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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Quebec Inc.

Serial No. 78927844

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Quebec Inc.

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(Chris A.F. Pedersen, Managing Attorney).

Before Quinn, Hairston and Bergsman, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Quebec Inc. filed an application to register the term
ACOUSTIK for "rubber flooring, namely, subflooring and
flooring underlayments"¹ in International Class 19.

The trademark examining attorney refused registration
under Section 2(e)(1) of the Trademark Act, 15 U.S.C.

§1052(e)(1), on the ground that applicant's proposed mark,

¹ Application Serial No. 78927844, filed July 12, 2006, alleging
first use anywhere and first use in commerce on August 30, 1999.

when used in connection with applicant's goods, is merely descriptive thereof. The examining attorney also refused registration based on applicant's failure to comply with the requirement to submit acceptable specimens showing use of the mark.

When the refusals were made final, applicant appealed. Applicant and the examining attorney filed briefs.

Mere Descriptiveness

Before turning to the respective arguments, we need to clarify one point. Throughout the prosecution of the application, the examining attorney refused registration on the Principal Register under Section 2(e)(1) on the ground of mere descriptiveness. The examining attorney also indicated in every Office action that the proposed mark appeared to be generic as applied to the goods and, therefore, incapable of functioning as a source-identifier for applicant's goods. Consequently, the examining attorney stated that she could not recommend an amendment to proceed under Section 2(f), or an amendment to the Supplemental Register. Applicant, in its responses, focused on the mere descriptiveness refusal, but also addressed the issue of genericness. After issuance of the final refusal grounded on mere descriptiveness, applicant,

in requesting reconsideration, argued that its mark was neither merely descriptive nor generic. Applicant concluded its remarks as follows: "For the reasons set forth hereinabove, Applicant's mark is at least entitled to registration on the Supplemental Register." No formal amendment to the Supplement Register, however, accompanied applicant's request for reconsideration. In denying applicant's request the examining attorney stated: "The applicant then stated the mark is at least entitled to registration on the Supplemental Register, but did not actually ask that the application be amended to the Supplemental Register. As such, that statement will not be addressed." The examining attorney began her appeal brief by asserting that the final refusal was made on mere descriptiveness and that the term ACOUSTIK "may be generic for the overall genus of goods." The examining attorney characterized the issue on appeal as being whether the mark "is descriptive and possibly generic." The examining attorney also stated the following, citing TMEP §1209.02 (5th ed. 2007):

An examining attorney should not issue a refusal in an application for the Principal Register on the ground that a mark is a generic name for the goods or services unless the applicant asserts that the mark has acquired distinctiveness under 15 U.S.C.

§1052(f). Even if it appears that the mark is generic, the proper basis for refusal is §2(e)(1). If there is strong evidence that the proposed mark is generic, a statement that the subject matter appears to be a generic name for the goods or services can be included as part of the §2(e)(1) refusal.

We recognize that the examining attorney and applicant have made arguments relative to the genericness of the term sought to be registered. As often stated, genericness is "the ultimate in descriptiveness," and if so found, is the death knell of a term functioning as a trademark. So as to be clear, while applicant late in the prosecution made reference to the Supplemental Register, applicant never filed a formal amendment to seek registration on the Supplemental Register; and the examining attorney, in her brief, stated that "the proposed mark has not been refused as generic as yet." Given the instruction set forth above in the TMEP, and since applicant is seeking registration on the Principal Register without resort to Section 2(f), we will confine this appeal to the issue of mere descriptiveness under Section 2(e)(1).

The examining attorney maintains that applicant's proposed mark ACOUSTIK is the phonetic equivalent of "acoustic," a term used by applicant and others in the flooring industry to describe a key feature of a type of

flooring or flooring underlayment that deadens or absorbs sound. In support of the refusal the examining attorney introduced a dictionary definition of "acoustic," printouts of the Internet search results using the search engine of GOOGLE, excerpts of third-party websites, and excerpts of articles retrieved from the NEXIS database.

Applicant contends that its mark is not merely descriptive because it "does not communicate a clear understanding of [applicant's] goods." Rather, according to applicant, an inferential leap is required to associate the mark with applicant's goods. Applicant also argues that the term "acoustic" has a variety of meanings and could refer to a sound barrier, a guitar or speakers and amplifiers. According to applicant, its mark is, at worst, only suggestive of flooring products. In support of its arguments applicant submitted dictionary definitions of "acoustic."

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828 (Fed. Cir. 2007); and *In re Abcor Development*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA

1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; rather, it is sufficient that the term describes one significant attribute, function or property of the goods or services. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with the goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. Contrary to the gist of a portion of applicant's argument, that a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Also contrary to one of applicant's arguments, it is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002). The "average" or "ordinary"

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consumer is the class or classes of actual or prospective customers of applicant's goods or services. *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987).

The term "acoustic" is defined, in pertinent part, as "designed to control, absorb, or carry sound."

www.encarta.msn.com; "deadening or absorbing sound."

www.m-w.com.

The record includes applicant's advertisements (submitted as substitute specimens) for the flooring products identified in its application. Applicant's own use of the term "acoustic," as shown in these materials, belies its argument that the slightly misspelled phonetic equivalent term ACOUSTIK is just suggestive.

ACOUSTIK acoustic subflooring
Acoustik is ideal under wood floors.
It provides better resistance to impact
noise and enhances the floor's acoustic
performance.

Canada Mortgage and Housing Corporation
requires acoustic insulation that meets
FIIC 55.

ACOUSTIK acoustic subflooring REDUCES
NOISE.

The examining attorney also introduced excerpts of two search summaries generated by GOOGLE's search engine showing over 36,500 "hits" for "acoustic flooring," and 800

"hits" for "acoustic underlayment flooring." These summaries are of little probative value as they provide insufficient context to determine how the term is actually used in the cited web pages. *Paris Glove of Canada Ltd. v. SBC/SportoCorp.*, 84 USPQ2d 1856 (TTAB 2007). However, the examining attorney further submitted excerpts of several "representative" web pages cited in the summaries. This evidence shows that many manufacturers use the terms "acoustic" in connection with their flooring products.

International manufacturer of
commercial floorcoverings - safety
flooring, sports flooring, acoustic
flooring...
(www.polyflor.com)

Sound proof floors and ceilings are
very specialized. Professional sound
proofing contractors can make sure your
acoustic flooring needs are met.
Contact Acousti today about our
acoustic floor solutions.
(www.acousti.com)

...many facility managers install
specialty floorcoverings that add value
and unique features to make the space
desirable. This includes cushioned
floorcoverings for workers who must
spend hours standing in one position or
area. Or, acoustic flooring that makes
the workplace more effective by
controlling overall sound transmissions
and absorption.
(www.floordaily.net)

QuietWalk is an acoustic flooring
underlay constructed of recycled

synthetic fibers with a polyethylene film vapor barrier.
(www.prweb.com)

Sound Proof Floors

We are excited to introduce our acoustic subflooring. This website will be updated to show you the many ways acoustic subflooring can install "peace and quiet."
(www.soundprooffloors.com)

There are many products and approaches on the market so we continually conduct exhaustive research to determine the optimal acoustic underlayment for different type floors.

(www.soundisolationcompany.com)

Impact-Son acoustic underlayment for laminate and engineered hardwood floors is definitely a product made for today's requirements. Its natural rubber layer reduces sound transmission and enhances underfoot comfort.

(www.quickstyle.com)

Acoustic Underlayments

With an acoustic underlayment adhered to the wood or laminate board, unwanted noise is reduced and so rooms become more comfortable to live in.

(www.interfloor.com)

The NEXIS excerpts include the following:

Schools Give Vinyl Top Marks for Acoustic Performance

With vinyl you get to keep all the other features of the product, the acoustic performance being a valuable add-on. We, like others, offer a range of ready made heterogeneous acoustic floorings...which all give an acoustic performance impact sound reduction of 19dB...Most vinyl manufacturers also

tend to offer an acoustic underlayment product...

(Contract Flooring Journal, April 1, 2007)

Stalheim's "SoundGuard" Includes Acoustic Cushion

The product features an attached acoustic underlayment designed to dampen noise.

(National Floor Trends, October 1, 2006)

Based on the record before us, we conclude that applicant's proposed mark ACOUSTIK, when applied to applicant's goods, is merely descriptive thereof under Section 2(e)(1). The term ACOUSTIK is the slightly misspelled phonetic equivalent of the commonly understood and recognized term "acoustic." It is well settled that a slight misspelling of a word will not turn a descriptive or generic word into a non-descriptive mark. *See, e.g., In re Hubbard Milling Co.*, 6 USPQ2d 1239 (TTAB 1987). *See also Nupla Corp. v. IXL Manufacturing Co.*, 114 F.3d 191, 42 USPQ2d 1711 (Fed. Cir. 1997). The mark immediately describes, without speculation or conjecture, a significant feature or characteristic of applicant's "rubber flooring, namely, subflooring and flooring underlayments," that is, the flooring products are acoustic in nature, serving to deaden or absorb sound.

In reaching our decision, we share the examining attorney's puzzlement over applicant's argument that the Internet evidence is not probative because the third-party uses of "acoustic" predate applicant's first use of ACOUSTIK. We also do not understand applicant's argument that the mark constitutes a double entendre. Although we acknowledge that any doubts must be resolved in applicant's favor on the issue of mere descriptiveness, as applicant urges, we have no doubt about the result herein.

The refusal to register on the ground of mere descriptiveness is affirmed.

Acceptability of Specimens

The examining attorney contends that applicant's specimens are not acceptable. Applicant's original specimen was identified as "a product sheet with specifications of the product." Applicant did not identify the specific nature of the substitute specimen, but clearly the specimen comprises advertising and informational material for applicant's flooring.

During prosecution of the application, applicant did not offer a single word in response to the examining attorney's requirement for acceptable specimens. After the requirement was made final, applicant simply submitted a

substitute specimen with its request for reconsideration. Then, in its appeal brief, applicant failed to make even a single reference to this requirement or to argue against the refusal.

Given applicant's complete silence regarding this requirement, applicant effectively has waived its right to object to the requirement. Under 15 U.S.C. §1062(b) and Trademark Rule 2.65(a), an applicant must respond completely to each issue raised in the examining attorney's Office action to avoid abandonment. A response is incomplete if it does not address one or more of the requirements or refusals in the Office action. TMEP §718.03 (5th ed. 2007). As indicated above, after the examining attorney refused to accept the substitute specimen, applicant made no response thereto in its brief. Moreover, even when the examining attorney maintained the requirement in her brief, applicant did not avail itself of the opportunity to file a reply brief addressing the specimen issue.

In any event, the specimens clearly are not acceptable. Advertising material is generally not acceptable as a specimen for goods. Any material whose function is merely to tell the prospective purchaser about the goods, or to promote the sale of the goods, is

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unacceptable to support trademark use. TMEP §904.04(b) (5th ed. 2007). Similarly, informational sheets or inserts are generally not acceptable to show trademark use. Thus, the specification sheet (original specimen) and the advertising and informational material (substitute specimen) are not acceptable as specimens of use on goods. *In re MediaShare Corp.*, 43 USPQ2d 1304 (TTAB 1997); *In re Drilco Industrial Inc.*, 15 USPQ2d 1671 (TTAB 1990); and *In re Bright of America, Inc.*, 205 USPQ 63 (TTAB 1979).

Accordingly, the requirement to submit acceptable specimens showing use of the mark on applicant's goods is affirmed.

Conclusion

The refusal on the ground of mere descriptiveness is affirmed.

The requirement to submit acceptable specimens is affirmed.

Accordingly, registration to applicant is refused.