

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE TTAB**

Mailed: March 26, 2010

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Medcon Products, Inc.

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Serial No. 76476330

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John W. Patton, Esq. of K&L Gates, LLP for Medcon Products, Inc.

Carrie Genovese, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

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Before Quinn, Hairston and Kuhlke, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Medcon Products, Inc. has filed an application to register the mark ILEX (standard character form) for goods ultimately identified as "medicated skin care preparations, namely, skin paste for use by ostomy patients to protect the stomal region of the body and medicated skin paste for the treatment of diaper rash" in International Class 5.<sup>1</sup>

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<sup>1</sup> Application Serial No. 76476330, filed on December 18, 2002, which sets forth a date of first use anywhere and in commerce of January 1, 1979.

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The trademark examining attorney has finally refused registration under Section 2(a) of the Trademark Act on the ground that applicant's mark is deceptive, and under Section 2(e)(1) of the Act on the ground that applicant's mark is deceptively misdescriptive of applicant's goods and the mark has not acquired distinctiveness.

Applicant has appealed, and both applicant and the examining attorney have filed briefs.

The examining attorney maintains that the word "ilex" means "plant of holly genus: a tree or bush belonging to a genus whose best-known member is the holly tree." *Encarta on-line dictionary*. Because applicant's medicated skin paste does not contain ingredients derived from ilex plants, the examining attorney contends that the mark ILEX misdescribes applicant's goods. Further, because ingredients derived from ilex plants are commonly found in skin care products, the examining attorney asserts that purchasers are likely to believe that applicant's medicated skin paste contains ingredients derived from ilex plants, when in fact, they do not; and because ingredients derived from ilex plants are sought after for their healing and soothing properties, purchasers are likely to buy applicant's goods on the basis of their mistaken belief that the medicated skin paste contains ingredients derived

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from ilex plants. In addition to the dictionary listing cited above, the examining attorney submitted various evidence to support the refusals to register. Among the evidence is the following *Wikipedia* entry for "Holly."

Holly (*Ilex*) is a genus of about 400 species of flowering plants in the family Aquifolaceae, and the only genus in that family. ... Holly berries are mildly toxic and will cause vomiting and/or diarrhea when ingested by people. ... Several American holly species are used to make various caffeine rich teas. The South American *I. paraguaniensis* is used to make yerba mate, a common drink ...

She also submitted webpages obtained from the Internet and excerpts retrieved from the NEXIS database which refer to the use of ilex (holly) plants as herbal remedies and ingredients in some products. The following are representative:

*Ilex verticilla* Winterberry - The bark is antiseptic, astringent, cathartic and tonic... A decoction is used internally in the treatment of diarrhea, malaria, etc, and internally in the treatment of indolent sores and chronic skin disease ... and *Ilex opaca* American Holly ... the leaves have also been used externally in the treatment of ... sore and itchy skin ...  
([pfaf.org/database/plants](http://pfaf.org/database/plants));

*Ilex opaca* - Sol. Ex Aiton  
American Holly  
Medicinal Uses  
Antiperiodic; Diuretic; Emetic; Laxative;  
Ophthalmic; Skin  
The leaves have also been used externally in the

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treatment of sore eyes, sore and itchy skin ... It has also been used as a wash for sore eyes and itchy skin.

(pfaf.org/database/plants);

BIOFREEZE® products with ILEX  
CRYOTHERAPY PAIN RELIEF

BIOFREEZE products contain ILEX, an herbal extract from a South America holly shrub. ILEX is used around the world in various health & wellness formulations. BIOFREEZE topical analgesic does not use waxes, oils, aloe or petroleum, The result is a fast-acting, penetrating, long lasting pain reliever.

(biofreeze.com);

CyroDerm Pain Relieving Cryotherapy Spray with MSM, Arnica, Bosella, ILEX - CyroDerm Pain Relieving Spray is the analgesic spray used across the USA ... to relieve muscle and joint pain.

(herbalremedies.com);

FL ORGANIC ESSENTIALS SKIN MASKS  
HERBAL SCRUB MASK contains ... Mate (Ilex Paraguanensis) Extract

(bewellstaywell.com); and

Christine Marie Cosmetics  
Ultra Free Cleansing Milk  
Contains: Holly leaf oil ...

(christinemariecosmetics.com).

In addition, the examining attorney submitted a copy of U.S. Patent No. 6,210,660, issued April 3, 2001, to a third-party for a "Cosmetic preparation containing Ilex resin method for obtaining Ilex resin and Ilex resin which can be obtained by this method;" and the following excerpt from the website of a specialty chemical supplier:

Ilex Wax CO2 (Ilex Paraguanensis)

The resin is very versatile in formulation. Used in skin care products a cream appears more nourishing. Depending on the concentration of Ilex resin the skin care action in o/w and w/o emulsions can be developed to produce really effective skin protection.  
(jarchem.com)

Applicant argues that its mark is neither deceptive nor deceptively misdescriptive, but rather is a coined term which is a combination of the word "ileostomy," a post-surgical condition that its skin paste is used to treat, and the word "excoriation," the breakdown of skin surrounding the stoma, which is a common complication for patients with an ileostomy. Applicant states that there is no need for its goods to contain ingredients derived from ilex plants, and that purchasers of its goods are not likely to believe that the goods contain such ingredients. Further, applicant criticizes the examining attorney's Internet and NEXIS evidence by asserting that the evidence pertains to goods that are either cosmetic in nature or taken orally, and not applicant's type of medicated skin paste. Finally, applicant argues that if its mark, ILEX, is found not to be deceptive, but deceptively misdescriptive of its goods, the mark has acquired distinctiveness.

In support of its position, applicant has submitted informational materials about the ileostomy procedure, a

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copy of U.S. Patent No. 5,194,261 which covers applicant's goods, a copy of the product information sheet for applicant's goods, Internet printouts showing that ilex (holly) extracts are used in beverages to treat a number of conditions unrelated to those affecting skin, and statements about applicant's goods from medical professionals and purchasers.

The test for determining whether a mark is deceptive under Section 2(a) has been stated by the Court of Appeals for the Federal Circuit as: (1) is the term misdescriptive of the character, quality, function, composition or use of the goods; (2) are prospective purchasers likely to believe that the misdescription actually describes the goods; and (3) is the misdescription likely to affect the decision to purchase. *In re Budge Manufacturing Co., Inc.*, 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988).

We begin our analysis by reviewing the product information sheet for applicant's goods to understand the specific nature of the goods. The information sheet describes applicant's goods as a "skin protectant paste" indicated "[f]or the prevention and treatment of skin irritations and excoriations from a variety of procedures such as ileostomy, colostomy, fistula, G-tube placements, excoriations resulting from pediatric and geriatric

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incontinence in the perianal region, fecal fistula, surgical and traumatic wounds with drainage causing dermal irritation and skin breakdown." It is readily apparent from this description that applicant's medicated skin paste is a highly specialized skin care preparation.

We find that neither prong of the test for deceptiveness is met. With respect to the first prong, the record is devoid of any evidence that medicated skin paste of the type made by applicant contains ingredients derived from ilex (holly) plants. Given this, we do not see how the term ilex misdescribes applicant's goods. Although the evidence indicates that topical pain relievers, cosmetic preparations, and herbal remedies contain ingredients derived from ilex plants, these types of products are obviously very different from applicant's medicated skin paste for use by ostomy patients and for the treatment of diaper rash. Thus, the fact that these products contain ingredients derived from ilex plants does not establish that medicated skin paste of the specific type made by applicant generally contains such ingredients.

In short, the examining attorney's evidence fails to establish that the term "ilex" misdescribes applicant's goods.

Even assuming arguendo that the term "ilex" misdescribes applicant's medicated skin paste because it does not contain ingredients derived from ilex plants, the second and third prongs of the test clearly are not met based on the record before us. As we have already found, there is no evidence in the record indicating that the type of medicated skin paste made by applicant contains ingredients derived from ilex plants. Furthermore, although "ilex" is a dictionary term, it is the scientific plant name for "holly," and it is highly unlikely that purchasers would be familiar with the term. Also, we find applicant's explanation with respect to coining the term ILEX entirely plausible in view of the use of applicant's goods. Under the circumstances, purchasers of applicant's medicated skin paste are not likely to be deceived by applicant's mark into believing that the medicated skin paste contains ingredients derived from ilex plants. On the contrary, they are likely to view applicant's mark ILEX simply as a coined term.

Furthermore, because the evidence does not establish that ingredients derived from ilex plants are a desirable component of applicant's type of medicated skin paste, even if we were to assume that the term "ilex" misdescribes applicant's goods, the misdescription would not materially



affect the purchasing decision. In this regard, we note the excerpt from "jarchem.com" which states that "[Ilex] resin is very versatile in formulation. Used in skin care products a cream appears more nourishing. ... ilex resin can be used to produce really effective skin protection."

However, we cannot conclude from this single excerpt that ilex resin is a desirable component of applicant's type of medicated skin paste. Insofar as the remaining excerpts are concerned, apart from the fact that they do not clearly tout the beneficial effects of ingredients derived from ilex plants, as previously indicated, the excerpts pertain to products that are very different from applicant's goods.

In view of the foregoing, we find that applicant's mark is not deceptive of its goods.

Insofar as the deceptive misdescriptiveness of applicant's mark is concerned, because the test for deceptive misdescriptiveness consists of the first two prongs of the test for deceptiveness, we find that applicant's mark is not deceptively misdescriptive of its goods for the reasons discussed above.

In view of our findings herein, we need not reach applicant's alternative Section 2(f) claim of acquired distinctiveness.

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**Decision:** The refusals to register under Sections 2(a) and 2(e)(1) of the Act are reversed. Applicant's application will go forward without the alternative Section 2(f) claim of acquired distinctiveness.