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Mailed: June 7, 2006
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Halocarbon Products Corporation

Serial No. 76588421

Nathaniel D. Kramer of Kirchstein, Ottinger, Israel & Schiffmiller, P.C. for Halocarbon Products Corporation.

Dominick J. Salemi, Trademark Examining Attorney, Law Office 106 (Mary Sparrow, Managing Attorney).

Before Seeherman, Hairston and Grendel, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Halocarbon Products Corporation has filed an application to register on the Principal Register the mark shown below,



for goods that were ultimately identified as:

"fluorochemicals for industrial purposes" in class 1;
"industrial synthetic oils, general purpose grease, and
industrial waxes for lubrication purposes" in class 4; and
"inhalation anesthetics for surgical use" in class 5."¹

With respect to the HALOCARBON portion of its mark,
applicant claims that it has become distinctive of the
goods pursuant to Section 2(f) of the Trademark Act.

The examining attorney has made final a requirement
that applicant disclaim the term HALOCARBON, and has
refused registration in the absence of such disclaimer.
The examining attorney contends that the term HALOCARBON,
when used in connection with the identified goods, is
generic. Further, if the term is not generic, the
examining attorney views the evidence of acquired
distinctiveness submitted by applicant as insufficient to
establish that the term HALOCARBON has acquired
distinctiveness.

Applicant has appealed. Applicant and the examining
attorney have filed briefs, but an oral hearing was not
requested.

¹ Application Serial No. 76588421, filed April 22, 2004, alleging
a bona fide intention to use the mark in commerce. Applicant
claims ownership of Registration No. 2,030,817.

Before turning to the merits of the appeal, we must discuss an evidentiary objection. The examining attorney, for the first time in his brief on appeal, "paraphrased" dictionary definitions of the term "halocarbon" taken from the on-line dictionaries "MyWiseOwl.com" and "Wikipedia.com." The examining attorney did not submit copies of the Internet printouts of the definitions. Applicant, in its reply brief, has objected to the definitions as untimely submitted. The Board has stated that it will not take judicial notice of dictionary definitions submitted after appeal that have been retrieved from on-line dictionaries that are not readily verifiable and reliable. In re Red Bull GmbH, 78 USPQ2d 1375 (TTAB 2006) and In re Total Quality Group Inc., 51 USPQ2d 1474 (TTAB 1999). Thus, applicant's objection to the on-line dictionary definitions is well taken, and we have not considered them in reaching our decision herein. However, as discussed infra, the Board has taken judicial notice of a definition of the term "halocarbon" taken from a print dictionary.

We turn then to the refusal to register and the merits of the disclaimer requirement. According to the examining attorney, the term HALOCARBON is in "common use in the industrial and scientific fields,"

and the term is "generic for the salient ingredient of applicant's goods which include 'anesthetics' and 'industrial' goods." (Examining attorney's brief at unnumbered pp. 2-3). Citing In re Hask Toiletries, Inc., 223 USPQ 1254 (TTAB 1984) [HENNA 'N" PLACENTA held incapable of distinguishing hair conditioner] and In re Pepcom Industries, Inc., 192 USPQ 400 (TTAB 1976) [JIN SENG held incapable of distinguishing soft drinks], the examining attorney argues that it is well settled that "generic terms include those for primary ingredients of goods and so this class must be considered incapable of identifying and distinguishing their source..". (Examining Attorney's brief at unnumbered p. 4).

In support of the refusal, the examining attorney made of record the following four excerpts retrieved from the NEXIS database showing use of the term "halocarbons":

... polluter United States of America, lists six greenhouse gases, being carbon dioxide, methane, nitrous oxide, perfluorocarbons, halocarbons and sulphur hexaflouride, which all have a CO-2e value as follows...

(Monday Business Briefing, "The Carbon Markets - Western Financial Opportunities from Western Pollutions," February 22, 2005);

... climatologist's timeline is the succession of catastrophic events. It is foolish to deny the

risks involved with maintaining high outputs of carbon dioxide, halocarbons and methane.

(The Columbus Dispatch, "Columnist is Wrong To Ignore Global Warming," January 1, 2005);

Emissions of six gases would be affected: carbon dioxide, methane, nitrous oxide, and three halocarbons, used as substitutes for ozone-damaging chlorofluorocarbons.

(Xinhua General News Agency, "Key facts about Kyoto Protocol" October 1, 2004); and

Series 700 is for ultrahigh-purity inert or low-hazard gases such as halocarbons, carrier and cylinder purge gases.

(Semiconductor International, "Gas Regulators," September 15, 2004).

Also, as evidence of the genericness of the term HALOCARBON, the examining attorney points to the fact that applicant has disclaimed the term in its mark shown below, which is the subject of Registration No. 2,030,817. This registration covers the same goods as those involved herein.



Finally, the examining attorney was not persuaded by applicant's evidence of acquired distinctiveness. It is the examining attorney's position that no amount of evidence "can transform [the term HALOCARBON] into a registrable trademark." (Examining attorney's brief at unnumbered p. 4).

Applicant, in urging reversal of the refusal to register, argues that the examining attorney has failed to meet his burden of establishing that HALOCARBON is generic for the goods in the involved application. Applicant maintains that the examining attorney's evidence shows nothing more than that "halocarbons" are gases; not that the term "halocarbon" is understood by the relevant public primarily to refer to the genus of goods in the involved application.

Further, it is applicant's position that the term has acquired distinctiveness, and in support of its claim, applicant submitted the declaration of its chief operating officer, Peter Murin, along with a sampling of advertisements and labels. In his declaration, Mr. Murin states that "'HALOCARBON' has become distinctive of applicant's goods in the instant application in view of the substantial advertising and sales of such goods under the mark, and through applicant's substantially exclusive and continuous use of the mark in commerce for at least five years immediately before the date of this declaration [January 19, 2005]"; that "applicant has utilized the term 'Halocarbon' as part of its company name since approximately 1950"; that "applicant has utilized the term 'HALOCARBON' as a trademark for the goods of the instant

application since at least as early as 1981"; and that "[i]n the past five years, applicant has sold tens of millions of dollars worth of its HALOCARBON brand products as set forth in the instant application." Further, Mr. Murin states that for the years 1999 through 2003, annual sales under the mark HALOCARBON have been at least approximately 20 million dollars in every year, and that applicant's advertising expenditures for HALOCARBON brand products have increased from \$110,000 in 1999 to \$220,000 in 2003.

As indicated, applicant has submitted a sampling of advertisements and labels. These advertisements and labels show use of applicant's trade name Halocarbon Products Corporation; the words Halocarbon Laboratories; Halocarbon per se; and applicant's mark shown below.



Finally, applicant has submitted copies of four third-party registrations which issued under Section 2(f). Applicant maintains that each of the marks in these registrations "incorporates a 'commonly used term in the chemical industry'" and no disclaimer of the term was required.

The issues in this case are whether the term HALOCARBON is generic, and if the term is not generic, whether applicant's evidence of acquired distinctiveness is sufficient. Inasmuch as applicant amended its application to assert a claim of acquired distinctiveness as to the term HALOCARBON, there is no issue concerning the descriptiveness of the term.

We first turn to the issue of genericness. The critical issue in determining genericness is whether members of the relevant public primarily use or understand the designation sought to be registered to refer to the genus or category of goods or services in question. See *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). In making our determination, we follow the two-step inquiry set forth in *Marvin Ginn* and reaffirmed in *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999):

- (1) What is the genus or category of goods at issue? and
- (2) Is the designation sought to be registered understood by the relevant public primarily to refer to that genus or category of goods?

"The correct legal test for genericness, 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.'" American Fertility Society, 51 USPQ2d at 1836. That is, do the members of the relevant public understand or use the term sought to be registered to refer to the genus of the goods and/or services in question? The genus or category of goods in this case are industrial fluorochemicals; industrial synthetic oils; general purpose grease; industrial waxes for lubrication purposes; and inhalation anesthetics for surgical use.

In considering the understanding of the relevant public, we must first determine who comprises the public for the identified goods. The relevant public for applicant's goods are industrial companies and those in the surgical field.

As noted previously, it is the examining attorney's burden to establish that the applied-for mark is generic. In this case, the examining attorney submitted only four Nexis excerpts that contain references to the term "halocarbons." None of the excerpts shows that "halocarbon" is the term by which the identified goods are known. This evidence falls far short of establishing that the term "halocarbon" is understood by the relevant public as referring to the genus of goods in applicant's identification of goods. None of the excerpts shows

generic use of the term for the identified goods. At most, the Nexis excerpts show that "halocarbons" are gases. While we judicially notice² that The American Heritage Dictionary of the English Language (4th ed. 2000) defines "halocarbon" as: "A compound, such as a fluorocarbon, that consists of carbon and one or more halogens", we are not persuaded from this definition that the term is generic for the identified goods. Further, the fact that applicant has disclaimed the term HALOCARBON in another registration for the same goods is not persuasive evidence that the term is generic rather than merely descriptive. In short, the examining attorney has not met his burden of establishing a prima facie case that the term HALOCARBON is generic.³

Having concluded that the record does not establish that the term HALOCARBON is generic, we must consider whether applicant has demonstrated that the term has

² The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

³ In reaching our decision, we have accorded little weight to the third-party registrations made of record by applicant. As is often stated, each case must be decided on its own merits. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). ["Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court."].

acquired distinctiveness under Section 2(f) of the Act. Applicant has the burden of proving that the term has acquired distinctiveness. *Yamaha International Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988).

Although the record does not establish that the term HALOCARBON is generic, it is nonetheless clear from the dictionary definition that the term is highly descriptive of applicant's goods. That is, it may be said that applicant's fluorochemicals for industrial purposes; industrial synthetic oils; general purpose grease; industrial waxes for lubrication purposes; and inhalation anesthetics for surgical use contain halocarbons, even if the record does not demonstrate that they are the primary ingredient of such goods. Given the highly descriptive nature of the term HALOCARBON, a great deal of evidence must be submitted in order to find that the designation has become distinctive of applicant's goods. That is to say, the greater the degree of descriptiveness, the greater the evidentiary burden on the applicant to establish acquired distinctiveness. *Yamaha International Corp. v. Hoshino Gakki Co.*, supra; and *In re Merrill Lynch, Pierce, Fenner & Smith*, supra 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987).

Applicant seeks registration of its mark for goods in classes 1, 4, and 5. Mr. Murin, in his declaration, has offered evidence with respect to the acquired distinctiveness of the term for the goods in the "instant application." The evidence relates to the length of use of the term HALOCARBON and advertising and sales figures. While such evidence is significant, we have know way of knowing, for example, what percentage of the sales and/or advertising have been for the goods in class 1. In other words, we do not know that applicant has had a high level of sales and advertising for the goods in each class of the application. Thus, we are unable to conclude that the term HALOCARBON has become distinctive of the goods in each class of the application.

In sum, we find that the term HALOCARBON has not been proven to be generic of applicant's goods. However, because the term is merely descriptive and applicant has failed to establish that the term has acquired distinctiveness with respect to the goods in each class of the application, the examining attorney's requirement for a disclaimer of HALOCARBON is proper.

Decision: The refusal to register applicant's mark in the absence of a disclaimer of the term HALOCARBON is affirmed. However, in the event that applicant submits the

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required disclaimer within thirty days from the date of this decision, the refusal to register will be set aside, the disclaimer will be entered, and the application will go forward.