

THIS DISPOSITION IS NOT CITABLE AS
PRECEDENT OF THE TTAB 9/30/99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cortec Corporation

Serial No. 75/159,195

Orrin M. Haugen of Haugen Law Firm PLLP for Cortec Corporation.

Fred Mandir, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before Seeherman, Bucher and Bottorff, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Cortec Corporation has filed an application for registration of the mark "MIGRATING CORROSION INHIBITORS" for a "chemical preparation for use in reduction of corrosion of steel reinforcing members present in concrete structures."¹ In response to the initial Office action, applicant claimed that its applied-for mark has acquired distinctiveness under Section 2(f) of the Trademark Act.

The Trademark Examining Attorney issued a final refusal to register based upon Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that the applied-for term is generic for such products. In the alternative, the Trademark Examining Attorney held that if this term is not generic, then applicant's mark is so highly descriptive that applicant's claim of acquired distinctiveness pursuant to Section 2(f) of the Trademark Act is insufficient to permit registration.

Applicant has appealed the final refusal to register. Briefs have been filed but applicant did not request an oral hearing. We affirm the refusal to register.

The issues on appeal are whether the term "Migrating Corrosion Inhibitors" is generic for applicant's goods and, alternatively, if such designation is not regarded as generic, whether it has acquired distinctiveness. As to the first issue, by maintaining his position that this matter is a generic designation, the Trademark Examining Attorney has the burden of proving genericness by "clear evidence" thereof. See, *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). Evidence of the relevant public's perception of a term may be acquired from any competent source, including newspapers, magazines, dictionaries, catalogs

¹ Serial No. 75/159,195, filed September 3, 1996, alleging use since May 1991.

and other publications. *In re Leatherman Tool Group Inc.*, 32 USPQ2d 1443, 1449 (TTAB 1994), citing to *In re Northland Aluminum Products, Inc.*, 777 F.2d 1566, 227 USPQ 961, 963 (Fed. Cir. 1985). Under the test articulated by our reviewing court in *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d. 987, 228 USPQ 528 (Fed. Cir. 1986):

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 ... understood by the relevant public primarily to refer to that genus of goods or services?

We turn to a review of the evidence in the file. First, the front cover of a company brochure accompanying applicant's response on September 5, 1997 is titled as follows:

MCI[®]

Migrating Corrosion Inhibitors for Concrete Structures

Then, text within the brochure includes the following excerpts (emphasis supplied):

A revolutionary new product line from Cortec can be used to rehabilitate concrete structures which are deteriorating due to **corrosion** or can be incorporated into the building process, significantly increasing the life span of the

structure. Catastrophic structural failures have resulted in injuries, deaths and severe financial losses in recent years due to the devastating effects of corrosion. With Cortec MCI® products for concrete, structural integrity is preserved, vulnerable structures can now be rehabilitated, and environmental concerns are alleviated. The unique feature of MCI® is that even if not in direct contact with metal, the **inhibitor** will **migrate** a considerable distance through concrete and seek out the ferrous member and protect it...

Cortec MCI, however, can be easily added to concrete for rehabilitation and will not delay construction or increase construction costs other than the small cost of the material. Unlike standard inorganic inhibitors, Cortec MCI®s do not have to come in contact with the reinforcing steel upon application in order to seek out the steel and protect it...

Comparison of CORTEC MCI® to other **inhibitors**:
... **Migrates** through concrete to steel for **corrosion** protection. [p.3]

MCI® 2000 ... A **migratory corrosion inhibitor** admixture to protect rebar in concrete... [p.4]

Applicant's own generic uses of this terminology throughout its brochure, especially its generic use of "Migrating Corrosion Inhibitors" on the cover of the brochure, are highly persuasive evidence of the genericness of the matter sought to be registered. In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987).

We turn next to the LEXIS/NEXIS entries. Four of the five LEXIS/NEXIS entries the Trademark Examining Attorney placed into the record appear to refer to applicant's corrosion inhibiting

product. We have reproduced below two of these brief excerpts (emphasis supplied):

"... A **migrating corrosion inhibitor**, called the MCI 2020, offers a way to cut rebar corrosion in existing concrete structures..." (Engineering News-Record, Vol. 238, No. 21, p.122, May 26, 1997).

"A water-based, environmentally friendly and biodegradable corrosion inhibitor is used as an admixture for concrete. It combines both contact and **migrating corrosion inhibiting** protection to ferrous metals in concrete structures such as reinforcing bars, galvanized rebar, steel mesh and aluminum..." (Engineering News-Record, Vol. 234, No. 14, p. 30, April 10 1995).

These references indicate that "*migrating corrosion inhibitor*" is an appropriate term to refer to this product.

We acknowledge that the number of LEXIS/NEXIS® excerpts submitted by the Trademark Examining Attorney is relatively small. However, we believe that this can be explained by the fact that applicant's chemical preparation appears to be a new product. Applicant states in its brochure that this is "[a] revolutionary new product line from Cortec..." Hence, to the extent that the phrase sought to be registered herein is for a "revolutionary," or even a "newly created product category," we would not expect much to have been written about it by the time the evidentiary record in this case closed. That is, there has simply not been sufficient time for evidence of generic usage by others to emerge. *cf.* In re The American Fertility Society,

Case 98-1540, ____ F.3d ____, 51 USPQ2d 1832 (Fed. Cir. 1999); and *In re Ferrero S.p.A.*, 24 USPQ2d 1155 (TTAB 1992).

The Trademark Examining Attorney has also furnished two entries from a chemical dictionary which define the terms "migrates"² and "inhibitor."³ The words are defined, respectively, in pertinent part as "movement of a substance from one material to another..." and "[a] compound (usually organic) that retards or stops undesirable chemical reaction, such as corrosion...."

After reviewing all of the evidence of record, and upon careful consideration of the arguments made by applicant and by the Trademark Examining Attorney, we conclude that the term "Migrating Corrosion Inhibitors" would be perceived as a generic term for applicant's identified goods.

In order to render a complete opinion, we next turn to applicant's claim of acquired distinctiveness, assuming for this discussion that the applied-for term is merely descriptive, rather than generic. It is applicant's burden to establish a

² "migration. Movement of a substance from one material to another with which it is in intimate contact..." ..."
Hawleys Condensed Chemical Dictionary, 10th Edition, p. 695, (Van Nostrand Reinhold 1981).

³ "inhibitor. (1) A compound (usually organic) that retards or stops undesirable chemical reaction, such as corrosion, oxidation, or polymerization... Such substances are sometimes called negative catalysts..."
Hawleys Condensed Chemical Dictionary, 12th Edition, p. 635, (Van Nostrand Reinhold 1993).

prima facie case of acquired distinctiveness. Further, as a "mark's descriptiveness increases," the amount of proof required to demonstrate acquired distinctiveness likewise increases.

Yamaha International Corp. v. Hoshino Gakki Co., Ltd., 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). In support of its claim of acquired distinctiveness, applicant has submitted only a declaration of five years of substantially exclusive and continuous use of the mark in interstate commerce. In light of the very highly descriptive nature of the designation "migrating corrosion inhibitors," such an allegation of five years use is insufficient to show acquired distinctiveness.

Decision: The refusal to register is affirmed.

E. J. Seeherman

D. E. Bucher

C. M. Bottorff

Administrative Trademark Judges,
Trademark Trial and Appeal Board