

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

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re M C Y III Corporation

Serial No. 75/250,032

Thomas I. Rozsa of Rozsa & Chen for applicant.

Richard A. Straser, Trademark Examining Attorney, Law
Office 104 (Sidney Moskowitz, Managing Attorney).

Before Hairston, Walters and Rogers, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

M C Y III Corporation has filed a trademark
application to register on the Supplemental Register the
mark ENGINE FLUSH for "distributorship services featuring
automotive engine flushing machines, parts therefor, and
chemical flushes for automotive flushing machine."¹

¹ Serial No. 75/250,032, in International Class 42, initially filed on
the Principal Register on March 3, 1997, based on use of the mark in
commerce, alleging dates of first use and first use in commerce as of
January 31, 1996. On April 3, 1998, applicant filed an amendment
seeking registration on the Supplemental Register.

This application was originally filed on the Principal Register. The Examining Attorney refused registration, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that the applied-for mark is merely descriptive of the services identified in the application; and under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. 1051, 1052, 1053 and 1127, on the ground that the subject matter of the application does not function as a service mark. Additionally, the Examining Attorney found the specimens and the identification of services deficient.

Applicant responded by filing its amendment to seek registration on the Supplemental Register. Applicant also amended its identification of services and submitted verified substitute specimens. The Examining Attorney issued a final refusal to register on the grounds that the subject matter of the application does not function as a mark because it is the apt name of the services and is merely informational; and that it is generic in connection with the services identified in the application and, thus, it is incapable of identifying applicant's services and distinguishing them from those of others. In connection therewith, the Examining Attorney found the specimens

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unacceptable on the ground that "the specimens show ENGINE FLUSH as the apt and only name of the goods."

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

We begin by finding the Examining Attorney's contention that the specimens are deficient to be not well taken. On the advertisement submitted as a substitute specimen, the phrase ENGINE FLUSH appears with initial capital letters both as "the Bilstein Engine Flush machine" and as "The Bilstein Engine Flush System." Additionally, the phrase ENGINE FLUSH appears next to, but clearly distinct from, the word "Bilstein" on the machine pictured in the advertisement. Putting aside the issue of genericness, the specimens are adequate evidence of service mark use of the phrase ENGINE FLUSH.

To the extent that the Examining Attorney's refusal on the ground that the subject matter does not function as a mark pertains to the manner of use of the phrase on the specimens, the refusal is not well taken for the reasons stated herein regarding the acceptability of the specimens. To the extent that this ground of refusal pertains to the question of whether the subject matter is generic, we discuss the issue of genericness below.

With respect to genericness, the Examining Attorney contends that ENGINE FLUSH is the common, commercial name of automotive flush machines. In support of his position, the Examining Attorney quoted, for the first time in his brief, dictionary definitions of the individual words "engine" and "flush," and submitted copies of several third-party registrations that include in the identifications of goods the phrase "cooling system flush machine." Applicant argues, on the other hand, that ENGINE FLUSH is capable of distinguishing its distributorship services.

The Office has the burden of proving genericness by "clear evidence" thereof. *In re Merrill, Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). "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). Further, any doubt on the issue of genericness must be resolved in favor of applicant. *In re Waverly Inc.*, 27 USPQ2d 1620, 1624 (TTAB 1993).

The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods in question. *In re Women's Publishing*

Co. Inc., 23 USPQ2d 1876, 1877 (TTAB 1992). Our primary reviewing court has set forth a two-step inquiry to determine whether a mark is generic: First, what is the category or class of goods at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that category or class of goods? *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

We find that the Examining Attorney has failed to make of record any evidence whatsoever showing the use by others of the term "engine flush." Instead, the Examining Attorney has simply relied upon dictionary definitions of the individual words "engine" and "flush." Nor do the third-party registrations in the record demonstrate use of the phrase "engine flush."

Our primary reviewing court has made it clear that when dealing with phrases consisting of a number of words, as opposed to unitary compound words, it is not sufficient to "simply cite definitions and generic uses of the constituent terms of a mark" in an effort to show that the mark as a whole is generic. *In re American Fertility Society*, ___F.3d ___, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999). Instead, it is incumbent upon the Examining

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Attorney to present evidence showing the generic use by others of the phrase "engine flush" to establish that the phrase is indeed generic. American Fertility Society, 51 USPQ2d at 1837.

Because the Examining Attorney has failed to make of record any evidence showing that others have used the term "engine flush" in a generic manner for the services for which applicant seeks registration, we reverse the refusal to register on the ground that the subject matter is generic and/or does not function as a mark.

We find, further, that to the extent that we have doubts as to whether ENGINE FLUSH is generic for applicant's services, such doubts must be resolved in favor of the applicant. Waverly, 22 USPQ2d at 1624. However, we note that, on another evidentiary record in an *inter partes* proceeding, a different finding on the issue of genericness could well result.

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Decision: The refusal to register on the Supplemental Register on the ground that the applied-for mark does not function as a service mark and/or is generic in connection with the identified services is reversed. Similarly, the refusal to register on the Supplemental Register on the ground that applicant has failed to submit acceptable specimens of use is reversed.

P. T. Hairston

C. E. Walters

G. F. Rogers
Administrative Trademark Judges,
Trademark Trial and Appeal Board