

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mannington Mills, Inc.

Serial No. 76335533

Sherry H. Flax of Saul Ewing LLP for Mannington Mills, Inc.

Catherine Pace Cain, Trademark Examining Attorney, Law
Office 113 (Odette Bonnet, Managing Attorney).

Before Simms, Seeherman and Hairston, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Mannington Mills, Inc. filed a trademark application
to register JERUSALEM STONE on the Principal Register for
"laminated floor covering."¹

The Trademark Examining Attorney² refused to register
the mark on the ground that, when used on the identified

¹ Application Serial No. 76335533, filed November 9, 2001. The application is based on applicant's allegation of a bona fide intent to use the mark in commerce.

² The current Examining Attorney was not the original Examining Attorney in this case.

goods, JERUSALEM STONE would be merely descriptive of them. 15 U.S.C. §1052(e)(1). After the Examining Attorney made the refusal final, this appeal followed. Briefs have been filed, but no oral hearing was requested.

The Examining Attorney's position is that the mark JERUSALEM STONE is merely descriptive because "it will immediately convey a characteristic or feature of applicant's goods to prospective consumers, that is, the goods are made to look like Jerusalem stone." (Final Office action, p. 2). The Examining Attorney submitted several NEXIS excerpts that refer to "Jerusalem stone" as a flooring material. The following are representative:

The floor tile in the front vestibule is "Jerusalem Stone," a type of pale beige sandstone required in many buildings in Jerusalem's Old City
(The Hartford Courant, August 28, 2000);

"People like the intricately carved moldings, the marble floors outlined with Jerusalem stone and richly stained mahogany walls in his den," Dupuis said.
(Sarasota Herald-Tribute, February 13, 2000);

Floors are tiled in hand-hammered Jerusalem stone, a material that looks like travertine, which continues midway up the columns dividing the otherwise open living-dining space.
(Press Journal, Vero Beach, FL, October 3, 1999); and

They replaced ceramic tile on the 2,800 square-foot first floor with Jerusalem stone, ...
(USA Today, September 1, 1999).

To further support her position, the Examining Attorney also submitted numerous NEXIS excerpts concerning laminate or vinyl flooring that is made to look like natural material such as tile, wood, stone and marble. The following are representative:

Flooring from Shaw Industries includes hardwood and carpeting, but there also are ceramic tiles finished to look like river stone, linoleum in stylish colors and laminates that look like slate, stone and wood.

(The Dallas Morning News, May 23, 2003);

Flooring and countertop manufacturers continue their efforts to produce materials that look like stone. Armstrong's Jaspe collection is vinyl sheet flooring that is supposed to replicate the appearance of stone.

(St. Petersburg Times, January 19, 2002);

People who want family friendly floors also are opting for vinyl and laminate flooring that looks like stone, complete with realistic-looking grout lines.

(Pittsburgh Post-Gazette, December 14, 2002);

Laminate flooring, which looks like wood or stone, has become popular in the United States in the last five years, says Laurie Baum, director of design at the Expo Design Center.

(The Dallas Morning News, May 12, 2000); and

There's also interest in high-end vinyl that looks like marble or stone, and wood and cork composition products that look like vinyl.

(Florida Times-Union, August 9, 1997).

Also, the Examining Attorney made of record a printout from the web site www.ntlfloortrends.com that discusses

applicant's line of vinyl tiles of which JERUSALEM STONE is a pattern.

Mannington, on the other hand, has introduced NatureForm Textures, the next generation of its NatureForm line. Textures was developed to deliver a more realistic resilient depiction of slate, ceramic, sandstone, limestone and even metal.

Finally, the Examining Attorney points to applicant's own web site as touting the realistic nature of applicant's laminate floor covering.

With this evidence, the Examining Attorney concludes "the relevant public would immediately understand that JERUSALEM STONE describes a characteristic of applicant's goods." (Final office action, page 2).

Applicant, on the other hand, argues that JERUSALEM STONE does not describe any material or attribute of its identified goods. Although applicant acknowledges "stone quarried in Israel is known as Jerusalem stone," applicant contends that "laminate flooring is a man-made product made from melamine with a recycled wood filler. Accordingly, the JERUSALEM STONE mark does not describe any aspect of the goods and does not connote laminate flooring in any respect." (Brief, p. 3).

Also, applicant points to registration of the marks SPANISH STONE (Reg. No. 789,605); MEDITERRANEAN STONE (Reg.

No. 1,617,656); COLISEUM STONE (Reg. No. 1,786,763); and WINDSOR STONE (Reg. No. 1,720,299) for paving stones or floor tiles as support for its position that its mark is registrable.

It is well settled that a term is considered to be merely descriptive of goods, 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. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods in order for it to be considered to be merely descriptive thereof; rather it is sufficient if the term describes one significant attribute, function or property of the goods. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods for which registration is sought. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

In this case, the record establishes and applicant does not dispute that Jerusalem stone is a natural flooring material. Moreover, as the evidence submitted by the Examining Attorney shows, it is quite common for laminate

floor coverings to be made to look like natural materials such as stone. Indeed, a significant feature of these floor coverings is the extent to which they look like the natural material. The Examining Attorney has made of record a printout from applicant's web site in which applicant itself touts the realistic nature of its "NatureForm" laminate tiles:

NatureForm Tile: The Most Realistic Tile Ever
...
... creating looks that are so natural, you'll have to feel the difference...
...
... our surface texture is three dimensional, just like natural stone...

In view of the above, we conclude that JERUSALEM STONE, when applied to applicant's laminate floor covering, immediately describes a significant characteristic or feature thereof, namely that the floor covering simulates the look of Jerusalem stone.³ In reaching this conclusion, we recognize that there is no evidence that Jerusalem stone is in common use in the field of laminate floor covering. However, it seems to us that competitors of applicant would need to use such term to describe their laminate flooring with similar characteristics.

³ The Examining Attorney has not refused registration on the ground that JERUSALEM STONE is deceptively misdescriptive of laminate floor coverings. Thus, we need not decide that question.

With respect to the third-party registrations relied on by applicant, they are of limited probative value. As often noted by the Board, each case must be decided on its own merits. We are not privy to the records in the files of these registrations. Also, there is no evidence that the marks in the third-party registrations, e.g., COLISEUM STONE, are types of stone. In any event, "[e]ven if some prior registrations had some characteristics similar to [applicant's mark], the PTO's allowance of such prior registrations does not bind the Board or this court"). In *re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

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