

Hearing:
February 24, 2004

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

Mailed:
June 29, 2004
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Diamond Machining Technology, Inc.

Serial No. 76345344

Request for Reconsideration

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

Richard A. Straser, Trademark Examining Attorney, Law Office
114 (K. Margaret Le, Managing Attorney).

Before Quinn, Bucher and Drost, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Diamond Machining Technology, Inc. has requested
reconsideration of this Board's May 4, 2004 decision
affirming the Trademark Examining Attorney's refusal to
register the mark DIAMOND WHETSTONE for goods identified as
"whetstones for sharpening, honing, deburring and abrading,"
in International Class 8.¹

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.

Based upon a thorough review of the entire record before us, we had reasonable doubts on the issue of genericness, resolved these doubts in favor of applicant, and reversed the Trademark Examining Attorney on his holding of genericness. However, we also held that the term DIAMOND WHETSTONE was so highly descriptive of applicant's goods that applicant's mere claim of use since 1981 had failed to demonstrate that such term has in fact acquired distinctiveness as an indication of source for the identified goods. It is this latter decision that applicant has asked us to reconsider.

In order to ensure that applicant is provided the fairness and due process to which it is entitled, we review the contents of each exchange during the course of prosecution of this application with an eye toward the issue of acquired distinctiveness.

(1) In the thirdline of the application papers filed on December 5, 2001, applicant merely requested "that said mark be registered pursuant to Section 2(f)" of the Trademark Act.

(2) In the first Office action of March 6, 2002, the initially-assigned Trademark Examining Attorney refused registration, holding this term to be merely descriptive

under §2(e)(1) of the Lanham Act. He went on to say that, in fact, the term was generic as applied to the involved goods, and hence was incapable of acquiring distinctiveness. Although the application had already been filed under §2(f) of the Act, the Trademark Examining Attorney included form paragraph language saying that "[u]nder these circumstances, the examining attorney cannot recommend an amendment to proceed under Trademark Act Section 2(f)..."

(3) Applicant's response of September 6, 2002 took issue with the Office's position as reflected in the initial Office action, arguing that this matter was not generic.

(4) On October 11, 2002, the current Trademark Examining Attorney issued a final action, highlighting three excerpted uses attached to the initial Office action that he alleged proved genericness. The final refusal made no reference, in the alternative, to the sufficiency of applicant's claim of acquired distinctiveness or Section 2(f) of the Trademark Act.

(5) In applicant's request of March 25, 2003 to the Trademark Examining Attorney to reconsider his final refusal, applicant argued that the three articles highlighted in the final Office action do not prove

genericness as the Trademark Examining Attorney had claimed. Again, there was no mention of acquired distinctiveness.

(6) In the Trademark Examining Attorney's denial of applicant's request for reconsideration (April 25, 2003), most of the discussion was on the statutory refusal under Section 2(e)(1) and the Trademark Examining Attorney's attempts to show the genericness of this alleged mark. However, as to acquired distinctiveness, there is one phrase suggesting that this was still an issue: "The statutory refusal is under Section 2(e)(1), not Section 23, and the showing under Section 2(f) is insufficient based upon evidence of highly descriptive and possible generic use of the mark by others." [emphasis supplied]

(7) Applicant notes in its appeal brief of July 18, 2003 that this application was filed under Section 2(f) of the Trademark Act, having been used in connection with applicant's products since April 26, 1981. Applicant points to the declaration of Christine Miller dated December 4, 2001 (as filed with the application on December 5, 2001) and argues that the use of this mark for more than five years prior to filing the application constituted *prima facie* evidence that the mark had become distinctive. Applicant continued to argue that the term DIAMOND WHETSTONE is

neither highly descriptive nor generic, but rather is indicative of the acquired distinctiveness of this term.

(8) In the Trademark Examining Attorney's appeal brief of October 21, 2003, he states that one of the issues in the appeal is whether "the generic use by third parties of 'diamond whetstone' negated the showing of acquired distinctiveness?" He went on to state that "... Section 2(f) of the Trademark Act does not allow registration of a trademark when applicant's mark is generic," and that "... the refusal to register under Section 2(e)(1) because the mark is generic should be affirmed ..."

In our decision of May 4, 2004, after explaining our doubts on the issue of genericness, we found the DIAMOND WHETSTONE designation to be highly descriptive of diamond-coated whetstones, compelling applicant to make a strong showing of acquired distinctiveness before this term could be registered. Moreover, we found that applicant's mere claim of use since 1981 failed to demonstrate that such term had in fact acquired distinctiveness as an indication of source for the identified goods.

In its request for reconsideration, applicant requested that the application be remanded to the Trademark Examining

Attorney for further prosecution on the issue of acquired distinctiveness.

In footnote 6 on page 12 of the Decision, the Board *admitted* that the Examining Attorney did not raise the issue whether Applicant had established a *prima facie* case of acquired distinctiveness as an alternative basis for the refusal. Therefore, it would be improper for the Board to render a final decision on this issue, which "was never the focus of any discussion during the prosecution of the application."

If the Examining Attorney disputed the Applicant's claim of acquired distinctiveness under Section 2(f), he should have raised all applicable objections during prosecution. First, the Board admits that it would have been "better practice for the Trademark Examining Attorney explicitly to have raised this" issue. Second, the Examining Attorney failed to follow the mandate of T.M.E.P. § 1212.02(c), which requires the Examining Attorney to separately consider the question of, assuming the matter is determined to be registrable, whether acquired distinctiveness has been established.

Moreover, the Examining Attorney properly should have requested that the applicant submit additional evidence of acquired distinctiveness "before a final refusal on this ground was made." See 37 C.F.R. § 2.41(a) (applicant may submit evidence "in response to a request for evidence"). T.M.E.P. § 1212.02(g) clearly states, "If the examining attorney determines that an applicant's evidence is insufficient to establish that the mark has acquired distinctiveness, the examining attorney should suggest, where appropriate, that the applicant submit additional evidence." Also, for an application claiming acquired distinctiveness under Section 2(f) and in which there is a genericness rejection, T.M.E.P. § 1209.02 requires that the "examining attorney should also explain why the showing of acquired distinctiveness is insufficient."

Finally, contrary to the Board's statement (Decision at 12), there *is* evidence in the record of acquired distinctiveness. In particular, evidence submitted by both the Examining Attorney and the Applicant in connection with the genericness rejection containing references to the Applicant and its products points to acquired distinctiveness. There is no requirement as the Board implies, that the application has to provide "direct evidence" showing that the mark distinguishes these goods. The evidence presently of record points to the "duration, extent and nature of use in commerce" by the Applicant of its mark to support a claim of acquired distinctiveness. 37 C.F.R. § 2.41(a). However, Applicant will be able to submit the referenced "direct evidence," including further declarations, on remand of the application to the Examining Attorney.

Although the prosecution of this application, up to and including the oral hearing, reflects uncertainty about whether the issue of acquired distinctiveness was appropriately raised, we do not hold applicant free of responsibility for the situation in which we found ourselves at the time of the final decision on this case. Nonetheless, because neither Trademark Examining Attorney pursued this alternative ground for refusal in their Office actions, applicant was never asked to submit additional evidence of acquired distinctiveness prior to the current Trademark Examining Attorney's issuing a final refusal on the ground of mere descriptiveness/genericness. While the Trademark Examining Attorney, in his denial of applicant's

request for reconsideration mailed on April 25, 2003, did include a single, terse phrase arguably showing that the insufficiency of the Section 2(f) evidence was still an outstanding issue, that was buried within a longer discussion of the §2(e)(1) refusal. We noted in our earlier decision our unhappiness that during almost two years of prosecution of this application - amid dozens of pages of legal argumentation on genericness - this alternative basis for refusal was never clearly raised by the Trademark Examining Attorney.

Despite the fact that applicant has made minimal efforts to demonstrate the acquired distinctiveness of this highly descriptive term, unfortunately, it is true that this is a ground that applicant has not been prompted with any force or clarity to address.

In light of applicant's protestations that it did not know there was any issue surrounding its claim of acquired distinctiveness, we are granting applicant's request for reconsideration and remanding this application to the Trademark Examining Attorney to articulate clearly a refusal based upon the insufficiency of the Section 2(f) evidence. While not strictly required by our rules and regulations, this is a judgment call growing out of an abundance of

caution to make sure that applicant has a fair chance to respond to this critical issue.

Hence, the Trademark Examining Attorney should promptly issue an Office action, providing applicant with the possibility of submitting supplementary § 2(f) evidence and with an opportunity to make any arguments related to a showing of acquired distinctiveness that it wishes the Office to consider. After such a submission, should the Trademark Examining Attorney remain unconvinced, he should then issue a new final refusal, as appropriate.

Decision: We hereby vacate that portion of our decision of May 4, 2004 concerning the issue of acquired distinctiveness wherein we affirmed the refusal of the Trademark Examining Attorney. This case is remanded to the Trademark Examining Attorney for further prosecution consistent with this order.