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SERIAL NO: 77/443720

MARK: EVITAMINS



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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Twin Associates, LC

CORRESPONDENT'S REFERENCE/DOCKET NO:

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the examining attorney's refusal to register the mark EVITAMINS under Section 23 of the Trademark Act on the ground that the mark is generic of the recited services, namely, "mail order catalog services featuring vitamins and dietary supplements; on-line retail store services featuring vitamins and dietary supplements."

FACTS

The applicant, Twin Associates, LC, DBA EVitamins, filed an application to register the mark EVITAMINS for "mail order catalog services featuring vitamins and dietary supplements; on-line retail store services featuring vitamins and dietary supplements."

On July 22, 2008, the examining attorney refused registration under Section 2(e)(1) with a generic advisory. On January 19, 2009, the applicant responded to the refusal and

amended the application to add a claim of acquired distinctiveness under Section 2(f). On February 23, 2009, the examining attorney issued a Section 2(e)(1) generic refusal and indicated that applicant's claim of acquired distinctiveness under 15 U.S.C. §1052(f) was insufficient to overcome the refusal because no amount of purported proof that a generic mark has acquired secondary meaning can transform it into a registrable trademark. On April 9, 2009, the applicant argued against the generic refusal. On April 17, 2009, the examining attorney issued a final refusal maintaining the Section 2(e)(1) refusal and deeming the Section 2(f) evidence insufficient because of the generic nature of the mark. In response the applicant filed an appeal.

OBJECTION TO UNTIMELY EVIDENCE

Applicant has submitted with its brief an additional list of registrations that were not properly made of record. Applicant's brief, page 14. It should be noted that the mere submission of a list of registrations or a copy of a private company search report does not make such registrations part of the record. *See, e.g., In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998); *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1561 n.6 (TTAB 1996). To make registrations part of the record, an applicant must submit copies of registrations from USPTO records only. *E.g., In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002); *In re Carolina Apparel*, 48 USPQ2d 1542, 1543 n.2 (TTAB 1998); TBMP §1208.02; TMEP §710.03.

ARGUMENT

I. SECTION 23 – REFUSAL TO REGISTER ON THE SUPPLEMENTAL REGISTER

A. Generic Refusal

Registration was refused under Trademark Act Section 23, 15 U.S.C. §1091, because the proposed mark is generic and therefore unregistrable on the Supplemental Register. 37 C.F.R. §2.64(a).

The applicant applies to register the mark EVITAMINS for “mail order catalog services featuring vitamins and dietary supplements; on-line retail store services featuring vitamins and dietary supplements.” Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods and/or services. TMEP §1209.01(c); *see In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001); *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986). Generic terms are by definition incapable of indicating a particular source of the goods and/or services, and cannot be registered as trademarks and/or service marks; doing so “would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.” *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1569, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987); *see* TMEP §1209.01(c).

B. Applicant’s Arguments

The applicant argues that the public understands the mark to refer to the applicant’s services as demonstrated by their exclusive use of the term. Furthermore, the use of the “e” prefix coupled with a descriptive term is capable of distinguishing the applicant’s services. Applicant’s brief, page 8. The applicant supports these arguments by

referencing to its Section 2(f) evidence already submitted and discounting the evidence submitted by the examining attorney.

C. Generic Test

A two-part test is used to determine whether a designation is generic:

- (1) What is the class or genus of goods and/or services at issue?; and
- (2) Does the relevant public understand the designation primarily to refer to that class or genus of goods and/or services?

H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986); TMEP §1209.01(c)(i).

1. Genus of the Goods Being Sold On-line

With respect to the first prong of the generic test, the goods being sold on-line are identified as vitamins and dietary supplements. A word or term that is the name of a key ingredient, characteristic or feature of the services can be generic for those services and thus, incapable of distinguishing source. A term does not need to be the name of the services to be found incapable of serving as an indicator of origin. *In re Eddie Z's Blinds & Drapery, Inc.*, 74 USPQ2d 1037 (TTAB 2005) (holding BLINDSANDDRAPERY.COM generic for online retail store services featuring blinds, draperies and other wall coverings); *In re Candy Bouquet Int'l, Inc.*, 73 USPQ2d 1883 (TTAB 2004) (holding CANDY BOUQUET generic for “retail, mail, and computer order services in the field of gift packages of candy”); *In re Reckitt & Colman, N. Am. Inc.*, 18 USPQ2d 1389 (TTAB 1991) (holding PERMA PRESS generic for soil and stain removers); *see* TMEP §§1209.01(c) *et seq.*

Please refer to the definitions below extracted from evidence attached in the February 23, 2009 Office action and the April 17, 2009 Final Office action, which define a vitamin as:

“Any of various fat-soluble or water-soluble organic substances essential in minute amounts for normal growth and activity of the body and obtained naturally from plant and animal foods.”

“[An] organic substance essential to nutrition.”¹

The recitation of services itself satisfies the burden of proof with respect to the first prong of the generic test. The plain meaning of the wording used in the recitation shows that vitamins are the class of goods at issue being sold on-line by the applicant.

A term that is generic for a type of goods is also generic for the service of selling primarily those goods. See *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001) (holding RUSSIANART generic for art dealership services in the field of Russian art); *In re Log Cabin Homes Ltd.*, 52 USPQ2d 1206 (TTAB 1999) (holding LOG CABIN HOMES generic for architectural design of buildings and retail outlets featuring kits for constructing buildings, especially houses); *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224 (TTAB 1987) (holding LA LINGERIE generic for retail store services featuring clothing); *In re Wickerware, Inc.*, 227 USPQ 970 (TTAB 1985) (holding WICKERWARE generic for mail order and distributorship services featuring products made of wicker); *In re Half Price Books, Records, Magazines, Inc.*, 225 USPQ 219

¹ The Trademark Trial and Appeal Board can take judicial notice of definitions obtained from dictionaries in printed format. In addition, the Board can also take judicial notice of online dictionaries available in printed format or online dictionaries that are readily available and capable of being verified, e.g., dictionaries that are available in specifically denoted editions via the Internet and CD-ROM. See Fed. R. Evid. 201; 37 C.F.R. §2.122(a); *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828 (Fed. Cir. 2007); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006); TBMP §1208.04; TMEP §710.01(c).

(TTAB 1984) (holding HALF PRICE BOOKS RECORDS MAGAZINES generic for retail book and record store services); TMEP §1209.03(r). As provided in the July 22, 2008, February 23, 2009, and April 17, 2009 Office Actions and the applicant's submitted specimen, the applicant's website, www.evitamins.com, indicates that it is primarily selling vitamins electronically, or on-line:

<http://www.evitamins.com/> 02/07/09 12:00:58 PM

The screenshot shows the eVitamins website interface. At the top, there is a navigation bar with the eVitamins logo, a shopping cart icon showing 11 items for \$80.00, and links for My Account, Clearance, Re-Order, and Help. Below this is a search bar and a category menu with options like Bath & Beauty, Bodybuilding, Herbs, Pets, Sexual, Vitamins, Weight Loss, and Other Categories. A secondary navigation bar offers 'Shop By Product', 'Shop By Brand', and 'Shop By Gender', along with a toll-free order number: 1.888.222.8088.

The main content area is divided into several sections:

- Featured Items:** A central section titled "Featured Items" with the subtitle "Some of our most popular items!". It displays six products with their names, images, and prices:
 - all Diet Pill Refill Kit (120 Caps) \$59.99
 - Fast Trim 90 Caps \$34.97
 - Fast Ultra 3 Caps \$12.95
 - Hib-Pox Extreme 110 Caps \$29.95
 - Alpha-Pro ECG 120 Caps \$55.99
 - Vital-Aid 60 Caps \$24.99
- Feature Name Brands:** A section titled "Feature Name Brands" with the subtitle "Save up to 70% off today!". It features logos for Dr. Dees, Carlson Labs, and Dr. Christopher's.
- What's New:** A vertical sidebar on the right titled "What's New!" listing several products with their MSRP and current price:
 - SECURE Denture Adhesive by Bioforce
 - Safe Menopause Tablets by Bioforce
 - Digestive Aid by Bioforce
 - Shin-Aid by Bioforce
- Health News:** A section on the left titled "Health News" with a list of articles:
 - Chronic Low Back Pain Is on the Rise
 - Cyclosporine Eye Drops a Good Deal for Dry Eye
 - Health High Grid: Feb. 13, 2009
 - Chronic Insulin Update Feb. 10, 2009
- Health Resources:** A section on the left titled "Health Resources" with a list of links:
 - Health Encyclopedia
 - Webinars & Conferences
 - Health Store
 - Healthy Recipes
- FREE Product Catalog:** A promotional box on the left offering a free product catalog, with options for "MAIL" or "ONLINE" delivery.

Applicant's mark is formed by joining the prefix "e" and the generic term VITAMINS.

The services include the on-line retailing of vitamins. The evidence of record shows that relevant consumers clearly understand the VITAMINS designation to primarily refer to

the class or genus of the goods provided via the services at issue in this case namely, vitamins and dietary supplements. The evidence also shows that consumers recognize that the “e” prefix has become commonly recognized as a designation for goods or services that are electronic in nature or are sold or provided electronically. Please refer to the definitions below extracted from evidence attached in the February 23, 2009 and the April 17, 2009 Office actions, which define

“e-” as follows:

“Electronic;” and “electronic data transfer via the internet.”

“(Electronic-) The ‘e’ prefix, with or without the hyphen, may be attached to anything that has moved from the physical world to its electronic alternative, such as ‘e-mail’ and ‘e-commerce.’ ‘E’ words have become synonymous with the Internet.”

Applicant contends that an “e” prefix does not make its mark generic. Applicant’s brief, page 12. This Board has repeatedly held that when the “e” prefix, with or without the hyphen, is coupled with a generic word or term for electronic goods and/or services, then the entire mark is considered generic. *See In re Int’l Bus. Mach. Corp.*, 81 USPQ2d 1677 (TTAB 2006) (holding ESERVER generic for computer hardware and operating software that allow network connectivity and administration and processing of information); *Cont’l Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385 (TTAB 1999) (holding E-TICKET generic for computerized reservation and ticketing of transportation services); TMEP §1209.03(d).

A combination of generic words may result in a unitary designation that is registrable if the meaning is incongruous or the juxtaposition of such words evokes a unique commercial impression. However, as in the present case, if the combination of two or

more generic words is such that each word retains its generic significance, then the combined expression is generic and incapable of denoting source. *See In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE); *see also In re Leatherman Tool Group, Inc.*, 32 USPQ2d 1443 (TTAB 1994) (POCKET SURVIVAL TOOL); *In re Lowrance Elecs.*, 14 USPQ2d 1251 (TTAB 1989) (COMPUTER SONAR); *Turtle Wax, Inc. v. Blue Coral, Inc.*, 2 USPQ2d 1534 (TTAB 1987) (WASH WAX); TMEP §1209.01(c)(i).

2. Relevant Public Perception of Genus

It should be noted that evidence of the public's understanding of a term can be obtained from any competent source, including dictionary definitions, research databases, newspapers and other publications. *See In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985) (BUNDT, a term that designates a type of cake, held generic for ring cake mix); *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989) (ANALOG DEVICES held generic for devices having analog capabilities). Applicant's website and the websites of others are also proper sources of evidence as to the meaning of the proposed mark and the manner in which it is used in relation to the goods/services. *In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007) (In holding LAWYERS.COM generic for "providing an online interactive database featuring information exchange in the fields of law, legal news and legal services," the Board properly considered applicant's website and eight other websites containing

“lawyer.com” or “lawyers.com to determine the meaning of applicant’s “information exchange about legal services.”).

When a term is compound, as here, the burden of proof can be satisfied in producing evidence that each of the constituent words is generic, and that the separate elements retain their generic significance when joined to form a compound. In other words, the compound element retains the generic meaning of the individual elements. TMEP Section 1209.01(c)(i); citing *In re Gould Paper Corp.*, 834 F.2d. 1017, 5 USPQ2d 1110, 1111-1112 (fed. Cir. 1987)(SCREENWIPE held generic as applied to premoistened antistatic cloths for cleaning computer and television screen).

The record in this case shows that both the prefix “e” and the term VITAMINS are generic of the services. When used in combination, the terms retain their generic meaning. In establishing the genericness of the wording, the examining attorney previously submitted dictionary definitions and evidence gleaned from a search on the Internet indicating that the relevant public understands that consumers may buy vitamins on-line. Such evidence from the February 23, 2009 Office action included a website caption from www.evitaminstore.com , an online store that sells vitamins.

With regards to the VITAMINS portion of the mark, the dictionary definitions, web search results and evidence supplied by the applicant show that VITAMINS is commonly used to identify vitamins and dietary supplements. Evidence in the April 17, 2009 Office action indicates that consumers are very familiar with obtaining vitamins online. The

applicant also repeatedly refers to EVITAMINS for online retail store services that sell vitamins in the submitted Section 2(f) evidence. Examples include the following statements advertising EVITAMINS:

Captions from the January 19, 2009 Applicant response:

“Michigan’s Largest Online Vitamin and Supplement Superstore” (page 9.)

“Simply log on to EVitamins, the Vitamin e shop.” (page 13).

“eVitamins, an award-winning online nutritional superstore, carries more than 300 top name brands- all priced below standard retail prices.” (page 17).

“eVitamins sells online, via its website...” (page 19).

“What it does: Sells vitamins and other nutritional products online and in a catalogue.” (page 21).

The applicant avers that the use of the “e” prefix coupled with a descriptive term is capable of distinguishing the applicant’s services. Applicant’s brief, page 8. In support, the applicant asserts that its services do not solely feature the selling of “vitamins,” but includes other goods. Applicant’s brief, pages 8-9. “A mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services.” *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if the term describes only one significant function, attribute or property. *In re Oppedahl*, 373 F.3d at 1173, 71 USPQ2d at 1371; TMEP §1209.01(b). Here, the term “vitamins” does not merely describe the goods sold through the services; it is generic for those goods and thus generic for the related services.

The applicant argues that the public solely associates the mark with the applicant's services through their exclusive use of the wording EVITAMINS. Please note that the fact that an applicant may be the first and only user of a generic designation is not dispositive on the issue of genericness where, as here, the evidence shows that the word or term is generic. *See Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1631 (TTAB 1998); TMEP §1209.03(c).

The applicant argues that there is no dictionary definition of the term EVITAMINS. Applicant's brief, page 13. The fact that applicant's mark is not found in the dictionary is not controlling on the question of registrability. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977); TMEP §1209.03(b).

Applicant avers that its mark also refers to a family of vitamin products containing the "Vitamin E complex." In its brief, the applicant states the following: "Applicant's services, in their totality, are on-line selling of vitamins, herbal products, body-building supplements, bath and beauty products, pet products, sexual aids, anxiety remedies, and weight loss products, with vitamins being just *one* of the many items offered by Applicant." Applicant's brief, pages 8 and 9. This statement, along with the applicant's submitted 2(f) evidence and the evidence submitted from the applicant's website, make no reference to the applicant's averment. Descriptiveness is considered in relation to the relevant services. The fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness. *In re Chopper Indus.*, 222 USPQ 258,

259 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979); TMEP §1209.03(e). This argument is not well founded as the proposed mark is EVITAMINS not VITAMIN E.

3. Sufficient Evidence

The applicant contends that the evidence is insufficient to prove that the mark is generic. Applicant's brief, page 13. The examining attorney acknowledges that the Office has the burden of proving genericness by clear evidence. *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). In satisfying the first prong of the generic test, the recitation of services provides such proof. In addition, with respect to the second prong of the generic test, the record contains dictionary definitions, evidence from a search of the global computer networks, and scores of material supplied by the applicant to show distinctiveness. Moreover, evidence of the relevant public's understanding of the terms or disputed phrase has been obtained from competent sources. *See In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985)(BUNDT, a term that designates a type of cake, held generic for ring cake mix); *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd*, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989)(ANALOG DEVICES held generic for devices having analog capabilities). Here, evidence provided by the examining attorney and the applicant establishes that to the average consumer, the term EVITAMINS immediately conveys the meaning vitamins obtained on-line. There is nothing incongruous in the term EVITAMINS, when used in connection with on-line services retailing vitamins. Consumers encountering the term EVITAMINS in connection with

on-line services retailing vitamins would immediately grasp the informational connotation of the term. Therefore, the burden of proof has been satisfied.

II. CLAIM OF ACQUIRED DISTINCTIVENESS INSUFFICIENT

In the alternative, the applicant argues that the mark has acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. §1052(f). Applicant's brief, page 5. The applicant's evidence in support of its claim of acquired distinctiveness consists of applicant's allegation of five years' use coupled with a declaration statement, news stories and other studies, customer satisfaction surveys, and various website captions.

The burden of proving that a mark has acquired distinctiveness is on the applicant.

Yamaha Int'l Corp. v. Yoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 122 USPQ 372 (C.C.P.A. 1959); TMEP §1212.01. An applicant must establish that the purchasing public has come to view the proposed mark as an indicator of origin.

More evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the named services would be less likely to believe that it indicates source in any one party. *See, e.g., In re Bongrain Int'l Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); *In re Seaman & Assocs., Inc.*, 1 USPQ2d 1657 (TTAB 1986).

No amount of purported proof that a generic term has acquired secondary meaning can transform that term into a registrable trademark. Such a designation cannot become a

trademark under any circumstances. *See In re Bongrain*, 894 F.2d at 1317 n.4, 13 USPQ2d at 1728 n.4; *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989, 228 USPQ 528, 530 (Fed. Cir. 1986); TMEP §1212.02(i). Applicant's allegation of five years' use coupled with a declaration statement, news stories and other studies, customer satisfaction surveys, and various website captions are insufficient evidence of distinctiveness in this case because the mark, herein, is generic as used in connection with the identified services. *See* TMEP §1212.04(a). *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985); TMEP §1212.05(a). *In re Kalmbach Publishing Co.*, 14 USPQ2d 1490 (TTAB 1989).

Because the applied-for mark is highly descriptive of applicant's services, the allegation of five years' use is insufficient to show acquired distinctiveness. *In re Kalmbach Publ'g Co.*, 14 USPQ2d 1490 (TTAB 1989); TMEP §1212.05(a). Applicant's proffered claims of significant advertising expenditures merely indicate that it has enjoyed commercial success. The applicant's advertising expenditures are merely indicative of both its success and its efforts to develop distinctiveness, not evidence that the mark has actually acquired distinctiveness. *See In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991). The "customer satisfaction surveys" do not support a claim of acquired distinctiveness. The proposed mark, as shown on the news stories and website captions simply reinforces the generic nature of the mark.

In sum, no amount of purported proof that a generic term has acquired secondary meaning can transform that term into a registrable trademark. Such a designation cannot

become a trademark under any circumstances. *See Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 195 USPQ 281 (7th Cir. 1977), *cert. denied*, 434 U.S. 1025, 196 USPQ 592 (1978).

CONCLUSION

The evidence of record demonstrates that the applicant's proposed mark is generic of the services. The services with which the applicant intends to use the mark involve on-line retailing of vitamins. The addition of the prefix "e" merely serves as a designation of the Internet as the means of obtaining these products. The mark is therefore incapable of registering on the Supplemental Register.

The examining attorney, therefore, respectfully submits that the refusal of registration be affirmed.

Respectfully submitted,

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