

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB NOV. 23, 99
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re M C Y III Corporation

Serial No. 75/251,499

Thomas I. Rozsa of Rozsa & Chen LLP for M C Y III
Corporation.

Richard A. Straser, Trademark Examining Attorney, Law
Office 114 (Mary Frances Bruce, Managing Attorney).

Before Hanak, Hohein and Wendel, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

M C Y III Corporation (applicant) seeks to register
ENGINE FLUSH SYSTEM in typed drawing form on the
Supplemental Register for "distributorship services
featuring automotive engine flushing machines, parts
therefor, and chemical flushes for automotive flushing
machines." The application was filed on March 4, 1997 with
a claimed first use date of January 31, 1996.

The Examining Attorney refused registration contending that "ENGINE FLUSH SYSTEM is generic [for applicant's services] and, therefore, is incapable of functioning as a mark." (Examining Attorney's brief page 2). When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

We note at the outset that "the burden of showing that a proposed trademark [or service mark] is generic remains with the Patent and Trademark Office." In re Merrill Lynch, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). Moreover, it is incumbent upon the Examining Attorney to make a "substantial showing ... that the matter is in fact generic." Merrill Lynch, 4 USPQ2d at 1143. Indeed, this substantial showing "must be based on clear evidence of generic use." Merrill Lynch, 4 USPQ2d at 1143. Thus, "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). Moreover, any doubt whatsoever on the issue of genericness must be resolved in favor of the applicant. In re Waverly Inc., 27 USPQ2d 1620, 1624 (TTAB 1993).

In this case, the Examining Attorney has failed to make of record any evidence whatsoever showing the use by

others of the term "engine flush system(s)." Instead, the Examining Attorney has simply relied upon dictionary definitions of the individual words "engine"; "flush"; and "system." (Examining Attorney's brief pages 2-3). In addition, the Examining Attorney points to applicant's specimen of use which, on its front cover, depicts the term ENGINE FLUSH SYSTEM in all capital letters preceded by the word BILSTEIN, also depicted in all capital letters which are decidedly larger than the capital letters used to depict ENGINE FLUSH SYSTEM. (Examining Attorney's brief page 4).

Our primary reviewing court has recently 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 Attorney to present evidence showing the generic use by others of the compound term in order to establish that the compound term 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 system(s)" in a generic manner for the services for which applicant seeks registration, we reverse the refusal to register. Indeed, while not sufficient to establish genericness of the term as a whole, we note in passing that the Examining Attorney has not even made of record evidence showing "generic uses of the constituent terms of a mark, such as "engine flush." American Fertility Society, 51 USPQ2d at 1836.

Finally, as for the Examining Attorney's argument that applicant almost always precedes ENGINE FLUSH SYSTEM with the word BILSTEIN depicted in decidedly larger lettering, two comments are in order. First, the fact that applicant often depicts BILSTEIN in a more prominent fashion does not, by itself, establish that ENGINE FLUSH SYSTEM is generic for applicant's services. Second, we note that throughout its specimen of use (a twenty-three page brochure), applicant consistently depicts ENGINE FLUSH SYSTEM in solid capital letters or, at a minimum, with initial capital letters. The Examining Attorney was unable to point to, and we cannot find, even one instance where ENGINE FLUSH SYSTEM is depicted by applicant in all lower case letters.

In conclusion, we find that based upon this particular evidentiary record, there are, at a minimum, doubts as to whether ENGINE FLUSH SYSTEM is generic for applicant's services. Accordingly, said doubts on the issue of genericness must be resolved in favor of the applicant. Waverly, 22 USPQ2d at 1624. However, we hasten to add that on another evidentiary record, such as in a cancellation proceeding, a different finding on the issue of genericness could well result.

Decision: The refusal to register is reversed.

E. W. Hanak

G. D. Hohein

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