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March 18, 2004
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**This Opinion is Not
Citable as Precedent
of the TTAB**

File Entry
No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Oldcastle Glass, Inc.

Serial No. 76372028

John F.A. Earley III of Harding, Earley, Follmer & Frailey
for Oldcastle Glass, Inc.

Zhaleh S. Delaney, Trademark Examining Attorney, Law Office
116 (Meryl Hershkowitz, Managing Attorney).

Before Simms, Bottorff and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Oldcastle Glass, Inc. has filed an application to register **E•FAB** on the Principal Register as a trademark for goods ultimately identified as "glass, namely, glass panels; tempered glass panels for building purposes," in Class 19. Applicant asserts that it has a bona fide intention to use the mark in commerce on or in connection with the identified goods. The examining attorney,

however, has refused registration under Section 2(e)(1) of the Lanham Act, on the ground that the designation is merely descriptive of the identified goods.

When the refusal of registration was made final, applicant filed this appeal. Both applicant and the examining attorney have filed briefs. In addition, applicant, through counsel, and the examining attorney presented arguments at an oral hearing.

As a preliminary matter, we address the nature of the mark. Applicant, in its application, responses to office actions, and its briefing of this appeal, has consistently presented its mark as **E•FAB**, i.e., with a bold, raised period. The office, however, when it processed applicant's application and input data on the application into office databases, characterized the mark as E.FAB, i.e., as a mark in typed rather than stylized form. The examining attorney, in her office actions, did not attempt to clarify the issue and has alternately referred to the mark as E.FAB or E-FAB, apparently accepting the office's initial coding or characterization of precisely what mark it is that the application covers. In her brief, she refers to the mark as "E-FAB in typed form." We note that the Trademark Manual of Examining Procedure states the following about marks employing a raised period:

The applicant may *not* use a typed drawing if the mark contains foreign characters or punctuation marks other than those listed above. The degree symbol (°), raised or "rolled" periods, superscripts, subscripts and exponents are *not* permitted in typed drawings. *In re AFG Industries Inc.*, 17 USPQ2d 1162 (TTAB 1990) (special form drawing required for raised numeral). Underlining and bold print are not permitted in a typed drawing.

A special form drawing is required to show a raised period. However, if otherwise appropriate, the mark may be represented by a typed drawing by substituting a hyphen for the raised period.

TMEP 807.06(a) (3rd ed., rev. 2, May 2003)

Because we are, by this order, reversing the refusal of registration, the involved application shall go forward and applicant will receive a notice of allowance. If applicant later makes use of its mark and files an allegation of use, it should also clarify the nature of its mark by either stating that the original drawing was submitted in special form (albeit no larger than the usual typed mark) and should be scanned into the Office's databases, to accurately reflect the nature of the mark, or by stating that it seeks registration in typed form and amending the drawing to E-FAB, as permitted by the practice set forth in the TMEP.¹

¹ In the text of this decision, we have set forth the mark in bold with a large, raised period symbol, to indicate our conclusion that, pending clarification by the applicant, the application appears to seek registration in stylized form.

As for the refusal of registration, the question 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 will be used, on or in connection with those goods or services and the possible significance that the term would have to the average purchaser or user of the goods or services. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979), and In re Recovery, 196 USPQ 830, 831 (TTAB 1977).

A proposed mark is considered merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Lanham 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. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-218 (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 merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. In re Venture Lending Associates, 226 USPQ 285 (TTAB 1985).

The examining attorney bears the burden of establishing a prima facie case in support of a descriptiveness refusal. See In re Gyulay, *supra*. The examining attorney is not required to prove that the public would actually view a proposed mark as descriptive, but must at least establish a reasonable predicate for the refusal, based on substantial evidence, i.e., more than a scintilla of evidence. In re Pacer Technology, 338 F.3d 1348, 67 USPQ2d 1629 (Fed. Cir. 2003).

The examining attorney relies on the following materials to carry her burden of proof: a dictionary definition of "fab" as an "informal" noun, meaning "Fabrication: *building a shed of metal fab*"; various on-line or "hard copy" dictionaries, acronym finders, or encyclopedias, all to establish that E can mean "electrical" or "electronic" and that "e-" is a prefix that "may be attached to anything that has moved from paper to its electronic alternative"; and various excerpts of articles retrieved from the NEXIS database to show that "e" and "e-" when used as a prefix meaning electronic generally are so used to show that the product or service is available via the internet.² The examining attorney also

² For example, one excerpt, under the headline "To e or not to e; A certain letter of the alphabet is running e-mok" reads as

introduced a list of "search results" or "hits" obtained when searching the internet, using the Google search engine, by typing in "fabrication glass 'efab.'" However, none of the webpages represented by the search results have been provided and we therefore have little, if any, context within which to assess the use of EFAB on these websites. All we can note is that the excerpts appear to use EFAB as shorthand for "Electrochemical Fabrication."

With her action denying applicant's request for reconsideration, the examining attorney introduced a reprint from an on-line "acronym finder" showing that FAB means "fabrication," and certain reprints of what the examining attorney states is "evidence from the world wide web" showing use by entities other than applicant of "efab" and "electronic fabrication." Office action of July 25, 2003. The reprints of these pages do not, however, reveal the web addresses where they can be found and the examining attorney's office action does not report the addresses. Finally, in her brief, the examining attorney asks that we take judicial notice of an entry from the "Acronyms, Initialisms & Abbreviations Dictionary" that FAB can mean

follows: "Unsatisfied with being the most popular letter in the English language, 'e' has become a real Jabba the Hut of jargon, coasting its way to the front of the line of Internetspeak just because it makes a handy abbreviation for 'electronic.'" Star Tribune (Minneapolis, MN), December 5, 1999.

"fabricate" (in addition to "fabrication"). We grant the request that we take judicial notice of this entry.

Applicant did not offer any exhibits or evidence into the record.

In her initial office action, the examining attorney argued that "[a] feature of the applicant's goods appears to be fabricated glass products made all, or in part, via electronic means, or electronically fabricated glass products." Action of May 7, 2002, p. 2. In her second office action, which made the refusal of registration final and ripe for appeal, the examining attorney explained that applicant's products must be viewed as being produced "at least in part, electronically" because orders are placed by customers via the internet. As an alternative theory, and in apparent reliance on the "Google" search that returned a list of websites discussing "electrochemical fabrication" of certain products, the examining attorney asserted that "if the proposed goods are produced or fabricated via electromechanical [sic] means, the proposed mark is still merely descriptive." Action of December 11, 2002, p. 2. Given the introduction by this action of the Google search results, we presume the examining attorney meant to use the term "electrochemical," and read the argument as if it used that term. Finally, in her action denying applicant's

request for reconsideration, the examining attorney raised still a third possible rationale for refusing registration, asserting that if applicant's goods were "not produced at least in part, electronically, the proposed mark is deceptively misdescriptive." Action of July 25, 2003, p. 2.

In its response to the initial office action, applicant stated that it "tempers and fabricates glass" used in a wide variety of applications and that its products "are produced using information (e.g., specifications) transmitted over the Internet from applicant's customers." Response of November 7, 2002, p. 2. In addition, applicant argued that its goods are not customarily described by its competitors using the term **E•FAB**. In its request for reconsideration, applicant argued that its goods are not made electronically but are made by passing the goods through heated ovens, and asserted that its mark does not describe either "how the goods are made" or "what goods are made."

In briefing the appeal, neither applicant nor the examining attorney discusses the Google search results attached to the second office action (i.e., the final refusal) and the examining attorney's once-stated theory that EFAB (the term appearing in the list of Google search

results) means "electrochemical fabrication" and that this is the meaning that consumers would ascribe to applicant's mark. The absence of any arguments on this theory signals that neither applicant nor the examining attorney considers it an issue on appeal. Even if the examining attorney expected that it would be preserved for appeal merely because it was mentioned in one office action, we have already noted that the Google search results are not probative evidence because we have not been provided with reprints of the webpages themselves and we therefore have no understanding of the context within which EFAB may mean "electrochemical fabrication." In addition, applicant has stated that its goods are merely tempered glass heated in ovens, rather than a product of a more specialized electrochemical process. Accordingly, we discern no prima facie case in the record for refusing registration of applicant's mark on the theory that it stands for "electrochemical fabrication" and that it is descriptive because applicant's products are made by such a process.

In addition, neither applicant nor the examining attorney discussed in the briefs the examining attorney's alternative theory that unless applicant's goods are "produced at least in part, electronically, the proposed mark is deceptively misdescriptive." Accordingly, we do

not consider any theory of deceptive misdescriptiveness before us on appeal.

In essence, the examining attorney's theory of this case is that E-FAB or EFAB is shorthand for "electronic fabrication," and that applicant's goods must be viewed as produced by an electronic fabrication process because applicant's customers transmit to applicant, via the internet, specifications for the glass products they seek. The only alternative theory for the refusal that we believe has been preserved for consideration on appeal is the theory that applicant actually uses an "electronic fabrication" production process of some type.

As for the latter theory, the record does not support a prima facie case that glass products generally, or applicant's glass products in particular, are made by an electronic fabrication process. In this regard, the examining attorney's Google search results are inconclusive, for the evidence consists only of a list of web sites, with a few words from each site appearing in an excerpt. As we have noted, this evidence is not probative of how EFAB is used in the websites themselves. Moreover, as we have also noted, the only two excerpts on the list that indicate what EFAB stands for do not indicate that it stands for electronic fabrication but, rather, indicate

that it stands for electrochemical fabrication. The only other evidence tending to draw an association between EFAB or E-FAB and electronic fabrication are the purported webpages introduced by the examining attorney with her order denying applicant's request for reconsideration. These were not properly introduced because nothing in the record or the examining attorney's action reveals the addresses for the webpages. Even if the pages had been properly introduced, we would not find them probative on the question whether electronic fabrication is a term utilized in the industry to describe a process for making glass products, for the content of these pages focuses on, respectively, a software product for managing a manufacturing operation and "electronic fabrication of micro and nanoscale devices."

We are left, then, to consider what appears to be the primary theory for the examining attorney's refusal of registration, i.e., that applicant's "fabricated" products must be considered to be produced or fabricated electronically because customers' specifications are transmitted via the internet. We do not disagree that, under these circumstances, applicant's products might reasonably be said to be "electronically ordered fabricated glass products" or "electronically ordered glass

fabrications." However, implicit in the examining attorney's theory is not only the assumption that applicant's customers would shorten such phrases to "electronic fabrication" but also the assumption that they also would equate **E•FAB** with that term. See Modern Optics, Inc. v. Univis Lens Co., 234 F.2d 504, 110 USPQ 293, 295 (CCPA 1956); Racine Industries Inc. v. Bane-Clene Corp., 35 USPQ2d 1832 (TTAB 1995).

We find the examining attorney's reasoning a bit too strained. In addition, as the record reveals, FAB can be taken as shorthand for the laudatory word "fabulous." The record does not reveal whether applicant's customers would be more likely to consider FAB to mean "fabrication" or "fabulous." In sum, we find that the examining attorney has not presented a prima facie case for refusal and there is some doubt as to how customers would perceive applicant's proposed mark.

When there is doubt about whether a term is descriptive or suggestive when used on or in connection with an identified product, doubt must be resolved in favor of the applicant and publication of the designation for potential opposition. See In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972). See also, In re Bel Paese Sales Co.,

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1 USPQ2d 1233 (TTAB 1986). In this case, we resolve such doubt in favor of applicant.

Decision: The refusal of registration under Section 2(e)(1) of the Lanham Act is reversed.