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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Diamond Machining Technology, Inc.

Serial No. 76345344

Jeffrey L. Snow of Kirkpatrick & Lockhart LLP for Diamond
Machining Technology, Inc.

Richard A. Straser, Trademark Examining Attorney, Law
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Before Quinn, Bucher and Drost, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Diamond Machining Technology, Inc. seeks registration on the Principal Register of the mark DIAMOND WHETSTONE for goods identified as "whetstones for sharpening, honing, deburring and abrading," in International Class 8.¹ The original application was filed pursuant to the provisions of Section 2(f) of the Trademark Act, 15 U.S.C. 1052(f).

¹ Application Serial No. 76345344 was filed on December 5, 2001 based upon applicant's allegation of use in commerce since at least as early as April 26, 1981.

This case is now before the Board on appeal from the final refusal to register on the ground that the designation DIAMOND WHETSTONE is generic and, thus, incapable of distinguishing applicant's services from like services of others under Section 2(e)(1) of the Act, 15 U.S.C. 1052(e)(1). If the mark is determined not to be generic but rather merely descriptive, then we must determine the sufficiency of the Section 2(f) claim of acquired distinctiveness.

Both applicant and the Trademark Examining Attorney have briefed the case and both appeared at an oral hearing held before the Board.

It has been repeatedly stated that "determining whether a mark is generic ... involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?" H. Marvin Ginn v. International Association of Fire Chiefs, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Of course, in a proceeding such as this, the genus of goods at issue is based upon the goods set forth in the identification of

goods in the application itself. Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991).

Moreover, the burden rests with the Trademark Examining Attorney to establish that the mark sought to be registered is generic for the goods as described in the application. In re Merrill Lynch, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1997). It is incumbent upon the Trademark Examining Attorney to make a "substantial showing ... that the matter is in fact generic." Indeed, this substantial showing "must be based on clear evidence of generic use." Merrill Lynch, 4 USPQ2d at 1143. Thus, it is beyond dispute that "a strong showing is required when the Office seeks to establish that a term is generic." In re K-T Zoe Furniture Inc., 16 F.3d 390, 29 USPQ2d 1787, 1788 (Fed. Cir. 1994). Furthermore, doubt on the issue of genericness must be resolved in favor of the applicant. In re Waverly Inc., 27 USPQ2d 1620, 1624 (TTAB 1993).

Addressing the first part of the Marvin Ginn genericness inquiry above, the record herein, beginning with the identification of goods, confirms that the involved goods are a particular type of whetstones. A whetstone is defined as "a hard, fine-grained stone for honing tools" (The American Heritage® Dictionary of the

English Language, Fourth Edition 2000) or "an abrasive stone for sharpening knives or other edged tools" (Webster's New World Dictionary, 2d ed. 1984). According to a package insert included with applicant's product, this is a "stone" having a sharpening area that is covered or impregnated with continuous monocrystalline diamond particles to create an abrasive surface. Hence, we find that the genus of goods at issue in this case would be diamond-encrusted whetstones, diamond-coated whetstones, diamond-covered whetstones, diamond-impregnated whetstones, diamond sharpeners or diamond sharpening stones.

We turn next to the second part of the Marvin Ginn genericness inquiry: whether the matter applicant seeks to register, DIAMOND WHETSTONE, is understood by the relevant public primarily to refer to the genus of goods at issue, i.e., diamond-impregnated whetstones, diamond sharpening stones, etc.

Applicant argues that the applied for mark cannot be generic because this would literally be "a whetstone made of a diamond":

... Applicant respectfully submits that even an uneducated consumer would recognize that a "diamond whetstone" would be unlikely to refer to a whetstone that is, or is made entirely from, a diamond, and so must be referring to something else... [Based on its

package insert], [a]pplicant therefore submits that there is no such thing as a "diamond whetstone," but that the mark rather refers to applicant's diamond-coated or diamond-impregnated sharpener. The combination of the two words "diamond" and "whetstone" therefore produces a phrase that has a literal meaning that clearly cannot be an actual product in the eyes of the purchasing public (*i.e.*, a whetstone made of a diamond).

(Applicant's appeal brief, pp. 3 - 4)

We note at the outset, even before examining the state of current usage in newspapers, advertisements and online content, that in the context of applicant's identified goods, the term "diamond whetstone" is clearly *not arbitrary* in origin. Given the variety of generic designations that the record shows are used for the involved goods (e.g., "diamond-impregnated whetstones," "diamond sharpening stones," etc.), and in light of our national penchant for adopting shorthand terminology,² it is arguable that the term "diamond whetstone" would rather readily follow from these quite similar, admittedly generic expressions.

Nonetheless, given the fact that the Trademark Examining Attorney must make a substantial showing of

² See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978) (J. Rich, concurring opinion): "... [T]he

genericness based upon clear evidence of generic usage, we turn to the actual evidence of record.

The Trademark Examining Attorney initially assigned to this case provided excerpted stories he had retrieved from the LEXIS/NEXIS database. As noted by applicant, the following articles expressly refer to applicant's products:

HEADLINE: "Olympian visits Marlboro company"
Work at Diamond Machining Technology Inc. ground to a halt yesterday morning when one of the company's best known clients stopped by to show employees the importance of the **diamond whetstones** they make in his drive toward Olympic gold..
Worcester Telegram and Gazette, September 27, 1997.

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HEADLINE: "Pantone develops broad color palette"
... DMT, based in Marlborough, Mass., makes **diamond whetstones** for blade sharpening..
Plastics News, July 25, 1994.

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HEADLINE: "Tagged Sharks for the Record"
... carry a recently manufactured whetstone in which industrial diamonds provide the cutting edge. Called Diafold, it is made by Diamond Machining Technology of Marlborough, Mass..

Diamond whetstones have been around for quite a while ...

users of language have a universal habit of shortening full names - from haste or laziness or just economy of words..."

The New York Times, June 23, 1988.

At least one LEXIS/NEXIS story retrieved by the Trademark Examining Attorney that referred to applicant used the words "diamond" and "whetstone" in individually descriptive but separate ways, as pointed out by applicant:

HEADLINE: "Marlboro firm opens addition"
The company celebrated its construction of an 8,000 square foot addition and the purchase of a horizontal molding machine designed to increase production of **diamond**-coated **whetstones**, according to Chairman Elizabeth P. Powell.
Worcester Telegram and Gazette, March 30, 1999.

The text of other LEXIS/NEXIS stories (if not all of their headlines) reflects similar usage of the "diamond-impregnated" terminology that applicant argues is the correct generic designation for these goods, but wherein it is not clear whether the reference is to applicant's goods:

HEADLINE: **Diamond Whetstones** Sharp, but Costly Idea
... You probably saw **diamond**-impregnated **whetstones** on those TV cooking shows. These "stones" have a fine steel lattice studded with diamond that is bonded to a hard base, generally plastic..
The Palm Beach Post, February 12, 1998.

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HEADLINE: "Some points about knives; Choices abound - care a must"
Traditional **whetstone[s]** or **diamond** impregnated sharpening stones can bring

back a knife's edge, Larson says, but they seem to require a "knack." ...
The Bismarck Tribune, November 30, 1996.

The Trademark Examining Attorney also provided a number of webpages retrieved from an Internet search. It is clear in a majority of these sites that the items being offered for sale or otherwise referenced are applicant's products.³ In some of these cases, the term is shown with initial upper-case letters, with a trademark symbol ("™"), etc. On the other end of the spectrum, where the Internet excerpt is drawn from an online, informal chatroom, the probative value of the seemingly generic usage is most limited.⁴

On the other hand, in reviewing the balance of the LEXIS/NEXIS and Internet evidence, it is clear that there are several occasions where the writer, speaker or online retailer is using the term "diamond whetstone" in a generic-like manner and/or is referring specifically to a similar product manufactured by someone other than applicant. Nonetheless, these instances appear to represent a distinct minority of the uses found by the Trademark Examining Attorney. As if to demonstrate this

³ www.sharpeningstones.com, www.profhdwr.com, www.seamar.com, www.gofastest.com

⁴ <http://carverscompanion.com>.

reality, on September 4, 2002, applicant conducted an Internet search on the Google® search engine for the words "diamond whetstone." From the printed summaries of the first fifty hits from this search (a search that garnered a total of 9,510 hits), applicant showed that all fifty of these websites referred specifically to applicant and/or applicant's trademarked products.

Hence, we find that in answering the second prong of the Marvin Ginn genericness inquiry as to how the term DIAMOND WHETSTONE is understood by the relevant public, this record reveals a mixed bag. Despite the highly descriptive (if not generic) nature of these individual words when applied to these goods, and in spite of an evidentiary record having scattered indications of generic usage, we have reasonable doubts on the issue of genericness based upon a thorough review of this entire record. Under our case law, we must resolve these doubts in favor of applicant. Accordingly, on the issue of genericness, we have no choice but to reverse the refusal to register made by the Trademark Examining Attorney.

In addition to the compelling case for descriptiveness reflected above, there is no dispute but that DIAMOND WHETSTONE must be viewed as merely descriptive of

applicant's goods inasmuch as the application was filed under the provisions of Section 2(f) of the Act. Having determined that the Trademark Examining Attorney has failed on this record to make a substantial showing of genericness, the critical determination herein is whether of not the term has been shown to have acquired distinctiveness as a trademark.

It is settled that the applicant has the burden of proof with respect to establishing a *prima facie* case that a merely descriptive term has acquired distinctiveness.⁵ For instance, as stated in Yamaha International Corp. v. Hoshino Gakki Co. Ltd., 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988), "the ultimate burden of persuasion under Section 2(f) on the issue of acquired distinctiveness is on ... [the] applicant."

⁵ Under Trademark Rule 2.41(a), an applicant may demonstrate that such a term has acquired distinctiveness by submitting "affidavits, or declarations in accordance with §2.20, depositions, or other evidence showing duration, extent and nature of use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and affidavits, or declarations in accordance with §2.20, letters or statements from the trade or public, or both, or other appropriate evidence tending to show that the mark distinguishes the goods." In the alternative, Trademark Rule 2.41(b) provides that "[i]n appropriate cases, ownership of one or more prior registrations on the Principal Register ... of the same mark may be accepted as *prima facie* evidence of distinctiveness" and that an acquired distinctiveness claim may also be based on a verified statement that the asserted mark has been in "substantially exclusive and continuous use in

In addition, as our principal reviewing Court has noted with respect to the possible registrability of merely descriptive terms which may nevertheless acquire distinctiveness, the more descriptive the term, the more evidence of acquired distinctiveness is required to attain registration. See In re K-T Zoe Furniture Inc., 16 F.3d 390, 29 USPQ2d 1787, 1789 (Fed. Cir. 1994) [Court confirms that the words THE SOFA & CHAIR COMPANY were aptly descriptive of "custom manufacturing of furniture upholstered with fabrics furnished or pre-selected by customers," and that the degree of acquired distinctiveness that must be shown varies with the degree of descriptiveness of the mark]; In re Bongrain International (American) Corp., 894 F.2d 1316, 13 USPQ2d 1727, 1728 (Fed. Cir. 1990); and Yamaha International Corp., *supra*.

In this context, we find the DIAMOND WHETSTONE designation to be highly descriptive of diamond-coated whetstones. Therefore, the law requires a relatively strong showing of acquired distinctiveness before it can be registered.

Nonetheless, applicant has provided no direct evidence showing that the mark distinguishes these goods, such as

commerce ... by applicant for the five years before the date on

the extent and nature of the annual or cumulative sales of this product, the nature and volume of expenditures for advertising and other promotional activities, or any statements or letters from the trade the relevant public.⁶

In light of our finding that the term DIAMOND WHETSTONE is highly descriptive of applicant's goods, we find that applicant's mere claim of use since 1981 fails to demonstrate that such term has in fact acquired distinctiveness as an indication of source for the identified goods.⁷

Accordingly, it is adjudged that applicant has failed to establish a *prima facie* case of acquired distinctiveness and thus has not overcome the refusal on the ground of mere

which the claim of distinctiveness is made."

⁶ Both the Trademark Examining Attorneys and applicant have focused exclusively on the issue of genericness since the time of the initial Office action. Hence, the alternative issue of whether applicant had established a *prima facie* case of acquired distinctiveness was never the focus of any discussion during the prosecution of this application. While it would have been better practice for the Trademark Examining Attorney explicitly to have raised this as an alternative basis for the refusal, the Trademark Examining Attorney never conceded *de facto* acquired distinctiveness. Applicant retains the burden of making the case for acquired distinctiveness, and in our judgment, has clearly failed to do so during the prosecution of this application.

⁷ In fact, while the opening sentence of the original application papers contained a clause that applicant "requests that said mark be registered pursuant to Section 2(f) ...," applicant has nowhere asserted that the mark DIAMOND WHETSTONE has become distinctive of applicant's goods as a result of substantially exclusive and continuous use in commerce by applicant for the five years before the date on which the claim of distinctiveness is made. See Trademark Rule 2.41(a).

descriptiveness. See In re Pennzoil Products Co., 20 USPQ2d 1753, 1760-61 (TTAB 1991); and In re Packaging Specialists, Inc., 221 USPQ 917, 920-21 (TTAB 1984).

Decision: The refusal under Section 2(e)(1) on the ground of genericness is reversed, but the refusal on the ground of mere descriptiveness is affirmed due to the insufficiency of applicant's claim of acquired distinctiveness.