3/8/02

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Paper No. 16
ejs

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Caldwell Tanks, Inc.

Serial No. 75/672,039

Jack A. Wheat and Jamie K. Neal of Stites & Harbison for Caldwell Tanks, Inc.

Megan Sweeney, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).[1]

Before Seeherman, Bottorff and Rogers, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Caldwell Tanks, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register STAC-4 and design, as shown below, as a service mark for "construction of elevated tanks."[2]

---

[1] The Examining Attorney who wrote the brief was not the attorney who examined the application.

[2] Application Serial No. 75/672,039, filed March 29, 1999, and asserting first use and first use in commerce December 3, 1998.

Registration has been refused pursuant to Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. 1051, 1052, 1053 and 1127, on the ground that the proposed mark identifies a system, rather than being used as a service mark to identify the source of the identified services.

The appeal has been fully briefed; an oral hearing was not requested.

In order to determine whether STAC-4 and design functions as a mark for applicant's identified services of "construction of elevated tanks," we must look at the specimens and other advertising material submitted by applicant. **In re Produits Chimiques Ugine Kuhlmann Societe Anonyme**, 190 USPQ 305 (TTAB 1976). Further, because applicant's services are offered to a specialized audience, we must consider the specimens and other literature in light of this audience.

Applicant has explained that its identified services, "construction of elevated tanks," refer to the construction of water towers. These water towers are a composite

elevated tank in which a metal water tank is placed atop a cement silo type tower. Applicant has explained that construction of the water tower is its service, and the references in the specimens to the manner of construction identify not only a process, but the service as well.

The specimens prominently feature the trademark STAC-4 and design, under which is the explanation "Specified Tolerance for Architectural Construction." A caption under the words "STAC-4 by Caldwell Tanks" states "A Superior Jump Form System for the Construction of Composite Elevated Water Tanks" and the text below that heading includes the following:

> Designed to meet construction tolerances for plumb, roundness, and leveling in composite elevated tank shafts, STAC-4 allows Caldwell's construction personnel control of the concrete pour by limiting the form height to four feet. ...
>
> STAC-4's diameter specific forms utilize reusable wall spacers, eliminating potential bulging of forms as well as the plug holes cause by alternative systems' ties. ... Finally, STAC-4's unique rustication pattern hides all horizontal and vertical construction joints, further enhancing the appearance of the tank shaft.

On the obverse side of the brochure specimen, under a prominent display of STAC-4 and design, is the following text:

> Caldwell's STAC-4 jump form system provides greater control of concrete construction tolerances in the erection of composite elevated tank shafts. Utilizing three, four-foot high, steel forms, STAC-4 meets or exceeds all ACI 371R-97 guidelines for the analysis, design and construction of concrete pedestal water towers while delivering a smooth geometric appearance.

This page of the brochure also has a column captioned "Advantages of the STAC-4 system" which lists various benefits, including, "unique rustication pattern hides vertical and horizontal form joints"; "designed specifically for composite elevated tanks"; and "constructed solely by Caldwell personnel."

Although both applicant and the Examining Attorney have cited various cases dealing with whether the name of a process can function as a mark, these cases are so fact specific, in terms of whether the particular specimens show trademark or service mark use, that they are of little help in our analysis herein. They do, however, stand for the following legal propositions: if a term is used only as the name of a process it does not function as a mark, **In re Universal Oil Products Company**, 476 F.2d 653, 177 USPQ 456 (CCPA 1973); a term can be the name of a process and still function as a mark for services, **In re Produits Chimiques Ugine Kuhlmann**, supra; and the fact that the word "process"

is used in connection with the term does not ipso facto mean that it designates a process and not more. **In re Stafford Printers, Inc.**, 153 USPQ 428 (TTAB 1967).

After reviewing the applicant's specimens we find that STAC-4 and design is used as a service mark for the construction of elevated tanks. Although the specimens use the mark, in part, in conjunction with the phrase "jump form system," the word "system," like "process," does not automatically prevent a term from functioning as a mark. Here, the construction system is such an intrinsic part of the construction service that consumers will view STAC-4 and design, as used on the specimens, not merely as the name of the system, but as a mark for the service.

Decision: The refusal of registration is reversed.