

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Diamond Core Drilling and Sawing Company

Serial No. 76622449

Sherry H. Flax of Saul Ewing LLP for Diamond Core Drilling
and Sawing Company.

Kapil K. Bhanot, Trademark Examining Attorney, Law Office
108 (Andrew Lawrence, Managing Attorney).

Before Holtzman, Kuhlke and Mermelstein, Administrative
Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Diamond Core Drilling and Sawing Company, applicant,
has filed an application to register the mark DIAMOND CORE
DRILLING AND SAWING COMPANY (standard character form) on
the Principal Register for "commercial and residential
construction services, namely concrete cutting, core
drilling, and wall sawing" in International Class 37.¹

¹ Application Serial No. 76622449, filed November 22, 2004, under
Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), alleging
March 18, 1980 as the date of first use and first use in
commerce.

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 merely descriptive of its services, and its evidence of acquired distinctiveness is insufficient to entitle it to registration under Section 2(f).²

Applicant has appealed and both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

Inasmuch as applicant has amended its application to seek registration under Section 2(f) based on acquired distinctiveness, applicant has conceded that the phrase DIAMOND CORE DRILLING AND SAWING COMPANY is descriptive, and the only issue before us is applicant's assertion of acquired distinctiveness.³ *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988); *In re Cabot Corp.*, 15 USPQ2d 1224, 1229 (TTAB 1990). We note, in any event, that the examining attorney

² The first examining attorney required that applicant only disclaim the wording CORE DRILLING AND SAWING COMPANY on the ground that it is merely descriptive of applicant's services. Applicant submitted a disclaimer of the words which remains in the record; however, the only issue before the Board is the refusal pertaining to the entire mark as discussed above.

³ It is clear from the record that applicant did not seek registration under Section 2(f) in the alternative, and, therefore, the amendment acts as an admission of the mark's descriptiveness.

has submitted ample evidence to establish the mere descriptiveness of the phrase "diamond core drilling and sawing company" as shown below in the discussion relating to the highly descriptive nature of the phrase.

It is applicant's burden to prove acquired distinctiveness. *Yamaha, supra*, 6 USPQ2d at 1006; *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) ("[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant"). "[L]ogically that standard becomes more difficult as the mark's descriptiveness increases." *Yamaha, supra*, 6 USPQ2d at 1008. A claim that applicant has been using the subject matter for a long period of substantially exclusive use may not be sufficient to demonstrate that the mark has acquired distinctiveness. See *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1952 (TTAB 2001) (66 years of use). The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case, *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (CCPA 1970), and more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the goods or services would be less likely to believe that it indicates source in any one party. See *In re*

Bongrain International Corp., 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990). Evidence of acquired distinctiveness can include the length of use of the mark, advertising expenditures, sales, survey evidence, and affidavits asserting source-indicating recognition. However, a successful advertising campaign is not in itself necessarily enough to prove secondary meaning. In re Boston Beer Co. L.P., 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately eighty-five million dollars, and annual advertising expenditures in excess of ten million dollars, not sufficient to establish acquired distinctiveness in view of highly descriptive nature of mark).

It is the examining attorney's position that DIAMOND CORE DRILLING AND SAWING is highly descriptive and applicant's evidence is not sufficient to establish acquired distinctiveness. The examining attorney argues that the evidence shows that DIAMOND CORE DRILLING is a type of drilling which uses diamond-impregnated drill bits. Br. p. 4. Further, the examining attorney argues that the evidence also establishes that SAWING COMPANY is highly descriptive.

In support of his position, the examining attorney submitted evidence from third-party websites that show

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various combinations of the words in the phrase DIAMOND CORE DRILLING AND SAWING COMPANY widely used as terms of art in the drilling and sawing industry to describe various goods and services including the services applied for by applicant. See, for example:

Concrete Core Drilling Machines Hand-Held & Rig Mounted (Electric, Hydraulic & Pneumatic) Wet and Dry Diamond Drilling ...Diamond Core Drilling Machines ...
www.csunitec.com

All of our diamond core drills are manufactured with our exclusive metal bond ... Braemar can build your diamond core drills to suit your exact needs ... diamond core drills can be made with natural or synthetic diamonds, sieved to the desired grit size ...
www.bgsusa.com

High quality, long lasting diamond core drill bits manufactured to Concrete Sawing and Drilling Association (CSDA) standards.
www.kor-it.com

Diamond Core Drilling Accessories ... Our products include as follows: Diamond core bits Diamond reamer shells Drill rods Core barrels ...
www.tradekey.com

Unico Completes Phase II Diamond Core Drilling Program at the Deer Trail Mine ... The Phase II underground diamond core drilling program was primarily designed to target known horizons of mineralization and identify new mineralized horizons throughout the main ore channel of the Deer Trail Mine. The Deer Trail Mining Company, LLC reported that it has completed 7,235 feet of diamond core drilling and finished 13 underground drill holes.
www.findarticles.com

Diamond Core Drilling Services Suppliers ...
PowerSourcing is your best source for finding
diamond core drilling services suppliers. Use our
expansive on-line directory to source diamond core
drilling services and other products and services
from thousands of suppliers.
www.powersourcing.com

Lang Exploratory Drilling USA ... Provides rotary,
reverse circulation and diamond core drilling
services to the exploration, mining, water, energy
and construction industries.
www.boartlongyear.com

Ahtna Caron Drilling JV ... Alaska-based diamond
core drilling services.
www.minersmanual.com

Warren Diamond Core Drilling Services ... Business
types: Concrete Breaking Coring Cutting Drilling &
Sawing
www.allpages.com

Diamond Core Drilling Manufacturers Association
Acronyms.thefreedictionary.com
Class 16 Exploration Drilling Methods and Drill
Sections ... The two principle types of drilling
are diamond core drilling and reverse circulation
drilling ... Diamond core drilling uses a diamond
bit, which rotates at the end of drill rod ...
www.dmtcalaska.org

DOT Diamond Core Drilling is a full-service
concrete cutting business offering a wide range of
sawing and drilling expertise including wall
sawing, flat sawing, horizontal curb cutting, wire
sawing, hand sawing, bridge deck grooving, slab
sawing, and core drilling.
www.dotdrilling.com

Roughneck Concrete Drilling & Sawing Company
provides concrete cutting services including core
drilling ... and slab sawing ...
www.roughneck1.com

Concrete Wall Sawing Company, Inc., was founded in
1966 as a service-contracting company specializing

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in commercial and industrial concrete cutting and demolition. Our primary business is core drilling, sawing concrete walls and slabs, using diamond-tipped cutting tools.
www.cwsco.com

Taylor's Concrete Cutting Services, LLC ... Diamond Core Drilling and Sawing In the Business since 1982 ... Diamond Core Drilling ... We drill round holes ... in concrete, reinforced concrete ... Flat Sawing ... We cut slab openings, trenches ... Wall Sawing ... We can saw from 0" to 14" deep, or 28" deep if both sides are accessible.
www.taylorsccs.com

The examining attorney also submitted an excerpt from the website Wikipedia where "diamond core drilling" is described as utilizing "an annular diamond-impregnated drill bit attached to the end of hollow drill rods to cut a cylindrical core of solid rock." wikipedia.org.

Finally, the examining attorney submitted copies of third-party registrations where "diamond core drills," "diamond core drilling machines" or "diamond core bits" are listed in the identifications of goods. See, for example, Reg. Nos. 1489877, 1456173, 2608957, 0806675, 0938717, 0969568, 2038864 and 2164512.

We are persuaded by the evidence of record that the phrase DIAMOND CORE DRILLING AND SAWING COMPANY is highly descriptive of applicant's services.

As proof of acquired distinctiveness, applicant's attorney states that applicant has been using "using the

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mark continuously in interstate commerce for twenty-five (25) years, since 1981" (Response filed June 22, 2006) and that applicant has approximately 20 employees, has \$1.8 million in annual revenue and has spent approximately \$185,000 in advertising for its services in connection with the mark during the past five years (Response filed February 8, 2007).

Applicant submitted excerpts from various websites listing applicant's name and address. See e.g., www.allpages.com, washingtondc.citysearch.com, www.foremansfinder.com, www.constructionwork.com, www.thomasnet.com, www.thebluebook.com, and www.local.yahoo.com. Applicant also submitted a copy of a "transcript of a Montgomery County, Maryland Board of Education meeting that took place on March 21, 1983, that references Applicant as a low bidder on a construction project." Response filed June 22, 2006. Finally, applicant submitted an excerpt from the Maryland Department of Assessments and Taxation showing the date of applicant's formation as an entity.

After a careful review of the record, we find that applicant has not shown that the phrase "DIAMOND CORE DRILLING AND SAWING COMPANY" has acquired distinctiveness. Put simply, the evidence submitted by applicant does not

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serve to show that the relevant consumers recognize this phrase a mark. Thus, despite the many years of use, given the highly descriptive nature of the phrase, we do not find that DIAMOND CORE DRILLING AND SAWING COMPANY has come to signify the commercial source of the services, but rather continues merely to inform the consumers about the nature of the services.

Decision: In view of the fact that applicant has not shown that its mark is entitled to registration pursuant to Section 2(f) of the Trademark Act, the refusal under Section 2(e)(1) is affirmed.