

**THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Paper No. 12

TJQ

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Marconi Communications, Inc.

Serial No. 75/782,260

Mark S. Svat of Fay, Sharpe, Fagan, Minnich & McKee for applicant.

M. Catherine Faint, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Simms, Cissel and Quinn, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Marconi Communications, Inc. to register the mark MICA for "indoor cabinets used to house electronic equipment at central offices of phone companies, whereby the cabinets are used in commercial establishments."¹

¹ Application Serial No. 75/782,260, filed August 23, 1999, based on an allegation of a bona fide intention to use the mark in commerce. The identification of goods was amended by applicant in its May 24, 2001 response, and the Examining Attorney accepted the amendment in the Office action dated September 4, 2001. Applicant, in its appeal brief, refers to the original identification of goods. As correctly pointed out by the

The Trademark Examining Attorney refused registration under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark, if applied to the goods, would be deceptively misdescriptive of them.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs.² An oral hearing was not requested.

The Examining Attorney maintains that the term "mica" is a common word, found in the dictionary, meaning "[a]ny of a group of chemically and physically related aluminum silicate minerals, common in igneous and metamorphic rocks, characteristically splitting into flexible sheets used in insulation and electrical equipment." The American Heritage Dictionary of the English Language (3rd ed. 1992). Because applicant's cabinets do not contain any mica, the Examining Attorney contends that the term misdescribes the goods. Further, because cabinets are often made of or contain mica, and because mica is used for electrical insulation, the Examining Attorney asserts that purchasers

Examining Attorney, however, the amended identification is the one used in determining the merits of the refusal.

² Applicant, in its brief (p. 6), states that in the event the refusal is affirmed, "[a]pplicant will request the application be remanded back to the Examining Attorney for potential amendment to the Supplemental Register." Although the point is moot by virtue of this decision, such procedure is not permissible. Trademark Rule 2.142(g). See: *In re S. D. Fabrics, Inc.*, 223 USPQ 56 (TTAB 1986). See generally: TBMP Section 1218.

are likely to believe that applicant's cabinets are made of or contain mica when, in point of fact, they are neither. In addition to the dictionary listing cited above, the Examining Attorney submitted webpages obtained from the Internet and excerpts retrieved from the NEXIS database.

Applicant argues that its mark is not deceptively misdescriptive, but rather that its coined mark is an acronym for "Modular Indoor Cabinet Architecture." Applicant states that there is no need for electrical insulation in its product which might be accomplished by the use of mica, and that sophisticated purchasers of applicant's sophisticated goods will know this and that, therefore, purchasers are not likely to believe that mica is involved. Applicant criticizes the Examining Attorney's Internet and NEXIS evidence by asserting that the evidence pertains to furniture-type cabinets found in home kitchens and bathrooms, and not the type of sophisticated cabinets for electronic equipment produced by applicant and bought by phone companies.

The test for deceptive misdescriptiveness has two parts. First it must be determined if the matter sought to be registered misdescribes the goods. If so, then it must be ascertained if it is also deceptive, that is, if anyone

is likely to believe the misrepresentation. In re Quady Winery Inc., 221 USPQ 1213, 1214 (TTAB 1984).

It is helpful to review applicant's product literature in an effort to understand the specific nature of the involved goods. The literature describes the goods as "indoor cabinets" designed "to house and protect telecommunications equipment deployed in indoor applications." The literature indicates that the cabinets have a "[r]ugged metal housing made of heavy gauge steel, which is cold-rolled with a powder coat finish for durability."

We find that neither prong of the test for deceptive misdescriptiveness is met. With respect to the first prong, we recognize that "mica" is a dictionary term. The record is completely devoid of any evidence, however, that cabinets of the type produced by applicant are ever made of or include mica. Given this, we do not see how the term misdescribes the goods. Although the evidences indicates that mica is used in a variety of applications, including as a general insulation material in electrical applications, none of the applications appears to pertain to the type of product made by applicant.

We will assume for the sake of argument, however, that the term "mica" misdescribes applicant's goods because

applicant's cabinets do not include mica. Even making this assumption, the second prong of the test clearly is not met based on the record before us.

Applicant's goods are fairly technical in nature, and would be sold to sophisticated purchasers, such as phone companies. As indicated earlier, the term "mica" does not have a specific meaning with respect to the type of cabinets here, namely, cabinets used to house electronic equipment at phone companies. A sophisticated buyer carefully purchasing such cabinets not made of mica will not be deceived by applicant's mark into believing that the cabinets are made of mica.

To the extent that the Examining Attorney's evidence shows that mica is used for cabinets, the evidence pertains to domestic-type cabinets, that is, cabinets used in the home, such as kitchen cabinets or bathroom cabinets. To reiterate, none of the evidence shows use of mica in connection with indoor cabinets used to house electronic equipment at central offices of phone companies, or with any similar type goods. There is no evidence which, in applicant's words, "would imply that there is or needs to be a function of electrical insulation which might be accomplished by the use of mica." (brief, p. 5).

Decision: The refusal to register is reversed.