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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hayward Baker Inc.

Serial No. 76632117

Royal Craig of Ober, Kaler, Grimes & Shriver for Hayward Baker Inc.

W.K.H. Price, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).

Before Quinn, Drost and Walsh, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

Hayward Baker Inc. (applicant) has applied to register FOUNDATION SERVICES in standard characters on the Principal Register for services now identified as "geotechnical construction services, namely, foundation rehabilitation, drilled foundations, earth retention/underpinning, injection services for expansive soils, namely the injection of products into soil for limiting heave due to expansive clays, strengthening railroad subgrades,

pavements and landfills and stabilizing slopes, site improvement, soil/slope stabilization, settlement control, excavation support, liquefaction mitigation and groundwater control, namely through chemical grouting and jet grouting service" in International Class 37. Applicant claims first use of the mark anywhere in December of 1985 and first use of the mark in commerce in 1990.

The Examining Attorney finally refused registration on the Principal Register under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), on the grounds that FOUNDATION SERVICES is merely descriptive of the identified services. Applicant subsequently amended the application to seek registration on the Supplemental Register. The Examining Attorney ultimately also finally refused registration on the Supplemental Register under Trademark Act Section 23, 15 U.S.C. § 1091, because FOUNDATION SERVICES is generic for the identified services.

Applicant appealed. Applicant and the Examining Attorney have filed briefs. We affirm.

Before addressing the merits, we must address one evidentiary issue. With its reply brief applicant submitted evidence for the first time, namely, a copy of a listing of USPTO electronic records related to certain third-party registrations and copies of selected electronic

records related to specific registrations from that listing. Trademark Rule 2.142(d), 37 C.F.R.

§ 2.142(d), requires that the record be complete prior to the filing of an appeal subject to certain exceptions not relevant here. Applicant's submissions with its reply brief are untimely, and we have not considered them.¹ We hasten to add that, if we had considered them, we would reach the same conclusions in this case.

We now turn to the merits. A term is generic if it identifies the class, genus or category of goods or services at issue. See *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

The Court of Appeals for the Federal Circuit provided a framework for the consideration of whether or not a term is generic in the *Fire Chief* case. Specifically, the Court dictated a two-step inquiry: "First what is the genus of goods or services at issue? Second, is the term sought to

¹ Applicant also attached new evidence to its main brief, specifically, a short listing of results from a search in the Google search engine, and a definition from an electronic dictionary. The Examining Attorney has not objected to this evidence and appears to have considered it. Therefore, we deem it of record, and we have considered this evidence for whatever probative value it possesses in deciding this case.

be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services." *H. Marvin Ginn Corp. v. International Assn. of Fire Chiefs, Inc.*, 228 USPQ at 530.

The ultimate test for determining whether a term is generic is the primary significance of the term to the relevant public. See Section 14(3) of the Act. See also *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999) and *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991). The Examining Attorney has the burden of establishing by clear evidence that the term is generic. See *In re Merrill Lynch, Pierce, Fenner and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). Evidence of the relevant public's understanding of a term may come from any competent source, including direct testimony of consumers, consumer surveys, newspapers, magazines, dictionaries, trade journals, catalogs, and other publications. See *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

As to the first question *Fire Chief* poses, the genus question, applicant and the Examining Attorney have taken slightly different positions. Applicant asserts that the relevant genus is "geotechnical construction services."

Applicant's brief at 7. The Examining Attorney asserts that the relevant genus is "geotechnical construction services, namely, foundation rehabilitation, drilled foundations, earth retention/underpinning, injection services for expansive soils, namely the injection of products into soil for limiting heave due to expansive clays, strengthening railroad subgrades, pavements and landfills and stabilizing slopes, site improvement, soil/slope stabilization, settlement control, excavation support, liquefaction mitigation and groundwater control, namely through chemical grouting and jet grouting service," that is, the services as identified in the application. Examining Attorney's Brief at 5. In the end, the distinction between the two proposals is a distinction without a difference. We would find FOUNDATION SERVICES generic in either case.

The Examining Attorney proposes that we refer to the identification of services to determine the genus, as the Court did in *Fire Chief. H. Marvin Ginn Corp. v. International Assn. of Fire Chiefs, Inc.*, 228 USPQ at 532. Applicant suggests a simpler and perhaps broader genus. Based on the evidence in this case, we conclude that "geotechnical construction services" is the appropriate genus.

In *Fire Chief*, because the evidence showed that there were other "magazine[s] directed to the field of fire fighting," the goods identified in the application at issue, use of the identification as the genus was warranted. Here the evidence shows that there are other "geotechnical construction services." However, unlike the *Fire Chief* case where the Court found that the FIRE CHIEF mark did not identify a class of publication directed to that field, here the evidence does establish that FOUNDATION SERVICES identifies a class of services in that field.

The fact that the genus is conceptually broader or narrower than the identification of goods does not inexorably lead to the conclusion that a term, such as FOUNDATION SERVICES, is not generic. *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628 (TTAB 1998) (MASSFLO held generic for flowmeters for the measurement of flow of mass of fluids); *In re Central Sprinkler Co.*, 49 USPQ2d 1194 (TTAB 1998) (ATTIC held generic for automatic sprinklers for fire protection); *Stromgren Supports Inc. v. Bike Athletic Co.*, 43 USPQ2d 1100 (TTAB 1997) (COMPRESSION held generic for hosiery); *In re Reckitt & Colman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1991) (PERMA PRESS held generic for soil and stain removers for permanent press fabrics);

In re Analog Devices Inc., 6 USPQ2d 1808 (TTAB 1988),
aff'd, 10 USPQ2d 1879 (Fed. Cir. 1989) (ANALOG DEVICES held
generic for a wide range of electronic products in
International Class 9²).

We now turn to the second question *Fire Chief* poses -
Is the term sought to be registered understood by the
relevant public primarily to refer to that genus of goods
or services?

The Examining Attorney states, "... the evidence of
record demonstrates that the relevant public commonly
understands and refers to this class of services [the
services identified in the application] as 'foundation
services.'" Examining Attorney's Brief at 6.

² The goods include: "operational amplifiers, power supplies, active filters, converters including analog-to-digital and digital-to-analog converters, instrumentation and isolation amplifiers, analog computational circuits, voltage references, transducers, sample track-hold amplifiers, data-acquisition modules, switches, multiplexers, monolithic chips, linear IC testers, analog multiplier/dividers, log-analog amplifiers, signal conditioners, digital panel meters, microcomputer I/O subsystems comprising input/output boards, measurement and control systems comprising signal conditioners, signal isolators and converters, computer programs for electronic data processors for computer based measurement of signals, computer programs for electronic data processors for computer based measurement and display of input signals and computer programs for electronic data processors for computer based measurement of input signals and generation of output signals in response to measured input signals for control thereof; computer programs for visual inspection of assembly and production lines, quality control for production and assembly lines, robot guidance of assembly operations, inventory control; digital thermometers; computer interface products, namely, realtime interfaces and data exchangers, serial transmittal card/modules, serial receiver card/modules and serial multiplier card/modules."

The Examining Attorney submitted clear and substantial evidence in support of this conclusion. The evidence includes excerpts from websites related to companies in relevant fields, for example:

localwin.com - "Who is a foundation contractor? Foundation service providers are skilled professionals who traditionally lay the foundation in a home or building for the start of the building process. ... to provide foundation services for professional buildings. ... Top Constructor will help you to find the best corporations providing ... complete foundation services."

atlanticcaisson.com - "... With our ability to provide site and foundation services associated with a complete design for your project."

pmmacaygroup.com - "P.M. MacKay can provide electrical, plumbing, and foundation services, as well as finishing services..."

pouredbrickwalls.com - "Poured Brick Walls offers a full range of commercial and industrial trenching and foundation services."

astlecorp.com - "Astle Corp. is a multidiscipline general contracting company, formed in 1963 and has provided complete structural foundation services to a variety of bulk materials industries. ... [W]e will self-perform all of the work for our client's foundations..."

goldenconstructionx.com - "Premier Foundation Contractor - Call Golden Construction in Houston, Texas, for a variety of foundation services."

builderonline.com - "BMC Construction, which provides turnkey framing and foundation services to 19 of the industry's 25 largest home builders."

yellowusa.com - "Foundation Contractor Kingman Arizona - Individuals who want to make their sidewalks, garages, or driveways look better or safer often consult contractors for foundation services."

corporateinformation.com - "Syntec Construction... The Group's principal activities are the provision of building construction and civil engineering contracting services, ... piling and foundation services..."

Office Action, dated August 21, 2007. These examples are representative of the website excerpts in the record.

The Examining Attorney also provided brief excerpts from articles obtained through a search of the NEXIS data base. See Office Action, dated January 26, 2007. Although the NEXIS excerpts also support the conclusion that FOUNDATION SERVICES is generic for the identified services, we found the examples we presented above, which provided more context, more probative.

The Examining Attorney has also provided a definition of "geotechnical engineering" from wikipedia.com, an online encyclopedia. In relevant part, it states, "Geotechnical engineering includes investigating existing subsurface conditions and materials, assessing risks posed by site conditions, designing earthworks and structure foundations, and monitoring site conditions, earthwork and foundation construction. ... A geotechnical engineer then determines and designs the type of foundation and/or pavement

subgrades required for the intended man-made structure to be built. ... Geotechnical engineers design foundations based on the load characteristics of the structure and the properties of the soils and/or bedrock at the site."

Office Action, dated August 21, 2007.

We have consulted additional dictionaries.³ The *Dictionary of Civil Engineering* (4th ed. 1993) defines "geotechnical engineer as "an engineer who specializes in *rock mechanics, soil mechanics, foundations, groundwater, etc.*" The *Construction Dictionary Illustrated* (2001) defines "Geotechnical Engineer" as "an engineer who specializes in rock and soil mechanics, groundwater and foundations." *The Contractors' Dictionary of Equipment, Tools, and Techniques* (1995) defines "foundation" as "1. solid mass designed to support a superstructure; 2. material that supports a structure, cut or fill, whether strengthened or not by piles, mats or other means, to secure adequate bearing." The *Means Illustrated Construction Dictionary* (3rd ed. 2002) defines "foundation engineering" as "The category of engineering concerned with evaluating the ability of a locus to support a given

³ The Board may take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

structural load, and with designing the substructure or transition member needed to support the construction."

We find the totality of the evidence more than sufficient to conclude that FOUNDATION SERVICES is generic for a class or category of services in the genus of "geotechnical construction services" and for "geotechnical construction services, namely, foundation rehabilitation, drilled foundations, earth retention/underpinning, injection services for expansive soils, namely the injection of products into soil for limiting heave due to expansive clays, strengthening railroad subgrades, pavements and landfills and stabilizing slopes, site improvement, soil/slope stabilization, settlement control, excavation support, liquefaction mitigation and groundwater control, namely through chemical grouting and jet grouting service."

Applicant argues that FOUNDATION SERVICES is not generic for its services because a fair presentation of the uses of FOUNDATION SERVICES indicates that the term is used primarily in connection with "charitable planning and giving solutions." Applicant's Brief at 7. However, we must analyze the significance of FOUNDATION SERVICES to relevant purchasers, not in a vacuum, but in relation to the identified services. The fact that FOUNDATION SERVICES

may have a different meaning in another context is not relevant for purposes of our analysis. Accordingly, we reject this argument.

Applicant also argues, "In this case, the term FOUNDATION SERVICES is not understood by relevant purchasers to primarily refer to the genus of services known as Geotechnical Construction Services." *Id.* at 7-8. Applicant points to examples, primarily from the NEXIS evidence, to argue that the various companies identified in those examples are engaged in different types of work, for example, foundation repairs versus shoring systems. Applicant then states, "While it appears that the Examiner is correlating 'foundation' with a building foundation, the cited evidence cannot be correlated to any particular type of foundation and hence fails to make the requisite substantial showing that the term is in fact generic to Appellant's genus of goods." Applicant's Brief at 8. Applicant then argues that FOUNDATION SERVICES is only suggestive of the identified services, stating, "It [FOUNDATION SERVICES] vaguely suggests services related to foundations, but does not specify what type(s) of foundations or specifically what Appellant's services are." *Id.*

We find these arguments unpersuasive. Again, we must analyze the significance of FOUNDATION SERVICES to relevant purchasers in context, not in a vacuum. Applicant uses the term "foundation" twice in its identification of services in identifying "foundation rehabilitation" and "drilled foundations" as among its services. Most, if not all of the balance of the identified services, can also relate in some sense to foundations. The definitions cited above consistently identify "foundations" as a significant, if not the most significant, category of services performed by geotechnical engineers in providing "geotechnical construction services." The evidence cited above from the websites of companies in the relevant field show uses of FOUNDATION SERVICES as a class or category of services which includes some or all of the services in the identification of services.

Applicant's suggestion that FOUNDATION SERVICES is too vague or not specific enough to be generic misses the point. The record establishes beyond question that FOUNDATION SERVICES identifies a category or class of services which comprehends most, if not all, of the services applicant identified in its application and a class or category of services within the genus of "geotechnical construction services."

Accordingly, we conclude that the Examining Attorney's evidence clearly establishes that FOUNDATION SERVICES is generic for "geotechnical construction services, namely, foundation rehabilitation, drilled foundations, earth retention/underpinning, injection services for expansive soils, namely the injection of products into soil for limiting heave due to expansive clays, strengthening railroad subgrades, pavements and landfills and stabilizing slopes, site improvement, soil/slope stabilization, settlement control, excavation support, liquefaction mitigation and groundwater control, namely through chemical grouting and jet grouting service."

Decision: We affirm the refusal under Trademark Act Section 23 to register FOUNDATION SERVICES on the Supplemental Register on the grounds that FOUNDATION SERVICES is generic.