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Mailed:

September 16, 2005
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sagoma Plastics Corp.

Serial No. 76172450

James C. Wray, Esq. for Sagoma Plastics Corp.

Julie A. Watson, Trademark Examining Attorney, Law Office 113
(Odette Bonnet, Managing Attorney).

Before Hohein, Bucher and Drost, Administrative Trademark Judges.
Opinion by Hohein, Administrative Trademark Judge:

Sagoma Plastics Corp. has filed an application to register on the Principal Register the term "IN MOLD HOLOGRAM" for "molding machines, molds, tooling and parts therefor for creating fine pattern capable of producing holographic images directly on surfaces of molded and formed parts and products" in International Class 7.¹

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that, when used in connection with applicant's goods, the term "IN MOLD HOLOGRAM" is merely descriptive thereof.

¹ Ser. No. 76172450, filed on November 29, 2000, which is based on an allegation of a bona fide intention to use such term in commerce.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of such use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Applicant contends in its brief that the term "IN MOLD HOLOGRAM," when used in connection with its "molding machines, molds, tooling and parts therefor for creating fine pattern capable of producing holographic images directly on surfaces of molded and formed parts and products," "means nothing or at the most is suggestive." In particular, applicant asserts, although notably without any explanation, that the term "IN MOLD HOLOGRAM does not define the goods and is not a key element" thereof. Such term, applicant simply urges, "does not reveal what the referenced goods are and requires a ... leap of imagination," arguing that any "descriptiveness of the components [thereof] is lost in the combination of the terms[,] making the mark merely suggestive of the ... [goods] described."

Applicant additionally states that "[t]he buyers of the goods--[which are] parts used to create fine patterns capable of producing holographic images directly on the surface of formed parts--are the relevant public." An "appreciable number" of such purchasers, applicant insists, would "need to stop and think what the mark means," thereby indicating that it is suggestive rather than merely descriptive. Moreover, as to whether there is a competitive need for other sellers in the trade to use the term "IN MOLD HOLOGRAM," applicant maintains that:

The prohibition against registration of merely descriptive designations is intended to prevent one party from precluding all others from fair use of descriptive terminology in connection with goods ... which are described thereby. Nothing in the record suggests that others in the relevant field have used or would need to use IN MOLD HOLOGRAM to describe their goods. Here, non-

use [sic] supports the Applicant's argument that the mark is not merely descriptive and that the mark is more properly classified as ambiguous or suggestive in the least, when analyzed in light of the goods associated with the mark.

The Nexis article cited by the Examiner is not relevant to ... finding the mark merely descriptive. Relevant consumers would not need to use the mark IN MOLD HOLOGRAM in order to describe products. The cited article itself refers to the Applicant's product. The only mention of IN MOLD HOLOGRAM is in the title of the article. No mention of IN MOLD HOLOGRAM was used to describe any similar technology in the body of the article.

Previous searches by the Examining Attorney did not reveal any previous articles that used the words "in mold hologram" at all. This indicates that the relevant industry does not need to utilize the mark in order to function in the marketplace. The lack of use of "in mold hologram" also indicates that IN MOLD HOLOGRAM is not merely descriptive, but instead should be registered.

The Examining Attorney, on the other hand, asserts in her brief that the term "IN MOLD HOLOGRAM" is merely descriptive "of a feature of the goods" because "applicant's 'molding machines, molds, tooling and parts therefor' will create holograms and apply those holograms to products while still in the product mold." The Examining Attorney, in support of her position, notes that applicant answered "yes" in response to each of the following inquiries which she raised in one of her Office actions: (i) "Will the applicant's molding machines have the capacity to create holographic images and apply those holographic images during the molding process directly on the surfaces of molded and formed parts and products?"; and (ii) "Will the

applicant's molding machines have the capacity to apply in mold labeling, decorations or finishing of any kind?" Citing, furthermore, the various dictionary definitions of record of the word "hologram" which are set forth below, the Examining Attorney points out with respect to the identification of applicant's goods that the "holographic images" which its molding machines, molds, tooling and parts therefor produce directly on the surfaces of molded and formed parts and products are known as "holograms":

(i) "1. The pattern produced on a photosensitive medium which has been exposed by holography and then photographically developed. 2. The photosensitive medium so exposed and so developed." -- The American Heritage Dictionary of the English Language (3d ed. 1992);² and

(ii) "**1. three-dimensional photographic image:** a three-dimensional image of an object that is a photographic record of light interference patterns produced using a photographic plate and light from a laser." -- Encarta World English Dictionary (2004).

As additional support for her position, the Examining Attorney contends that "the article excerpts taken from the ... search of the NEXIS® computer database and ... [made of record] indicate that 'in mold' is a term of art in the relevant industry," pointing in particular to the following excerpts from the trade publication Plastic News (emphasis added):

² The same dictionary, we note from the record, also defines in relevant part the word "in" as meaning "1. a. Within the limits, bounds, or area of" and lists "mold" in pertinent part as connoting "1. A hollow form or matrix for shaping a fluid or plastic substance. 2. A frame or model around which something is formed or shaped. 3. Something that is made in or shaped on a mold."

"In a demonstration . . . , Battenfeld GmbH of Meinershagen, Germany, molded car-body bumpers using three injection units and **in-mold** decorating." -- January 25, 1999;

"About two months ago, Precise acquired Phaff BV, a Zevenhuizen, Netherlands, injection molder specializing in **in-mold** labeling and high-speed decorations." -- July 17, 2000;

"The acquisition allows the combined company to take advantage of Eimo's strengths in automation technologies, **in-mold** decorating and advanced finishing" -- July 17, 2000; and

"[T]he company has teamed up with an injection molder to offer what it is touting as a potentially 'revolutionary' advancement in security--holograms embedded in plastic molds.

ABNH unveiled the process at Pack Expo 2000 in Chicago. The company claims it can replace the more traditional method of **in-mold** decoration or attaching a holographic sticker to the finished product. -- November 20, 2000 (article headlined: "**In-mold holograms** are reality for ABNH").

Also of record, we observe, from the same trade journal are other pertinent excerpts, including the following (emphasis added):

"It also makes **in-mold** labels for injection molding." -- October 12, 1998;

"Precise invested \$10 million in an existing facility to form a new subsidiary, Precise IML, an injection molding operation dedicated to **in-mold** labeling" -- May 20, 2000; and

"The Decoform press will allow Delta to test both traditional injection molded parts and those made using **in-mold** lamination

. . . .
The Decoform horizontal press offers both traditional injection molding and **in-mold** lamination Previously, **in-mold** lamination was done on vertical presses." -- June 20, 2000 (article headlined: "Delta tells N. America of **in-mold** lamination").

Further "evidence that the wording 'in mold' is a term of art in the industry," the Examining Attorney contends, consists of copies in the record of several third-party registrations which "show IN MOLD used descriptively with the identification of goods [and services]." Examples thereof include Reg. No. 2,611,951 (issued on August 27, 2002 for the mark "NORTHERN ENGRAVING"), which covers "**in-mold** decorating ... of metal and plastic parts"; Reg. No. 2,482,711 (issued on August 28, 2001 for the mark "AUTOFLEX XTRAFORM"), which sets forth "formable plastic sheets and films for use in printing, display and/or **in-mold** decoration purposes, namely, a process whereby a design may be applied or imbedded in a mold"; and Reg. No. 2,476,685 (issued on August 7, 2001 for the mark "STYLECOAT"), which lists "**in-mold** coating compositions for use in the manufacture of molded plastic articles" (emphasis added).

Moreover, although not mentioned by the Examining Attorney in her brief, we note with respect to use of the term "in-mold" in the holographic or hologram labeling industry that the record contains an excerpt from applicant's website which, in reference to its "In-Mold Holograms™" products, contains the following statement (emphasis in original): "**In-Mold Holography** is our patented and other patents pending technology that facilitates the incorporation of holography into plastic products in an efficient and cost effective way." Similarly, while not noted by the Examining Attorney in her brief, the record reveals several excerpts from other websites which variously use "in-

mold" as a term of art in the field of holographic or hologram labeling as follows (emphasis added): (i) "**In-mold** labeled containers"; (ii) "prelabeled thermoformed parts" which are "[d]one **in-mold**"; (iii) "**In-Mold** Decorating Equipment"; (iv) "**In-Mold** Labels"; and (v) "**In-Mold** Labeling Makes Strides Worldwide." The latter, we also observe, is the headline for an article about "The ninth annual International In-Mold Labeling Conference," which was reportedly held "in Amsterdam, Netherlands, Sept. 26-27, 2000." Such article indicates, *inter alia*, that (emphasis added):

In-mold labels keep making inroads as technologies and materials improve.

....

Successful **in-mold** label production requires special ink formulations, printing processes, and converting needs.

Lastly, the Examining Attorney relies upon certain additional Internet excerpts which she made of record, including an excerpt from applicant's website. Such excerpts, she insists, "indicate that the applicant's molding machines will be used to produce a 'hologram master' that 'is incorporated into the mold'." In particular, the excerpt from applicant's website recites, *inter alia*, that (bold in original; italics added as emphasis):

Holograms Are Images capable of **recording 3D information** on flat surfaces using the interference of light.

....

*With In-Mold™ Holography, a hologram master is **incorporated into the mold** and the*

holographic image is formed as the plastic product is being produced.

*Because In-Mold™ Holograms are **formed simultaneously with the part**, and are not a sticker or label, **it saves time and money** for our clients while adding a higher level security and unique visual appeal.*

Another Internet excerpt, which consists of a third-party article (dated September 8, 2004) on means of combating counterfeiting in the fabricated plastic products industry, discusses various authentication technologies, including the use of holograms. In pertinent part, such article indicates that (emphasis added):

To combat the problem of counterfeiting, producers of plastic products and the resins that go into them are enlisting a handful of authentication technologies. These include the use of micro-particle tags, identifying pigments and dyes, radiofrequency identification tags, **holographic label designs**, and laser marking systems that inscribe indelible bar-codes.

....

The three-dimensional images of a hologram, which are difficult for counterfeiters to copy, are already common security features in credit cards, currency, and bond certificates. **Plastics packagers have also begun to adopt holograms**, both for brand differentiation and product protection. Among the plastic packaging films on which holograms are commonly imprinted are PVC, PET

....

Transferring holographic images to a plastic film is a multistep process that usually involves applying an embossable coating to the film offline before the hologram can be imprinted. A recent development is the introduction ... of a PET film that can be directly embossed with a hologram without the need for a separate coating operation. The product is said to

speed commercialization of new holographic patterns.

Another innovation is a technology that allows holograms to be applied to a plastic part while it is being injection molded. This is done by means of a holographic master plate that is inserted into the mold before processing begins. The advantage of **in-mold holography** is that it saves time and money for processors, who don't have to apply the holograms in a separate step.

Based upon the excerpts noted above and the other evidence of record mentioned in her brief, the Examining Attorney concludes that because "applicant's goods will be used to make in mold holograms," it follows that "the proposed mark, IN MOLD HOLOGRAM, is [merely] descriptive of a feature of the goods and is unregistrable on the Principal Register." Citing, *inter alia*, In re Tower Tech Inc., 64 USPQ2d 1314, 1317-18 (TTAB 2002) [term "SMARTTOWER" found merely descriptive of "commercial and industrial cooling towers and accessories therefor, sold as a unit"]; In re Sun Microsystems Inc., 59 USPQ2d 1084, 1087 (TTAB 2001) [term "AGENTBEANS" held merely descriptive of "computer software for use in the development and deployment of application programs on a global computer network"]; and In re Copytele Inc., 31 USPQ2d 1540, 1542 (TTAB 1994) [term "SCREEN FAX PHONE" found merely descriptive of "facsimile terminals employing electrophoretic displays"], the Examining Attorney properly notes that while, "[a]s applicant correctly indicates, a mark that combines descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning," she insists that "if, as is the case with applicant's mark, each

component retains its descriptive significance in relation to the goods ..., the combination results in a composite that is itself [merely] descriptive." Finally, citing, inter alia, In re Acuson, 225 USPQ 790, 792 (TTAB 1985) [term "COMPUTED SONOGRAPHY" held merely descriptive of "ultrasonic imaging instruments"], the Examining Attorney correctly points out that "the fact that the applicant may be the first and sole user of a merely descriptive combination of words does not justify registration where the evidence shows that the terms are merely descriptive of the identified goods."

Upon consideration of the evidence and arguments presented, we agree with the Examining Attorney that, when considered in its entirety, the term "IN MOLD HOLOGRAM" is merely descriptive of applicant's "molding machines, molds, tooling and parts therefor for creating fine pattern capable of producing holographic images directly on surfaces of molded and formed parts and products." The dictionary definitions, "NEXIS" articles and Internet excerpts made of record by the Examining Attorney, along with applicant's answers to the inquiries which she specifically raised concerning the "capacity" or function of applicant's goods, demonstrate that the term "IN MOLD HOLOGRAM" immediately conveys, without the need for speculation or conjecture, that a significant feature, purpose or use of such goods is that they produce an in-mold hologram directly on the surfaces of molded and formed parts and products. In the context of applicant's goods, there is nothing in the term "IN MOLD HOLOGRAM" which, to the technologically sophisticated purchasers

of applicant's molding machines, molds, tooling and parts thereof, is incongruous, ambiguous or even suggestive, nor is there anything which would require the exercise of imagination, cogitation or mental processing, or necessitate the gathering of further information, in order for the merely descriptive significance thereof to be readily apparent to such customers. Instead, the term "IN MOLD HOLOGRAM" conveys forthwith that a significant aspect of applicant's goods is that they enable the creation, while the plastic product being produced is in the mold (i.e., "in-mold"), of a holographic image (i.e., "hologram") directly on the surface of such product. Accordingly, based on the evidence of record herein, the term "IN MOLD HOLOGRAM" has been shown to be merely descriptive of applicant's goods within the meaning of the statute.

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