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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Glendale International Corp.**

Serial No. 76173905

Bruce A. Tassan of Tassan Law Firm for Glendale International Corp.

Barbara A. Gaynor, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

Before Seeherman, Quinn and Rogers, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Glendale International Corp., a Canadian corporation, has appealed from the final refusal of the Trademark Examining Attorney to register TITANIUM as a trademark for goods ultimately identified as "recreational vehicles, namely, a vehicular type unit primarily designed as

temporary living quarters for recreational, camping, travel or seasonal use that is mounted on or towed by another vehicle, namely, camping trailers, fifth wheel trailers, travel trailers, and truck campers."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 applicant's mark is deceptively misdescriptive of its identified goods.

Applicant and the Examining Attorney have filed appeal briefs. Applicant did not request an oral hearing.

As a preliminary matter, we note that after the appeal was filed applicant submitted a request for remand in order to make of record an affidavit by its president. The Board denied the request because the additional evidence could have been submitted at the time the appeal was filed. Nevertheless, applicant submitted a copy of the affidavit with its brief, to which the Examining Attorney objected.² The affidavit not being of record, it has been given no consideration.

¹ Application Serial No. 76173905, filed December 1, 2000, based on Section 1(b) of the Trademark Act (intent-to-use) and also asserting a claim of priority pursuant to Section 44(d), based on a Canadian application filed on October 27, 2000. Applicant does not base its application on Section 44(e).

² Applicant referred to the affidavit as being the subject of a request for remand, and included it as an exhibit, as part of its recital of the prosecution history. Applicant did state that the request for remand had been denied. However, given that the Board stated that the affidavit would not be allowed into the record, applicant should not have submitted it with its brief.

The test for deceptive misdescriptiveness was set out in *In re Quady Winery Inc.*, 221 USPQ 1213, 1214 (TTAB 1984):

The test for deceptive misdescriptiveness has two parts. First we must determine if the matter sought to be registered misdescribes the goods. If so, then we must ask if it is also deceptive, that is, if anyone is likely to believe the misrepresentation.

See also, *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047 (TTAB 2002); *In re Woodward & Lothrop Inc.*, 4 USPQ2d 1412 (TTAB 1987).

Titanium, as the record shows, is "a strong, low-density, highly corrosion-resistant, lustrous white metallic element that occurs widely in igneous rocks and is used to alloy aircraft metals for low weight, strength, and high-temperature stability."³ Applicant has acknowledged that its goods do not contain any titanium, so the first part of the deceptive misdescriptiveness test has been met. It is with respect to the second part of the test that applicant and the Examining Attorney differ.

See *In re Psygnosis Ltd.*, 51 USPQ2d 1594 (TTAB 1999), in which the Board sanctioned an applicant for attempting to circumvent a Board order denying a motion to waive the page limitation for an appeal brief.

³ The American Heritage Dictionary of the English Language, 3d ed. © 1992.

It is applicant's position that titanium is not used in recreational vehicles of the type identified in its application and is too expensive to be used for such purpose and, therefore, that consumers will not believe that titanium is a component of applicant's products. The Examining Attorney, on the other hand, contends that it is plausible for consumers to believe that recreational vehicles, or components of them, are made in whole or in part of titanium. In support of her position, she has made of record excerpts taken from the NEXIS database, some of which are shown below:

More aluminum and aluminum-alloy products, such as titanium, are finding their way into automobiles and recreational vehicles. Not only do these materials make vehicles lighter (500-800 lb lighter than those just 10 or 15 yr ago), but they also make them more structurally sound.
"Tooling & Production," June 1996

Pierce's 410 car has the titanium components in the frame that make it lightweight and fast like an Outlaws vehicle. A 410 car on the Outlaws tour is between 1,000 and 1,200 pounds, much lighter than the 1,325-pound regulation....
"The News Tribune," August 17, 2001

Titanium seems to be a material of interest—although let's face it: with titanium we are talking about comparatively exotic vehicles, not the run-of-the-road sorts of things that most of us roll in.

"Automotive Manufacturing & Production," May 2001

The use of titanium instead of steel in automotive suspension system coil springs can reduce the space requirements in the undercarriages of vehicles, according to Titanium Metals Corp.

American Metal Market," April 2, 2001

In a typical American-built five-or six-passenger family vehicle like a Ford Taurus, Chevrolet Impala or Dodge Intrepid, Timet spokesmen said a total savings of 20 to 30 pounds per car would be achieved just by converting the four coil springs to titanium.

"American Metal Market," February 19, 2001

Those are some of the virtues of the recently introduced titanium tailpipe/muffler assemblies on the new Chevrolet Corvette Z06 for 2001. The fabricator of the assemblies, ArvinMeritor Inc., Troy, Mich., and the supplier of the metal, Titanium Metals Corp. (Timet), Denver, Col., are hoping the public appreciates these qualities and encourages automakers to put more exhaust systems of this kind into use on this vehicle...

Executives of ArvinMeritor believe titanium exhaust system components are extremely promising for the future in the North American Auto industry, where durability, fuel economy and vehicle performance are becoming increasingly important.

...

Timet officials think titanium in the other forms mentioned above also can be used to achieve significant weight savings and durability improvements in additional areas of family vehicles,

including engine components, drive-train parts positioned downstream from the transmissions, suspension system applications, and structural parts.
"American Metal Market," October 6, 2000

Titanium-based alloys also now are formed and shaped into things as diverse as automotive mufflers, valves and lifters; architectural panels and other components; marine vehicles and equipment; medical implants;....
"Purchasing Magazine," July 13, 2000

Automakers are interested in titanium because, even though it costs several times more than stainless steel, the lighter systems prevent redesigned vehicles from advancing to a heavier EPA weight class.
"Ward's Auto World," September 1998

A titanium alloy division specifically to serve the automotive industry has been launched by Titanium Metals Corp., Denver, Colo. ... The amount of titanium in automobiles, trucks, and motorcycles is forecast to be 1100 metric tons in 2002. This compares with 100 metric tons in 1995.
"Advanced Materials & Processes," March 1, 2002

...Research said 'meaningful acceptance' of titanium by the auto industry may still be five years in the future.

'The cost of titanium is far too expensive for the Big Three (automakers) to begin accepting the material on all of the automotive models, but we see tremendous opportunities within the luxury and sporting vehicles,' Olin said.
"The Denver Post," January 6, 2002

Headline: Fully 'Vette-ed; General Motors' 2002 Z06 takes America's sports car to its highest level

The exhaust system is a first for the auto industry in a mass-market vehicle: It uses titanium in the twin mufflers and tailpipes.

"San Antonio Express-News," January 4, 2002

In street-vehicle applications, titanium is used for engine valves, connecting rods, wheel-rim screws, exhaust systems, and suspension springs.

"American Machinist," January 1, 2002

Headline: Ford says what's inside counts

"By and large, automakers use the same key technologies and offer the same types of vehicles, but it's still possible to set your products apart with better materials, greater use of leather, wood and titanium finishes, and more attention to detail."

"The Washington Times," August 2, 2002

Headline: Ford Focus for the future
Using lightweight materials such as magnesium, aluminum, and titanium knocks 400 lb off the vehicle.

"Machine Design," June 20, 2002

Headline: Infiniti G35 will win a lot of friends; Sedan paves way for sports car due out in 2003

Test vehicle: 1002 Infinite G35 rear-drive sport sedan

Standard features include: Leather and titanium interior, automatic climate control, six-way power-adjustable driver's seat

"The Atlanta Journal and Constitution," June 14, 2002

Applicant is correct that these articles are not persuasive evidence of routine current use of titanium in recreational vehicles. However, they indicate that titanium can be used in recreational vehicles, that there is a trend to increase the use of it in vehicles, and that titanium can be used in suspension coil springs. Such springs could be used in mounted or towed recreational vehicles. Further, the articles show that there is an advantage to using titanium in recreational vehicles because it is lighter in weight, and therefore it can increase fuel economy. Also, as "The Washington Times" article indicates, titanium is a selling feature.

Thus, although titanium may not at this time be used routinely as a component in recreational vehicles, it appears that it may be so used in the future. Consumers who are familiar with the usage of this element in vehicles, and the trend to expand such usage, would not regard TITANIUM as being merely a fanciful use of a term for recreational vehicles.

Rather, consumers familiar with the benefits of titanium would conclude, upon seeing the mark TITANIUM used in connection with applicant's identified recreational vehicles, that the vehicles contain titanium, or that titanium is used in fabricating some of the parts of the

vehicles. Thus, they are likely to believe the misdescription. This belief would be reinforced by applicant's own promotional brochure, which emphasizes the advanced composite materials used in its products and the lighter weight of its materials:

While other RV manufacturers are talking about advanced manufacturing techniques and composite materials, we are putting ours to the test.

LITE WEIGHT composite materials are used during production which provide significant reduced overall Weight.

Applicant argues that, because recreational vehicles such as applicant's can cost between \$25,000 and \$50,000, they will be bought by very sophisticated purchasers. Generally the cost of goods is a duPont factor to be considered in connection with the issue of likelihood of confusion. To the extent that applicant is suggesting that consumers will go behind the trademark to determine whether its products contain any titanium, there is no evidence to support the contention that consumers would make such an investigation. The Examining Attorney is not asserting that the misrepresentation that applicant's goods contain titanium would be material to the decision to buy such goods. If that were the case, the refusal of registration

would be made under Section 2(a) (deceptiveness), rather than Section 2(e)(1). Because the Examining Attorney does not contend that the presence of titanium in applicant's goods is a material element in the purchasing decision, we cannot assume that purchasers would inquire as to whether the goods contain titanium. Moreover, there is an inherent problem in requiring consumers to go behind the trademark in order to counteract the misdescription of the trademark.

In any event, the fact that applicant's TITANIUM recreational vehicles are expensive is more likely, rather than less likely, to cause consumers to believe that such products do, in fact, contain titanium. As applicant has pointed out, titanium is an expensive element. Therefore, consumers would expect goods that contain titanium to be expensive. Further, sophisticated purchasers are likely to know about the trend to use titanium in vehicles.

Finally, applicant has submitted third-party registrations for marks containing the words GOLD and SILVER for goods it characterizes as vehicles and vehicle parts.⁴ Applicant points to these registrations as

⁴ Applicant submitted copies, taken from the U.S. Patent and Trademark Office records, of the third-party registrations for the GOLD marks, but submitted only a listing for SILVER marks, which does not show the goods for which they are registered. Such a listing is insufficient to make such registrations of record. However, because the Examining Attorney never objected

indicating that the Office has allowed other precious metal marks to be registered for such goods. We are not persuaded, on the basis of these registrations, that TITANIUM should be registered. The Board is not bound by prior decisions of Examining Attorneys, but must decide each case on its own merits. In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). In this case we have evidence that titanium can be used in recreational vehicles and other vehicles; we do not know whether there was any evidence in the GOLD and SILVER applications that such metals could have been used in the various goods listed therein, e.g., severe duty disc brake pads and shims, sold as a unit for land vehicles;⁵ cleaning, polishing and protecting preparations for motor vehicle tires;⁶ and travel trailers, fifth wheel trailers, park trailers, motor homes.⁷ We also agree with the Examining Attorney that the term "gold" has a laudatory significance that "titanium" does not have. As for the SILVER registrations, it is clear even from the mere list of marks which is of record that the term "silver" as used in those

to the form of this listing, we have considered the list for the very limited probative value it has.

⁵ Registration No. 2131722 for GOLD MAX.

⁶ Registration No. 2032861 for TIRE GOLD.

⁷ Registration No. 2014343 for GOLD.

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marks would not be regarded as referring to the metal, e.g., in SILVER EAGLE "silver" modifies the noun, while QUICKSILVER is another word for mercury.

In conclusion, we find that, because applicant's goods do not contain titanium, and because consumers are likely to believe, upon viewing the mark TITANIUM in connection with applicant's goods, that they do contain this element, applicant's mark TITANIUM is deceptively misdescriptive of its goods.

Decision: The refusal of registration is affirmed.