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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Brink's Mfg. Co., Inc.**

Serial No. 75/472,290

Edmund J. Sease of Zarley McKee Thomte Voorhees & Sease for  
**Brink's Mfg. Co., Inc.**

**David Stine**, Trademark Examining Attorney, Law Office 114  
(Margaret Le, Managing Attorney)

Before Simms, Hairston and Bottorff, Administrative  
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Brink's Mfg. Co., Inc. (applicant), a Minnesota  
corporation, has appealed from the final refusal of the  
Trademark Examining Attorney to register the mark VAN  
LADDER for truck-mounted work platforms and aerial booms.<sup>1</sup>  
The application has been amended to seek registration under

<sup>1</sup> Application Serial No. 75/472,290, filed April 22, 1998, based upon allegations of use since September 7, 1968. In the original application, applicant claims ownership of Supplemental Registration No. 904,505, issued December 15, 1970, of the mark VAN LADDER and design. Office records show that this registration has expired.

the provisions of Section 2(f) of the Act, 15 USC § 1052(f).

The Examining Attorney has refused registration under Section 2(e)(1) of the Act, 15 USC § 1052(e)(1), arguing that applicant's mark is generic as applied to van-mounted ladders, and that, even if applicant's mark is not generic, applicant's evidence of acquired distinctiveness is insufficient to permit registration on the Principal Register. Applicant and the Examining Attorney have submitted briefs.<sup>2</sup>

Essentially, it is the Examining Attorney's position that applicant's goods are ladders for use on vans (among other vehicles), in other words, van ladders. Relying upon dictionary definitions, which the Examining Attorney submitted with his appeal brief, the Examining Attorney argues that the mere combination of two words, each with separately generic character, into a compound word does not necessarily produce a registrable term. In this case, the Examining Attorney argues that applicant's combination is generic since it would be perceived by the purchasing

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<sup>2</sup> On page 14 of applicant's appeal brief, applicant requested an oral argument. Trademark Rule 2.142(e)(1) states that a request for oral hearing should be by separate notice. Because applicant did not request oral argument by separate notice, the request was not seen until this case was assigned for decision. Accordingly, and in view of the disposition of this case, the request for oral argument is considered moot.

public as the common name for applicant's goods because the combination would have no different meaning than its constituent words. In this regard, the Examining Attorney relies upon *In re Gould Paper Corp.*, 835 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987).

Even if the term VAN LADDER were not considered generic, the Examining Attorney argues that, because of the highly descriptive nature of applicant's mark, a greater showing of acquired distinctiveness is required. In this regard, the Examining Attorney criticizes the declaration of the inventor of applicant's device in several respects. The Examining Attorney maintains that the declaration contains no evidence of the perception of applicant's mark in the relevant trade; argues that the fact that competitors use different terms does not mean that applicant's mark is not generic, because products may have more than one generic name; and argues that the declaration is only circumstantial evidence in that there is no evidence of actual recognition of applicant's mark as an indication of origin in the relevant market. The Examining Attorney states that the commercial success of a product per se does not necessarily show that applicant's mark has become distinctive of its goods.

Genericness

Applicant's attorney and the Examining Attorney do not dispute the test for determining genericness. The primary significance of a mark to the relevant public is the test for determining whether a mark is generic. See Section 14(3) of the Act, 15 USC § 1064(3). A term is generic if it names the class of goods or services to which it is applied. *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). As noted, the test for determining whether a term is generic is its primary significance to the relevant public; that is, whether the term is used or understood, by purchasers or potential purchasers of the goods at issue, primarily to refer to the class of such goods. *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); and *H. Marvin Ginn Corp.*, *supra*. Evidence of the relevant public's understanding of a term may be obtained from any competent source, including direct testimony of consumers, consumer surveys, newspapers, magazines, dictionaries, catalogs and other publications. *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, *supra*, and *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed.

Cir. 1985). The Office has the burden of proving genericness with clear evidence. In re Merrill Lynch, Pierce, Fenner, & Smith Inc., *supra*.

The only evidence which the Examining Attorney has submitted are dictionary definitions. As noted above, the Examining Attorney has placed strong reliance upon the *Gould* decision. However, we believe that the more recent decision, In re America Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), substantially limits *Gould*. In *America Fertility*, the Board had found that evidence, such as dictionary definitions, third-party applications and registrations as well as articles from the Nexis computer search system reflecting uses of the term "reproductive medicine," were sufficient evidence to conclude that the phrase SOCIETY FOR REPRODUCTIVE MEDICINE was a generic name of applicant's services. The Court reversed, stating that the Board had not applied the correct test for genericness. The Court said that the Office must be able to satisfy the elements of the *Marvin Ginn* test--that is, that there be evidence that the term sought to be registered was the genus of the goods at issue and that there be evidence of the understanding by the relevant public that the asserted mark refers primarily to that genus of goods. The Court stated, at 1836-37:

Aptness is insufficient to prove genericness... As the PTO produced no evidence at all of the public's understanding of the phrase as it relates to the Society's services, it clearly failed to carry its burden. The Board cannot simply cite definitions and generic uses of the constitute terms of a mark, or in this case, a phrase within the mark, in lieu of conducting an inquiry into the meaning of the disputed phrase as a whole to hold a mark, or a phrase within the mark, generic.

In contrast to *Gould*, this is not a case where the PTO has clearly proven that the mark as a whole is no less generic than its constituents. Rather, this is a case where, like *Merrill Lynch* and *Marvin Ginn*, there was no evidence produced that the term is used by the relevant public to refer to a similar class (in the instance case, the class of services provided by societies). Therefore, the Board erred in finding that the proven genericness of the words, "society," and "reproductive medicine," without more rendered generic the phrase SOCIETY FOR REPRODUCTIVE MEDICINE.

*Gould* is limited, on its facts, language, and holding, to compound terms formed by the union of words. It is legally erroneous to attempt to apply the language quoted below to phrases consisting of multiple terms, which are not "joined" in any sense other than appearing as a phrase.

The compound immediately and unequivocally describes the purpose, function and nature of the goods as *Gould* itself tells us. *Gould* has simply joined the two most pertinent and individually generic terms applicable to its product, and then attempts to appropriate the ordinary compound thus created as its trademark. In this instance, the terms remain as generic in the compound as individually, and the compound thus created is itself generic.

*Gould*, 834 F.2d at 1019, 5 USPQ2d at 1112 (citations omitted).

The correct legal test, which was not applied by the Board, is set forth in *Marvin Ginn* and is to be applied to a mark, or a disputed phrase thereof, as a whole, for the whole may be greater than the sum of its parts. Properly interpreted, *Gould* does not justify a short-cut around this test, but rather found that the evidence presented met this burden...

The Board erred in applying the wrong legal test, which it derived from *Gould*, to the facts at issue here. The correct legal test for genericness of phrases, as set forth in *Marvin Ginn*, requires evidence of "the genus of goods or services at issue" and the understanding by the general public that the mark refers primarily to "that genus of goods or services." *Gould* provides additional assistance in determining the genericness of compound words only, and holds that if the PTO can prove (1) the public understands the individual terms to be generic for a genus of goods and species; and (2) the public understands the joining of the individuals terms into one compound word to lend no additional meaning to the term, the PTO has proven that the general public would understand the compound term to refer primarily to the genus of goods or services described by the individual terms. The PTO here failed to provide any evidence that the phrase as a whole, SOCIETY FOR REPRODUCTIVE MEDICINE, has acquired no additional meaning to the relevant public that the terms "society" and "reproductive medicine" have individually. The Board must now apply the *Marvin Ginn* test to the phrase as a whole, and not focus only on the individual terms.

Here, as applicant has pointed out, there is but a single piece of evidence (supplied by applicant) that the term "van ladder" has appeared anywhere, and that is in an editorial appearing in the St. Petersburg Times of March 10, 1989, in the following context:

Editor: Before we get a second license plate, we should be more observant of the one we have. But how can we when there are trailer hitches, van ladders, license plate frames, overhanging truck loads, plus the lights that the manufacturer installed so we can observe at night that are not working. In those states that have two plates, how many times has a moving car license on the front been copied by law enforcement? Vehicle violations should be ticketed not only by the state but also by county and city law enforcement agencies.

Except for this one instance (where it is arguable that the term was used to refer to a ladder attached to a van for climbing to the top thereof, and not to refer to an aerial ladder and platform of the type sold by applicant), there is no evidence that this phrase has been exposed to the public, except by applicant. There is simply no evidence that the relevant consumers use this term to refer to the category or type of product made by applicant. Moreover, as applicant has pointed out, an extension ladder is only a part of applicant's goods, which consist of a work platform mounted on top thereof, there is no dictionary definition of this term, and there is no evidence of use of this mark by competitors or by consumers to refer to a category of product. In view of the paucity of evidence that these words have been use generically, we cannot say that the relevant public understands the mark sought to be registered to refer primarily to a genus or category of

product. The Office has failed to carry its burden of proof on the issue of genericness.

Acquired Distinctiveness

Having concluded that applicant's mark is not generic, we turn to the evidence of secondary meaning, which we conclude presents a prima facie case of acquired distinctiveness. In this regard, applicant submitted the declaration of the inventor of the extension ladder now made by applicant, covered by a patent issued in 1969. Among other things, that inventor, Eugene Faulstich, states that the asserted mark has been used since September 1968 (that is, for over 30 years); that this mark has been registered by this Office (on the Supplemental Register); that in the patent covering this device, the term VAN LADDER has not been used generically to describe the extension ladder unit anchored on a truck with an electrically powered shaft connected to a cable which extends and raises the ladder; that applicant's product may be used on a variety of vehicles including service vans, flatbed, pickup and utility trucks, four-wheel-drive vehicles, utility vehicles, station wagons and off-road tractors; that, over the years, millions of dollars in sales have been realized so that now applicant's mark is one of the best known names in the industry; that

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competitors do not use this term (as evidenced by brochures of those companies) and that they are able to compete effectively without use of applicant's mark; and that the generic term for applicant's goods is "portable aerial boom/bucket" or simply "aerial lift."

Upon careful consideration of this declaration, and in the absence of countervailing evidence, we conclude that applicant has demonstrated a prima facie case of acquired distinctiveness. There is adequate circumstantial evidence of buyer exposure, including the length of time of applicant's use of this mark. If we had any doubt in this matter, that doubt should be resolved in favor of publication. In re Women's Publishing Co. Inc., 23 USPQ2d 1876 (TTAB 1992) (DECORATING DIGEST held merely descriptive but not generic for applicant's magazines, finding applicant's mark to have acquired distinctiveness.

Decision: The refusal of registration is reversed.