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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sharadha Terry Products Limited

Serial No. 78027603
Serial No. 78027605¹

Amy J. Benjamin of Darby & Darby, P.C. for Sharadha Terry Products Limited.

Florentina Blandu, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Chapman, Holtzman and Zervas, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

The two applications involved herein were filed on September 25, 2000, by Sharadha Terry Products Limited (a corporation of India) to register on the Principal Register² the mark (shown below)

¹ The Board granted applicant's motion (filed September 8, 2004) to consolidate these two applications in an order dated September 9, 2004.

² In both applications, applicant filed on February 18, 2002 (via certificate of mailing), an amendment seeking registration on the Supplemental Register. However, on September 26, 2002 (via certificate of mailing), applicant filed a withdrawal of its



for "towels and other textile piece goods" in International Class 24 (Serial No. 78027603) and "bathrobes" in International Class 25 (Serial No. 78027605). Application Serial No. 78027603 is based on applicant's claimed date of first use and first use in commerce of November 1, 1999.³ Likewise, application Serial No. 78027605 is based on applicant's claimed date of first use and first use in commerce of November 1, 1999.⁴

amendment to the Supplemental Register in each application. Although the Examining Attorney did not specifically acknowledge applicant's request to withdraw its previous amendment to the Supplemental Register in either application (it would have been the better practice), nonetheless, it is not necessary for the Examining Attorney to do so. Applicant's request to withdraw its amendment to seek registration on the Supplemental Register is clear and unequivocal in both applications. Thus, the issue of the registrability of the mark on the Supplemental Register is not before the Board in either of these two applications.

³ Application Serial No. 78027603 was originally also based on Section 44(d) of the Trademark Act, 15 U.S.C. §1126(d). However, in applicant's response filed July 5, 2001 (via certificate of mailing), applicant requested that its Section 44(d) filing basis be removed and applicant stated that it seeks registration only under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a).

⁴ Applicant included in its July 5, 2001 response in application Serial No. 78027605, a request for removal of the Section 44(d) basis of the application, despite the fact that there was no such basis in the application. The second basis listed in this application was applicant's assertion of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b). The Examining Attorney nonetheless accepted the removal of the Section 44(d) basis. Trademark Rule 2.34(b)(1) provides, in relevant part, that "the applicant may not claim both sections 1(a) and 1(b) for the identical goods or services in the same application." In view of this rule and

In applicant's response (filed July 5, 2001--via certificate of mailing) in both application files, applicant amended its drawing to MICRO COTTON (in standard character form).

In application Serial No. 78027603 the goods were ultimately amended to read as follows:

"bath linen, bath mats, bed blankets, bed linen, bed sheets, bed spreads, cloth napkins for removing make-up, curtains, covers for cushions, doormats, duvet covers, duvets, eiderdowns [sic] quilts, golf towels, handkerchiefs, kitchen towels, household linen, pillow cases, quilts, table covers, table linens, table mats, tea towels, textile napkins, textile place mats, textile wall hangings, towels, wash cloths and window curtains" in International Class 24; and

"aprons, bathing caps, bathing suits, bathing trunks, bathrobes, beach cover-ups, beachwear, bibs, blazers, blouses, briefs, foul weather gears, gloves, headwear, hoods, mittens, muffs, neckerchiefs, night shirts, night wears [sic], pants, polo shirts, robes, shawls, shirts, shorts, socks,

because application Serial No. 78027605 includes only one item of goods -- "bathrobes," the Board presumes that applicant sought to remove the Section 1(b) basis for application Serial No. 78027605. Both applications are based solely on Section 1(a) of the Trademark Act.

(Although application Serial No. 78027605 originally included both Section 1(a) and Section 1(b) as bases therefor, applicant filed a specimen with the original application, which the Examining Attorney found unacceptable and required a substitute specimen. The substitute specimen accompanying applicant's July 5, 2001 response was accepted by the Examining Attorney in her Office action dated January 14, 2002.)

stockings, sweatbands, swimwear,
trousers, underwear" in International
Class 25.⁵

The Examining Attorney has refused registration in each application under Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127, on the basis that applicant's mark, MICRO COTTON, does not function as a trademark because it "is generic for a particular type of fabric and it does not identify or distinguish the goods of applicant from those of others..." (Final Office action dated October 14, 2003, p. 2.)

When the Examining Attorney made final the refusal to register the proposed mark for failure to function as a trademark, applicant appealed in each application to the Board.⁶ Briefs have been filed, and applicant did not request an oral hearing.

The Examining Attorney's position essentially is that "applicant's mark fails to function as a mark because it describes what the goods are made of, namely, micro cotton, [a] term which is widely recognized in the industry to be a

⁵ The Board notes that application Serial No. 78027605 for "bathrobes" is not a duplicate of Serial No 78027603 (which includes "bathrobes" in the identification of goods) because the identifications of goods are not the same.

⁶ The Examining Attorney had also finally refused registration under Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), in both applications. She withdrew that refusal in her July 22, 2004 denials of applicant's requests for reconsideration. Thus, that issue is not before the Board in either application.

type of material." (Brief, unnumbered page 3.) As she stated in her brief (unnumbered page 3): "The generic term for the type of fabric used in applicant's goods is micro cotton and the examining attorney submitted overwhelming evidence to show that the term in question is generic for a type of fabric. ... The consumers perceive the term micro cotton as a type of fabric and not as a trademark."

In support of the refusal to register, the Examining Attorney submitted (i) printouts of several excerpted stories retrieved from the Nexis database; (ii) printouts from several Internet web sites; and (iii) printouts of the results of some Google searches showing lists of "hits."

Applicant essentially contends that its mark is not generic for the goods, but rather "is suggestive of the soft, luxurious quality" of applicant's goods (brief, p. 9); that "the generic term for the type of fabric used in Applicant's Goods is 'low twist cotton'" (brief, p. 9); that the Examining Attorney has not met her burden of proof to establish by clear evidence that the term is generic for the involved goods; that the several third-party registrations and one third-party application properly submitted into the record by applicant "demonstrate a pattern of allowing registration of MICRO formative marks, including those like Applicant's Mark that combine MICRO

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with the generic name of a fabric, e.g., MICROWOOL
[Registration No. 1726690, now expired], MICROSILK
[Registration No. 2239121, 'silk' disclaimed], MICROSUEDE
[Registration Nos. 1913379 and 2360607], MICRO FELT
[Registration No. 2793385, 'felt' disclaimed]." (brief, p.
13); that applicant's mark, MICRO COTTON, functions as a
trademark; and that doubt is resolved in applicant's favor.

In support of its position, applicant submitted, inter
alia, (i) printouts of pages from several third-party web
sites; (ii) printouts of pages from searches of the patent
database of the USPTO; (iii) letters from experts in the
fiber and textile industry (Marylyn Goutmann and William
Oxenham); (iv) the declaration of one of applicant's
customers (Keith R. Sorgeloos); (iv) printouts of several
third-party registrations and one application; and (vi)
copies of letters from third parties agreeing to cease use
of applicant's mark MICRO COTTON.

There are three preliminary evidentiary matters we
must address. First, applicant argues (brief, p. 19) that
all of the printouts of pages from web sites and printouts
of Goggle search list hits submitted by the Examining
Attorney which refer to use outside the United States
should not be given any weight as they are not relevant to
how the U.S. consuming public views the mark.

The Examining Attorney argues that the web sites deriving from foreign sources should be given the same weight as evidence from U.S. sources because the Internet knows no boundaries and the Board accepted foreign sources in *In re Remacle*, 66 USPQ2d 1222 (TTAB 2002).

In the Remacle case, the Board made clear that foreign sources have limited evidentiary value in establishing purchaser perception in the United States; and that "in particular situations" and involving "professionals in medicine, engineering, computers, telecommunications..." inferences regarding accessibility and familiarity with foreign publications may be made. Unlike the Remacle case, in the applications now before us applicant's goods are various items of clothing, linen, and other textile household items offered for sale to the general public. That is, there is nothing involved in the applications now before us, which justifies an extension of the Board's consideration of foreign materials as discussed in the Remacle case. Thus, while the foreign uses are properly of record, their probative value is quite limited.

Second, applicant specifically referred to the Google lists of search results as containing (i) duplicative information with the web sites that the Examining Attorney did submit in printout form, and (ii) non-uses of MICRO

COTTON. Applicant noted that if not specifically relied on by the Examining Attorney, applicant did not individually check any of the Google search listed sites because the web sites may be inactive. (Brief, p. 19, footnote 14.) This type of evidence (a Google search "hit" list) is admissible. However, its probative value is limited and evidence of use of a term or phrase in headings or content on individual web sites has far greater probative value. See *In re Fitch IBCA Inc.*, 64 USPQ2d 1058 (TTAB 2002).

Third, applicant offered new evidence with its brief on the case. See Trademark Rule 2.142(d). Specifically, applicant submitted (i) the full-text of one Nexis database article that the Examining Attorney had submitted in excerpt form (brief, p. 16, footnote 13), and (ii) additional pages from web sites from which the Examining Attorney had initially made other pages of record (brief, pp. 20--footnote 15, 21, 23). Applicant argues that all of the new evidence is admissible on appeal, citing *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 820 (Fed. Cir. 1986). The full-text article of which an excerpt had been made of record by the Examining Attorney is admissible. However, we decline to extend the Bed & Breakfast Registry case to encompass applicant's (or an Examining Attorney's) submission of additional pages from

web sites after appeal. This situation is quite different from and involves a different source than that of Nexis database articles. The transitory or changing nature of websites (i.e., Internet postings may be modified or deleted at any time) is not analogous to the printout in full format of a story previously submitted in excerpted format from a printed publication. See *In re Trans Continental Records Inc.*, 62 USPQ2d 1541, footnote 2 (TTAB 2002). We have considered applicant's full-text Nexis database article, but we have not considered applicant's submission of additional pages from web sites.

Tuning now to the merits of these consolidated cases, we begin by clarifying that although the Examining Attorney refused registration under Sections 1, 2 and 45 of the Trademark Act (failure to function as a mark), it is clear that she was refusing registration of the applied-for mark as the generic name of the fabric used to make the involved goods. We will determine these cases based on an analysis of whether the phrase MICRO COTTON is generic for the involved goods in International Classes 24 and 25.

The test for determining whether a designation is generic, as used in connection with the goods or services in an application, turns upon how the term or phrase is perceived by the relevant public. See *Loglan Institute*

Inc. v. Logical Language Group, Inc., 962 F.2d 1038, 22 USPQ2d 1531 (Fed. Cir. 1992). Determining whether an alleged mark is generic involves a two-step analysis: (1) what is the genus of the goods or services in question? and (2) is the term sought to be registered understood by the relevant public primarily to refer to that genus of goods or services? See *In re The American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); and *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). As noted earlier, "the correct legal test for genericness, as set forth in *Marvin Ginn, supra*, requires evidence of 'the genus of goods or services at issue' and the understanding by the general public that the mark refers primarily to 'that genus of goods or services.'" *American Fertility Society, supra*.

The Examining Attorney bears the burden of proving that the proposed mark is generic, and genericness must be demonstrated through "clear evidence." See *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); and *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd*, *unpubl'd*, but appearing at 10 USPQ2d 1879 (Fed. Cir. 1989). The evidence of the relevant public's perception of a term or

phrase may be acquired from any competent source, including newspapers, magazines, dictionaries, catalogs and other publications. See *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and *In re Leatherman Tool Group, Inc.*, 32 USPQ2d 1443 (TTAB 1994), citing *In re Northland Aluminum Products, Inc.*, 777 F.2d 1566, 227 USPQ 961 (Fed. Cir. 1985).

In these cases, the Examining Attorney has submitted evidence which shows mixed uses of the term "MICRO COTTON." There are a few uses that appear to be generic uses of the term "micro cotton" for a fabric. But, as pointed out by applicant, most of the Examining Attorney's evidence either refers to applicant's goods sold under its MICRO COTTON trademark, or shows that the term "micro cotton" does not exist as an industry term, or the uses of the two words do not relate to the use in the context of these applications, or the uses are misuses of the term. Examples of the Examining Attorney's evidence from third-party web sites and excerpted stories retrieved from the Nexis database are reproduced below (emphasis added):

Headline: Premiere Vision Takes Turn
Into Sportier Directions...
...One of Erba's best sellers is the
chambray or ribbed color-woven **micro
cotton**. "It's a new hand and it's very
hard to weave so not everybody can do

it," ... "Daily News Record," October 5, 1993;

Headline: Teens and Online Shopping Don't Click...

...He was frustrated by many color and textile descriptions: "These fancy names mean nothing to me. What's **micro-cotton**? If they'd use laymen's terms like 'lightweight cotton' or 'windbreaker material,' I'd have a better idea of what I'm buying." ... "USA Today," September 7, 1999;

Headline: New Micros to Debut at Yarn Fair...

...In addition to being shown in Cyanamid's booth, MicroSupreme will be displayed by three other Yarn Fair exhibitors: National Spinning; Richmond; and Harriet Henderson, which is showing an 80/20 **micro/cotton** blend that is air-jet spun. ... "Daily News Record," August 13, 1991;

Headline: Micros Can Give Men's Big Boost; Use of Microfibers in Men's Apparel

...Microfibers are, of course, man-made fibers. There is no **micro cotton**, wool or even silk. Microfibers are the finest fibers made-by agreed definition, less than one denier per filament. ...

...He is using 100 percent poly micro fabrics from Milliken and soon from Burlington, he said, and poly **micro/cotton** blends from Japan and Germany. ... "Daily News Record," November 20, 1990;

Headline: The Soft Suitor, Leading Trend In Menswear Takes on Softer Feel ... (Color) Trent Scull models a three-button suit and shirt from Ermenegildo Zenga's Soft collection (above and top) : the glen plaid suit is \$975, and the

cotton micro-dot shirt is \$140 at Boston's of Memphis. "The Commercial Appeal (Memphis)," October 23, 1994;

Headline: Embellishments, Fabrics Making Fall Fashion Fun Again
.....sweaters are showing up with interesting treatments in combinations of **cotton**, rayon and **micro**-fibers. The micro-fibers help the sweaters hold their shape... "The Post and Courier (Charleston, SC)," August 29, 1999;

Headline: The Handyman: Space-age Marvels Come Down to Earth at Chicago Housewares Show
Another space-age product was the Clean Touch Plus, an anti-bacterial wash cloth by the Daikyo/Palt Group of Japan.... This light blue cloth has ultra fine copper **micro** fibers embedded in the **cotton** and rayon fabric. The copper mesh disrupts the molecular balance of bacteria... "The Detroit News," January 17, 1998;

New Hotel Collection

...
The Hotel **micro cotton** towels boast softness and are most absorbent. ...
www.touchofcotton.com;

Hotel Collection

An affordable luxury brand for the home, offering exceptional quality and value. Hotel Collection features 460- and 600-count sheets, **micro-cotton** towels, cashmere throws,...
www.federated-fds.com;

Welcome to Doubleberger

Micro-Cotton Six-Piece Towel Set
...They are made from **micro-cotton** which uses the world's finest combed cotton...
www.doubleberger.com;

Home Textiles Today

...

It is also showing **microcotton** bath mats and throws as well as an accessory product in development for next market...

"We're also working on micro cotton sheeting and blankets," said Keith Sorgeloos, president. ...
www.hometextilestoday.com;⁷

Paddling.net Store

Putty Hat

This Low Profile Water Repellant Cap is made of a soft, **micro-cotton** performance twill. ...
www.paddling.net; and

Senator Zell Miller

Press Release

Miller, Cleland Back Georgia farmers With Over \$15 Million in Federal Funding requests for Georgia Agriculture

...

\$7 million for Agricultural research at the University of Georgia, including:
... \$1 million for a **Micro Cotton** Gin Facility for the improvement of cotton fiber quality...
www.miller.senate.gov;

It is clear from the record that the overwhelming majority of the evidence of record does not show generic use of the words "micro cotton" to refer to a type of fabric. As applicant has explained, numerous references

⁷ Applicant points out that this web site page was a reprinted October 15, 2001 article, and that Mr. Sorgeloos came to understand that the generic name is "low-twist cotton" as evidenced by, inter alia, his March 18, 2004 declaration (discussed more fully infra) in which he avers, inter alia, that MICRO COTTON is not a type of fabric, but is applicant's trademark, and is so recognized in the industry and by consumers.

are to applicant and its goods sold under the trademark MICRO COTTON (e.g., doubleberger.com, touchofcotton.com, federated-fds.com), while other uses are simply irrelevant as they do not refer to "micro cotton" in the context of a fabric or goods such as applicant's made from fabric (e.g., "micro/cotton" referencing a blended microfiber and cotton, "micro fibers embedded in the cotton," and "Micro Cotton Gin Facility").

Applicant contends that the few sporadic misuses of its trademark MICRO COTTON (presumably by the media and by web site designers), does not meet the burden of proof required to establish that an applied-for mark is generic.

As explained previously, our primary reviewing Court, the Court of Appeals for the Federal Circuit, has held that the burden of establishing genericness of a term or a whole phrase rests with the Office and that the showing must be based on clear evidence. See *In re Merrill Lynch*, supra, 4 USPQ2d at 1143; and *In re The American Fertility Society*, supra, 51 USPQ2d at 1835. Because the record before us shows varied uses of the phrase "MICRO COTTON," we find that there is insufficient clear evidence that the phrase MICRO COTTON is the generic term for a type of fabric used to make applicant's various items of clothing, linens and other textile items. The Examining Attorney's evidence

simply does not establish that the phrase MICRO COTTON is generic for the genus of the type of fabric used to make applicant's involved goods.

With regard to the second prong of the genericness test, the evidence of record as to how the relevant purchasers (the general public) would perceive this phrase in relation to applicant's identified goods is again mixed. While there are a few generic uses of the phrase for a type of fabric, some of the Examining Attorney's examples of purportedly generic use actually refer to applicant's goods and show the words capitalized. Some are apparent misuses of the words MICRO COTTON by third-party web designers or journalists.

Moreover, applicant has submitted significant evidence in rebuttal. This evidence includes the following: (i) a letter from Associate Professor of Textile Technology at Philadelphia University, Marylyn Goutmann (33 years with the University), stating, inter alia, that "Micro is not a generic classification of cotton and the prefix is not used as a descriptive [term] for cotton fibers in the same way that it is used for manufactured fibers. ... There is just not a micro cotton."; (ii) a letter from William Oxenham, the Abel C. Lineberger Professor and Associate Dean, Academic Programs, North Carolina State University (he has

published over 120 papers on fiber and textile technology), in which he states, inter alia, "'Micro Cotton' is an adopted phrase used by [applicant]... .. It is thus apparent to me that the terminology 'Micro Cotton' is a marketing name and has no meaning in terms of the variety or quality of the cotton fiber."; (iii) the declaration of Keith R. Sorgeloos, president and CEO of Home Source International (with this company for 5 years, the company is one of applicant's customers), in which he avers, inter alia, that "I am not aware of any type of cotton know [sic] as 'micro cotton'.... Based on my experience in the industry, I believe that MICRO COTTON is viewed as a brand name or trademark..."; and (iv) the search results from various industry web sites (e.g., the web sites of "fiber source," "Cotton Incorporated," "National Cotton Council of America," and "Cotton Council International") and a patent search of USPTO patent records, all showing that the phrase MICRO COTTON is not the name of a type of fiber or fabric as "no matches" were found.

The Examining Attorney has not established that the relevant purchasing public would perceive the phrase MICRO COTTON as the name of the fabric used to make applicant's various clothing and other textile items.

In considering the records of these two applications we find that the Examining Attorney has not established a prima facie showing that the phrase MICRO COTTON is generic in relation to applicant's identified goods.

Decision: The refusal to register under Sections 1, 2, and 45 of the Trademark Act on the basis that the mark is generic and does not function as a trademark is reversed in both applications. However, neither application will be forwarded to publication absent submission and entry of applicant's disclaimer of the generic word "cotton." Applicant is allowed until thirty days from the date of this decision to submit to the Board a disclaimer (in proper form) of the word "cotton" in either or both applications. Once the disclaimer(s) is(are) entered, then the application(s) shall proceed to publication.