum noted for copper crafts:

"Around Santa Clara de Cobre - **cobre is Spanish for copper** - an estimated 5,000 villagers are engaged in coppersmithing. Many of them are descendants of the Purepecha Indians

....

Santa Clara de Cobre is 10 miles south of Patzcuaro. Prices are rock bottom at the shops lining the arcade. Small rectangular copper baking dishes sell for as little as \$6. At the Galeria Tiamuri, where works from the government school are sold, prices are higher but so is the quality. A heavy French-style copper saucepan with lid is about \$28; small copper vases are \$13, larger vases \$40 and up.

The Museo del Cobre on Morelos near the plaza (closed Mondays), features a permanent display of fabulous works by local artists, including winners from an annual competition, with prices as high as \$5,000." -- Star Tribune (Minneapolis, MN), May 10, 1992.

In addition, with his appeal brief, the Examining Attorney has submitted a copy of a definition of the word "copper" from the Random House Unabridged Dictionary (2d ed. 1993) at 448 which lists such word, in relevant part, as meaning "1. A malleable, ductile, metallic element having a characteristic reddish-brown color: used in large quantities as an electrical conductor and in the manufacture of alloys, as brass and bronze ..." and "5. a container made of copper."⁴ As used in connection with items of ornamental copper hollowware, the Spanish term "COBRE," being the equivalent of the English word "copper," would convey forthwith to those conversant with Spanish that applicant's goods are copper containers or made of copper. The relevant purchasing public, consisting of ordinary consumers as well as those in the trade for ornamental copper hollowware, would readily understand that the English word "copper" refers primarily to the category or genus of goods at issue, that is, ornamental hollowware made of copper. Such word, therefore, is generic for ornamental copper items like vases, plates and bowls and, under the doctrine of foreign equivalents, its Spanish

⁴ As the Examining Attorney correctly notes, the Board may properly take judicial notice of dictionary definitions. 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).

counterpart, namely, the term "COBRE," is also generic for such goods.

Applicant's unsupported assertion that an ordinary consumer who is familiar with the Spanish language would not be compelled to stop and translate the term "COBRE" strikes us as pure speculation which, moreover, is glaringly at odds with the evidence of record. Such a consumer, we think, could not help but immediately translate the Spanish term "COBRE" into its English equivalent of "copper" when encountering objects, including applicant's goods, which are made from copper. As the Examining Attorney persuasively points out in his brief (footnotes omitted):

The evidence of record shows that COBRE has one unadulterated meaning to Spanish speakers and that is copper. The dictionary definition of record and the newspaper story of record show only one usage for the term COBRE. Applicant claims that the average American consumer well versed in Spanish would not be "compelled" to stop and translate the mark. Of course, this raises the vexing proposition as to what a monolingual Spanish speaker or a bilingual Spanish-English speaker would envisage if it saw copperwares labeled as copper. Common sense dictates that this person in fact would read the metallic element applied to goods made of the same and believe that COBRE identifies the nature of the goods. There is simply no evidence of record to indicate that a Spanish speaking individual would see any other meaning. The *Lexis/Nexis* evidence of record shows a lucid and unfettered understanding for COBRE; the MUSEO DEL COBRE in Mexico recognizing copper

goods clearly denotes the sense and significance of COBRE. A pertinent English definition of "copper" is a "container made of copper". [The names of] ... metallic elements and compounds are usually used to refer to items made of such material, e.g., silver for silver plates and utensils, tin for tin containers, zinc for zinc roofs and steel for steel compounds. Copper and its Spanish equivalent COBRE are used to refer to copper and to identify the component of the goods made of copper and thus the goods themselves. "Under the doctrine of foreign equivalents, foreign words are translated into English and then tested for descriptiveness or genericness." See McCarthy on Trademarks and Unfair Competition Section 12:41 (West Group 1999). Copper is a generic noun and adjective of copperware, therefore, the Spanish translation of this term, COBRE, should also be considered generic.

Thus, not only has the Spanish term "COBRE" been shown to be merely descriptive of applicant's ornamental copper goods, since it is plainly the equivalent of the English word "copper" and has no other meaning, but the evidence relied upon by the Examining Attorney, particularly the definition from a Spanish-English dictionary, constitutes plain and unambiguous proof of genericness. Applicant, notably, has offered nothing to contradict the Examining Attorney's showing. In view thereof, and contrary to applicant's remaining contention, the evidence relied upon by the Examining Attorney is sufficient, in the circumstances of this case, to satisfy the Office's burden of demonstrating by clear evidence that, under the doctrine of

foreign equivalents, the Spanish term "COBRE" is a generic designation for applicant's ornamental vases, plates and bowls made from copper.

Nevertheless, in the event that applicant should ultimately prevail upon her assertion that the term "COBRE" is not generic for items of ornamental copper hollowware, we turn to the issue of whether applicant has established her alternative assertion that such term, even if merely descriptive of her goods, has been shown to have acquired distinctiveness. As support for her claim of acquired distinctiveness, applicant relies upon her substitute declaration, dated August 3, 1999, in which she alleges, inter alia, that with respect to her "copper hollowware," "my trademark COBRE" has become distinctive of my goods through my substantially exclusive and continuous use of the mark in commerce since at least April 13, 1994, which is more than five years before the date of this statement"; that she "sell[s] copper hollowware under my trademark COBRE throughout the U.S."; that she "estimate[s]" that her product sales constitute "approximately ninety (90) percent of the entire copper hollowware market"; that, as shown by a representative sample thereof, she has "promoted my trademark COBRE by using it in promotional and sales material," including business cards, marketing booklets, catalogs, response cards, price lists and advertisements in trade and retail magazines,

which is distributed to "clients and potential customers"; that she has "spent tens of thousands of dollars advertising my business under my trademark COBRE by running recurrent advertisements in national magazines";⁵ and that her "business symbolized by my trademark COBRE has developed a national reputation in the copper hollowware market as represented by my national customer base," including several museums and art institutes. Such evidence, applicant maintains, establishes that the term "COBRE" has in fact acquired distinctiveness for applicant's ornamental copper hollowware, namely, vases, plates and bowls.

We concur with the Examining Attorney, however, that the evidence furnished by applicant does not overcome the refusal on the ground of mere descriptiveness. Applicant's asserted mark "COBRE," being the Spanish term for the word "copper" and having no other demonstrated meaning, must be characterized as so highly descriptive of copper hollowware that it simply does not serve as an indication of source for such goods.⁶ As our principal reviewing court has noted with respect

⁵ Such magazines are said to include American Bungalow, American Style, Bonsai Today, Garden Décor, Garden Design, Horticulture, Museum Store Association, Niche, Land Forum, Old House Interiors and Roth.

⁶ See, e.g., *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999), holding that the phrase "THE BEST BEER IN AMERICA" for beer and ale to be "so highly ... descriptive of the qualities of [the applicant's] product that the slogan does not and

to the possible registrability of merely descriptive terms which may nevertheless acquire distinctiveness or secondary meaning, "the greater the degree of descriptiveness the term has, the heavier the burden to prove it has obtained secondary meaning." *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988). See also *In re Bongrain International (American) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1728 (Fed. Cir. 1990) at n. 4.

Here, besides the high degree of descriptiveness which is inherent in the term "COBRE" and which would be readily apparent to the growing body of Spanish-speaking consumers in the United States, the Examining Attorney also accurately points out that applicant's "promotional materials, which presumably include the labels of record, show an ambiguous use of the term COBRE."⁷ Given such contextual ambiguity and the high degree of

could not function as a trademark to distinguish Boston Beer's goods and serve as an indication of origin."

⁷ While such labels, in particular, direct purchasers and prospective consumers to "[l]ook for the Cobre mark" as "an assurance that your copper piece was made in the traditional bonfire method using the simple tools of the smith's trade," the words "Cobre mark" are immediately followed by a stylized design of what appears to be a copper pitcher. The stylized pitcher design, however, is displayed separately elsewhere on the specimens and is separately featured in applicant's promotional materials as well. Thus, the term "Cobre mark," when used in connection with items of copper hollowware, could reasonably be understood as referring to applicant's stylized pitcher design as her "copper" mark rather than to the term "COBRE" itself. Furthermore, applicant's claim of acquired distinctiveness appears directed more to the registrability of a stylized version of the term "COBRE" which is also shown on the specimen labels. Nevertheless, because applicant is seeking to register the term "COBRE" itself

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descriptiveness of the term "COBRE" as used in connection with products--including ornamental vases, plates and bowls--made of copper, we conclude that applicant's evidence is insufficient to demonstrate that the term "COBRE" has in fact acquired distinctiveness with respect to applicant's items of copper hollowware.

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

E. J. Seeherman

G. D. Hohein

H. R. Wendel
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rather than, for example, a stylized version thereof with a disclaimer of such term, applicant must establish acquired distinctiveness for the term "COBRE" alone and not for a particular stylized presentation of such term.