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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re American Biltrite Inc.

Serial No. 78368992

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Rothstein & Ebenstein for American Biltrite Inc.

Theodore McBride, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Quinn, Walters and Bergsman, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by American Biltrite Inc. to register the mark COLD SEAL for "acrylic adhesive used to manufacture pressure sensitive tape" in International Class 1.¹ When registration was refused on the Principal Register under Section 2(e)(1) of the Trademark Act on the ground of mere descriptiveness, applicant amended its application to

¹ Application Serial No. 78368992, filed February 17, 2004, based on an allegation of a bona fide intention to use the mark in commerce.

seek registration on the Supplemental Register under Section 23 of the Trademark Act.²

The trademark examining attorney refused registration on the Supplemental Register on the ground that the matter sought for registration is generic and, thus, incapable of registration.

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.

Applicant argues that its designation is, at worst, merely descriptive and, thus, is registrable on the Supplemental Register. Applicant contends that its designation comprises a noun, "SEAL," modified by an adjective, "COLD," and that because "COLD" describes the type of "SEAL," the mark in its entirety, COLD SEAL, does not identify a class of goods, so the designation cannot be generic. The examining attorney has not met the heavy burden of establishing genericness because, applicant asserts, the evidence shows "cold seal" used as an adjectival phrase to modify a noun, as for example, "cold seal adhesives" or "cold seal applications." Thus, according to applicant, while the record may establish mere descriptiveness, the third-party uses do not show the

² Applicant concurrently filed an amendment to allege use, setting forth dates of first use of August 30, 2004.

genericness of the designation sought to be registered. Applicant also points to the existence of several third-party registrations of marks comprising, in part, the term "SEAL." Applicant concludes by urging that any doubt, in accordance with well-settled case law, be resolved in its favor.

The examining attorney maintains that the designation "cold seal" refers to a class of adhesives that is commonly known and recognized in the adhesive and packaging industry as "cold seal adhesives." The examining attorney contends that the statute not only prohibits registration of generic nouns, but generic adjectives as well. The examining attorney's evidence includes third-party registrations showing use of the term "cold seal" to modify a type of adhesive in the identifications of goods. The examining attorney also submitted excerpts from third-party websites and excerpts from printed publications retrieved from the NEXIS database showing third-party uses of "cold seal" as a term of art in the adhesives industry to refer to a specific type of adhesive.

"The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question." *H. Marvin Ginn Corp. v.*

International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Determining whether a term is generic involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services? Id. See also *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005). "Evidence of the public's understanding of the term may be obtained from any competent source, such as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers, and other publications." *In re Merrill Lynch, Fenner and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). Therefore, to be generic, members of the relevant public must primarily use or understand applicant's term as referring to the genus of its goods. *Ginn*, 228 USPQ at 530.

Our first task under Marvin Ginn is to determine, based on the record before us, the genus of applicant's goods. Applicant's specimen shows the following use:



Given the description of the goods on the specimen, coupled with the identification of goods in this application, we find that the genus of goods is acrylic adhesives used to manufacture pressure sensitive tape.

We next must determine whether the term applicant seeks to register, COLD SEAL, is understood by the relevant public primarily to refer to that genus of goods. The examining attorney has made of record numerous excerpts of articles retrieved from the Internet and the NEXIS database. The following examples are representative of the evidence:

Glossary

Cold Seal: A pressure sensitive adhesive coating on plastic films or laminates that will allow the packages to be sealed by application of pressure (with no heat or minimal heat).
(www.sorbentsystems.com)

Glossary

Cold-seal adhesive:

An adhesive typically used on natural rubber and having the characteristic of great adhesive attraction for itself but little attraction for other materials. Used on plastic films where normal heat sealing can't be used. The surfaces to which a cold-seal adhesive has been pre-applied are simply brought into contact with one another.

(www.packageone.com)

Cold Seal is a packaging industry term used to describe a film or paper coated with a cohesive adhesive.

(www.cortecvci.com)

Cold Seal Adhesives

We are basically interested in cold seal adhesives for application on one side of paper/plastic films, the other side of which is coated with release coating.

(www.finishing.com)

Department of Health & Human Services
Public Health Service

The final rule does not contain language that is confusing...there is sufficient evidence that the rule should be applied to adhesives in "cold seal" packaging...the agency considers devices that are packaged using natural rubber-containing "cold-seal" adhesives likely to contact the user and required by the rule to display a labeling statement.

(www.advamed.org)

Experts in "cold seal adhesive"

Definition: A pressure sensitive adhesive consisting of a base polymer of polyisoprene. Cold seal adhesives have the unique property of bonding

readily to itself, with application of pressure, but not to other surfaces.
(www.intota.com)

Nip-Weld Cold Seal Adhesives
Bostik Findley is the leading supplier of cold seal adhesives for use in high-speed flexible packaging systems.
(www.bostik-us.com)

Technical Coatings' flexible-packaging adhesives business includes the development, production and distribution of a full line of cold-seal adhesives marketed under the Coseal trademark...further complement[ing] our global cold-seal offering.
(*Adhesives & Sealants Industry*, February 2002)

Water- and solventborne, alcohol-based and cold-seal adhesives are used for a variety of laminating applications.
(*Adhesives & Sealants Industry*, May 2004)

Fox's chose a patterned cold seal adhesive...
(*Packaging Magazine*, February 19, 2004)

A new adhesive for cold seal flexible packaging is said to give an extremely reliable seal at very fast line speeds on applications...
(*Packaging Magazine*, February 7, 2002)

The Gravure Flex station configures for flexo or gravure and can apply cold-seal adhesives.
(*Converting*, June 1, 2002)

Two growing markets...the use of cold-seal adhesives to package ice cream bars and other heat-sensitive foods.
(*Chemical Week*, April 10, 2002)

Their wide range of coatings, extrudable resins, laminating adhesives, heat seals, and cold seals provide customers with "Total Packaging Solutions" for flexible packaging and converting.

(Flexible Packaging, December 2002)

It's suitable for extrusion, adhesive, and cold-seal applications.

(Packaging Digest, April 1, 2003)

Robond CS water-based cold seal adhesives are said to be ideal for cold seal flexible packaging...

(Rubber World, December 22, 2001)

The acquisition includes the development, production and distribution of a full line of cold-seal adhesives, mainly for the food and medical industries.

(Converting, December 1, 2001)

Cohesive & Cold Seal Adhesives
Surfaces coated with the same cohesive or cold seal adhesives will only adhere to other surfaces coated with the same adhesive.

(www.basicadhesives.com)

The most up-to-date technology available for cold seal applications will be featured in the company's full line...Rohm and Haas cold seal adhesives are also ideal for...

(www.specialchem4adhesives.com)

The evidence also includes generic use of "cold seal" in a third-party registration's identification of goods (see, for example, Reg. No. 3112809, for the mark TURBO SEAL covering "adhesives for use by the packaging, paper converting, and printing industries, namely cold-seal

adhesives for high-speed packaging of heat sensitive foods and medical articles").

We find that this evidence clearly establishes that "cold seal" would be recognized by relevant purchasers in the trade as referring to a type or category of adhesives used to manufacture pressure sensitive tape, and that it therefore is generic for applicant's goods.

We are not persuaded by applicant's argument that COLD SEAL cannot be generic because it is used as an adjective to modify "adhesive". The expression "generic name for the goods or services" is not limited to noun forms but also includes generic adjectives, that is, adjectives which refer to a genus or species, category or class, of goods or services. *In re Central Sprinkler Co.*, 49 USPQ2d 1194 (TTAB 1998) [ATTIC is generic for automatic sprinklers for fire protection]. As noted by Professor McCarthy, "[a] rule of thumb sometimes forwarded as distinguishing a generic name from a descriptive term is that generic names are nouns and descriptive terms are adjectives. However, this 'part of speech' test does not accurately describe the case law results." J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §12:10 (4th ed. updated June 2006). See, e.g., *In re Sun Oil Co.*, 426 F.2d 4011, 165 USPQ 718 (CCPA 1970) [CUSTOMBLENDED is generic for

gasoline]; *In re Helena Rubinstein, Inc.*, 410 F.2d 438, 161 USPQ 606 (CCPA 1969) [PASTEURIZED is generic for face cream]; and *In re Reckitt & Colman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1991) [PERMA PRESS is generic for soil and stain removers for permanent press fabrics].

The third-party registrations of marks that include the word "SEAL" are of no moment. Firstly, we are not privy to the records pertaining to the registrations. Secondly, and more importantly, none of the registered marks comprise the two terms "cold seal" sought to be registered herein. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the board or this court."].

In this case, the evidence of record establishes that COLD SEAL, whether viewed as a noun or an adjective, is generic as applied to applicant's goods. The evidence of record, as discussed above, clearly shows that "cold seal" is a generic name for a certain type of adhesive that is sold by applicant and others in the industry. Applicant's arguments to the contrary are wholly unpersuasive.

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Decision: The refusal to register on the Supplemental Register is affirmed.