

Paper No. 13

HRW

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OCT. 23, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re HWE, Inc.

Serial No. 74/609,202

Michael A. Painter of Isaacman, Kaufman & Painter, P.C. for applicant.

Barney L. Charlton, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney)

Before Cissel, Walters and Wendel, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

HWE, Inc. has filed an application to register the mark TSUBO for "electro-mechanical massage apparatus". Although originally filed as an intent-to-use application, the application was subsequently amended to allege use and to seek registration on the Supplemental Register.

Registration has been finally refused under Section 23 of the Trademark Act on the ground that the matter sought

to be registered is generic and, thus, incapable of distinguishing applicant's goods from those of others.¹

Applicant and the Examining Attorney have filed briefs, but no oral hearing was requested.

The Examining Attorney has submitted as evidence in support of his refusal the materials accompanying the letter of protest filed in connection with the case. In particular, he points to excerpts from the book, Tsubo, Vital Points for Oriental Therapy, which the Examining

¹ The application was refused registration after the evidence provided in a letter of protest was forwarded to the Examining Attorney. While the initial refusal was based on Section 2(e)(1), after applicant amended its application to seek registration on the Supplemental Register, the refusal was restated as one under Sections 1, 2, and 45 on the ground that the proposed mark did not function as a trademark. The refusal was made final on this basis, although the Examining Attorney also stated in the final refusal that the term TSUBO was deemed "incapable of being perceived by purchasers as a source indicator" and "the name of a device used in TSUBO therapy." In the Examining Attorney's brief on appeal, the refusal was set forth in terms of TSUBO being incapable of functioning as a mark.

While we believe that applicant was adequately put on notice of the grounds for final refusal, we find the language used by the Examining Attorney in his refusal of registration on the Supplemental Register to be inappropriate. Whether or not a proposed mark presently functions as a mark is not the standard for registration on the Supplemental Register; it is whether the matter submitted for registration has the capacity of distinguishing applicant's goods from those of others and of serving, at some point, as a mark for applicant. It is true that a refusal on the basis that the matter sought to be registered is generic may be couched in terms of Sections 1, 2, and 45, but such an analysis is applicable only to registration on the Principal Register. On the Supplemental Register, the question is capability, and the refusal should be stated in terms of the specific reason that the matter cannot, rather than does not, function as a mark. In this case, the reason is because the word "Tsubo" is generic.

Attorney has ascertained to be available in the United States, even though it is a Japanese publication. In this book, the term "Tsubo" is defined as the "points on the human body...[which by] pressing, rubbing, or massaging them...can relieve many symptoms of illness." (Id. at 29). "Tsubo therapy" is described as consisting of the application of pressure to the appropriate "tsubo" for the particular health problem involved. The remaining publications submitted with the letter of protest contain additional information with respect to the "Tsubo points" and "Tsubo therapy", including the use of massage equipment in applying pressure to these points.² The Examining Attorney has also submitted excerpts from the Nexis database describing "...therapists [who] concentrate on various trigger points (tsubos) in order to release energy (chi) and relax the nerves and muscles" (The Record, Aug. 9, 1993) and showing a listing for sale of a "Tsubo massager" (The Independent, Dec. 9, 1995).

On the basis of this evidence, the Examining Attorney considers the term "Tsubo" to refer to "the name of a part of the body to which a particular form of massage is

² Although the publications are in English, we have no assurance that they are available in the United States and thus have placed no determinative weight on the information found therein. This information, however, appears to be no more than cumulative to information found elsewhere by the Examining Attorney.

applied, as well as to a device used to perform this type of massage." Thus, he takes the position that applicant's goods would be perceived by the relevant public as the name of, or the generic term for, the types of massagers which are designed for use in connection with the Tsubo points.

Applicant argues that the fact that the term "Tsubo" is used in Oriental physical therapy to describe "trigger points" is not sufficient to refuse registration on the Supplemental Register. Applicant maintains that the only issue is whether the term is capable of eventually serving as a trademark, which applicant argues holds true for TSUBO as used by applicant on its massage equipment.

Generic terms are by definition incapable of indicating source and thus can never attain trademark status. In re Merrill Lynch Pierce, Fenner, and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). The critical issue in determining whether a term is generic is whether the members of the relevant public primarily use or understand the term sought to be registered to refer to the genus of goods or services in question. H. Marvin Ginn Corp. v. International Association of Fire Chiefs Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

In a recent decision, the Board noted that, in making a determination as to whether a term is generic in

reference to the goods involved, consideration must be given to the fact that a product may fall not only into a broad category of goods, but also a narrower category within this broad category. See *In re Central Sprinkler Co.*, ___USPQ2d___, (TTAB 1998) [ATTIC held to be generic term for category of sprinklers for protection of attics]. In the present case, the broad category or genus into which applicant's goods fall is massage apparatus. But, at the same time, there can be narrower categories within this genus, directed to the particular type of massage or therapy involved. The evidence of record is sufficient to show that the term "Tsubo" is the name of such a type of massage or therapy, and that it serves to designate not only this type of massage or therapy, but also the equipment used to perform the therapy. The evidence also establishes that the relevant public, namely, persons associated with the field of massage or physical therapy, would recognize the term in this manner.

Furthermore, the fact that applicant seeks to register only the adjective TSUBO for its apparatus and not the complete name TSUBO GLOVE, as shown on its specimens, does not avoid the issue of genericness. As pointed out in *In re Central Sprinkler Co.*, supra, an adjective, as well as a noun, may be generic, when the adjective identifies a

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particular category. See also, *In re Reckitt & Colman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1989)[PERMA PRESS held generic for soil and stain removers]. Here, TSUBO in itself names the type of massage or therapy for which applicant's apparatus is intended. Thus, the term is generic for massage equipment in this category and cannot serve to distinguish applicant's goods from similar goods of its competitors. Moreover, applicant has no right to preclude competitors from freely using this generic term to name their goods.

Accordingly, we find the term TSUBO to be generic and incapable of distinguishing applicant's goods from those of others.

Decision: The refusal to register on the Supplemental Register is affirmed.

R. F. Cissel

C. E. Walters

H. R. Wendel
Trademark Administrative Judges,
Trademark Trial and Appeal Board

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