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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Welding, Cutting, Tools & Accessories, LLC.

Serial No. 78212695

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for Welding, Cutting, Tools & Accessories, LLC.

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101 (Ronald R. Sussman, Managing Attorney).

Before Bucher, Rogers and Drost, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Welding, Cutting, Tools & Accessories, LLC. seeks
registration on the Supplemental Register of the term
WELDING, CUTTING, TOOLS & ACCESSORIES (*standard character
drawing*) for services recited in the application, as amended,
as follows:

"Retail stores, on-line retail stores and
mail order catalog services all in the field
of welding equipment" in International Class
35.¹

¹ Application Serial No. 78212695 was filed on the Principal Register on February 10, 2003 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. In an Amendment to Allege Use (AAU) filed on November 23, 2004, applicant claimed first use of the mark on these services anywhere and first use in commerce at least as early as October 2003. On the same date, applicant also filed an amendment to the Supplemental Register.

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation, based upon the ground that this term is incapable of functioning as a trademark for the services set forth above. Section 23 of the Trademark Act, 15 U.S.C. § 1091.

Applicant and the Trademark Examining Attorney have fully briefed the case, but applicant did not request an oral hearing. We affirm the refusal to register.

Applicant argues that the burden is on the Trademark Examining Attorney to establish by clear evidence that the applied-for matter is incapable of distinguishing the applicant's services, and that she has failed on this record to demonstrate genericness with clear evidence.

By contrast, the Trademark Examining Attorney argues that the evidence of record, namely, a third-party web page and the contents of a letter and of catalogue pages produced by applicant, when combined with the plain meaning of the words of the proposed mark, is sufficient to show that the applied-for matter is the generic name of the specified services.

A proposed mark is a generic name if it refers to the class, genus or category of goods and/or services on or in connection with which it is used. In re Dial-A-Mattress

Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The test for determining whether a mark is generic is its primary significance to the relevant public. Section 14(3) of the Act; In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551, 1552-53 (Fed. Cir. 1991); and H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., *supra*. The Trademark Examining Attorney has the burden of establishing by clear evidence that a mark is generic and thus unregistrable. In re Merrill, Lynch, Pierce, Fenner and Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Evidence of the relevant public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

We turn to the first question of Marvin Ginn, *supra*, which focuses on the genus of applicant's services. As noted, *supra*, the services recited in the application are "retail stores, on-line retail stores and mail order catalog services all in the field of welding equipment."

Applicant came into being in 2003, when Lincoln Electric Holdings, Inc. formed a new business unit called "Welding, Cutting, Tools & Accessories, LLC" (also known as "WCTA"), for Lincoln's retail welding supply business.² Lincoln Electric purchased the Century welding and cutting equipment and accessories business, the Marquette welding products and accessories business, and the Century battery charging product lines from Clore Automotive LLC. Judging by the nearly identical listing of goods shown in the third-party website of Auto Body Bargains, the descriptions of applicant's products as contained in the letter to new customers, and the list of discontinued items, the record demonstrates that applicant is a retail subsidiary of Lincoln Electric created to focus on the automotive after-market industry and retail Do-It-Yourselfer (DIY) channels, the latter emphasizing ultimate sales to the hobby welder.

Accordingly, in a letter dated October 2004, WCTA's sales manager announced to long-time, authorized Century and Marquette service and sales dealers applicant's new business plan. The letterhead below shows trade name usage of the term "Welding, Cutting, Tools & Accessories, LLC," along with the two newly-acquired brand names ("Marquette" and "Century") of products it is promoting:

² This is consistent with applicant's claim in its AAU of first use in commerce of "Welding, Cutting, Tools & Accessories" as of October 2003.



In her brief, the Trademark Examining Attorney highlighted a sentence from this October 2004 letter: "We believe this plan will create significant opportunities for you to grow your welding program sales by offering the highest quality welding products in the market today."

Catalogue pages attached to the letter demonstrate that applicant's *welding* products focus on arc-welding products, while the *cutting* devices are largely plasma cutting equipment. According to the letter, inasmuch as applicant plans to maintain "higher quality Lincoln Electric consumables and accessories," it is discontinuing redundant Century and Marquette *tools* such as punch tools, flange tools, chipping tools, wire brushes, and other welding/metal fabrication cleaning tools. The same attached pages show that some of the transition in sourcing for *welding accessories* include consumables such as packs of stick electrodes, attachments such as work cables, electrode holders, ground clamps, feeding kits, masks, helmets, lens shades; and Lincoln Electric replacements for *cutting*

accessories including nozzles, electrodes, and assorted parts.

Applicant's services, as recited, involve the sale of welding equipment. The evidence of record shows that applicant's goods include welding tools and welding accessories. Applicant also clearly sells plasma cutting equipment, with the attendant tools and accessories for this cutting equipment. Breaking these goods down into four categories of welding and cutting items that applicant markets, they are best summarized as follows:

- WELDING equipment;
- CUTTING equipment;
- TOOLS for welding and cutting; and
- ACCESSORIES for welding and cutting.

We turn then to the second question of Marvin Ginn, *supra*, namely, whether the term sought to be registered is understood by the relevant public primarily to refer to the involved genus of goods or services.

If one takes the ordinary meaning of the words derived from the first step of the Marvin Ginn test, applicant is marketing WELDING equipment, CUTTING equipment; TOOLS for welding and cutting and ACCESSORIES for welding and cutting.

As argued by the Trademark Examining Attorney:

The applicant has used the common commercial [names] for the goods, combined them and then attempted to appropriate the ordinary compound wording as its mark. A combination of generic terms may result in a unitary

designation that is registrable if the juxtaposition of terms is incongruous or evokes a unique commercial impression. However, if the combination of two or more generic terms is such that each term retains its generic significance, then the combined expression is generic and thus incapable of denoting source. In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) [SCREENWIPE]. See also Eastern Air Lines, Inc. v. New York Air Lines, Inc., 559 F.Supp. 1270, 218 USPQ 71 (S.D.N.Y. 1983) [AIR SHUTTLE]; Surgicenters of America, Inc. v. Medical Dental Surgeries, Co., 196 USPQ 121 (D. Ore. 1976), *aff'd* 202 USPQ 401 (9th Cir. 1979) [SURGICENTER]; In re Leatherman Tool Group Inc., 32 USPQ2d 1443 (TTAB 1994) [POCKET SURVIVAL TOOL]; In re Lowrance Electronics, 14 USPQ2d 1251 (TTAB 1989) [COMPUTER SONAR]; Turtle Wax Inc. v. Blue Coral Inc., 2 USPQ2d 1534 (TTAB 1987) [WASH WAX]; In re National Shooting Sports Foundation, Inc., 219 USPQ 1018 (TTAB 1983) [SHOOTING, HUNTING, OUTDOOR TRADE SHOW & CONFERENCE].

Based on this record, we find that the entire phrase "Welding, Cutting, Tools & Accessories" is merely a combination of generic terms that has no separate or distinct commercial impression apart from what one who understands the individual meanings of the terms would expect the terms to signify. In re Gould Paper Corp., *supra*.

In short, the word "welding" is clearly generic for welding equipment, the word "cutting" is clearly generic for cutting equipment, and the words "tools" and "accessories"

are clearly generic for applicant's welding and cutting tools and welding and cutting accessories, respectively.

Furthermore, because the applied-for matter is generic as to the goods available from applicant, there is no question but that the matter also is generic for intimately-related services such as retailing those goods. See In re Candy Bouquet International Inc., 73 USPQ2d 1883 (TTAB 2004) [CANDY BOUQUET generic for retail, mail, and computer order services in the field of gift packages of candy]; In re CyberFinancial.Net, Inc., 65 USPQ2d 1789 (TTAB 2002) [BONDS.COM generic for providing information regarding financial products and services on the Internet and providing electronic commerce services on the Internet]; In re A La Vielle Russie Inc., 60 USPQ2d 1895 (TTAB 2001) [RUSSIANART generic for a particular field or type of art and also for dealership services directed to that field]; In re Bonni Keller Collections Ltd., 6 USPQ2d 1224 (TTAB 1987) [LA LINGERIE generic for "retail store services in the field of clothing"]; In re Half Price Books, Records, Magazines, Incorporated, 225 USPQ 219 (TTAB 1984) [HALF PRICE BOOKS RECORDS MAGAZINES generic for "retail book and record store services"]; and In re Log Cabin Homes Ltd., 52 USPQ2d 1206 (TTAB 1999) [LOG CABIN HOMES generic for "architectural design of buildings, especially houses, for others"].

We have concluded that this combination of individual words forms an "apt" or "common" descriptive name of applicant's services selling welding and cutting equipment, and related tools and accessories. National Shooting Sports Foundation, Inc., *supra*. However, the Court of Appeals for the Federal Circuit, in American Fertility Society, reminds us that "[a]ptness is insufficient to prove genericness." 51 USPQ2d at 1836.

A combination of generic terms can sometimes result in composite marks that are protectable.³ In light of the admonitions of our primary reviewing Court in American Fertility Society, *supra*, although we still consider the ordinary meanings of the individual words as evidence of the likely perception of the whole term, the Trademark Examining Attorney must meet the rather heavy burden placed on the United States Patent and Trademark Office to demonstrate genericness through additional evidence of generic uses of the term. That is, under the standard set by American Fertility Society, we must "apply the Marvin Ginn test to the phrase as a whole." American Fertility Society, 51 USPQ2d at 1837.

³ See In re Chesapeake Corp. of Virginia, 164 USPQ 395 (CCPA 1970); Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Co., 186 USPQ 557 (TTAB 1975), *aff'd.*, 189 USPQ 348 (CCPA 1976); California Cooler Inc. v. Loretto Winery Ltd., 227 USPQ 808 (9th Cir. 1985); Texas Pig Stands, Inc. v. Hard Rock Cafe Int'l., Inc., 951 F.2d 684, 21 USPQ2d 1641 (5th Cir. 1992), *reh'g, en banc*, denied, 966 F.2d 956, 23 USPQ2d 1639 (5th Cir. 1992).

The only third party website having this exact combination of terms that the Trademark Examining Attorney found was a now-inactive website of Auto Body Bargains.⁴

Pursuing Auto Body's product category of "Welding/Cutting Tools & Accessories," one finds pictured and promoted "Welders & Accessories," "Plasma Cutters," "Hoods," etc. These pages appear to have been targeted to the automotive after-market

Product Catalog:
Abrasive and Grinding Equipment/Materials
Equipment
Safety Equipment
Tools
Paint Application Tools/Equipment
Welding/Cutting Tools & Accessories

industry and retail DIY channels. This represents precisely the same class of consumers who in 2003 may well have been considering similar products from Clore Automotive LLC, from whom Lincoln Electric/applicant bought the Century and Marquette lines of products.

In addition to contending that this lone website printout does not meet the stated standard of "providing clear evidence of generic use" of the applied-for matter for the recited services, applicant argues there is significance to the slight differences in punctuation or presentation:

In this regard, the website printout referred to in the above mentioned Office Actions states "Our Products: Welding/Cutting Tools & Accessories," with no commas, and with a forward slash "/" between the word "welding" and the word "cutting." ... [T]he usage of the slash in this particular website printout would indicate to the relevant public that

⁴ http://cart.autobodybargains.com/ProductCart/pc/viewCat_P.asp?idCategory=9

the products are tools and accessories for use in welding or cutting, wherein "welding/cutting" would be interpreted as modifying the word "tools." No such connotation is derived from the subject mark, which is WELDING, CUTTING, TOOLS & ACCESSORIES, with two commas and no slash. Therefore, the evidence of record is not relevant to the mark in the present application.

We disagree with applicant's conclusion that this type of evidence is not relevant. Our focus must be on the connotation of the words themselves, and we find slight differences in punctuation to be of no importance in this critical genericness determination. We cannot so easily disregard a substantially-exact formulation used by a one-time competitor. We find a continuing interest in securing for all competitors the unencumbered right to use generic terms for goods and services. As noted by the late Judge Rich, in his concurring opinion in the case of In re Sun Oil Company, 426 F.2d 401, 165 USPQ 718, 719 (CCPA 1970): "All of the generic names for a product belong in the public domain." [*emphasis in original*].

In a recent Federal Circuit decision on genericness, In re Steelbuilding.com, 415 F.3d 1293, 75 USPQ2d 1420 (Fed. Cir. 2005), our primary reviewing Court found that joinder of the separate words "steel" and "building" with the TLD ".com" created a "formulation" that, in context, could be perceived by the relevant public as meaning either "steel

buildings" available via the Internet or "the building of steel structures" via an Internet website. While not using the term "double entendre," the Court's reasoning in Steelbuilding.com suggests a non-descriptive connotation (perhaps not unlike SUGAR & SPICE for bakery products,⁵ THE SOFT PUNCH for noncarbonated soft drink,⁶ and NO BONES ABOUT IT for fresh pre-cooked ham⁷). The Court found that simply joining the separate words "steel" and "building" and the TLD ".com" does not necessarily create a compound term that would be generic for "computerized online retail services in the field of pre-engineered metal buildings and roofing systems." Specifically, given the interactive design feature of that applicant's goods and services, the Court concluded that STEELBUILDING could also refer to "the building of steel structures." However, in the instant case, applicant does not argue there are double entendres or realistic multiple connotations created by this four-word string in the context of its services.

To reverse the Trademark Examining Attorney in this case would be to countenance the following scenario:

- Any manufacturer or merchant could select four, non-distinctive words from its industry, and combine these words

⁵ In re Colonial Stores Incorporated, 394 F.2d 549, 157 USPQ 382 (CCPA 1968).

⁶ In re Delaware Punch Co., 186 USPQ 63 (TTAB 1975).

⁷ In re National Tea Co., 144 USPQ 286 (TTAB 1965).

into a word string, possibly sprinkling in appropriate commas, slashes, ampersands, etc.

- Each individual word is by definition generic, answering the question of "what-are-you?"
- It is most unlikely that anyone else in the field will be using that exact permutation of items in a single four-word string.
- Hence, neither a Trademark Examining Attorney nor any competitor will be able to locate that exact phraseology when doing a database search, or may find only applicant's precise usages.
- For example, one could posit a hypothetical stationery store named "Binders, pencils, paper and school supplies."
- If this exact combination is not found anywhere on the Internet when conducting a search on Google, or using any other search engine, any tribunal must then take the position that this four-word string is capable of acquiring distinctiveness as a source indicator in this field.

We do not read Marvin Ginn as demanding such a result. In this case, the goods that applicant markets are best summarized as *welding equipment, cutting equipment, tools* for welding and cutting, and *accessories* for welding and cutting. Applicant's four-word designation is nothing more than the common commercial names of its involved goods.

Decision: The refusal to register on the ground that the applied-for mark is generic in connection with the recited services is hereby affirmed.