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Paper No. 20
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Isbre Holding Corp.**

Serial No. 75/164,568

Anthony J. Casella of **Casella & Hespos LLP** for **Isbre Holding Corp.**

Mark Rademacher, Trademark Examining Attorney, Law Office 101 (**Jerry Price**, Managing Attorney).

Before **Hanak**, **Hairston** and **Wendel**, Administrative Trademark Judges.

Opinion by **Hairston**, Administrative Trademark Judge:

An application has been filed by Isbre Holding Corp. to register the term ISBRE on the Supplemental Register for bottled spring water.¹

The Trademark Examining Attorney has refused registration under Section 23 of the Trademark Act on the ground that the term ISBRE is generic and is thus incapable

¹ Serial No. 75/164,568, filed September 12, 1996, which alleges a date of first use of March 1996 and a date of first use in commerce of April 1996.

of distinguishing applicant's goods from those of others. The word "isbre," as evidenced by the dictionary entry made of record by the Examining Attorney, is a Norwegian word, which means "glacier" in English.²

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney submitted briefs.

Section 23 of the Trademark Act provides that a mark is registrable on the Supplemental Register if it is capable of distinguishing the applicant's goods or services. Thus, the issue on appeal is whether or not ISBRE is capable of identifying and distinguishing applicant's bottled spring water.

In urging that the refusal be reversed, applicant argues that the Examining Attorney has not sustained the Office's burden of proof. Applicant's position is that Norwegian is not a common language and that ISBRE, when viewed by most persons within the United States would appear to be a coined mark. Further, applicant argues that the category of goods at issue here is bottled water; that "glacier water" is merely a species of a large and varied genus of bottled water; and that there is no evidence that the relevant public refers to this category of goods as

² Languages of the World CD-ROM (Sony 1990).

"glacier water." In this regard, applicant points out that the trade association for the bottled water industry makes no mention of "glacier water" at its website. According to applicant, "glacier" by itself, at most suggests a possible source or quality of applicant's goods.³ In further support of its position that ISBRE is registrable on the Supplemental Register, applicant points to two prior Supplemental registrations (now cancelled) owned by a third-party for the marks GLACIER in typed drawing form and GLACIER and design, both for bottled drinking water and flavored bottled drinking water.

The Examining Attorney, on the other hand, maintains that ISBRE is generic, naming a category of bottled water that comes from a glacier. In support of the refusal, the Examining Attorney made of record the following relevant excerpts from the NEXIS database, which refer to "glacier water."

Other brands stocked include Canadian Mystic **glacier water**, packaged in a 1-liter triangular plastic bottle that retails for \$1.45; . . .
(Supermarket News; October 21, 1996);

. . . a rail link is planned, and one of his fellow expedition members, Frank Trask, is promoting bottled **glacier water**, guided tours

³ We note that applicant has admitted that its bottled spring water comes from a spring fed by a glacier.

of the ice fields, and a chalet for paying guests.

(The Washington Post; October 20, 1996);

Glacier water should be new bottled water classification, Rep. Don Young told FDA last month. . . . Young asked FDA to publish a draft regulation establishing the new classification. He wants **glacier water** to be obtained from "glacier ice", including tidal, alpine and river glaciers."

(Food Labeling News; June 6, 1996);

I advocate burning Snocoaches, chopping down gondola rides and an end to the bottling of **glacier water** and public bathing in hot springs.

(St. Louis Post-Dispatch; April 7, 1996);

The Tohono O'odham Nation's San Xavier District has agreed to distribute in Arizona the **glacier water** bottled by a group of Canadian Indians.

(Arizona Daily News; December 17, 1995);
and

. . . gaining reputation for its pure water and there are several waters to choose from. Add a small bottle of 1,000 year-old **glacier water** to complete your Alaska food gift package.

(Anchorage Daily News; November 29, 1995).

In addition, the Examining Attorney submitted with his appeal brief, a copy of a citizen petition filed October 13, 2000 with the Federal Food and Drug Administration (FDA) by Jane Adair, Director of the Division of

Environmental Health for the state of Alaska.⁴ This petition, filed on behalf of the state of Alaska, requests in pertinent part that the FDA add "glacier water" as a type of bottled water under its regulations and adopt the following standard of identity for "glacier water":

The name of water that is obtained directly from the melting of glacier ice or from a stream or lake that is fed directly by a glacier and that has not been diluted or otherwise influenced by a non-glacial source is "glacier water."

Finally, the Examining Attorney argues that applicant reinforces the idea that its bottled drinking water comes from a glacier by its depiction of a large glacier on the label for the goods and applicant's characterization of the goods as "Pure Norwegian Glacial Water" as its website

The test for genericness is whether members of the relevant public primarily use or understand the term sought to be registered to refer to the genus (category or class) of goods in question. See *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). However, the

⁴ Pursuant to Trademark Rule 2.142(d), materials submitted with an appeal brief are generally untimely. While we note that the Examining Attorney requests that we take judicial notice of this petition, such a petition is not the kind of "fact" which may be judicially noticed. However, applicant did not object to the petition, but rather discussed it in its reply brief. Thus, we consider applicant to have waived any objection to the petition and we will treat it as properly of record.

Board has noted, with respect to cases involving the issue of genericness, the difficulty in attempting to postulate a hard and fast rule "that will uniformly yield the correct result." See *In re Boston Beer Co. L.P.*, 47 USPQ2d 1914, 1920 (TTAB 1998) [citing to the *H. Marvin Ginn Corp.* case]. Thus, the Board's determinations of genericness "must be made on a case-by-case basis in light of the particular designation for which registration is sought and the record in the application which is under consideration." *Id.*

There is no dispute that the broad general category of goods involved in this case is bottled drinking water. However, as the Board noted in *In re Central Sprinkler Company*, 49 USPQ2d 1194 (TTAB 1998), a product may be in more than one category. We find the evidence submitted by the Examining Attorney sufficient to establish that "glacier water" is a narrower category of bottled drinking water, and that this term would be understood by the relevant public to refer to bottled drinking water, which comes from a glacier. Thus, the term "glacier water" is generic for bottled drinking water such as applicant's, which comes from a glacier. Moreover, we find that "glacier" alone is similarly generic for such goods because it directly describes the most important aspect or feature

thereof, namely, that the bottled drinking water comes from a glacier. See *In re Central Sprinkler Company*, supra [ATTIC for sprinklers for use in attics held generic] and cases cited therein. We believe "glacier" is no different from "spring" in that "spring water" is clearly generic for a category of bottled drinking water and "spring" alone is likewise generic for this category of goods.

With respect to the two third-party registrations relied upon by applicant, it is well settled that each application for registration of a mark must be decided on its own set of facts. Moreover, we note that these registrations issued in 1992 and it appears that "glacier water" is a relatively new category of bottled drinking water.

As to applicant's contention that Norwegian is not a common language and that ISBRE would therefore be perceived by the American public as a coined mark, it is well settled that the foreign equivalent of a generic English word is no more registrable as a trademark than the English word itself. This is the case even if the foreign term is not well known to the American public generally. See *In re Atavio, Inc.*, 15 USPQ2d 1361, 1362 (TTAB 1992). Thus, ISBRE, being the foreign equivalent of "glacier," is

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generic for applicant's goods and, thus, not registrable on the Supplemental Register.

Decision: The refusal to register is affirmed.