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PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re A & I Supply Company

Serial No. 75/703,296

Robert Berliner of Fulbright & Jaworski LLP for applicant.

Vivian M. First, Trademark Examining Attorney, Law Office
104 (Sidney Moskowitz, Managing Attorney).

Before Simms, Hairston and Rogers, Administrative Trademark
Judges.

Opinion by Hairston, Administrative Trademark Judge:

A & I Supply Company has appealed from the final
refusal of the Trademark Examining Attorney to register
GREEN STRAND as a trademark for "wire rope."¹ Registration
has been refused pursuant to Section 2(e)(1) of the
Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that

¹ Application Serial No. 75/703,296, filed May 11, 1999, and alleging a
bona fide intention to use the mark in commerce.

applicant's mark is merely descriptive of the identified goods.

Applicant and the Examining Attorney have filed briefs, but no oral hearing was requested.

We reverse the refusal to register.

According to the Examining Attorney, the record in this case shows that wire rope is composed of multiple strands of wire and that each strand is composed of several wires; that a number of suppliers of wire rope "use one or more colored wire strands to serve as indications of origin;" and that applicant's particular wire rope "involves" a green strand made of many filaments which are green. (Brief, p. 3). Thus, the Examining Attorney argues that the term GREEN STRAND "is merely descriptive of applicant's wire rope which features a green strand of wire filament." (Brief, p. 5). In support of the refusal to register, the Examining Attorney made of record the following definitions taken from *The American Heritage Dictionary of the English Language, Third Edition* (1992):

green: something green in color;

strand: a complex of fibers or filaments that have been twisted together to form a cable, rope, thread, or yarn; and

filament: a fine or thinly spun thread, fiber of wire.

Applicant, in urging reversal of the refusal to register, argues that the Examining Attorney "has not met her burden of proof of showing mere descriptiveness." (Brief, p. 3). Applicant acknowledges that it intends to use a green color in its wire rope for source identification. However, it is applicant's position that the term GREEN STRAND "requires prospective customers to go through a multistage reasoning process to capture the connection between its wire rope goods," and that "the consumer would be unable to determine anything else about the goods offered by [a]pplicant, without additional information, investigation, or further thought." (Brief, p. 6).

Further, applicant maintains that it is significant that other suppliers of wire rope have used one or more colored wire rope strands to serve as indications of origin. Applicant submitted printouts obtained from the Office's TESS database of twelve third-party registrations of marks that consist of the name of a color(s) and the word STRAND for goods identified as wire rope.²

² The marks are: SILVER STRAND; GREEN AND WHITE STRAND; DOUBLE GOLD STRAND; GOLD STRAND; TAN STRAND; ORANGE STRAND; WHYTE STRAND; BLACK STRAND; RED-STRAND; BLUE STRAND; GRAY STRAND; and YELLOW STRAND.

A term is merely descriptive, and therefore unregistrable pursuant to Section 2(e)(1) of the Trademark Act, if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods with which it is used. On the other hand, a term which is suggestive is registrable. A suggestive term is one that suggests, rather than describes characteristics or attributes of a product, such that imagination, thought or perception is required to reach a conclusion on the nature of the goods. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). There is but a thin line of distinction between a suggestive and a merely descriptive term, and it is often difficult to determine when a term moves from the realm of suggestiveness into the sphere of impermissible descriptiveness. In re Recovery, Inc., 196 USPQ 830 (TTAB 1977).

We note that the Examining Attorney, in her brief, has acknowledged that suppliers of wire rope use color on their rope as an indication of origin; and in the case of Wire Rope Corporation America, Inc. v. Secalt S.A., 196 USPQ 312, 315 (TTAB 1977), the Board recognized the practice of wire rope manufacturers to use color as a source indicator:

Insofar as the nature of the use of colored strands in the wire products field is concerned, it is not disputed that it is

the custom, as previously indicated, for manufacturers to use different colors for application to their wire rope or cable for identification purposes and that purchasers do recognize the individual colors as source indicia.

Therefore, it is only logical that a manufacturer/supplier of wire rope would also identify its product by a mark that is the "literal equivalent" of the colored strands, i.e., the name of the color and the word STRAND. The third-party registrations submitted by applicant confirm this industry practice. A review of these third-party registrations reveals that two of the registrations issued on the Principal Register under the provisions of Section 2(f); one of the registrations issued on the Supplemental Register; and nine of the registrations issued on the Principal Register, without benefit of the provisions of Section 2(f), albeit several of the registrations have a disclaimer of the word STRAND. It would appear from these registrations that the Office generally has not considered these literal equivalent marks to be merely descriptive of wire rope. At the very least, the Office's treatment of these marks has been inconsistent.

The intent of Section 2(e)(1) is to protect the competitive needs of others, that is "descriptive words [or

terms] must be left free for public use." In re Colonial Stores, Inc., 394 F.2d 549, 157 USPQ 382, 383 (CCPA 1968). In this case, it does not appear that other manufacturers/suppliers of wire rope would be damaged by the registration sought by applicant.

Considering then the commercial realities, and the fact that the Office has been at least somewhat inconsistent in its treatment of marks that are the literal equivalents of colored strands of wire, this raises doubt on the issue of mere descriptiveness. It is well settled that where there is doubt on this issue, the doubt must be resolved in applicant's behalf and the mark should be published for opposition. See In re Rank Organization Ltd., 222 USPQ 324, 326 (TTAB 1984) and cases cited therein.

Decision: The refusal to register under Section 2(e)(1) is reversed.