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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Lincoln Global, Inc.

Serial No. 76429068

Robert V. Vickers of Fay, Sharpe, Fagan, Minnich & McKee,
LLP for Lincoln Global, Inc.

Brian J. Pino, Trademark Examining Attorney, Law Office 114
(Margaret Le, Managing Attorney).

Before Walters, Chapman and Bottorff, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On July 1, 2002, Lincoln Global, Inc. (a Delaware corporation) filed an application, based on Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), to register the mark ARCWELD on the Principal Register for various goods classified by applicant in International Class 9.

Applicant ultimately amended the goods in three classes with the basis for each class set forth therewith as follows:

"welding consumables, namely, welding fluxes" in International Class 1 (based on applicant's assertion of a bona fide intention to use the mark);

"welding consumables, namely, welding wire and welding rods" in International Class 6 (based on applicant's claimed date of first use and first use in commerce of September 2000); and

"electric arc welders, wire feeders, and welding electrodes" in International Class 9 (based on applicant's assertion of a bona fide intention to use the mark).

Applicant included in the original application a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), based on its claim of "substantially exclusive and continuous use thereof as a mark by applicant in commerce ... for a substantial time prior to filing of the application." Also in the initial application is applicant's claim of ownership through a related company of Registration No. 2554211 issued March 26, 2002 on the Supplemental Register to Lincoln Electric Company of Canada Limited (a Canada corporation) for the mark ARCWELD for "welding electrodes and welding wire for welding applications" in International Class 9.

The Examining Attorney made final his refusal to register the mark because it is merely descriptive of the goods in all three classes, and applicant's proof of

acquired distinctiveness is insufficient. See Sections 2(e)(1) and 2(f) of the Trademark Act, 15 U.S.C. §§1052(e)(1) and (f). He also made final his requirement for full compliance with the request for information under Trademark Rule 2.61(b).

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

Turning first to the Examining Attorney's requirement for information under Trademark Rule 2.61(b) in the Office action dated July 8, 2003, the Examining Attorney acknowledges that information has been provided, but he contends that he did not request information in the form of advertisements or other materials, but rather he requested direct answers to three specific questions, which he contends would "help the Examining Attorney place the existing evidence of record in the proper context."

(Brief, p. 4.)¹

Applicant contends that it has provided significant information which responds to the questions, albeit not in

¹ The Examining Attorney's three questions to applicant are the following: (1) "Does ARC WELD have any significance as applied to the goods or services other than trademark significance?"; (2) "Does ARC WELD have any significance in the relevant trade or industry other than trademark significance?"; (3) "Are the goods used for arc welding?"

"yes" or "no" form; and that applicant specifically responded to the third question through its statement that applicant's goods "are used in connection with the process of arc welding by an arc welder." (Response dated May 15, 2003, p. 2.)

Certainly, the Examining Attorney's requirement under Trademark Rule 2.61(b) for additional information about the goods was appropriate. However, having reviewed this record, we find that applicant has adequately responded to the questions asked. Applicant has complied with the Examining Attorney's request for information.

We turn to the Examining Attorney's refusal to register the mark on the Principal Register under Section 2(f) based on his assertion that applicant has submitted insufficient evidence of acquired distinctiveness.

"Applicant acknowledges that the mark of this application is merely descriptive for the recited goods." (Applicant's brief, p. 2.) "Applicant has conceded that 'arc weld,' ARC WELD or ARCWELD is merely descriptive for the goods of this application." (Applicant's reply brief, p. 2.)" Thus, the issue of mere descriptiveness is not before the Board. Rather, the only issue before us is whether applicant has submitted sufficient evidence to establish that the mark

has acquired distinctiveness under Section 2(f) as to any or all of the three classes of recited goods.

Applicant has the burden of establishing that its mark has become distinctive. See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988).

The question of acquired distinctiveness is one of fact which must be determined on the evidence of record. As the Board stated in the case of *Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1999 (TTAB 1986):

[e]valuation of the evidence requires a subjective judgment as to its sufficiency based on the nature of the mark and the conditions surrounding its use.

There is no specific rule as to the exact amount or type of evidence necessary at a minimum to prove acquired distinctiveness, but generally, the more descriptive the term, the greater the evidentiary burden to establish acquired distinctiveness. See *In re Bongrain International (American) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); and *Yamaha*, supra at 1008. See also, 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §§15:66 and 15:70 (4th ed. 2001).

The Examining Attorney's position is that he has shown that the mark is highly descriptive of these goods; and

that applicant's evidence does not establish acquired distinctiveness of the mark for the goods.

In support of his position that the mark is highly descriptive, the Examining Attorney submitted various evidence, including (i) printouts of pages from applicant's related company's web site; (ii) printouts of pages from third-party web sites; (iii) excerpts from numerous patents; (iv) a printout of a third-party registration; and (v) printouts of the first several pages from a Google search of the terms "arc weld."

Examples of the materials submitted by the Examining Attorney are set forth below:

"Welding Terms ...

Arc Welding A welding process where similar materials are joined with a heating process caused by an electric arc. In the most common use, this process includes the use of filler metal. ...

MIG Welding (Metal Inert Gas) Also known as wire-free welding, although it is possible to do wire-feed welding without the inert gas. Metals that are difficult to arc weld may be MIG welded." ...

www.savvyhomeadvice.com;

"Crater: The depression at the termination of an arc weld."

www.engineersedge.com;

"The AC-225 is Lincoln's best selling arc welder of all time. It has a broad welding amperage range of 40-225 amps. The AC-225 produces an extremely smooth

AC arc for welding a wide variety of materials including carbon, low alloy, and stainless steels as well as cast iron. Metals 16 gauge and heavier can be easily arc welded with the AC-225."
www.lincolnelectric.com;

"Checkmate communication system
...Platform 22 will be adhered to clip 20 by means of solder, spot-weld or arcweld, but not necessarily be limited to this kind of adherence. ..."
United States Patent No. 5568786;

"Ladder means and method of production
...After all the parts of the ladder have been clamped into position, a welding machine 38 is employed to effect a plurality of arcwelds (or spotwelds in the case of sheet metal being used) and since the flanges of both rungs and stiles are stiffened by the beads along the edges, a single weld between each rung and the stile at each end will result in a very rigid and reliable structure. ..."
United States Patent No. 4655320;

"Arc Welding Machine
...The advantages resulting from the use of ceramic or other non-conducting material covered electrodes in arc-welding are well established, however, due to the fact that the covering is nonconducting, it has not been possible heretofore to arc-weld with covered electrodes without a considerable wastage of electrode material and undue prolongation of the operating time. ..."
United States Patent No. 2019971;

"Pulse Width Modulated Pulsed DC Arc Welding
...There are many situations where it is desirable to arc weld together two pieces of metal. For example, a heat exchanger for an air conditioning

system may be made from sections of thin wall aluminum tubing which are joined to provide a continuous circuit for the flow of a refrigerant. The sections must be joined so that there are no leaks. One method for accomplishing this is by arc welding. ..."

United States Patent No. 4403135;

"Center for Employment Training™
Welding

Trainees will master job related tasks in the following competency areas:

...Arc Welding Shielded Filler Metal:

Observe and describe methods and procedures to safely arc weld shielded filler metal; perform arc welding of shielded filler metal assignments and projects under supervision. ..."

www.cetweb.org;

"Passive Detector Reference Design
Review

Lawrence Livermore National Laboratory

...While compressed, the steel will be welded with a semi-automatic arc-weld tool. The arcweld time is less than 30 seconds, so the operation is quick and does not produce a great deal of smoke.

..."

www.numi.fnal.gov;

"Manufacturing Talk

Air-cooled MIG torch eases aluminum welding

Aluminum is notoriously difficult to arc weld, but a new, air-cooled torch with a servo-powered wire feeding is capable of wire speed feeds of over 34m/mm and has a 'push-pull' wire feeder. With manufacturers particularly in the automotive industry using more and more aluminum, which is notoriously difficult to arc weld, Motoman has developed a new, air-cooled

torch with servo-powered wire feeding specifically for this application."
www.manufacturingtalk.com;

"Joining Technologies
Precision Welding Services
First Fully Integrated LASERLATHE™
System

...Machine lathes are also utilized to precisely rotate a cylindrical workpiece for induction or torch brazing, cladding, and/or arc weld [sic--welding?] procedures. ...";
www.joiningtech.com; and

"power supply/controllers for supplying power to electric arc weld heads and for supplying power to torches" as the identification of goods in International Class 9, United States Registration No. 2641454.

Applicant contends that although the term ARCWELD is descriptive of the goods, it is not highly descriptive of the goods; that the Examining Attorney has not established the term is highly descriptive;² and that the evidence submitted by applicant establishes the mark has acquired

² In applicant's brief, p. 15, it requested that documents attached to the Examining Attorney's Office action dated February 25, 2004 "be stricken from the record," arguing that many do not include sufficient information to determine the origin of the web page, and that some are from regions outside the United States. The Board denies applicant's request because (i) the request to strike does not identify exactly which documents it wishes to have stricken and on what specific basis for each one; and (ii) the Board generally declines to strike evidence timely and properly introduced into the record, but rather considers it for whatever probative value it may have. See TBMP §1208 (2d ed. rev. 2004).

distinctiveness and identifies applicant as the source of these goods.

With regard to the Examining Attorney's evidence that the term ARCWELD is highly descriptive, applicant essentially contends that there are "millions" of Internet sites, "millions" of trademark registrations and applications, and "millions" of issued patents, but only a very small number of these "millions" of records have been presented by the Examining Attorney which include the term "arc weld." Applicant concludes therefrom that this "actually shows that the phrase 'arc weld' cannot be considered 'highly descriptive' for the goods of this application." (Applicant's request for reconsideration, p. 6.)³

Applicant submitted several scientific publications or dictionaries (e.g., McGraw-Hill Dictionary of Scientific and Technical Terms (Sixth Edition), ASTM Dictionary of Engineering Science & Technology, Dictionary of Mechanical

³ Applicant addressed almost each piece of evidence submitted by the Examining Attorney, criticizing it on some particular basis. Applicant also listed the types of evidence "considered useful to show that a mark is generic or highly descriptive." (Applicant's request for reconsideration, p. 7.) We point out that applicant's mark has not been refused registration as the generic term for these goods. Rather, the Examining Attorney has refused to register applicant's mark on the Principal Register under Sections 2(e)(1) and (f) as he finds the evidence of acquired distinctiveness insufficient.

Engineering (Fourth Edition), Illustrated Dictionary of Metalworking and Manufacturing Technology, and Marks' Standard Handbook for Mechanical Engineers (Tenth Edition) with information on and definitions of terms such as "weld," "arc welding," "electric arc welding" and "shielded metal arc welding." Applicant argues in connection therewith that it is not attempting to register "arc welder" or "arc welding" which are terms "used in the industry to name a machine for welding or to name the process of welding using an arc welder" and that the "phrase 'arc weld' is not commonly used and is not the proper use of these terms." (Applicant's request for reconsideration, p. 6.)

In support of its position and its claim of acquired distinctiveness, applicant submitted two declarations from applicant's attorney, Robert V. Vickers (dated May 13, 2003 and January 6, 2004).⁴ In the first declaration, counsel avers, inter alia, that "applicant is a leader in the welding field with hundreds of millions of dollars in sales and millions of products sold annually in the United

⁴ The Examining Attorney takes the position (brief, p. 8) that the declarations of applicant's attorney are not persuasive, citing the case of *In re Gray Inc.*, 3 USPQ2d 1558, 1560 (TTAB 1987), and its reference to potential "bias." Applicant's attorney argues in its reply brief (p. 3) that he is "very qualified in the field of welding." We have considered the declarations in deciding this case.

States"; that "applicant has used the ARCWELD mark [of this application] in connection with over 850,000 sales transactions in the United States"; that applicant is using the mark ARCWELD as a secondary house mark with its "famous LINCOLN house marks" for the goods recited in the application; that applicant has extensive substantially exclusive and continuous use of the mark ARCWELD since September 2000; that applicant has used the mark for the goods in International Class 6 since September 2000; and that applicant has a bona fide intention to use the mark on the goods in International Classes 1 and 9.

In the second declaration of the attorney, Mr. Vickers avers, inter alia, that "applicant believes that based on its use of ARCWELD as a secondary house mark with applicant's famous LINCOLN house marks alone, ARCWELD has become distinctive for applicant's welding products recited in [its application]"; that its "extensive, substantially exclusive and continuous use of ARCWELD in commerce since at least as early as September 2000 has made ARCWELD distinctive for the goods..."; that applicant has used the mark "in connection with more than 1.3 million units sold and more than \$3 million dollars [sic] in sales in the United States"; that during the period from January to October 2003, applicant has used the mark in connection

with over one-half million units sold and over \$400,000 in sales in the United States; and that "because a package of consumable electrodes can include dozens of individual electrodes" whereby the consumer would observe the mark each time an electrode is removed for use, "as a result, the consumer has observed the mark of this application more than 10 million times." ⁵ The attachments to the attorney's second declaration include pages from the various technical dictionaries and handbooks, a photocopy of applicant's label and a photocopy of its product packaging used in connection with the goods recited in the application, and non-United States advertisements and promotional materials (from, for example, Canada and Singapore).

Having carefully reviewed the evidence of record, we find that applicant has not established that the term ARCWELD has acquired distinctiveness as a mark for the goods identified in any of the three classes involved herein. We agree with the Examining Attorney that the term ARCWELD is highly descriptive in connection with the identified goods. ARCWELD is the legal equivalent of ARC

⁵ We note that "electrodes" are listed in the International Class 9 identification of goods, which is based not on use, but on applicant's assertion of an intention to use the mark in commerce for those goods. In any event, we agree with the Examining Attorney that this figure of 10 million, even if honestly "calculated," is speculation by applicant.

WELD. See *In re Gould Paper*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987). Contrary to applicant's arguments, the evidence quoted previously herein establishes that "arc welding" is a type of welding, and that the weld produced by arc welding is called an "arc weld." Absent any limitation in applicant's identifications of goods, we must presume that the goods are used (or are intended to be used) in all types of welding, including arc welding to create arc welds. Thus, ARCWELD is not only merely descriptive, but indeed is highly descriptive of this key feature and purpose of the goods.

At this juncture, we reiterate that only International Class 6 in this application is based on applicant's claim of use of the mark in commerce; the other two classes (International Classes 1 and 9) are based on applicant's assertion of a bona fide intention to use the mark in commerce. Thus, we presume applicant's information and evidence regarding use of the mark ARCWELD for the goods recited in the application relates to "welding consumables, namely, welding wire and welding rods" in International Class 6. We begin by considering the question of acquired distinctiveness of the term ARCWELD with respect to these identified goods in International Class 6.

Applicant has used the mark for only a few years. Applicant's total sales figures for the International Class 6 goods since September 2000 (\$3 million, 1.3 million units) do not appear to be particularly substantial on their face. Nor do we have any basis for determining applicant's market share for such goods, i.e., whether such share is anything more than de minimis. Applicant failed to submit evidence of its expenditures for advertising and promoting the goods sold under the mark. Thus, given the relatively high degree of descriptiveness of the mark, a more substantial showing of sales and advertising figures would be required to establish acquired distinctiveness.

Applicant's assertion that its use of the mark ARCWELD as a secondary house mark with its "famous LINCOLN house mark" is insufficient to establish acquired distinctiveness. There is no evidence that its house mark LINCOLN is famous. Even if evidence of the fame of the mark LINCOLN were of record, there is no basis for concluding that such fame has contributed in any way to purchasers' perception of ARCWELD as a mark, rather than a merely descriptive term.

In addition, the record is devoid of any direct information of relevant consumer recognition, such as declarations (or even form letters) from purchasers and/or

users of applicant's identified goods. This type of direct evidence is not required, but is generally more persuasive than, for example, a few years of sales figures, and an assertion that the mark is used with a "famous house mark." The evidence submitted by applicant does not establish that the term ARCWELD identifies and distinguishes the goods offered by applicant in the minds of relevant purchasers and users. Applicant has provided no evidence at all as to the relevant public's perception of the applied-for mark, nor evidence from which to infer the relevant public's perception.⁶

We note for the record that applicant has not argued that its ownership through a related company of a prior registration (No. 2554211) establishes acquired distinctiveness. Inasmuch as the registration is on the Supplemental Register, any such argument would have been unavailing. See Trademark Rule 2.41(b).

We find that applicant's evidence is insufficient to establish acquired distinctiveness in the highly descriptive term ARCWELD for the goods in International Class 6. See *In re Pennzoil Products Co.*, 20 USPQ2d 1753

⁶ Applicant submitted several non-United States advertisements and promotional materials, but those are not probative evidence as to the perceptions of persons in the United States.

(TTAB 1991); and *In re Redken Laboratories, Inc.*, 170 USPQ 526 (TTAB 1971). That is, applicant has not met its burden to show that the proposed mark has acquired distinctiveness as to the International Class 6 goods on which the mark is in use in commerce.

We turn now to the issue of acquired distinctiveness of the term ARCWELD in relation to the identified goods in International Class 1 ("welding consumables, namely, welding fluxes") and International Class 9 ("electric arc welders, wire feeders, and welding electrodes"), which are based on intent-to-use. The Board stated the following in the case of *In re Rogers*, 53 USPQ2d 1741, 1744 (TTAB 1999):

Neither the plain language of [Section 2(f) of] the Act, nor the legislative history thereof, precludes the filing of a claim of acquired distinctiveness, under Section 2(f) of the Act, in an intent-to-use application prior to the filing of an amendment to allege use or a statement of use in the application.

...
[A]pplicant must establish, through the appropriate submission, the acquired distinctiveness of the same mark in connection with specified other goods and/or services in connection with which the mark is in use in commerce...
[A]pplicant must establish, through submission of relevant evidence rather than mere conjecture, a sufficient relationship between the goods or services in connection with which the mark has acquired distinctiveness and the goods or services recited in the

intent-to-use application to warrant the conclusion that the previously created distinctiveness will transfer to the goods or services in the application upon use.

In this case, if applicant had established acquired distinctiveness for the mark ARCWELD for welding wire and welding rods in International Class 6 (which it has not done), then applicant could have at least argued that its use of the mark on those goods and the resulting acquired distinctiveness therein supports acquired distinctiveness of the mark for the other goods in International Classes 1 and 9. See generally, TMEP §1212.09(a) (3d ed. 2002).

A fortiori, the evidence is insufficient to establish acquired distinctiveness in the mark ARCWELD for the goods in International Classes 1 and 9, both classes being based on applicant's assertion of a bona fide intention to use the mark in commerce in the future thereon.

We conclude that applicant's evidence is insufficient to support its Section 2(f) claim, especially given the highly descriptive nature of applicant's mark ARCWELD.

Decision: Applicant is deemed to have complied with the Examining Attorney's request for information under Trademark Rule 2.61(b), and the refusal to register based on non-compliance with this requirement is reversed. The refusal to register the mark on the Principal Register

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under Section 2(e)(1) because applicant has failed to prove that the applied-for mark has acquired distinctiveness under Section 2(f) is affirmed for all three classes of goods.