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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Smurfit Newsprint Corporation

Serial No. 75/918,594

Paul M. Denk, Esq. for Smurfit Newsprint Corporation.

Catherine Pace Cain, Trademark Examining Attorney, Law
Office 104 (Sidney I. Moskowitz, Managing Attorney).

Before Hohein, Holtzman and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

Smurfit Newsprint Corporation (applicant) filed a
trademark application to register the mark VINYLCLAD (in
typed form) on the Principal Register for goods ultimately
identified as "vinyl covered garage door panels, moldings

and millwork made primarily of non-metal" in International Class 19.¹

The examining attorney² refused to register the mark on the ground that the mark, when applied to the goods, is merely descriptive. 15 U.S.C. § 1052(e)(1). After the examining attorney made the refusal final, this appeal followed and applicant and the examining attorney have filed briefs.

The examining attorney's position is that the mark VINYLCLAD is merely descriptive for applicant's goods, which are "vinyl covered garage door panels, molding and millwork made primarily of non-metal." These goods are "a pressed wood panel, compressed under heat and pressure, and then ... coated with a clear vinyl." Applicant's Br. at 5. The examining attorney's position is that "applicant's wood panels are covered or clad with a protective layer of another material; in this case, the material is vinyl. The goods are 'vinyl clad.'" Ex. Atty. Br. at 4.

The examining attorney submitted numerous NEXIS references, some of which are set out below, that show use

¹ Serial No. 75/918,594, filed February 14, 2000. The application is based on applicant's allegation of a bona fide intention to use the mark in commerce.

² The current examining attorney was not the original examining attorney in this case.

of the term "vinyl-clad" to describe various building-related items.

Vinyl-clad closet shelving.
Orlando Sentinel, July 1, 2001.

[S]ome **vinyl-clad** homes may need cleaning every year or two.
Arizona Republic, June 23, 2001.

[T]he installation of new **vinyl-clad** windows makes the building more airtight.
Ventura County Star, May 31, 2001.

The facility makes wood windows but also fabricates **vinyl-clad** and metal building products.
Plastics News, March 6, 2001.

For the exteriors, consider cedar shake with a translucent stain and **vinyl-clad** trim.
The Record (Bergen County), March 4, 2001.

It will feature wood windows, not the **vinyl-clad** windows the house had at its end.
The Daily Record (Baltimore, MD), March 3, 2001.

On the exterior, **vinyl-clad** wood windows usually blend in with any painted wood trim.
Chicago Tribune, March 2, 2001.

Vinyl-clad wire closet shelving.
Orlando Sentinel, December 10, 2000.

The kit should be applied to painted or varnished wood or aluminum or **vinyl-clad** molding. *Philadelphia Inquirer*, November 10, 2000.

I think the **vinyl-clad** wood is best.
Boston Globe, August 27, 2000.

To further support her position, the examining attorney also submitted printouts from the Internet

advertising various products that were identified as "vinyl clad" including:

Vinyl Clad Cupolas - Cupolas manufactured using Wood wrapped with PVC (Vinyl coated aluminum).
www.vwdcorp.com.

And at Best Homes, **vinyl clad** railings are included in the price of every home.
Best Homes website.

MW **vinyl clad** windows and doors are the premium choice for homeowners.
www.mvwindows.com.

Vinyl Clad Wood Windows and Doors.
www.customwindows.com.

Vinyl Clad Steel Front Door w/Storm... **Vinyl Clad** Bottom Shelves.
www.glenwoodvillage.com.

The examining attorney concludes that these "excerpts show that the term 'vinyl clad' does have a plain descriptive meaning when used with related goods in addition to applicant's products." Examining Attorney's Br. at 7.

Applicant, on the other hand, argues that "applicant is not marketing a vinyl coating per se, for use for spraying or coating onto a product. Hence, VINYLCLAD is just not directly descriptive of the product of this application, per se." Br. at 4. Further, "the word VINYLCLAD simply suggests that there may be something involved in the manufacture of these panels, that probably

includes something to do with vinyl." Id. "Applicant will market these panels for use in the manufacture of garage doors, to the garage door manufacturers, it is a pressed word panel, compressed under heat and pressure, and then is coated with a clear vinyl, to provide panels for the manufacturer for use and assembling of garage doors." Id. at 5. Applicant also argues that the definition of "clad" means "metal coating bonded to a metal core." Br. at 4. Therefore, applicant concludes that its mark is a misnomer, and anyone seeing the mark on a carton "would not have the slightest notion as to what VINYLCLAD defines." Id. As a result, applicant asserts that its mark is not merely descriptive of its goods.

We affirm the examining attorney's refusal to register applicant's mark.

A mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information regarding a function, purpose, or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). See also In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Courts have long held that to be "merely descriptive," a term need only describe a single

significant quality or property of the goods. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959). We look at the mark in relation to the goods or services, and not in the abstract, when we consider whether the mark is descriptive. Abcor, 200 USPQ at 218.

First, we start by noting that applicant's goods are described as "vinyl covered garage door panels, molding and millwork made primarily of non-metal." Therefore, the word "vinyl" would at least describe the fact that the goods are "vinyl covered." The examining attorney also submitted a dictionary definition that defined "clad" as "to sheathe or cover (a metal) with a metal" and "to cover with a protective or insulating layer of other material."³ The combination of the words "vinyl" and "clad" would simply describe applicant's vinyl covered, non-metal door products because they would be a product covered with a protective layer of vinyl. There is nothing incongruous about this combination of "vinyl" and "clad" that would diminish the descriptive significance of the terms. When we view the mark in relation to the goods, which are vinyl covered door

³ *American Heritage Dictionary of the English Language, Third Edition* (1992).

panels, molding and millwork, applicant's mark would immediately inform prospective purchasers that its goods are covered or clad with a protective layer of vinyl. The fact that applicant spells its mark without a space between the words does not overcome the descriptive nature of the terms. Abcor, 200 USPQ at 218 (GASBADGE at least descriptive for gas monitoring badge).

In this case, the examining attorney does not rely only on the dictionary definitions to support the descriptiveness refusal. The examining attorney has submitted numerous references to show that the term "vinyl clad" is commonly used to describe various products that are used in the building industry. "Vinyl clad" is used to refer to homes themselves when they are covered with vinyl siding (See St. Louis Post-Dispatch, March 22, 1998; Arizona Republic, June 23, 2001; and Washington Post, May 10, 2001). Other products used in building or maintaining a home are referred to as vinyl-clad such as closet shelving (Orlando Sentinel, July 1, 2001), windows (Ventura County Star, May 31, 2001; Chicago Tribune, March 2, 2001), building products (Plastics News, March 5, 2001), cupolas (www.vwdcorp.com), railings (Best Homes website), and shelves (www.glenwoodvillage.com).

Applicant also argues that its garage door panels are made of "a pressed wood panel, compressed under heat and pressure, and then ... coated with a clear vinyl." Br. at 5. While applicant's identification of goods is not limited to wood, it is interesting to observe that vinyl clad is frequently used to describe wood products covered with a vinyl coating. See, e.g., *St. Louis Post-Dispatch*, March 22, 1998 and *Chicago Tribune*, March 2, 2001 (vinyl-clad wood frame windows); *Trailer Life*, November 1, 1999 ("The ceilings and interior walls are vinyl-clad 3/16-inch lauan plywood"); and www.vwdcorp.com ("Vinyl Clad Cupolas - Cupolas are manufactured using Wood wrapped with PVC coil (vinyl coated aluminum)). Furthermore, windows are described as wood, vinyl-clad wood, aluminum-clad wood, all-aluminum, vinyl, fiberglass, and steel. Vinyl-clad wood windows are "[g]enerally more expensive than wood, it combines wood with a vinyl exterior that is highly resistant to weather damage." www.improvenet.com. Finally, the evidence also shows that various doors are often described as "vinyl clad."

MW vinyl clad windows and doors are the premium choice for homeowners.
www.mvwindows.com.

Pollard Windows - Vinyl-Clad windows and doors
www.customwindows.com.

For our job, we installed an Anderson Frenchwood hinged patio door... It's a wooden model that's vinyl-clad on the exterior with unfinished interior surfaces.

Popular Mechanics, May 1, 2000.

36" residential Vinyl Clad Steel Front Door w/ Storm.
www.glenwoodvillage.com

VINYL-CLAD series Storm Doors

- High-impact-resistant solid wood core won't twist, rattle or warp.

- While vinyl exterior is maintenance-free, and scratch and rust-resistant.

www.larsondoors.com.

Based on this record, we conclude that applicant's mark is merely descriptive. Applicant's goods meet the definition of being clad with vinyl or VINYLCLAD. Furthermore, the evidence demonstrates that the products made of wood and coated with vinyl are referred to as "vinyl clad." Clearly the term "vinyl clad" would have descriptive significance in the home building and maintenance industry as a result of its use on a wide variety of products including doors and windows. When applicant would use the term VINYLCLAD on closely related products, garage door panels, molding, and millwork made primarily of non-metal, the term would merely describe the fact that applicant's goods, like other building products, are covered with vinyl. Therefore, inasmuch as applicant's mark identifies a feature or characteristic of applicant's goods, it is merely descriptive.

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Decision: The examining attorney's refusal to register the term VINYLCLAD on the ground that the mark is merely descriptive of the involved goods is affirmed.