

12/22/00

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

Hearing:
July 6, 2000

Paper No. 18
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Erretre S.R.L.

Serial No. 75/324,462

Joseph J. Orlando of Bucknam and Archer for applicant.

Jennifer Stiver Chicoski, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

Before Simms, Cissel and Walters, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Erretre S.R.L. has filed a trademark application to register the mark CHEMICAL MILLING for goods identified below.¹

Chemical preparations for use in the processing of leather, in International Class 1;

Colorants for use in the processing of leather, in International Class 2;

Greases for use in the processing of leather, in International Class 4;

¹ Serial No. 75/324,462, in International Class 1, 2, 4, 7, 9 and 18, respectively, filed July 14, 1997, based on use of the mark in commerce, alleging first use and use in commerce as of October 1994 in all classes.

Machines, namely, combination milling, upgrading, and finishing with special effects machines, for use in the dry processing of leather, in International Class 7;

Climatic controls to control the microclimate inside machines for the processing of leather, in International Class 9;

Leather sold in bulk, in International Class 18.

The Trademark Examining Attorney has finally refused registration, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive of its goods.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs and an oral hearing was held. We affirm the refusal to register.

Applicant does not contest the Examining Attorney's characterization of its identified goods as "a variety of goods involved in the processing of leather as well as finished bulk leather ... [and these goods] are all for use in the milling of leather utilizing chemicals in the process or are finished leather pieces that have undergone such a process." Applicant acknowledges that the milling of leather "is a term of art in the industry wherein leathers are placed in a special drum which rotates to render the leather soft."

The Examining Attorney contends that CHEMICAL MILLING is merely descriptive of applicant's goods because the milling of leather is a component of the process of

processing leather; applicant's goods "include chemical preparations for use in the processing of leather"; applicant's goods include "finished bulk leather that has undergone this process"; and, therefore, CHEMICAL MILLING "tell[s] exactly what the goods do, namely, mill bulk leather using chemicals, and how the finished goods have been treated."

In support of her position, the Examining Attorney has submitted a dictionary definition of the phrase "chemical milling" as "the process of producing metal parts to predetermined dimensions by removing metal from the surface with chemicals"; and various excerpts of articles from the LEXIS/NEXIS database demonstrating use of the phrase "chemical milling" in the context of metal production. The Examining Attorney has also submitted an excerpt from applicant's web site which includes the following statements:

Finishing and Upgrading while Milling

All the advantages of Chemical Milling technology. Chemical Milling is an extraordinary new reality in tanning. It is the technology of finishing during milling - a real revolution in the finishing field and Erretre is among the leaders in it.

The Erretre 3000 stainless steel machines allow you to finish and upgrade the skins directly during the milling phase. In practice, it is like having several machines in one, with the advantage of not having to go through several production passages. In short, it provides good savings in time and resources.

Applicant contends that that its goods involve no "chemical milling" as that term is defined in the context of metal production; and that, while the individual terms "chemical" and "milling" are "descriptive of some products utilized in the [leather finishing] process and an element of the process, ... the composite term is incongruous with respect to applicant's process and is not merely descriptive." Applicant argues that the phrase "chemical milling" has a "known meaning or connotation unrelated to applicant's goods or process" for tanning or finishing leather; and that applicant's customers in the leather processing industry "would be familiar with the definition of 'chemical milling' as noted above and recognize the incongruity of applicant's adoption and use of the mark CHEMICAL MILLING."² Applicant states that "the term CHEMICAL MILLING" as used by applicant is the name of the novel process and products used therein as developed by applicant and although possibly sometimes inadvertently used incorrectly, it is not intended to define the process."

The test for determining whether a mark is merely descriptive is whether the involved term immediately conveys information concerning a quality, characteristic, function,

² In support of its argument, applicant submitted the results, in brief, of a search of the Internet. The mere listing of search results is of no probative value and has not been considered. Applicant also submitted a paper in Italian, with no translation into English, which is, similarly, of no probative value.

ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

We agree with the Examining Attorney that applicant's mark is merely descriptive in connection with its identified goods. The fact that the phrase "chemical milling" is a term of art in the field of metal production is not relevant because it is a definition in a field unrelated to applicant's goods. Thus, this fact does not lend an incongruity to the phrase in the context of applicant's goods. Similarly, the fact that applicant may be the first or only user of the phrase in the leather finishing industry

does not necessarily mean that the phrase is not merely descriptive. As stated above, we must look at the record as a whole and consider the phrase in the context of applicant's goods.

It is clear that applicant's goods, excluding its bulk leather, are used in the processing of leather; that "milling" is one part of leather processing; and that applicant's mark is used in connection with a chemical form of leather processing that combines several leather finishing processes into one process that occurs during the milling phase. Further, relevant purchasers are likely to view applicant's bulk leather products as having been finished using applicant's process. In the present case, it is our view that, when applied to applicant's goods, the term CHEMICAL MILLING immediately describes, without conjecture or speculation, a significant feature or function of applicant's goods, as described herein. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's services to readily perceive the merely descriptive significance of the term CHEMICAL MILLING as it pertains to applicant's identified goods.

Decision: The refusal under Section 2(e)(1) of the Act is affirmed.