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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Optical Cable Corporation

Serial No. 74/694,775

Thomas J. Moore of Bacon & Thomas, PLLC, for Optical Cable Corporation.

Jesse Billings, Trademark Examining Attorney, Law Office 103
(Michael Szoke, Managing Attorney).

Before Cissel, Chapman and Bucher, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On June 28, 1995, applicant applied to register the mark "OPTICAL CABLE CORPORATION" on the Principal Register for "electrical, electronic and fiber optic apparatus, instruments and products, including fiber optic cable," in Class 9. The basis for the application was applicant's claim of use of the mark in connection with these goods in commerce. Applicant claimed that the mark had acquired distinctiveness within the meaning of Section 2(f) of the Lanham Act based on substantially exclusive and continuous

use "as a trade name and trademark by applicant for fiber optic cable" in interstate commerce since June 1983.

Applicant provided a table which listed its annual sales for each year, beginning with almost \$600,000 in 1984, and ending with over \$26 million in 1994, the year previous to the filing of the application. Applicant disclaimed the exclusive right to "CABLE CORPORATION" apart from a mark as shown.

The Examining Attorney held that under Section 2(e)(1) of the Act, the proposed mark is highly descriptive of the goods set forth in the application, and that applicant's claim of acquired distinctiveness under Section 2(f) of the Act was without adequate support. Attached to the refusal to register were excerpts from articles retrieved by the Examining Attorney from the Nexis® database of published articles wherein the term "optical cable" is used in a descriptive, generic sense in connection with fiber optic cable. Additionally, the Examining Attorney required applicant to amend the identification-of-goods clause in the application to be more specific.

Applicant responded by amending the identification-of-goods clause and arguing against the refusal to register under Section 2(f) of the Act.

Applicant's response was to amend the application to claim use of the mark in connection with "wire mesh pulling grips, termination tool kits, splice kits, stripping tools, polishing fixtures, and hotmelt termination kits in the nature of splice kits," in Class 8; and "electrical, electronic and fiber optic apparatus, instruments and products, namely, fiber optic cables, distribution cables, breakout cables, subgrouping cables, assembly cables, aerial messenger cables, armored cables, electro-optical cables, military tactical field cables, tempest cables also known as transient electromagnetic pulse emission shielding techniques cables, CATV/TELCO cables, under carpet cables, and zero halogen cables, cable connectors, connector mating adapters, cable assemblies and pigtails, fanout/breakout tubing, innerduct, mechanical splices, splice trays and housings, transceivers, modems, fiber multiplexers, rack mount patch panels, wall mount patch panels, attenuators, optical power meters, fiber line drivers and laser sources," in Class 9.

Applicant again argued that the term sought to be registered has acquired distinctiveness, and attached the declaration of Kenneth Harber, applicant's "Vice President Finance," in support thereof. Mr. Harber avers that

applicant's revenues in 1995 were over \$36 million, and that revenues for 1996 were over \$45 million.

The Examining Attorney responded by again refusing registration under Section 2(e)(1) of the Act, noting that the proposed mark "appears to be generic as applied to the goods and, therefore, incapable of identifying applicant's goods and distinguishing them from those of others." The Examining Attorney advised that under these circumstances, applicant's evidence of acquired distinctiveness was unacceptable, and that amendment to the Supplemental Register could not be suggested.

Applicant requested reconsideration of the refusal to accept the evidence of distinctiveness. Applicant argued that fourteen years of substantially exclusive and continuous use of the mark in commerce and substantial sales of products bearing the mark supported its position. Further, applicant stated that even if "OPTICAL CABLE" is a generic term, this fact should not prevent registration of "OPTICAL CABLE CORPORATION."

The Examining Attorney made final the refusal to register under Section 2(e)(1) of the Act because the proposed mark is "so highly descriptive of identified goods as to be generic." The Examining Attorney stated that the term "optical cable," is therefore incapable of acquiring

distinctiveness as applied to them, and that the additional term in the proposed mark, "corporation," is incapable of serving a source-identifying function.

Applicant timely filed a notice of appeal, attached to which were additional declarations. The first is from the aforementioned Mr. Harber, who attests to the fiscal year 1997 and 1998 (through August 31) revenues of applicant. The figure for 1997 is over \$52 million, and the amount shown for part of 1998 is over \$41 million.

Two other declarations were provided, both from customers of applicant. Each declarant states as follows: "When I hear 'OPTICAL CABLE CORPORATION,' I immediately think of OPTICAL CABLE CORPORATION of Roanoke, Virginia, and not just any company that provides optical fiber." Neither declaration makes any reference to "OPTICAL CABLE CORPORATION" as a trademark for any of the goods specified in the application. Each declarant simply states that when he "hears" the name of applicant, it immediately brings to mind the applicant corporation.

Applicant requested that the appeal be instituted, but that the application be remanded to the Examining Attorney to consider these declarations. The Board did so, but not suprisingly, the Examining Attorney did not find the declarations persuasive that the term sought to be

registered had acquired secondary meaning as a trademark for the goods identified in the application. In further support of the position that the term sought to be registered has not acquired secondary meaning, the Examining Attorney attached additional evidence retrieved from the Nexis® database showing use of "optical cable" as a generic term in connection with fiber optic cables, as well as highly descriptive of the tools and other apparatus used in conjunction with such cable.

We have considered this evidence over applicant's objection to it. It was properly made of record by the Examining Attorney as evidence of descriptiveness in response to the additional declarations submitted by applicant in support of its claim of acquired distinctiveness. When action on the appeal is suspended and the application is remanded to the Examining Attorney for consideration of additional evidence submitted by the applicant, the Examining Attorney may make of record additional evidence in support of his or her position on the issue to which applicant's new evidence is relevant.

Applicant filed an appeal brief and the Examining Attorney filed a brief in response. Applicant timely filed a reply brief, and the above-referenced oral hearing before the Board was held.

Based on careful consideration of the arguments and record before us in this appeal, we hold that although the Examining Attorney has not established by clear and convincing evidence that "OPTICAL CABLE CORPORATION" is the generic name for any of the goods specified in this application, it is nonetheless unregistrable on the Principal Register because it is merely descriptive of the specified products and applicant has not established that it has acquired distinctiveness as a trademark for these goods.

Under Section 2(e)(1) of the Lanham Act, a mark is merely descriptive of the goods with which it is used if it immediately and forthwith conveys information about an ingredient, quality, characteristic or feature of the goods, or directly conveys information regarding the nature, function, purpose or use of them. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

Even applicant does not seriously contend that "OPTICAL CABLE" is not merely descriptive of applicant's fiber optic cables and related products. Instead, applicant argues that the addition of the word "CORPORATION" results in a combination of words that is registrable in view of the secondary meaning that applicant has developed for them.

The Examining Attorney asserts that no amount of evidence of de facto distinctiveness could transform

"OPTICAL CABLE CORPORATION" into a registrable trademark because the term is generic as applied to applicant's products.

The test for genericness, however, requires clear and convincing evidence that the term is primarily understood by the relevant purchasing public to refer to the genus or class of goods at issue. *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). In other words, a generic term is the common descriptive name of a class of products.

Simply put, while "OPTICAL CABLE CORPORATION" may well be generic for a business in the field of optical cable, it does not name a particular genus or class of goods. "Optical cable" is a generic term for the products identified in the identification-of-goods clause in this application. An optical cable corporation, however, is a business entity in the field of optical cable. As the declarations from a applicant's customers make clear, people in this field understand "OPTICAL CABLE CORPORATION" as a reference to applicant as a business entity.

This is analagous to the Ginn case, *supra*, wherein the term sought to be registered was generic for the people to whom the publication was directed, but the mark was not

generic for the type of publication set forth in the application.

Applicant's claim that this descriptive term has acquired secondary meaning in connection with applicant's products is based on the Harber declarations stating how much revenue applicant has generated and the two customer declarations stating that the matter sought to be registered is understood as the name of applicant's business. This evidence is simply not a sufficient basis upon which the Board could predicate a finding that the term has acquired distinctiveness as a trademark indicating the source of applicant's products as a result of applicant's use and promotion of it as such. Notwithstanding all the revenues applicant has generated, and even assuming that all the sales were of goods listed in the application and that they all bore the term applicant seeks to register (which is not clear from the confusing wording of the two statements by Mr. Harber), the record before us is devoid of any information concerning the promotion of this descriptive terminology as applicant's trademark for these goods, and we have no evidence that clearly or convincingly establishes that purchasers or potential purchasers of these products view these otherwise descriptive words as a trademark for these goods. That they understand that it is the name of

the applicant corporation is immaterial to our inquiry under Section 2(f) of the Act.

In summary, although it is clear that "OPTICAL CABLE CORPORATION" is regarded as applicant's trade name, this record does not establish that it is generic for the goods specified in the application. The record does show that the term is merely descriptive of them, however, and applicant has failed to establish that its use and promotion of these words have resulted in their acquisition of secondary meaning to purchasers of these products as an indication of the source of the goods. Accordingly, the refusal to register based on Section 2(e)(1) of the Act is affirmed.

R. F. Cissel

B. A. Chapman

D. E. Bucher
Administrative Trademark Judges,
Trademark Trial and Appeal Board

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