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Mailed: June 2, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Arvin Technologies, Inc.

Serial No. 78214399

Marjory G. Basile of Miller, Canfield, Paddock and Stone,
P.L.C. for Arvin Technologies, Inc.

April Rademacher, Trademark Examining Attorney, Law Office
102 (Thomas V. Shaw, Managing Attorney).

Before Hohein, Chapman and Rogers, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

On February 13, 2003, Arvin Technologies, Inc. (a
Michigan corporation) filed an application to register on
the Principal Register the mark METAL CAT for goods amended
to read "catalytic converters for motors and engines" in
International Class 7. The application is based on
applicant's assertion of a bona fide intention to use the
mark in commerce.

The Examining Attorney refused registration on the
ground that the term METAL CAT, when used on or in

connection with the identified goods of applicant, is merely descriptive of those goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

When the refusal was made final, applicant appealed to the Board. Both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

Preliminarily we address an evidentiary matter. As part of applicant's appeal brief on the case, it submitted as additional evidence Exhibits A and B, respectively consisting of printouts of pages from applicant's website and a page from a third-party website. The Examining Attorney objected to such evidence as untimely. (Brief, p. 6.)

Trademark Rule 2.142(d) provides, in relevant part, that the record should be complete upon filing of the appeal, and if either applicant or the Examining Attorney desires to introduce additional evidence, the procedure to do so is a request for remand. Applicant's newly submitted evidence attached to its brief on the case was untimely filed. The Examining Attorney's objection is sustained, and applicant's Exhibits A and B attached to its brief have not been considered. We add, however, that even if the untimely evidence had been considered, it would not alter our decision herein.

Turning to the merits of the refusal to register on the basis that the term METAL CAT is merely descriptive, the Examining Attorney contends that "cat" is "an abbreviation for catalytic converter" (100megsfree4.com/dictionary) and "metal" is defined as "...3. an object made of metal. ..." (The American Heritage Dictionary (Third Edition 1992)); and that in combination the term METAL CAT merely describes applicant's goods, catalytic converters which are made of metal.

In support of her position, the Examining Attorney submitted a page from applicant's website in which applicant states the following:

Metal'Cat use[s] a METALLIC MONOLITH because it is both physically and thermally more robust than a ceramic monolith. They are environmentally friendly and more efficient. Their metal construction enables them to be easily recycled and results in faster light-off times.

In further support of her position, the Examining Attorney submitted copies of several excerpted stories retrieved from the Nexis database showing use of the term "cat" to refer to "catalytic converters." Examples from the Examining Attorney's Nexis database evidence are shown below (emphasis added):

Headline: N.C. Vehicle Emissions Testing Program Isn't Solving Air Pollution Problem

...This last operation involving the **catalytic converter (cat)** requires very tight control of the fuel system and must vary the gasoline-to-air (fuel) mixture by weight to a very narrow..., "The Ashville Citizen-Times," February 29, 2004;

Headline: Cool Cats; Emission Ingenuity Lets Saab Remain Hot For Turbochargers

...It's not that turbochargers create more emissions. Rather, they keep the **catalytic converter** from doing its job. The **cat** must be hot before it can thermally react on hydrocarbons, carbon monoxide and oxides of nitrogen. And there's the rub. The turbo is upstream of the **cat**. And its heavy metal housing acts as a heat sink that slows the..., "Automotive News," July 5, 1993;

Headline: Q & A

...A. Until you put the **catalytic converter** back on your truck, you won't get a tag. ... If you replaced your original exhaust system with a high-performance dual exhaust, you will need to install "**cats**" on both sides. ... "The Atlanta Journal-Constitution," April 21, 1997;

Headline: Cheap And Easy Don't Always Go Together

...A. If the original **catalytic converter** melted down from running too hot, the same fate could have befallen your new **cat**. This restricts exhaust flow, which can stall the engine. ... "Chicago Tribune," August 3, 2000; and

Headline: Quick Change Artist

...An important fact about **catalytic converters**, or **cats**, is that they

require a very strict diet to maintain an operating temperature hot enough to work but not so hot that ... "Chicago Tribune," December 30, 2002.

Applicant argues that the burden of establishing the mere descriptiveness of a mark is on the USPTO; that the mark METAL CAT "'suggests rather than describes' features or components of the product" (brief, p. 3); that applicant's combination of the words "metal" and "cat" results in a registrable mark; that the mark does not immediately and directly convey information about the particular characteristics of the goods; and that there are "more than 20 active records incorporating the term 'cat' for products or services specifically associated with catalytic converters." (Brief, p 4.)

A term or phrase is merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it immediately conveys information concerning 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 (CCPA 1978). It is not necessary that a term or phrase describe all of the properties or functions of the goods or services in order for it to be considered merely

descriptive thereof; rather, it is sufficient if the term or phrase describes a significant attribute of the goods or services.

The issue of whether a particular term or phrase is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used or is intended to be used on or in connection with those goods or services, and the possible significance that the term or phrase is likely to have to the average purchaser of the goods or services because of the manner in which it is used or is intended to be used. See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). See also, 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §§11:66-11:71 (4th ed. 2004). Further, the question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB

1990); and In re American Greetings Corp., 226 USPQ 365 (TTAB 1985).

In this case, the Examining Attorney has met the burden of establishing a prima facie case of mere descriptiveness. This record includes ample evidence that in the context of applicant's goods, "catalytic converters for motors and engines," the term "cat" is an abbreviated term for "catalytic converter"; and that applicant's involved goods are or may be made of metal. In fact, applicant stated that "[in refusing registration of the mark as merely descriptive, the Examining Attorney stated] the term 'cat' is used as an abbreviation for 'catalytic converters.' Applicant agrees that the term can be used in such a manner." (Applicant's response to first Office action, unnumbered page 3.) Applicant's argument that the term "cat" has other meanings, including a common well-known animal, is unpersuasive. The relevant meaning of the term "cat" in relation to applicant's goods is "catalytic converter." See In re Polo International Inc., 51 USPQ2d 1061 (TTAB 1999). Likewise, applicant's argument that consumers will not know what specific type of metal/metal substrate the goods are made of is unpersuasive.

The term METAL CAT, considered as a whole and in relation to applicant's goods, is merely descriptive

thereof. Specifically, the purchasing public would readily understand, without imagination or conjecture, that applicant's goods are catalytic converters made of metal.

Further, even if applicant is the first (and/or only) entity to use the term METAL CAT in relation to its identified goods,¹ such is not dispositive where, as here, the term unquestionably projects a merely descriptive connotation. See *In re Tekdyne Inc.*, 33 USPQ2d 1949, 1953 (TTAB 1994), and cases cited therein.

Applicant specifically argues that there are third-party registrations containing the term "CAT" covering catalytic converters or "catalytic-related goods and services." Applicant submitted USPTO Trademark Electronic Search System (TESS) records of three third-party registrations of marks for catalytic converters -- Registration No. 2513635 for MIDAS THUNDERCAT, Registration No. 2292438 for CAT-A-PASS and Registration No. 1928708 for CLEAN CAT. Applicant also submitted seven TESS records of third-party registrations of marks for catalytic-related goods -- Registration No. 2756255 for Z-CAT PLUS for "chemical additive for use in catalytic cracking in the

¹ The application is based on applicant's bona fide intention to use the mark in commerce, and thus, there are no specimens of record. However, the record shows that applicant has used "METAL'CAT" on its website.

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petroleum refining industry," Registration No. 2279113 for ICE CAT and design for "gas catalytic heating units for melting ice from aircraft," Registration No. 2627441 for QUIKCAT for "infrared catalytic heaters for industrial use," Registration No. 2004758 for ETHERCAT for "catalytic distillation structure for use in the manufacture of organic compounds for use in the chemical and petroleum industries," Registration No. 1286668 for LO-CAT for "catalytic reagent for use in hydrogen sulfide oxidation process," Registration No. 1392264 for HYDRO-CAT and design for "water treatment systems, comprising, holding tanks, catalytic beds, ...," and Registration No. 2478817 for GAS CAT and design for "gas catalytic heating units."

This evidence is not persuasive evidence supporting a reversal of the refusal in this case. Many of the marks in these third-party registrations are distinguishable on their face (e.g., MIDAS THUNDERCAT, CAT-A-PASS, ICE CAT and design); and the goods covered in many of the third-party registrations are not relevant to this case where applicant seeks to register METAL CAT for catalytic converters for motors and engines. In any event, while uniform treatment under the Trademark Act is an administrative goal, the Board's task in an ex parte appeal is to determine, based on the record before us, whether applicant's mark is merely

descriptive. As often noted by the Board, each case must be decided on its own merits. We are not privy to the records of the third-party registration files and, moreover, the determination of registrability of those particular marks by the Trademark Examining Attorneys cannot control our decision in the case now before us. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“Even if some prior registrations had some characteristics similar to [applicant’s application], the PTO’s allowance of such prior registrations does not bind the Board or this court.”)

Based on the record, we find that the term METAL CAT, when used on catalytic converters for motors and engines, immediately conveys to the purchasing public the idea of the goods as being catalytic converters made of metal. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (APPLE PIE merely descriptive of potpourri); *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) (FIRSTIER (stylized) merely descriptive of banking services); *In re Polo International Inc.*, supra (DOC-CONTROL merely descriptive of computer software for document management); and *In re Copytele Inc.*, 31 USPQ2d 1540 (TTAB 1994) (SCREEN FAX PHONE merely descriptive of facsimile terminals employing electrophoretic displays).

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