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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Dynamotors, Inc.

Serial No. 75260248

Robert V. Vickers of Fay, Sharpe, Fagan, Minnich & McKee
for Dynamotors, Inc.

Catherine Pace Cain, Trademark Examining Attorney, Law
Office 113 (Odette Bonnet, Managing Attorney).

Before Simms, Cissel and Chapman, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

On March 19, 1997, Dynamotors, Inc. (an Ohio
corporation) filed an application to register the mark
DYNAMOTORS on the Principal Register for "electric motors
for machines and electric controls therefor, sold as a
unit" in International Class 7. The application was based
on applicant's assertion of a bona fide intention to use
the mark in commerce in connection with the identified
goods. The Examining Attorney approved the application for

publication in the Official Gazette, and the mark was published for opposition on January 13, 1998. A Notice of Allowance was issued for this application on April 7, 1998. Following several requests to extend applicant's time to submit a Statement of Use (all of which were approved by the USPTO), applicant filed its Statement of Use on April 4, 2001, asserting a date of first use and first use in commerce of March 28, 2001.

The Examining Attorney finally refused registration on the grounds that applicant's mark, DYNAMOTORS, is (i) deceptive in relation to applicant's goods under Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a); (ii) deceptively misdescriptive of applicant's goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1); and (iii) generic for applicant's goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

Applicant appealed to the Board, and both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

In her brief on appeal (p. 3), the Examining Attorney withdrew the refusal to register the mark as generic for the identified goods. Thus, the only two issues before the Board are whether the mark is deceptive under Section 2(a)

and/or whether the mark is deceptively misdescriptive under Section 2(e)(1).

The Examining Attorney contends that "dynamotor" is the generic name for a device that consists of both a motor and a generator. The Examining Attorney submitted dictionary definitions of the term "dynamotor," such as the following:

A (usually small) self-contained motor-generator. The motor and generator portions are enclosed in a common housing, giving the machine the appearance of a simple motor. The Illustrated Dictionary of Electronics (Seventh Edition 1997);

A rotating device for changing a dc voltage to another value. It is a combination electric motor and dc generator Modern Dictionary of Electronics (1999); and

A motor generator combining the electric motor and generator. Merriam-Webster Dictionary (Unabridged Online).

In addition, we take judicial notice of the following definition of "dynamotor" from another standard English dictionary, Webster's Third New International Dictionary (1993):

A motor generator combining the motor and generator in a single machine with one field magnet and two armatures or with one armature and two windings one of which receives current as a motor

and the other of which generates current as a dynamo.

The Examining Attorney then contends that the proposed mark misdescribes applicant's goods because they are not dynamotors, i.e., applicant's goods do not include a generator; and that consumers are likely to believe the misdescription because a dynamotor "has the appearance of a simple motor" (brief, p. 5). Further, the Examining Attorney argues that because the additional generator function of a dynamotor is a desirable feature and an essential element of that product, it would materially affect the decision to purchase applicant's product by believing that it is a motor-generator when it is only a motor, thereby making term deceptive in relation to applicant's identified goods.

In further support of the refusals, the Examining Attorney made of record (i) copies of numerous excerpted stories retrieved from the Nexis database, and (ii) third-party registrations, all to establish that the term "dynamotor" is currently used to identify a particular device, specifically, a small, self-contained motor-generator.

Examples of the third-party registrations submitted by the Examining Attorney (all based on use, all still valid

and subsisting registrations when submitted by the Examining Attorney, and all containing the term "dynamotors" within the identifications of goods) include Registration No. 411,610, issued January 23, 1945 to Pioneer Gen-E-Motor Corporation; Registration No. 947,517, issued November 21, 1972 to Bendix Corporation; Registration No. 668,938, issued October 28, 1958 to Wincharger Corporation; Registration No. 612,989, issued September 27, 1955 to Motorola, Inc.; Registration No. 554,290, issued January 29, 1952 to Pyle-National Company; and Registration No. 2,540,310, issued February 19, 2002 to Dyna Technology, Inc.

Examples of the Nexis stories include the following:

Headline: Virginia
...The Pentagon's public affairs office said Sunday that a weapon of one of the complex's security guards had been discharged. But it was not clear whether that is related to the shooting. Alarming package contains dynamotor, not dynamite... But after x-raying the package, technicians opened it and found only a small motor - a dynamotor - inside, complete with wires and brackets. "The Virginian-Pilot (Norfolk, VA)," March 9, 1998;

Headline: N.E. Mysteries; 'Phantom P-40' Pilot's Identity Still a Mystery
...They removed the machine guns, ammunition, radio, oxygen equipment, dynamotor, and everything else not essential to the flight, and made a

stainless steel drop tank and another internal tank to carry extra gasoline. "The Patriot Ledger (Quincy, MA)," April 13, 1996; and

Headline: When the War Is Over
Footnotes to the Good War
...radioman, steals a refrigerator out of an abandoned Martin PBM seaplane, and Hoffman, an electrician's mate, converts it to the 110-volt current that feeds our barracks. He also finds a bunch of small dynamotors that, with some sheet aluminum, we convert into electric fans. "The Baltimore Sun," August 30, 1995.

Applicant argues that "a 'dynamotor,' as is generally known to those in the art, is 'a *converter* that combines both motor and generator action, with one magnetic field and with two armatures, or with one armature having separate windings' *IEEE Standard Dictionary of Electrical & Electronics Terms (2nd ed. 1977)*" (brief, p. 3); that "'dynamotors' were once part of the mobile-radio reality," but "they are hardly used in the field of power electronics anymore" and "the current edition of the *Standard Handbook for Electrical Engineers (13th ed. 1993)*, no longer includes an entry for dynamotors" (brief, p.4); and that applicant does not make dynamotors, but sells an electric motor which is a "machine that converts electric energy into mechanical energy by utilizing forces produced by magnetic fields on current-carrying conductors. *Standard*

Handbook for Electrical Engineers (5th ed. 1994) (brief, p. 4). (Applicant made of record (i) several scientific dictionary definitions and (ii) a one-page printout from "www.wps.com" discussing "dynamotors.")

Applicant specifically contends with regard to deceptive misdescriptiveness that the prefix "dyna" is wholly arbitrary with respect to applicant's goods; that applicant uses the mark as "DynaMotors" as shown on the specimen submitted with applicant's Statement of Use¹; that even if the mark misdescribes applicant's goods in that they are not dynamotors, it is not deceptively misdescriptive of the goods because "prospective purchasers of applicant's electric motors and electronic controls, i.e., those in the power electronics field, are not likely to believe that they are purchasing dynamotors" (brief, p. 7); and that applicant's goods and dynamotors are used in different situations for different purposes.²

¹ Applicant's specimen shows use of "DynaMotors, Inc." and "dynamotors.com."

² Applicant stated in its reply brief (p. 2), without specifying either the classes of potential consumers or the trade channels for its goods and without submitting evidence in support thereof, that "there is not a close relationship in the minds of knowledgeable persons who purchase or use such products between electric motors and dynamotors. These products are used in entirely different situations for entirely different purposes. Such consumers are not apt to be confused. Customers do not simply buy these products on the shelf of the local hardware store. Customers must buy the proper motor for each application."

Finally, applicant contends that even if one of applicant's products could lead a purchaser seeking electric motors to believe that the product may be a dynamotor, the record fails to show that such a misrepresentation would materially affect the decision to purchase applicant's goods; and that the third-party registrations and other materials do not show that purchasers are likely to believe the "misdescription" actually describes the goods.

The test to be applied in determining whether or not a term is deceptively misdescriptive under Section 2(e)(1) is set forth as follows: (1) whether the term misdescribes a characteristic, quality, function, composition or use of the goods, and (2) if so, whether prospective purchasers are likely to believe the misdescription actually describes the goods. See *In re Berman Bros. Harlem Furniture Inc.*, 26 USPQ2d 1514 (TTAB 1993); and *In re Quady Winery, Inc.*, 221 USPQ 1213 (TTAB 1984).

If the issue is whether or not the term is deceptive under Section 2(a), a third part is added to the test, namely, (3) if purchasers are likely to believe the misdescription actually describes the goods, whether the misdescription is likely to affect the decisions of purchasers to buy the goods. See *In re Budge Manufacturing*

Co. Inc., 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988),
aff'g 8 USPQ2d 1790 (TTAB 1988).

The third element, i.e., the materiality of the
misdescription to the purchasing decision, has been
addressed as follows by the Board in the case of Bureau
National Interprofessionnel Du Cognac v. International
Better Drinks Corp., 6 USPQ2d 1610, 1615 (TTAB 1988):

If the mark misdescribes the goods, and
purchasers are likely to believe the
misrepresentation, but the
misrepresentation is not material to
the purchasing decision, then the mark
is deceptively misdescriptive (citation
omitted)...

According to Professor McCarthy, the difference
between Section 2(a) deceptive and Section 2(e)(1)
deceptively misdescriptive is the "materiality" test. That
is, "would the misdescription 'move' the purchaser to
purchase the goods or services." "The 'materiality' test
focuses upon the question of whether purchasers care
whether the product contains the misdescribed quality.. .
If they do not care, the misdescription comes within §2(e)
and not §2(a)." As he succinctly states, "the probable
reaction of buyers is the key issue." 2 J. Thomas
McCarthy, McCarthy on Trademarks and Unfair Competition,
§§11:58 and 11:60 (4th ed. 2001).

The record establishes that there exists a product which is a combination motor/generator known as a "dynamotor"; and that applicant does not sell that product under its mark DYNAMOTORS, but rather applicant sells "electric motors for machines and electric controls therefor, sold as a unit," which do not include a generator. Thus, the term is misdescriptive of applicant's goods.

The record also establishes that potential purchasers are likely to believe this misdescription. One of the dictionary definitions quoted above expressly states that a "dynamotor" is a single unit and gives the appearance of "a simple motor," thus, purchasers would not necessarily be aware that applicant's electric motor is not a dynamotor.

While some of the evidence tends to show that "dynamotor" may be an antiquated term, nonetheless, we have evidence that the term is still in use. This evidence includes the scientific and standard English dictionaries dated 1993, 1997 and 1999; the Nexis stories which included use of the term "dynamotor(s)"; and the recently issued (2002) third-party registration. Thus, there is evidence that the term "dynamotor(s)" is still utilized and is encountered by purchasers and potential purchasers. We find that the prospective purchasers are likely to believe

that the misdescription actually describes applicant's goods. See *R. Neumann & Co. v. Bon-Ton Auto Upholstery, Inc.*, 326 F.2d 799, 140 USPQ 245 (CCPA 1964) (VYNAHYDE held deceptive and deceptively misdescriptive of plastic film and plastic film made into furniture slip covers); *R. Neumann & Co. v. Overseas Shipments, Inc.*, 326 F.2d 786, 140 USPQ 276 (CCPA 1964) (DURA-HYDE held deceptive and deceptively misdescriptive of plastic material of leatherlike appearance made into shoes); *In re Berman Bros.*, supra (FURNITURE MAKERS held deceptively misdescriptive of retail furniture store services, not including the manufacture of furniture); *In re Woodward & Lothrop Inc.*, 4 USPQ2d 1412 (TTAB 1987) (CAMEO and design held deceptively misdescriptive of jewelry, namely earrings, necklaces and bracelets, not inclusive of cameos or cameo-like elements); *In re Quady Winery*, supra (ESSENSIA held deceptively misdescriptive of wines); and *The American Meat Institute et al. v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981) (BAKED TAM held deceptively misdescriptive when applied to a chopped, formed turkey meat product). Cf. *In re Automatic Radio Mfg. Co., Inc.*, 404 F.2d 1391, 160 USPQ 233 (CCPA 1969) (AUTOMATIC RADIO held not deceptively misdescriptive of ignition systems, antennas and air conditioners); *In re Lyphomed Inc.*, 1

USPQ2d 1430 (TTAB 1986) (P.T.E. held not deceptively misdescriptive of pediatric mixture of injectable trace element additives for intravenous nutrition); and In re Econoheat, Inc., 218 USPQ 381 (TTAB 1983) (SOLAR QUARTZ held not merely descriptive or deceptively misdescriptive of electric space heaters).

Accordingly, we hold that the term DYNAMOTORS used on "electric motors for machines and electric controls therefor, sold as a unit," which are not dynamotors because they do not include generators, is deceptively misdescriptive under the Section 2(e)(1) of the Trademark Act.

This brings us to consideration of the refusal to register under Section 2(a) of the Trademark Act. Having found the term DYNAMOTORS, for the reasons stated above, to be deceptively misdescriptive of applicant's "electric motors for machines and electric controls therefor, sold as a unit," the determinative issue for the purpose of whether such term is also unregistrable as deceptive is whether the misdescription is likely to affect the decision to purchase the goods.

On this point the Examining Attorney essentially argues that "dynamotor" refers to a small motor-generator; that the term would be encountered by prospective customers

who wish to purchase a motor or motor/generator; that the classes and types of purchasers are not limited in applicant's identification of goods; that the additional generator function of a dynamotor is a desirable feature and an essential element of the product; that applicant's mark, when used on applicant's goods, misrepresents an essential and material element of the goods and is materially false; and that because of this difference between motors and dynamotors, the misdescription would be likely to affect the purchasers' decisions to buy. (Brief, pp. 10-11.)

In addition to the evidence outlined above, we note that the Examining Attorney has also submitted excerpted stories retrieved from the Nexis database to show that the relevant public is accustomed to seeing the term "motor" used to mean both a motor and a generator.

Applicant argues that applicant's electric motors for machines and motor/generators (dynamotors) are completely different products and thus it is illogical to think of one as superior or more desirable than the other; and there is no evidence that the decision to purchase applicant's electric motors is affected by the fact that "dynamotors" refers to other products, especially because the term refers to outdated products.

There is no doubt applicant's goods do not include generators. However, the Examining Attorney offers only speculation and conclusory statements that the additional generator function of a dynamotor is a desirable feature in relation to electric motors for machines.

Considering all of the evidence of record, we find the Examining Attorney has not made a prima facie showing that the purchaser's decision to buy applicant's goods is likely to be affected by the use of the term DYNAMOTORS as applicant's trademark for electric motors for machines. That is, although the record shows that the term DYNAMOTORS misdescribes applicant's goods and that purchasers are likely to believe the misdescription actually describes the goods, there is simply no evidence that the misdescription is likely to affect the decision to purchase. The facts that there is a difference between an electric motor and a dynamotor, and that the misdescriptive term is used on electric motors certainly establishes the term is deceptively misdescriptive under Section 2(e)(1). These facts, however, do not establish that the use of the term is likely to affect purchasers' decisions to buy applicant's products. See *U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307 (TTAB 1990) (*THE REAL YELLOW PAGES* (stylized lettering) held not deceptive or merely

descriptive or deceptively misdescriptive of classified directories). Cf. In re Budge Manufacturing Co. Inc., supra (LOVEE LAMB held deceptive of automobile seat covers made from synthetic fibers); In re Organik Technologies, Inc., 41 USPQ2d 1690 (TTAB 1997) (ORGANIK held deceptive of clothing and textiles made from cotton that is neither from an organically grown plant nor free of chemical processing or treatment); and In re Shapely, Inc., 231 USPQ 72 (TTAB 1986) (SILKEASE held deceptive of clothing not made of silk).

Decision: The refusal to register on the ground that the mark is deceptive under Section 2(a) of the Trademark Act is reversed, and the refusal to register on the ground that the mark is deceptively misdescriptive under Section 2(e)(1) is affirmed.