

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MARCH 30, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Diamond Communication Products, Inc.**

Serial No. 74/677,197

John A. Clifford of Merchant, Gould, Smith, Edell, Welter &
Schmidt for Diamond Communication Products, Inc.

Caryn L. Hines, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before **Simms**, Cissel and Quinn, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On May 19, 1995, applicant filed the above-referenced
application to register the mark "CABLE-TY" on the
Principal Register for "hardware, namely straps for
securing communication cables," in Class 3. The
application was based on applicant's claim of first use in
interstate commerce as early as December of 1991.

The Examining Attorney refused registration under Section 2(e)(1) of the Act on the ground that the mark applicant seeks to register is merely descriptive of the goods identified in the application because it is the phonetic equivalent of a descriptive term for them.

Attached to the refusal were copies of excerpts from articles retrieved from the Nexis® automated database of articles published in various periodicals. The excerpts show the term "cable tie" used in a generic fashion, i.e., as the name of a device used to bundle or tie electrical wire. Typical examples are as follows: "Cable ties bundle electrical wire, preventing unravelling."; "This proposal also would require tying back the loom with a cable tie to the cable loom support bracket..."; "Tyson Corporation's automatic cable tie tensioning tool reportedly increases productivity as it applies, tensions, and cuts off each cable tie in less than one second."; "...Secure the bundle of wires with a new nylon cable tie."; and "The cable tie product category is expanding rapidly...".

Applicant responded to the refusal to register with argument that the mark shown in the application is suggestive, rather than merely descriptive, by virtue of the hyphen and the misspelling of the word "tie."

The Examining Attorney was not persuaded, and the refusal to register was made final in the second Office Action. Attached to that action were more excerpts from published articles, all consistent with the excerpts submitted with the first Office Action.

Applicant filed a timely Notice of Appeal, but included an amendment to claim registrability under the provisions of Section 2(f) of the Act, a declaration from applicant's vice president of sales and engineering stating his belief that the term sought to be registered had acquired secondary meaning by virtue of applicant's substantially exclusive use for the five years preceding the filing of the application, and a request to suspend action on the appeal and remand to the Examining Attorney for consideration of the amendment.

The appeal was instituted and suspended, and the application was remanded for that purpose. The Examining Attorney held that applicant's showing in support of the claim of distinctiveness was insufficient in view of the evidence that the term is generic. Applicant's attorney responded, asserting sales of over five hundred thousand dollars for the period from 1992 through 1996.

The Examining Attorney was still not persuaded. She maintained the refusal to register because the term sought

to be registered is generic or at least highly descriptive and has not acquired distinctiveness.

The file was then returned to the Board for resumption of action on the appeal. Both applicant and the Examining Attorney filed briefs, but applicant did not request an oral hearing.

Based on careful consideration of the record in this application and the arguments made by applicant and the Examining Attorney, we hold that the refusal is proper and must be affirmed.

Applicant's claim of distinctiveness under Section 2(f) of the Act is in effect a concession that the term sought to be registered is merely descriptive of applicant's goods. In *re* Leatherman Tool Group, Inc., 32 USPQ2d 1443 (TTAB 1994). Applicant has never argued that its goods are not the kinds of goods referred to in the excerpted articles of record as "cable ties."

"TY" is plainly the phonetic equivalent of the descriptive term "tie," and as such, must be considered to be as descriptive as "tie" is. In *re* State Chemical Co., 225 USPQ 687 (TTAB 1985).

The issue in the instant case is therefore whether the descriptive term has acquired secondary meaning as an indication of the source of applicant's products. A

generic term can never acquire distinctiveness, and the level of proof needed to establish that a descriptive term is registrable under Section 2(f) increases as the descriptiveness of the term increases. *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988).

Applicant concedes the obvious fact that "TY" is the equivalent of "TIE," but applicant's argument that under the Examining Attorney's reasoning, for "CABLE-TY" to be generic for applicant's product, the goods would have to be ties made out of cable, borders on the disingenuous. The evidence submitted by the Examining Attorney establishes that the term "cable tie" is generic for cable ties, the devices used to secure electric wires or cables, and the application specifies that applicant's goods are such products, "straps for securing communication cables." That other generic words like "strap" or "fastener" might also be used to name such products does not make "cable tie" or its equivalent any less generic. No amount of evidence of de facto secondary meaning can dictate registration of a generic term. *Dan Robbins & Associates, Inc., v. Questor Corp.*, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979).

Moreover, even if we were to hold that the term is only highly descriptive of the goods on which applicant

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uses it, applicant has not submitted sufficient evidence in support of the claim that it has acquired distinctiveness by just noting that it has been used for the five years prior to the filing of the application and providing the sales figures for those years. Simply put, the fact that applicant has used the highly descriptive or generic term and has sold products bearing the designation does not establish that customers and prospective customers regard it as anything but descriptive terminology or a generic designation. We have no evidence of the promotion of the descriptive term as a trademark, nor do we have evidence that it is perceived as such by anyone other than applicant.

Accordingly, the refusal to register is affirmed.

R. L. Simms

R. F. Cissel

T. J. Quinn
Administrative Trademark Judges
Trademark Trial and Appeal Board

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