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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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Applied for Mark	CHILDREN'S DHA
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In Re Application of Nordic Naturals, Inc.

Application Ser. No. : 77/752,741

Filed : June 5, 2009

Mark : CHILDREN'S DHA  
(Stylized)

Trademark Trial and Appeal Board  
United States Patent and Trademark Office  
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**APPLICANT'S APPEAL BRIEF**

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Applicant, Nordic Naturals, Inc., seeks to register the trademark CHILDREN’S DHA in stylized form for use in connection with “nutritional supplements containing DHA” in International Class 5. Applicant has been using the CHILDREN’S DHA (Stylized) mark in commerce for more than 8 years and has achieved great commercial success. The Examining Attorney has refused to register Applicant’s mark, however, because the Examining Attorney believes that the wording “CHILDREN’S DHA” is a generic term for the identified goods or, alternatively, that Applicant’s mark is merely descriptive and that Applicant’s Section 2(f) evidence is insufficient to support its claim of acquired distinctiveness. Applicant hereby appeals the Examining Attorney’s refusal to register the mark and requests that the Trademark Trial and Appeal Board reverse the Examining Attorney’s decision, allowing the CHILDREN’S DHA (Stylized) mark to be registered on the Principal Register, after publication and an opportunity for third parties to oppose such registration.

### **STATEMENT OF THE ISSUES**

This Appeal presents the Board with the following four issues:

- (1) Whether the Examining Attorney has met her burden of proving that Applicant’s mark, as a whole, is generic for “nutritional supplements containing DHA”;
- (2) Assuming the Examining Attorney has not met her burden, whether Applicant’s mark is merely descriptive of “nutritional supplements containing DHA”;
- (3) In view of Applicant’s 8 years of continuous use and the substantial evidence of secondary meaning, including sales, promotional efforts, advertising expenditures, retailer declarations, and unsolicited end-user comments associating the product with the source, has Applicant met its burden of showing that Applicant’s mark has acquired distinctiveness; and

(4) Notwithstanding the above, whether Applicant's mark is sufficiently stylized to warrant registration on the Principal Register.

### **FACTS**

The following facts are part of the record below. Applicant began using "CHILDREN'S DHA" as a trademark in connection with its nutritional supplements in July 2000. Applicant adopted the subject stylized form of its CHILDREN'S DHA mark in October 2003, and has enjoyed substantially exclusive use of the stylized mark for more than 8 years. Applicant filed an application with the U.S. Patent and Trademark Office to register its CHILDREN'S DHA (Stylized) mark in June 2009. The Examining Attorney preliminarily refused registration of the mark, however, under Section 2(e)(1), based on the Examining Attorney's belief that "the applied-for mark merely describes an ingredient and user of applicant's goods" and, therefore, is merely descriptive. (September 9, 2009 Office Action).

In response to the September 9, 2009 Office Action, Applicant asserted that its CHILDREN'S DHA mark is suggestive, but that, even if it were considered descriptive, it had acquired distinctiveness, as evidenced by, among other things: (1) Applicant's substantially exclusive use of the mark for more than five years; (2) Applicant's sales of goods under the CHILDREN'S DHA mark; (3) Applicant's advertising expenditures and efforts to promote goods sold under the CHILDREN'S DHA mark; and (4) third parties' recognition of Applicant's CHILDREN'S DHA mark as a source identifier. (March 9, 2010 Response to Office Action). Notwithstanding this evidence, the Examining Attorney issued a second Office Action, maintaining her prior refusal to register the mark, asserting that the applied-for mark is generic. In the alternative, the Examining Attorney maintained the refusal on the basis that the mark is merely descriptive and that the Section 2(f) claim was insufficient. While recognizing that

Applicant had provided “evidence of high sales figures and significant advertising expenditures,” the Examining Attorney stated that “[s]uch extensive sales and promotion may demonstrate the commercial success of applicant’s goods . . . but not that relevant consumers view the matter as a mark . . . .” (March 13, 2010 Office Action).

In response to the March 13, 2010 Office Action, Applicant argued against the genericness refusal, argued that acquired distinctiveness had been shown, and asserted that, in maintaining the refusal, the Examining Attorney had ignored the stylized nature of Applicant’s mark. (September 13, 2010 Response to Office Action). However, the Examining Attorney again rejected Applicant’s arguments and evidence, making final the refusal of Applicant’s mark under Section 2(e)(1) based on the Examining Attorney’s belief that the mark is generic. (October 4, 2010 Final Office Action). Applicant filed this Appeal, as well as a Request for Reconsideration, on April 4, 2011.

In its Request for Reconsideration, Applicant argued that Applicant’s mark had been improperly dissected by the Examining Attorney, that the mark is not generic, that the mark has acquired distinctiveness, and that the stylized nature of the mark warranted registration. (April 4, 2011 Request for Reconsideration). In response to these arguments, a fourth Office Action, the second Final Office Action in this case, was issued by the Examining Attorney and responded to by Applicant.

On January 20, 2012, the Examining Attorney issued a fifth Office Action, denying Applicant’s second Request for Reconsideration and continuing the refusal to register Applicant’s mark under Section 2(e)(1). Accordingly, the Board resumed the appeal.

Notwithstanding the overwhelming evidence of record in support of Applicant’s position that its mark is not generic and has acquired distinctiveness, the Examining Attorney has refused

registration of Applicant's mark. The Examining Attorney's refusals have been maintained erroneously. Accordingly, Applicant respectfully submits this Appeal and asks the Board to reverse the Examining Attorney's refusals.

## **ARGUMENT**

### **APPLICANT'S MARK SHOULD BE APPROVED FOR PUBLICATION**

There are three reasons the Examining Attorney's refusal to register Applicant's mark should be reversed. First, Applicant's mark is not generic. Second, to the extent Applicant's mark is merely descriptive of Applicant's goods, Applicant has supported its claim of acquired distinctiveness. Third, Applicant's mark is sufficiently stylized such that registration of the mark on the Principal Register is warranted. For these reasons, as fully set forth below, Applicant respectfully requests that the Board reverse the Examining Attorney's refusals and order that Applicant's mark CHILDREN'S DHA (Stylized) be passed for publication.

#### **I. APPLICANT'S MARK IS NOT GENERIC**

In the face of evidence that establishes the source-identifying role of Applicant's mark, the Examining Attorney has refused registration of Applicant's mark believing it to be generic. In so doing, the Examining Attorney does not meet the substantial burden the Trademark Office bears to prove that Applicant's mark is generic. *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 1571, 4 USPQ2d 1141 (Fed. Cir. 1987).

A generic term is one that "the relevant purchasing public understands primarily as the common or class name for the goods or services." TMEP § 1209.01(c) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001); *In re Am. Fertility Soc'y*, 188 F.3d 1341, 1346, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999)). The test used to determine whether a term is generic requires analysis of two questions: "(1) What is the genus of goods or services at issue? and (2) Does the relevant public understand the designation primarily

to refer to that genus of goods or services?” TMEP § 1209.01(c)(i) (citing *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)).

“The test turns upon the primary significance that the term would have to the relevant public.”

*Id.*

The burden of proving that a term is generic is a high one and can only be met by “clear evidence.” *Merrill Lynch*, 828 F.2d at 1571. Indeed, the U.S. Patent and Trademark Office must be careful not over-limit registration, lest “valuable trademark rights will be lost.” *In re Ideal Indus., Inc.*, 508 F.2d 1336, 1338, 184 USPQ 487 (C.C.P.A. 1975). Therefore, in determining whether Applicant’s mark is merely descriptive (or generic), or suggestive or arbitrary, it is well established that the Examining Attorney must resolve any doubt in favor of Applicant. *See, e.g., In re Aid Labs., Inc.*, 221 USPQ 1215, 1216 (TTAB 1983). In this instance, the Examining Attorney has wholly failed to meet this burden, warranting reversal on this basis, alone.

Applicant’s mark is not generic. As a preliminary matter, “[t]he commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety . . . .” *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 545-46 (1920); *see also In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420 (Fed. Cir. 2005) (“An inquiry into the public’s understanding of a mark requires consideration of the mark as a whole.”).

Yet, the mark, as a whole, is not what the Examining Attorney reviewed. Applicant is not seeking registration for a standard character mark. Rather, Applicant seeks to register a highly stylized mark. Even if the literal element of a mark is arguably generic or merely descriptive, a mark can still be registered when the “stylization of the words or the accompanying design features of the asserted mark create an impression on purchasers separate

and apart from the impression made by the words themselves.” *In re Am. Acad. of Facial Plastic and Reconstructive Surgery*, 64 USPQ2d 1748, 1753 (TTAB 2002); *see also In re Jackson Hole Ski Corp.*, 190 USPQ 175 (TTAB 1976) (holding that stylization of the letters JH, used in connection with a geographic designation, was sufficient to be inherently distinctive) and *In re Venturi, Inc.*, 197 USPQ 714 (TTAB 1977) (holding that a stylized version of the mark THE PIPE had acquired distinctiveness).

Applicant’s mark consists of the stylized depiction of the words CHILDREN’S and DHA. Specifically, the letters of Applicant’s mark are shown in a distinctive and unique stylized, “handwritten” format and font. Further, each letter is presented in distinctive, bright, alternating colors, which colors are claimed as part of the mark as a whole. Specifically, color is claimed for each of the letters in the mark as follows: the C is fuchsia; the E, first H, and second D are orange; the I is green; the L is yellow-green; the N and first D are blue; the R is red; the S and second H are yellow; and the A is pink. With regard to the wording itself, the first term in the mark is a descriptive term that identifies the intended user of the identified goods. *See* TMEP § 1209.03(i) (“A term that identifies a group to whom the applicant directs its goods or services is merely descriptive.”). The second term in the mark is a descriptive term that identifies an ingredient in the identified goods. *See* TMEP § 1209.01(b) (“A mark is considered merely descriptive if it describes an ingredient . . . of the specified goods or services.”). The rights afforded to a registration of the proposed mark would be associated with the wording as it appears in the application—in large stylized font of bright alternating colors, as opposed to merely the wording itself.

In light of the fact that the mark is, at worst, a combination of descriptive terms and stylization, Applicant’s mark, as a whole, is, at a minimum, descriptive, not generic. *See* TMEP

§ 1209.03(d) (“When two descriptive terms are combined, the determination of whether the composite mark also has a descriptive significance turns upon the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive.”); *see also In re Wella Corp.*, 565 F.2d 143, 196 USPQ 7 (C.C.P.A. 1977) (finding mark comprising stylized lettering of BALSAM, with disclaimer of “BALSAM,” registrable). The Examining Attorney has failed to establish otherwise because the Examining Attorney has pointed to no evidence that Applicant’s mark as a whole is used by others or recognized by consumers as a generic term.

A mark that is not inherently distinctive (i.e., one that is descriptive) may be registered on the Principal Register upon proof of acquired distinctiveness, or “secondary meaning.” TMEP § 1212. In the alternative, merely descriptive marks may be registered on the Supplemental Register. TMEP §§ 815, 816.04; *Wella*, 565 F.2d 143, 196 USPQ 7.

**A. Proper Application Of The Test For Genericness Proves That Applicant’s Mark Is Not Generic**

Because Applicant’s mark is, at a minimum, descriptive, it is not necessary to apply the two-part test to determine whether the mark is generic. Nonetheless, as explained below, application of the test for genericness proves that Applicant’s mark is not generic.

**1. Class Or Genus Of Goods At Issue**

Applicant maintains that the class or genus of the identified goods is properly defined as “nutritional supplements” or, more narrowly, “nutritional supplements containing DHA.” Even under the more narrow definition, the class or genus of the identified goods necessarily includes all nutritional supplements that contain DHA, including supplements designed for use by infants, babies, toddlers, children, kids, adults, pregnant women, and perhaps even animals. It defies

common sense to say that nutritional supplements containing DHA that are designed for use by one or more of these intended users are commonly known as “children’s DHA,” and the Examining Attorney offers no evidence to support this position. Indeed, even referring to nutritional supplements containing DHA designed for use by children simply as “children’s DHA” would be an unnatural use of the English language. The goods for which Applicant is using its mark are commonly known and referred to as they have been listed in the identification of goods, i.e., “nutritional supplements containing DHA” and it is against that backdrop that the analysis must be undertaken.

**a. Applicant’s Mark Is Not Used To Refer To The Class Or Genus Of “Nutritional Supplements Containing DHA”**

The Examining Attorney states that “a mark is generic if it refers to a genus of goods that is a smaller category or subcategory of a broadly written identification of goods.” Office Action Issued June 29, 2011 at 6 (citing *In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1082 (TTAB 2010); *In re Wm. B. Coleman Co.*, 93 USPQ2d 2019, 2024-25 (TTAB 2010); and *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1790 (TTAB 2002)). However, as evidenced by the cases cited by the Examining Attorney, the Examining Attorney continues to ignore the stylized nature of Applicant’s mark—none of those cases deal with stylized marks. Here, Applicant’s mark is CHILDREN’S DHA in stylized form.

In the absence of any evidence that Applicant’s mark, as a whole, itself refers to the genus or class of “nutritional supplements containing DHA,” the Examining Attorney has not carried the substantial burden of proving that Applicant’s mark refers to the genus at issue. Furthermore, as explained below, there is no evidence that the relevant public understands Applicant’s mark primarily to refer to the class of goods at issue. As such, Applicant’s mark is not generic.

## **2. Relevant Public's Understanding Of Applicant's Mark**

Without any support whatsoever, the Examining Attorney asserts that the relevant public would understand Applicant's mark to refer primarily to the class or genus of goods to which the identified goods belong. A review of the record reveals that the evidence proves just the opposite.

### **a. Evidence Of Actual Public Understanding Of Applicant's Mark Was Improperly Ignored**

Applicant provided affirmative evidence that its mark, CHILDREN'S DHA (Stylized), is understood by the relevant public to refer specifically to Applicant's goods. The Examining Attorney has refused to consider that evidence notwithstanding the fact that it is probative and properly submitted. *See Merrill Lynch*, 828 F.2d at 1570 (holding that "[e]vidence 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 particular, Applicant has submitted excerpts from trade journals that depict the use of the marks CHILDREN'S DHA and CHILDREN'S DHA (Stylized) to refer specifically to Applicant's goods. (*See* March 9, 2010 Response to Office Action, Ex. 2). Applicant has also submitted affidavits from industry professionals stating that its mark CHILDREN'S DHA is associated exclusively with Applicant's goods. (*See id.*, Ex. 4). In addition, Applicant has submitted an affidavit by Joar Opheim, the Chief Executive Officer of Nordic Naturals, stating that the mark CHILDREN'S DHA was introduced and used exclusively by Applicant for five years. (*See id.*, Ex. 1). Collectively, this evidence establishes that the relevant public understands CHILDREN'S DHA (Stylized) to refer not to a general class of goods, but to Applicant's specific goods.

In short, Applicant has presented evidence that the relevant public understands Applicant's mark to refer specifically to Applicant's goods and, as explained below, the Examining Attorney has not met her burden of producing clear evidence to prove otherwise.

**b. None Of The Third Party Use Relied On By The Examining Attorney Is Evidence Of Genericness**

Many of the examples of third party use of the wording "children's DHA" cited by the Examining Attorney refer to "children's DHA supplement[s]" or "children's supplements," and not Applicant's mark. Furthermore, these examples contain the phrase "children's DHA supplement[s]" in the text of a sentence and use the phrase in its primary, descriptive sense to describe the nature and intended user of the nutritional supplements being sold.

With regard to the information supplied by the Examining Attorney in support of her contention that the record reflects "widespread" third party usage, Applicant asserts that most of the examples refer not to Applicant's mark, but to other designations (e.g., *Nutri-West - Complete Children's DHA/EPA*, *Coromega Child Brain and Body High DHA Omega-3*, Dr. Sears Family Approved Go Fish Children's Omega-3 DHA). Moreover, when viewed in context, each of these examples undermines rather than supports the Examining Attorney's position that Applicant's mark is being used to refer to the goods in a generic manner.

As for the remaining examples cited by the Examining Attorney, to the extent that third parties are using Applicant's mark as a designation of source for their own goods, as Applicant has previously stated, these are infringing uses, not evidence of genericness. The holding in *Merrill Lynch*, 828 F.2d 1567, is instructive. Merrill Lynch had introduced and marketed a service under the previously-unused phrase "Cash Management Account." For several years, Merrill Lynch used the term exclusively. However, when Merrill Lynch attempted to register the phrase to identify other services, the Trademark Trial and Appeal Board refused registration on

grounds that the mark was generic because third parties had subsequently begun using the same phrase. On appeal, the United States Court of Appeals for the Federal Circuit held that evidence of Merrill Lynch's first use, and the competitors' subsequent use was insufficient to "clearly place [the] mark in the category of a generic or common descriptive term." *Id.* at 1571. The Federal Circuit overturned the Board's finding of genericness because the demonstrated use did "not show, by clear evidence, that the financial community views and uses the term CASH MANAGEMENT ACCOUNT as a generic, common descriptive term for the brokerage services to which *Merrill Lynch first applied* the term." *Id.* (emphasis added).

As in *Merrill Lynch*, the evidence in this case shows that Applicant was first to use Applicant's mark, that Applicant did so exclusively for many years, and that some competitors subsequently have attempted to co-opt Applicant's mark. The mere fact that Applicant's mark is being infringed in this manner does not evidence that the *primary significance to the public* is that the term is generic. In short, Applicant's evidence of first and exclusive use precludes finding sufficiently clear evidence to place Applicant's mark in the category of a generic term.

**c. Additional Considerations Proving That Applicant's Mark Is Not Generic**

TMEP Sections 1209.03 *et seq.* provide a number of considerations to determine whether a mark is descriptive or generic. Each of the relevant considerations support Applicant's position that its mark, CHILDREN'S DHA (Stylized), is not generic.

One consideration is whether there are any third-party registrations for the mark. Applicant submits that no third-party federal registrations, or applications for that matter, other than its own, appear in a search for "CHILDREN'S DHA." In fact, neither the phrase "children's DHA" nor the phrase "children's DHA supplement" appear in any identification of goods or services in any of the U.S. Patent and Trademark Office's online records.

Another consideration is whether the mark appears in dictionary listings. “CHILDREN’S DHA” does not.

Yet another consideration is whether Applicant is the first or only user of the mark. To date, the application that is the subject of this Appeal and an application by Applicant for the same mark in standard characters are the only results returned in a search of the U.S. Patent and Trademark Office’s Trademark Electronic Search System for “CHILDREN’S DHA.”

Applicant developed an omega-3 fatty acid supplement that was palatable to children and began selling it under the CHILDREN’S DHA mark on or around July 1, 2000. (March 9, 2010 Response to Office Action, Ex. 1 ¶ 3). For at least the following five years, Applicant was the only seller of a fish oil supplement for children in the United States. (*Id.* ¶ 5). Applicant’s use of the CHILDREN’S DHA (Stylized) mark in commerce has been substantially exclusive and continuous for more than 8 years, i.e., since its first use in October 2003. Moreover, Applicant has presented arguments and evidence, as identified herein, that the Examining Attorney’s purported evidence to the contrary is inapposite. The Examining Attorney has failed to meet her burden of establishing *by clear evidence* that Applicant’s mark is a generic term for the identified goods.

#### **B. Applicant’s Mark Is Capable Of Distinguishing Source**

In denying Applicant’s December 29, 2011 Request for Reconsideration, the Examining Attorney states: “(1) that CHILDREN’S is a generic designation for nutritional supplements; and (2) that the stylization of applicant’s mark consisting of different colored letters is commonly used for children’s supplements and medications.” Even accepting the Examining Attorney’s statements as true, the Examining Attorney has not established that Applicant’s mark, as a whole, is generic.

At the very least, Applicant's mark is a combination of descriptive terms. Applicant's mark *is capable* of distinguishing source. Numerous marks have been registered that include words or terms that are names of key ingredients, characteristics, or features of the marks. *See, e.g., Dial-a-Mattress*, 240 F.3d 1341 (1-888-M-A-T-R-E-S-S not generic for "telephone shop-at-home retail services in the field of mattresses"); *Am. Fertility Soc'y*, 188 F.3d 1341 (SOCIETY FOR REPRODUCTIVE MEDICINE not generic for association services in the field of reproductive medicine); *Merrill Lynch*, 828 F.2d 1567 (CASH MANAGEMENT ACCOUNT for "stock brokerage services, administration of money market fund services, and providing loans against securities services" held merely descriptive, rather than generic, and remanded to Board to consider sufficiency of §2(f) evidence); *H. Marvin Ginn Corp.*, 782 F.2d 987 (FIRE CHIEF not generic for publications directed to the field of firefighting); *In re America Online, Inc.*, 77 USPQ2d 1618 (TTAB 2006) (INSTANT MESSENGER not generic for telecommunications services and computer services related to providing real time text messages; evidence submitted by applicant held sufficient to demonstrate acquired distinctiveness under §2(f)); *Zimmerman v. Nat'l Ass'n of Realtors*, 70 USPQ2d 1425 (TTAB 2004) (collective service marks REALTOR and REALTORS held not generic for real estate brokerage, management, appraisal, and planning services); *In re Federated Dept. Stores Inc.*, 3 USPQ2d 1541 (TTAB 1987) (THE CHILDREN'S OUTLET ("OUTLET" disclaimed), while merely descriptive of applicant's "retail children's clothing store services," held capable of functioning as a mark, with evidence submitted by applicant sufficient to establish acquired distinctiveness pursuant to §2(f)); *Hunter Publ'g Co. v. Caulfield Publ'g Ltd.*, 1 USPQ2d 1996 (TTAB 1986) (SYSTEMS USER for periodic trade journal held merely descriptive, rather than generic, and applicant's evidence held sufficient to establish acquired distinctiveness pursuant to §2(f)); *In re Failure Analysis Assocs.*, 1 USPQ2d

1144 (TTAB 1986) (FAILURE ANALYSIS ASSOCIATES, for “consulting services in the field of mechanical, structural, metallurgical, and metal failures, fires and explosions; engineering services in the field of mechanical design and risk analysis” and “consulting engineering services in the metallurgical field,” found to be merely descriptive of applicant’s services rather than incapable of distinguishing them from those of others; evidence submitted by applicant held sufficient to demonstrate acquired distinctiveness under §2(f)). *See also* TMEP § 1209.03(d) (listing no fewer than 16 marks held merely descriptive where the combination of descriptive components retains descriptive significance in relation to the goods or services and resulted in a composite that is itself descriptive). The same is true for Applicant’s mark. Applicant’s mark is not generic, but (at a minimum) descriptive.

**C. Doubt About The Proper Classification Of Applicant’s Mark Must Be Resolved In Applicant’s Favor**

Doubts about the classification of a mark must be resolved in Applicant’s favor. *Merrill Lynch*, 828 F.2d at 1571. In *Merrill Lynch*, the evidence against the applicant included information that third parties and trade magazines had been using the term sought to be registered “generically.” But, as here, there was also evidence that the marketplace had been using the term to refer to the applicant. Faced with this conflicting evidence, the Federal Circuit held that the “mixture of usages” precluded a finding of genericness. *Id.* at 1571. The court held, “[i]t is incumbent on the Board . . . to resolve reasonable doubt in favor of the applicant, in accordance with practice and precedent.” *Id.*

The evidence submitted in this case has raised doubts by showing, at worst, mixed uses of Applicant’s mark. These mixed uses include proper usage by Applicant, source recognition by the relevant public, and infringing use by third parties. As in the *Merrill Lynch* case, doubt must be resolved in favor of Applicant such that Applicant’s mark cannot be said to be generic.

For all of the foregoing reasons, Applicant respectfully requests that the Board reverse the Examining Attorney's refusal to register the mark on the basis of genericness.

## **II. APPLICANT'S MARK HAS ACQUIRED DISTINCTIVENESS**

Applicant's mark is not generic and should be passed for publication because it has acquired distinctiveness under Section 2(f). Applicant acknowledges that the burden of proving that a mark is distinctive is on the applicant. *See* TMEP § 1212.01. However, Applicant has met that burden.

In *Board of Supervisors v. Smack Apparel Co.*, 550 F.3d 465, 476, 89 USPQ2d 1338 (5th Cir. 2008), the United States Court of Appeals for the Fifth Circuit outlined several factors to consider regarding secondary meaning: (1) length and manner of use of the mark or trade dress; (2) volume of sales, (3) amount and manner of advertising, (4) nature of use of the mark or trade dress in newspapers and magazines, (5) consumer-survey evidence, (6) direct consumer testimony, and (7) the defendant's intent in copying the trade dress. In support of its claim of acquired distinctiveness, Applicant has submitted ample evidence demonstrating that all of these factors weigh in favor of a finding of secondary meaning in this case.

Specifically, in its March 9, 2010 Response to Office Action, Applicant submitted substantial evidence of acquired distinctiveness. This evidence addressed each of the factors laid out by *Smack Apparel*. Nonetheless, the Examining Attorney has seemingly dismissed all of the evidence of record as "insufficient" to show acquired distinctiveness.

Applicant has had great commercial success with its CHILDREN'S DHA brand and the products for which the mark is used. Applicant coined the term CHILDREN'S DHA in 2000 and has enjoyed a substantially exclusive use of the CHILDREN'S DHA (Stylized) mark for more than 8 years. Indeed, Applicant's 2(f) claim is based, in part, on its substantially exclusive and continuous use of the mark in commerce since at least as early as 2003. (*See* March 9, 2010

Response to Office Action). The Examining Attorney does not appear to give any weight whatsoever to this claim and provides no justification whatsoever for her failure to do so.

In addition, Applicant has invested considerable resources in promoting its CHILDREN'S DHA (Stylized) mark and its CHILDREN'S DHA-branded products. As a direct result, it has succeeded in creating in the minds of consumers an association between the mark CHILDREN'S DHA (Stylized) and Applicant as the origin of those goods. In response to this evidence, the Examining Attorney admits that Applicant's sales figures are "high" and its advertising expenditures "significant;" however, the Examining Attorney maintains that such evidence demonstrates Applicant's commercial success and not acquired distinctiveness. Applicant respectfully disagrees. Applicant's sales and advertising expenditures must be given appropriate weight. When this information is combined with the other evidence provided by Applicant, there can be little question that Applicant's mark has acquired distinctiveness.

Applicant also submitted ample customer testimony, which the Examining Attorney improperly discounts. In particular, Applicant submitted the declarations of several retailers of Applicant's products with the Response to Office Action on March 9, 2010. These and other retailers comprise the vast majority of Applicant's buyers. Furthermore, it is reasonable to infer that these retailers have encountered numerous nutritional supplement products, including those containing DHA and those intended for use by children—and specifically including the products produced by Applicant and those produced by Applicant's competitors. Thus, the retailers' understanding of Applicant's mark is perhaps of utmost significance. *See Thomas & Betts Corp. v. Panduit Corp.*, 138 F.3d 277, 294, 46 USPQ2d 1026 (7th Cir. 1998) (where the relevant buyer class includes both dealers and consumers, the state of mind of dealers is important).

In their declarations, the retailers of Applicant's products confirm that they recognize the name "CHILDREN'S DHA" as a mark, i.e., referring specifically to Applicant's nutritional supplement goods. (March 9, 2010 Response to Office Action, Ex. 4 ¶¶ 3-4). Moreover, these retailers state that, in their opinion, the ultimate end-user consumers of the goods do likewise. (*Id.* ¶ 5). Indeed, the retailers' opinion that end-user consumers also appreciate the significance of Applicant's mark is supported by the unsolicited consumer recommendations and testimonials appearing on blogs and bulletin boards wherein the consumers refer and discuss Applicant's CHILDREN'S DHA nutritional supplements, recognizing the mark CHILDREN'S DHA as Applicant's mark. (*See id.*, Ex. 5). Furthermore, Applicant's goods marked with CHILDREN'S DHA in stylized form have won national awards. In 2007, Applicant won a Most Valuable Product Award from Therapy Times and a Vity Award from Vitamin Retailer for its goods sold under the mark CHILDREN'S DHA (Stylized). *Id.*, Ex. 6. The awards bestowed on Applicant and the products bearing Applicant's mark have further enhanced consumers' recognition of Applicant's mark. Through consistent and significant efforts, Applicant has created in the minds of consumers a strong association between Applicant's mark and Applicant as a source of high-quality goods. Accordingly, this evidence strongly supports Applicant's 2(f) claim.

Finally, the fact that Applicant's competitors have intentionally copied the wording in and commercial impression evoked by Applicant's mark is a sufficient basis in and of itself to support Applicant's Section 2(f) claim. At least one of the search results attached by the Examining Attorney to the June 29, 2011 Final Office Action shows a third party product label that mimics not only the wording in Applicant's CHILDREN'S DHA mark, but also the stylized, multi-color text and arrangement of the text. The existence of products imitating Applicant's CHILDREN'S DHA (Stylized) mark, including the style, positioning, and coloring of the text, is

strong evidence that Applicant has been successful in its goal—establishing in the minds of consumers an association between the mark CHILDREN’S DHA in stylized form and Applicant as the source of the high-quality, high-purity, great-tasting Omega-3 fish oil supplements that are suitable for use by children. Intentional copying is strong evidence of secondary meaning because there is no reason for precise copying other than an attempt to capitalize upon existing secondary meaning of a mark. *Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, Inc.*, 280 F.3d 619, 639, 61 USPQ2d 1769 (6th Cir. 2002); *Transgo, Inc. v. Ajac Transmission Parts Corp.*, 768 F.2d 1001, 1016, 227 USPQ 598 (9th Cir. 1985) (“Proof of exact copying, without any opposing proof, can be sufficient to establish a secondary meaning.”). To be sure, Applicant polices improper use of its CHILDREN’S DHA (Stylized) mark to ensure that it does not become generic.

In short, as a result of the length of Applicant’s use of the CHILDREN’S DHA (Stylized) mark and Applicant’s extensive promotional efforts, retailers and consumers associate the mark with high-quality, high-purity, good-tasting omega-3 fatty-acid supplements originating exclusively from Applicant. Because Applicant has submitted ample evidence to support its claim that Applicant’s mark has acquired distinctiveness, Applicant’s mark should be passed for publication.

### **III. GIVEN THE HIGHLY STYLIZED NATURE OF THE MARK, APPLICANT’S MARK SHOULD BE PERMITTED REGISTRATION**

Even if the Board determines that the wording in Applicant’s mark is generic or merely descriptive and without secondary meaning, Applicant submits that the proper course of action would be to require a disclaimer of the words appearing in Applicant’s mark, rather than a complete rejection of the application. *See* TMEP § 1213. Distinctive lettering, coloring, or other design elements are capable of rendering a mark registrable even when combined with generic

words. *Courtenay Commc'ns Corp. v. Hall*, 334 F.3d 210, 216, 67 USPQ2d 1210 (2d Cir. 2003); *In re Wella Corp.*, 193 USPQ 585, 586 (TTAB 1977) (noting that a disclaimer of literal terms renders the descriptiveness of those terms moot).

The Board's holding in *Jackson Hole Ski Corp.*, 190 USPQ 175 (TTAB 1976), is instructive. In *Jackson Hole*, the literal mark consisted of the geographical term "Jackson Hole," and the applicant tried to register the mark with a stylized design of the letters "J" and "H." The applicant asserted that the letters were arranged distinctively and prominently displayed, creating a separate commercial impression from the literal and unregistrable words "Jackson Hole." *Id.* at 176. The Board agreed and approved registration. *Id.* See also *Wella*, 565 F.2d 143 (finding mark comprising stylized lettering of BALSAM, with disclaimer of "BALSAM," registrable) and *In re Miller Brewing Co.*, 226 USPQ 666, 667-68 (TTAB 1985) (holding that the script rendition of "LITE" on beer labels was registrable).

Applicant's mark consists of a highly stylized version of the wording CHILDREN'S DHA. As explained above, the letters of Applicant's mark are in shown in a unique stylized, "handwritten" format and font. Further, each letter is presented in distinctive, bright, alternating colors, which colors are claimed as part of the mark as a whole. Applicant's mark is much more like the marks in *Wella* and *Jackson Hole* than the marks in the cases cited by the Examining Attorney in the June 29, 2011 Final Office Action. See *In re Sambado & Son Inc.*, 45 USPQ2d 1312 (TTAB 1997) (in which the mark sought to be registered was filed as a typed drawing mark and was "stylized" only in that it used a hyphen) and *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224, 1227 (TTAB 1987) (in which the mark sought to be registered was composed of "a generic notation and [a] lettering style, [that] while somewhat embellished, is relatively ordinary"). Applicant maintains that the overall combination of the wording and stylization of

its mark makes a distinctive impression on purchasers over and above the impression made by the words themselves. On this basis alone, the mark should proceed to registration.

### CONCLUSION

For all of the foregoing reasons, and based on the evidence already of record, Applicant requests that the Board reverse the Examining Attorney's refusals to register Applicant's CHILDREN'S DHA (Stylized) mark. The Examining Attorney has not met her burden to establish by clear evidence that CHILDREN'S DHA is generic for the identified goods. To the contrary, the evidence of record establishes that: (1) Applicant's mark is not generic, as (a) CHILDREN'S DHA does not refer to the class or genus of goods consisting of "nutritional supplements containing DHA" and (b) the evidence shows that the public understands Applicant's mark CHILDREN'S DHA to refer specifically to Applicant's goods. Moreover, Applicant has met its burden of proof, by substantial and conclusive evidence, that Applicant's mark has acquired distinctiveness under Section 2(f). At the very minimum, Applicant's mark is sufficiently stylized to warrant registration on the Principal Register. Accordingly, Applicant submits that its mark is entitled to registration and requests that the refusals to register be reversed and that its mark be passed to publication.

Respectfully submitted,

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