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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Waste-Away Group, Ltd.

Serial No. 77887354

Gerard T. Gallagher of Barnes & Thornburg for Waste-Away Group, Ltd.

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Before Quinn, Ritchie and Hightower,
Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Waste-Away Group, Ltd. filed, on December 7, 2009, an application to register the term MECHANIC (in standard characters) for "maintenance and installation of waste handling equipment in the nature of compactors, pre-crushers and hoppers; repair and maintenance of waste handling equipment in the nature of refuse and waste handling trucks, compactors, pre-crushers and hoppers" in International Class 37. By way of amendment, applicant seeks registration on the Supplemental Register.

Applicant alleges first use anywhere and first use in commerce at least as early as July 1989.

The trademark examining attorney refused registration on the Supplemental Register under Section 23(c), 15 U.S.C. § 1023(c), on the ground that applicant's proposed mark, as used in connection with applicant's services, is generic and, thus, is incapable of registration.

Applicant originally sought registration on the Principal Register. The examining attorney initially refused registration on the ground of mere descriptiveness and, pursuant to Section 1209.02(a) of the TMEP (Oct. 2012), also advised applicant that the proposed mark appeared to be generic; applicant responded with a claim of acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f). The examining attorney found the claim to be insufficient, and again advised applicant that the proposed mark appeared to be generic. Applicant then amended the application to seek registration on the Supplemental Register, maintaining that the mark sought to be registered is not generic. When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs.

Applicant argues that the term is not generic for its services:

The genus of services identified in the present application is the maintenance, repair and installation of various waste

handling equipment. Applicant notes that in all of the evidence produced by the Examining Attorney, the term "mechanic" is used to refer to a person who performs certain services, not the services. Thus, although the public may interpret the term "mechanic" to mean someone who repairs and maintains equipment, there is simply no evidence that the relevant portion of the public refers to this class of *services* as "mechanic." Nor is the term "mechanic" the common descriptive name of maintenance, installation and repair services for waste handling equipment. (emphasis in original).

(Brief, pp. 2-3). Applicant submitted one of its flyers describing the services rendered under its proposed mark.

The examining attorney maintains that the proposed mark immediately identifies the genus or category of the provider of the services, as well as a specific genus of service provided by such persons. In this connection the examining attorney contends that the name of the provider of the services may also be the name of the services. According to the examining attorney, the evidence of record shows that the term "mechanic" identifies a type of repair and maintenance service. In support of the refusal, the examining attorney introduced dictionary definitions of the term "mechanic," and excerpts of several third-party websites allegedly showing generic usage of "mechanic" in connection with repair and maintenance services, some directed to waste handling equipment.

To be registrable on the Supplemental Register, the matter sought to be registered must be "capable of distinguishing applicant's goods or services" pursuant to Section 23 of the Trademark Act, 15 U.S.C. § 1091. Generic terms are, by definition, incapable of indicating a particular source of the goods or services. "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." *In re 1800Mattress.com IP, LLC*, 586 F.3d 1359, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009), citing *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 understood by the relevant public primarily to refer to that genus of goods or services? *Id.* "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). To be generic, members of the relevant public must primarily use or understand applicant's

term as referring to the genus of its goods or services. *Marvin Ginn*, 228 USPQ at 530.

Registrability must be determined in this appeal on the basis of the services as set forth in the application. *Magic Wand, Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991); *In re Grenliant Sys. Ltd.*, 97 USPQ2d 1078, 1081-82 (TTAB 2010); and *In re Vehicle Information Network Inc.*, 32 USPQ2d 1542, 1544 (TTAB 1994). Registration will be denied if a mark is generic of any of the services for which registration is sought. See *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980); and *In re Analog Devices, Inc.*, 6 USPQ2d 1808, 1810 (TTAB 1988), *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989).

Our first task under *Marvin Ginn* is to determine, based on the record before us, the genus of applicant's services. Applicant and the examining attorney are in essential agreement on this first factor. We find that the genus of services at issue, in relevant part, is repair and maintenance services for refuse and waste handling trucks and equipment, such as compactors, pre-crushers and hoppers.

We next determine whether the designation applicant seeks to register, MECHANIC, is understood by the relevant public primarily to refer to that genus of services. The relevant public comprises waste handling companies that are in need of

repair and maintenance services for their machinery and vehicles.

Having established the foundations of our determination, we now look to the evidence of record. The term "mechanic" is defined, in pertinent part, as "a person who repairs and maintains machinery, motors, etc." (www.dictionary.com).

Applicant submitted an informational flyer wherein applicant identifies its five business branches. One of the branches renders repair and maintenance services, and applicant summarizes its maintenance division's offerings under the proposed mark:

Mechanic

Mechanic, Inc. is a specialized equipment maintenance support facility serving the Waste-Away Group companies. Mechanic provides expertise in maintenance and installation as well as outside repair for specialized equipment. Mechanic has an in-house weld shop, fully stocked parts department and tire room. Mechanic is available for specialized equipment installation and repair of commercial and industrial customers. At Mechanic, "we keep the compactors compacting and the trucks trucking." (emphasis in original).

There also are several Internet articles about mechanics and the services they render in the waste management industry. The articles include the following:

The mechanic is one of the waste management jobs operating behind the scenes to keep the fleet of waste management trucks and service vehicles running. The mechanic will often

be employed full time for truck repairs and truck inspections. The size of the waste management fleet may depend on the size of the service area and the number of trucks in the fleet.

(www.wisegeek.com)

The Compactor Company operations personnel consist of professionally trained mechanics, certified welders and experienced management personnel. Our mechanics are well versed in dealing with refuse repair and service. We provide service and installation; complete roll off equipment; and fabrication and repairs.

(www.thecompactorcompany.com)

Let our staff of qualified mechanics extend the life of your refuse vehicle....MAWS is your service provider for problem equipment or preventive or annual maintenance inspections. Servicing ALL BRANDS of the following: Front Loaders, Rear Loaders, Roll-Offs, Hook Lifts, Sweepers.

(www.mawaste.com)

Premier Waste and Recycling operates a large vehicle fleet that provides waste disposal and recycling services throughout the Midwest....Premier Waste also has a team of skilled mechanics on-site to handle maintenance and repairs on vehicles and equipment, keeping our trucks and equipment in excellent working condition.

(www.premierwaste.net)

Mechanics who repair garbage trucks and recycling equipment serving most of Alameda County went on strike over wages early today in a move that could hobble trash pickups throughout the county.

(www.articles.sfgate.com)

Mechanic....Our technicians, working under limited supervision, perform preventative maintenance, run inspections and diagnostic

tests, and repair a variety of vehicle and equipment.
(www.greatjobs.net)

In some ways, garbage trucks are just like any other truck or vehicle on the road. They need their oil changed, their batteries installed, and their spark plugs replaced. As a Garbage Truck Mechanic, you're the one who does these basic tasks, and more.
(www.insidejobs.com)

The evidence includes excerpts of third-party websites of entities that are in the waste management industry and seeking mechanics to repair and maintain their machinery. As for example, Republic Services, Inc., a solid waste collection and disposal company, seeks a "Truck Mechanic" to repair and maintain equipment. (www.careerbuilder.com). Two other representative job postings of third parties are set forth below:

SOLID WASTE EQUIPMENT MECHANIC III. This is highly skilled work at the master level in the mechanical repair, maintenance, remanufacturing and reconditioning of gasoline or diesel powered solid waste collection equipment.
(www.stpete.org)

Truck Mechanic
We have a Mechanic/Technician A (CDL) position open in Amarillo, Texas. POSITION SUMMARY: performs repairs and maintenance on recycling equipment, compactors, Yellow Equipment (front end loaders, forklifts, skid steers) and light trucks to maximize safe and productive operations.
(www.careerbuilder.com)

As noted earlier, applicant contends that the evidence of record goes to show only that the term "mechanic" is used to refer to a person who performs certain services, not the services themselves. Thus, according to applicant, although the public may understand the term "mechanic" to mean someone who repairs and maintains equipment, there is no evidence to establish that the public understands the term "mechanic" to be a generic name for such services. The examining attorney contends, on the other hand, that the evidence shows that the relevant public would understand the designation "mechanic" to identify repair and maintenance services.

The central focus of applicant's repair and maintenance activities is the offering of the services of a mechanic. To state the obvious, mechanics are necessarily an integral part of repair and maintenance services for waste handling equipment. That is to say, an integral part of applicant's identified services concerns offering the services of their mechanics; repair and maintenance services and the mechanics who render them are inextricably intertwined, and one does not exist without the other. Thus, we find that members of the relevant public, namely waste handling entities, would readily understand the proposed mark MECHANIC to identify repair and maintenance services which, by necessity, are rendered by a mechanic. Because there is relevant precedent, we find applicant's

argument unavailing. See *In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007), *aff'g* 77 USPQ2d 1649 (TTAB 2005) (LAWYERS.COM is generic for "providing an online interactive database featuring information exchange in the fields of law, legal news and legal services"). See also *In re 1800Mattress.com IP, LLC*, supra (MATTRESS.COM is generic for "online retail store services in the field of mattresses, beds, and bedding"); and *In re Hotels.com, L.P.*, 573 F.3d 1300, 91 USPQ2d 1532 (Fed. Cir. 2009) (HOTELS.COM is generic for "providing information for others about temporary lodging; [and] travel agency services, namely, making reservations and bookings for temporary lodging for others by means of telephone and the global computer network"). In this case, the evidence shows that the term "mechanic" is necessarily used when repair and maintenance services are mentioned. In this regard, the Board previously has held that a term which is the name of the provider of goods or services is also generic of those goods or services. See, e.g., *In re E.I. Kane, Inc.*, 221 USPQ 1203 (TTAB 1984) (OFFICE MOVERS, INC. is incapable of distinguishing office facilities moving services); *In re Career Employment Services, Inc.*, 219 USPQ 951 (TTAB 1983) (THE PROFESSIONAL HEALTH CARE PEOPLE is generic when used in connection with providing temporary employment services for nurses, nurses aids and other medical personnel); and *In re Computer Store, Inc.*, 211 USPQ 72

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(TTAB 1981) (THE COMPUTER STORE for computers and computer book outlet services is incapable of registration).

Given the widespread use of the term "mechanic" in connection with repair and maintenance services, the term is incapable of distinguishing applicant's services from the same or similar services of others. Accordingly, we conclude that the proposed mark MECHANIC is generic for applicant's repair and maintenance services.

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