

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

Mailed: Sept. 30, 2003

Paper No. 24
ejs

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lamrite West, Inc.

Serial No. 75432936

Richard M. Klein, Sandra M. Koenig and Christopher B. Fagan
of Fay, Sharpe, Fagan, Minnich & McKee, LLP for Lamrite
West, Inc.

Scott M. Oslick, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Cissel, Seeherman and Chapman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Lamrite West Inc. has appealed from the final refusal
of the Trademark Examining Attorney to register PERFORATED
PLASTIC on the Supplemental Register as a trademark for
"plastic foundation material in sheet form for use with

needle work such as cross stitching."¹ The word PLASTIC has been disclaimed. Registration has been refused pursuant to Section 23 of the Trademark Act, 15 U.S.C. 1091, on the basis that the proposed mark is generic.²

The appeal has been fully briefed, but applicant did not request an oral hearing.

As background, we note that applicant initially sought registration on the Principal Register. The Examining Attorney to whom the application was originally assigned refused such registration pursuant to Section 2(e)(1) of the Act, on the ground that applicant's mark was merely descriptive of a feature or characteristic of the goods. In both the initial Office action making such refusal, and the second action in which the refusal was made final, the Examining Attorney stated that "applicant may amend the application to seek registration on the Supplemental Register."

¹ Application Serial No. 75/432,936, filed on the Principal Register on February 12, 1998, and amended to the Supplemental Register on May 26, 2000. Applicant has asserted first use and first use in commerce beginning "in at least May 1993."

² On the first page of the Examining Attorney's brief he makes the statement that "registration on the Supplemental Register was ultimately refused under Section 2(e)(1) of the Trademark Act." Section 2 of the Act concerns only registration of marks on the Principal Register, and the reference to this section was therefore incorrect. However, it is clear from applicant's papers that it clearly understood that Section 23 was the statutory provision under which registration was refused.

On May 26, 2000 applicant amended its application to the Supplemental Register. However, on November 30, 2000, the present Examining Attorney, to whom the application had been assigned, refused registration on the Supplemental Register, and subsequently made this refusal final.

Applicant asserts that such action was contrary to Office policy, citing TMEP Section 713.01 (3d ed.) which states that "When assigned to act on an application that was previously handled by a different examining attorney, the examining attorney should not take an approach that is entirely different from that of the previous examining attorney unless it is clearly appropriate to do so."

We note at the outset that it was acceptable for the present Examining Attorney to issue the refusal that he did. It is certainly regretted that applicant may have believed, based on the first Examining Attorney's actions, that an amendment to the Supplemental Register would put the application in condition for registration. However, the suggestion made by the first Examining Attorney that applicant amend its application to seek registration on the Supplemental Register cannot be regarded as a commitment by that Examining Attorney that a registration on the Supplemental Register would issue if such an amendment were made. More importantly, even if the initial Examining

Attorney believed that the mark was registrable on the Supplemental Register, if information later came to the attention of that Examining Attorney or a newly-assigned Examining Attorney that indicated the mark was not registrable on that Register, the Examining Attorney was free to refuse registration, regardless of any suggestion for amendment which might have been made earlier. It is the mandate of the Office to register only eligible marks, and therefore it may be proper for an Examining Attorney to raise a new ground for refusal even late in the examination process. In fact, even after an appeal has been filed, if it appears to the Examining Attorney that an issue not involved in the appeal may render the mark unregistrable, the Examining Attorney may request the Board to remand the application for further examination. See Trademark Rule 2.142(f)(6) and TMBP Section 1209.02 (2d ed. June 2003). In the present situation, where a new Examining Attorney took over responsibility for the application file, and refused registration at the first available instance, i.e., upon applicant's amending the application to seek registration on the Supplemental Register, we see no procedural error in the Examining Attorney's action.

This brings us to the substantive ground for refusal: whether PERFORATED PLASTIC is capable of functioning as a

trademark, and thus is eligible for registration on the Supplemental Register for plastic foundation material in sheet form for use with needle work such as cross stitching, or whether it is not capable because it is a generic term for such goods.

We reverse the refusal of registration.

As our primary reviewing court, the Court of Appeals for the Federal Circuit, has repeatedly stated, the determination of whether a mark is generic is made according to a two-part inquiry: "First, what is the genus of the goods or services at issue? Second, is the term sought to be registered...understood by the relevant public primarily to refer to that genus of goods or services?" *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986), cited in *In re Dial-A-Mattress Operating Corporation*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 1999) and *In re The Am. Fertility Soc'y*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999). The burden is on the Office to prove that a term is generic. *In re The Am. Fertility Soc'y*, supra.

There does not appear to be any dispute that the genus of goods in this case is plastic needlework foundation canvas, and that the relevant public for these goods are

people that do or are involved with needlework and other crafts.

Applicant asserts that the common generic name for such goods is "plastic canvas," and has submitted extensive evidence in support thereof. In addition to its own specimen labels and those of other products sold by its own subsidiary (Darice), in which "plastic canvas" is used as a generic term, applicant has submitted labels by third parties in which "plastic canvas" is used in the manner of a generic term, along with the respective trademarks QUICKCOUNT, QUICKSHAPE and UNIEK. Similarly, craft kits use "plastic canvas" as part of the description of the goods, e.g., "Plastic Canvas Video Box Kit" which bears the trademark HOBBYKRAFT and lists "plastic canvas" as one of the contents of the kits, along with "acrylic yarn" and "imported English needle." Applicant has also submitted copies of third-party registrations for goods which show that the Office has accepted "plastic canvas" as an identification of goods. See, for example, Registration No. 1,272,871. We will not burden this opinion with an extensive discussion of applicant's considerable evidence, but will simply note that it unequivocally shows that "plastic canvas" is a generic term for its goods.

However, a product may be referred to by more than one generic term, so we turn to a consideration of the Examining Attorney's evidence. The primary materials submitted by the Examining Attorney are excerpts of articles taken from the NEXIS database in which the term "perforated plastic" is found. For example:

Stored in the crisper drawer of the refrigerator in a perforated plastic bag, radishes will keep for a week or more....

"The Times Union," Albany, New York

Headline: The Methane Down Below; Problems with the Belmont Learning Complex are the Latest in a Region Dotted with Abandoned Oil Wells that can Leak the Explosive Gas.

Body: His design, which was being implemented before work on the system was suspended, included a barrier under buildings and passive collection through perforated plastic pipes.

"Los Angeles Times," July 30, 1999

Headline: Loose sand—not ants—causing porch to sag

Body: Plastic under the stones will deter the growth of weeds, but it won't deter the ants. If you use plastic, use perforated plastic for water to drain through....

"The Deseret News," July 18, 1999

...Jet-O-Matic shower jump rope. Craven, a retired TV repairman from St. Clair Shores, invented the rope a few years ago. It's a perforated plastic tube suspended between poles and

attached to a garden hose. Water pressure turns the rope and sprays the jumper.

"The Detroit News," July 16, 1999

The tournament still featured the classic wiffle ball, which is a perforated plastic ball that can spin, dip and dive....

"Chicago Daily Herald," May 23, 2002.

Again, we will not burden this opinion by reciting all the excerpts that have been made of record. What is most remarkable about them is that of the 20 excerpted articles submitted by the first Examining Attorney, and the 14 submitted by the present one, not one discusses or refers to the type of goods for which applicant seeks registration. Further, we cannot determine from these articles that there is actually a product called "perforated plastic" from which the goods which are discussed in the articles are made. Many of the articles appear to refer to "perforated" as simply an adjective describing the plastic object, e.g., "perforated plastic bags" which are used to store vegetables. Thus, the object itself may be made of plastic, and the plastic has been perforated, rather than the object being made of a material known as "perforated plastic." In this connection, we note one article refers to, not a "perforated plastic pipe," but a "plastic perforated pipe":

Headline: Amoco reveals cleanup plans
for Norledge

Body: As envisioned, the system will
deploy almost 50 horizontal "wells"
which, in fact, will be 3-inch plastic
perforated pipes....

"The Kansas City Star," July 15, 1999

The Examining Attorney has also submitted an excerpt
from the website for Crafter's Market,
www.craftersmarket.net. The page shows a picture of a
product, under which, in bold, all capitalized type, are
the words "PERFORATED PLASTIC." Before this is a text
description:

12 count "perforated" plastic canvas
sheets.

Use for cross stitch or plastic canvas
patterns.

(Spots and filled holes are normal)

8 1/8"x 10 7/8" sheets

Applicant has explained that this reference is to its own
product. Given that the term "perforated" appears in
quotation marks, we cannot say that this shows clear
generic usage of "perforated plastic." We note, however,
that additional pages from that website, submitted by
applicant, separately list, under "Plastic canvas
supplies," "Needles, Cross Stitch/Plastic Canvas";
"Perforated Plastic (Darice)";³ "Plastic Canvas Yarn, 92

³ As noted above, Darice is applicant's subsidiary.

yards"; "Perforated Plastic"; and "Plastic Canvas Yarn, 10 yards."

The Examining Attorney has also made of record excerpts from the website www.robinsnest.designs.com, which list various cross stitch kits. The kit descriptions state that they include "perforated plastic canvas, floss, needle, chart, and instructions." Applicant has explained that the "perforated plastic canvas" listed on the packaging refers to applicant's own plastic canvas, that the kit maker used applicant's mark incorrectly, and that "the website apparently picked up the language from the packaging." Request for remand, p. 6. Applicant has also explained that the kits bear copyright dates of 1994 and 1995, and that the entries on the website all state that "This item is out-of-print."

It is clear that applicant's goods are perforated and are made of plastic. It is also clear that PERFORATED PLASTIC describes a major characteristic or feature of applicant's goods, a fact which applicant has acknowledged by the amendment of its application to the Supplemental Register. However, we cannot say that the Office has met its burden of proving that PERFORATED PLASTIC is a generic term for "plastic foundation material in sheet form for use

with needle work such as cross stitching" or, as the record shows it is normally called, plastic canvas.

The Examining Attorney asserts that PERFORATED PLASTIC is generic because "perforated plastic" is the generic name for a type of plastic and the applicant's goods are made of perforated plastic. Although the Examining Attorney has asserted that "perforated plastic" refers to a specific type of plastic, as discussed previously, the evidence of record does not bear this out. More particularly, the Examining Attorney has not established that the specific plastic from which applicant's goods are made is referred to generically as "perforated plastic." Thus, the cases cited by the Examining Attorney are inapposite to the present situation. In particular, the Examining Attorney has relied on a number of cases in which services were found to be generic because the applied-for mark was the generic term for a central characteristic of the services, e.g., it named the goods sold through the services.

Of all the evidence which is of record, the only two pieces which indicate any generic usage are the references in the Crafter's Market and the robinsnest.com websites. However, given that the robinsnest.com website refers to a misuse that ended in 1995, and the Crafter's Market usages are equivocal, and given the overwhelming evidence

Ser No. 75432936

that the generic term for the product is plastic canvas, we cannot find, on this record, that the applied-for mark is generic. Accordingly, the term is capable of identifying and distinguishing applicant's goods from those of others, and is eligible for registration on the Supplemental Register.

Decision: The refusal of registration is reversed.