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282019999016 - EXAMINER BRIEF

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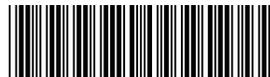
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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77752741

MARK: CHILDREN'S DHA



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TTAB INFORMATION:

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APPLICANT: Nordic Naturals, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO:

282019999016

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EXAMINING ATTORNEY'S APPEAL BRIEF

I. STATEMENT OF THE CASE

The applicant, Nordic Naturals, Inc., has appealed the trademark examining attorney's final refusal to register the proposed trademark CHILDREN'S DHA, in stylized form, for "nutritional supplements containing DHA" on the grounds that it is incapable of functioning as a trademark under Section 2(e)(1) of the Trademark Act of 1946 (as amended) (hereinafter "the Trademark Act"), 15 U.S.C. §1052(e)(1), or in the alternative, that the applicant has failed to establish acquired distinctiveness for the mark under Trademark Act Section 2(f), 15 U.S.C. §1052(f). It is respectfully requested that the refusal to register be affirmed.

II. FACTS

On June 5, 2009, applicant applied to register the mark CHILDREN'S DHA, in stylized form, based on use of the mark in commerce under Section 1(a) of the Trademark Act in connection with "nutritional supplements."

In an Office action dated September 9, 2009, the examining attorney refused registration under Section 2(e)(1) of the Trademark Act and included an advisory statement that the mark appears to be generic in connection with applicant's identified

goods. The examining attorney also required an amended color claim and mark description.

In a response filed March 9, 2010, the applicant argued against the refusal under Section 2(e)(1) of the Trademark Act, claimed the proposed mark had acquired distinctiveness as an alternative basis for permitting registration, and submitted an amended color claim and mark description.

On March 13, 2010, a non-final Office action was issued in which registration was refused on the grounds that the proposed mark is generic for the identified goods, and in the alternative, that the submitted evidence is insufficient to show acquired distinctiveness for the proposed mark. A requirement to amend the identification to avoid deceptiveness was also made.

Applicant responded on September 13, 2010, submitting additional arguments against the Section 2(e)(1) refusal and in favor of its acquired distinctiveness claim, and amended the identification of goods to “nutritional supplements containing DHA.”

The refusal of registration because the proposed mark is generic, and in the alternative, that the Section 2(f) evidence is insufficient, were made final by the examining attorney via an Office action sent October 4, 2010.

The applicant submitted additional arguments regarding the Section 2(e)(1) refusal and in favor of its acquired distinctiveness claim in an April 4, 2011 request for reconsideration. The applicant also filed a Notice of Appeal.

The application was reassigned to the undersigned examining attorney, and on June 29, 2011, a subsequent final action was issued maintaining that the proposed mark is generic for the identified goods, and in the alternative, that the submitted evidence is insufficient to show acquired distinctiveness for the proposed mark.

The applicant disclaimed DHA and argued against the Section 2(e)(1) refusal and in favor of its acquired distinctiveness claim in a December 29, 2011 request for reconsideration.

Applicant’s request for reconsideration was denied on January 20, 2012.

On March 23, 2012, applicant filed its Appeal Brief.

III. ARGUMENT

A. APPLICANT'S PROPOSED MARK IS GENERIC FOR THE IDENTIFIED GOODS.

Registration has been refused because the applied-for mark is generic for applicant's goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(c) *et seq.*, 1209.02(a)(ii).

Generic terms are common names that the relevant purchasing public understands primarily as describing the genus of applicant's goods. *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, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986); *see* TMEP §1209.01(c). Generic terms are by definition incapable of indicating a particular source of goods, and cannot be registered as trademarks. *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). Registering generic terms "would grant the owner of [a] 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 at 1569, 4 USPQ2d at 1142.

Determining whether a mark is generic requires a two-step inquiry:

- (1) What is the genus of goods or services at issue?
- (2) Does the relevant public understand the designation primarily to

refer to

that genus of goods or services?

In re 1800Mattress.com IP, LLC, 586 F.3d 1359, 1363, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009) (quoting *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d at 989-90, 228 USPQ at 530); TMEP §1209.01(c)(i).

1. What is the genus of goods at issue?

Regarding the first part of the inquiry, the genus of the goods is often defined by an applicant's identification of goods. *See, e.g., In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 1379, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 640, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991). In the present case, the identification, and thus the genus, is "nutritional supplements containing DHA."

Applicant contends that "...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,'"...(applicant's Appeal Brief at pages 7-8, hereinafter "(App. Br. at ___)").

Generally, an applied-for mark may be found generic where the identification is broadly worded and encompasses the narrower category of goods named in the mark. *See, e.g., In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1082 (TTAB 2010) (holding NANDRIVE generic for "electronic integrated circuits" because NAND drives were types of solid state flash drives, a subcategory of applicant's broadly worded "electronic integrated circuits"); *In re Wm. B. Coleman Co.*, 93 USPQ2d 2019, 2024-25 (TTAB 2010) (holding ELECTRIC CANDLE COMPANY generic for electric candles, a subcategory of applicant's broadly worded "lighting fixtures"); *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1790 (TTAB 2002) (holding BONDS.NET generic for information and electronic commerce services regarding financial products because bonds were a subcategory of applicant's broadly worded "financial products").

In the present case, applicant's goods are broadly worded and encompass the narrower category of DHA supplements for children or CHILDREN'S DHA because, as applicant stated in its Brief, the identification does not state that the goods are for any specific consumer, and therefore would encompass DHA supplements for all consumers, including adults and children. However, the goods on which applicant uses the mark are intended for use by children, as is shown by the specimen of record, which indicates that "Nordic Naturals has raised the bar with our 'Gold Standard' 100% Arctic Cod Liver Oil, Omega-3s to support children's focus, mood, learning and positive behavior." *See*, applicant's June 5, 2009 specimen. The excerpt about applicant's goods from its website also indicates that they are "[f]or children three years and older." (Attachment to March 13, 2010 Office action, page 42). Therefore, the genus of goods at issue includes CHILDREN'S DHA.

2. Does the public understand the designation primarily to refer to that genus of goods?

In determining the descriptiveness of a term or mark comprising more than one element, it is permissible to consider the significance of each element separately in the course of evaluating the term or mark as a whole. *See In re Hotels.com, L.P.*, 573 F.3d 1300, 1301, 1304, 1306, 91 USPQ2d 1532, 1533, 1535, 1537 (Fed. Cir. 2009) (holding HOTELS.COM generic for information and reservation services featuring temporary lodging when noting that the Board did not commit error in considering “the word ‘hotels’ for genericness separate from the ‘.com’ suffix”); *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1174-75, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004) (holding PATENTS.COM merely descriptive of computer software for managing and tracking the status of database records when noting that “the PTO may [separately] consider the meaning of ‘patents’ and the meaning of ‘.com’ with respect to the goods identified in the application.”); *In re Save Venice N.Y., Inc.*, 259 F.3d 1346, 1352, 59 USPQ2d 1778, 1782 (Fed. Cir. 2001) (holding a mark primarily geographically deceptively misdescriptive for a variety of goods when noting that “[i]t is not erroneous, however, for the examiner to consider the significance of each element within the composite mark in the course of evaluating the mark as a whole.”).

Not only is applicant’s proposed mark generic because it combines two terms that are each generic for “nutritional supplements containing DHA,” it has been shown to be generic because the evidence of record shows use of the mark in its entirety as a generic phrase.

As stated hereinabove, the term CHILDREN’S identifies the intended users for applicant’s identified goods. A mark that describes an intended user or group of users of a product or service is merely descriptive. *E.g., In re Planalytics, Inc.*, 70 USPQ2d 1453 (TTAB 2004) (holding GASBUYER merely descriptive of intended user of risk management services in the field of pricing and purchasing natural gas); *In re Camel Mfg. Co.*, 222 USPQ 1031 (TTAB 1984) (holding MOUNTAIN CAMPER merely descriptive of intended users of retail and mail order services in the field of outdoor equipment and apparel); *see* TMEP §1209.03(i). However, CHILDREN’S also identifies a specific category or genus of supplements, as indicated by the evidence from

LexisNexis® attached to the June 29, 2011 Office action, which includes the following excerpts, emphasis added:

Country Life, a long-time leader in **children's supplements**, offers this multivitamin and mineral product in both gummy and liquid forms. Both formulations are iron free for safety. In addition, Country Life has a DHA gummy for kids, which comes in three fruity flavors and provides fish oil- derived omega-3 fatty acids for brain health. *Natural Foods Merchandiser*, January 2011, Vol. 32, No. 1, pg. 32.

Sales of nutritional supplements to children are growing, but pediatricians caution that some children are taking them needlessly; sales of **children's supplements** were estimated at \$1.1 billion in 2008; some supplements taken in excessive doses, such as vitamin A, can be dangerous; trade group Council for Responsible Nutrition says most children between ages of 2 and 18 should take multivitamins because their diets alone do not meet nutritional requirements; drawings (M). *Wall Street Journal Abstracts*, May 4, 2010, Section 3, Column 1, pg. 1.

The two products are the newest introductions to Rainbow Light's Gummies line that experienced triple-digit growth in 2008, with combined sales growing 222 percent, according to SPINSscan, the leading natural products industry data-reporting agency. The company's **children's supplements** line grew 24 percent from January through June 2009, greatly outpacing the 1-percent category growth industry wide.(1) *Marketwire*, October 7, 2009.

The most popular **children's supplements**, however, remain multivitamins and minerals, which accounted for 70% of total **children's supplement** sales in 2008, according to Ms. Mast, who added that many manufacturers are now making supplements specifically for children. In fact, about one-third of American children aged 2 to "17 currently take such a supplement. *Neutraceuticals World*, October 1, 2009, Vol. 12, No. 8, pg. 42(4).

But, in fact, the **children's supplement** category is thriving, with companies constantly rolling out innovative new products formulated for and marketed to children and with U.S. consumers snatching up these offerings for their babies, toddlers and kids. According to Nutrition Business Journal research, dietary supplements constitute the second largest category of the U.S. healthy kids' market. In 2008, U.S. consumer sales of supplements formulated and/or marketed for children totaled \$1.1 billion - representing a little more than 10% of the healthy kids' market. **Children's supplements** made up about 4% of the total U.S.

supplement market, which generated more than \$24 billion in consumer sales last year.

...

For the most part, the supplement industry is bullish on the **children's supplement** category, as is evident by the large number of companies operating in the space. Source Naturals, Nordic Naturals, Rainbow Light, New Chapter, Hero, Nature's Plus, Twin Labs and numerous other companies have entered the category - most with multivitamin/multimineral products formulated for kids. Multivitamins, not surprisingly, make up the largest segment of the **children's supplement** category - generating 70% of the category's sales in 2008, according to NBJ's estimates.

...

NBJ research shows that products containing DHA generated about 1% of sales in the **children's supplement** category in 2008. Much of the growth in DHA supplementation for kids has been driven by research demonstrating the cognitive, visual and other benefits of this important omega-3 for kids. "There is a definite trend in the research on omega-3 fatty acids for overall wellness and for cognitive development," Clow said. "They are also finding that omega-3s can reduce the symptoms of learning disorders - such as ADD and dyslexia - and common ailments such as asthma." For instance, a 2005 study by Oxford University researchers found that supplementation with fatty acids potentially offer a safe and effective treatment for children with educational and behavioral problems and warrants further research. *Nutrition Business Journal*, April 1, 2009, pg. 13.

Material obtained from computerized text-search databases, such as LexisNexis®, is generally accepted as competent evidence. *See In re The Boulevard Entm't, Inc.*, 334 F.3d 1336, 1342-43, 67 USPQ2d 1475, 1479 (Fed. Cir. 2003) (accepting LexisNexis® evidence to show offensive nature of a term); *In re Giger*, 78 USPQ2d 1405, 1407 (TTAB 2006) (accepting LexisNexis® evidence to show surname significance); *In re Lamb-Weston Inc.*, 54 USPQ2d 1190, 1192 (TTAB 2000) (accepting LexisNexis® evidence to show descriptiveness); *In re Wada*, 48 USPQ2d 1689, 1690 (TTAB 1998) (accepting LexisNexis® evidence to show geographic location is well-known for particular goods); *In re Decombe*, 9 USPQ2d 1812, 1815 (TTAB 1988) (accepting LexisNexis® evidence to show relatedness of goods in a likelihood of confusion determination); TBMP §1208.01; TMEP §710.01(a)-(b).

Although applicant contends that “[t]he second term in the mark is a descriptive term that identifies an ingredient in the identified goods,” the letters DHA do not describe, but rather, are the generic designation for the key ingredient in applicant’s identified goods. (App. Br. at 6). Not only has applicant included “DHA” as the key

ingredient in its goods in the identification, but the letters have their own dictionary definition:

essential fatty acid: a polyunsaturated essential fatty acid found in cold-water fish and some algae that has been linked to the reduction of cardiovascular disease and other health benefits.

Full form docosahexaenoic acid

(Attachment to September 9, 2009 Office action, page 4).

In addition, DHA is specified as an ingredient and/or type of vitamin and supplement in several third-party registrations. *See*, attachments to June 29, 2011 Office action, pages 2-50.

The generic name of an ingredient of the goods is incapable of identifying and distinguishing their source and is thus unregistrable on either the Principal or Supplemental Register. *See In re Hask Toiletries, Inc.*, 223 USPQ 1254, 1255 (TTAB 1984) (holding HENNA 'N' PLACENTA incapable of registration on the Supplemental Register for hair conditioner); *In re Pepcom Indus., Inc.*, 192 USPQ 400, 402 (TTAB 1976) (holding JIN.SENG incapable for soft drinks); TMEP §1209.01(c).

The public thus understands the terms CHILDREN'S and DHA to be generic designations for applicant's identified goods. Furthermore, the evidence made of record also indicates that the public views and uses the phrase CHILDREN'S DHA as a generic designation for the identified goods, including in the advertising for applicant's own products. Several representative excerpts from the evidence of record are included below, with emphasis added:

Nordic Naturals Children's DHA is a small chewable **children's DHA** supplement flavored with strawberry essence. (Attachment to the September 9, 2009 Office action, page 7).

Ultimate Omega Children's DHA Formula is a small, natural strawberry flavored chewable **children's DHA** supplement. (Attachment to the March 13, 2010 Office action, page 47).

No other **children's DHA** supplement can match the ease and convenience of Animal Parade DHA! (Attachment to the March 13, 2010 Office action, page 34).

Another children's vitamin product offered by Shaklee is Mighty Smart, a **children's DHA** supplement. (Attachment to the March 13, 2010 Office action, page 38).

Children's DHA is a dietary supplement available specifically for children. The main ingredient – docosahexaenoic acid, or DHA for short – is an omega-3 fatty acid. It plays a crucial role in the proper development of infants and children. There are a number of DHA and omega-3 supplements available on the market today, including **children's DHA** and DHA for pregnant women.

...

When looking for a **children's DHA** supplement, experts agree that quality and safety are the most important factors. Because there are so many brands available, choosing the right one can seem like a daunting task for some, and researching each brand is important. Some scientists believe that the best **children's DHA** supplements are derived from flaxseed oil, or wild freshwater fish. These typically contain less contaminants than other brands. (Attachment to the October 4, 2010 Office action, page 5-6).

Children's dha is important in early development, read more on DHA and Nutrition For ADHD Children, Natural Treatment For ADHD. (Attachment to October 4, 2010 Office action, page 10).

Consider how much DHA for Children, the Omega-3 Dosage, the source of the **Children's DHA**, vegan DHA Supplements, all because Kids need DHA Omega-3s and a Vegan Omega 3 is better for Children. (Attachment to the June 29, 2011 Office action, page 80).

DHA Junior is a small, chewable **children's DHA** supplement flavored with strawberry essence, a delicious way for children (over 2 years) to supplement their diet with the essential brain nutrient, DHA. (Attachment to the June 29, 2011 Office action, page 84).

Nordic Naturals DHA Junior is a small, strawberry flavored chewable **children's DHA** supplement. (Attachment to the June 29, 2011 Office action, page 94).

Chewable **children's DHA** supplements are widely available; follow the dosage instructions on the container. (Attachment to the June 29, 2011 Office action, page 125).

NSI® Omega Fishies for Kids. Chewable **children's DHA** supplement promotes healthy brain development and visual function. (Attachment to the June 29, 2011 Office action, page 126).

Applicant argues that

Many 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." (App. Brief at 10).

But the use of "the phrase in its primary, descriptive sense to describe the nature and intended user of the nutritional supplements being sold" is generic usage of the phrase CHILDREN'S DHA. And the fact that the phrase is often used in connection with the term "supplements" does not mean that it is not generic. Using a term as an adjective does not prevent that term from being generic if the adjective refers to the relevant genus or category of goods. TMEP §1209.01(c)(ii). Thus an adjective may be generic if it denotes a narrower subcategory of the identified goods. *See, e.g., In re Northland Aluminum Prods. Inc.*, 777 F.2d 1556, 1560, 227 USPQ 961, 964 (Fed. Cir. 1985) (holding BUNDT generic for ring cake mix; i.e., the subcategory "bundt cakes"); *In re Cent. Sprinkler Co.*, 49 USPQ2d 1194, 1199 (TTAB 1998) (holding ATTIC generic for automatic sprinklers for fire protection installed primarily in attics; i.e., the subcategory "attic sprinklers"); TMEP §1209.01(c)(ii).

Applicant also contends that "...to the extent that third parties are using Applicant's mark as a designation of source for their 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." (App. Br. at 10). Applicant asserts that "[a]s 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. (App. Br. at 11).

First, assuming, arguendo, that applicant was the first and only user of the phrase CHILDREN'S DHA for the first five years' of its use, this fact is not dispositive on the issue of genericness where, as here, the evidence shows that the word or term is generic. *See In re Greenliant Sys. Ltd.*, 97 USPQ2d 1078, 1083 (TTAB 2010); *In re Nat'l Shooting Sports Found., Inc.*, 219 USPQ 1018, 1020 (TTAB 1983); TMEP §1209.03(c).

Furthermore, a term that was once arbitrary or suggestive may lose its distinguishing and origin-denoting characteristics through use in a descriptive sense over a period of time, and may come to be regarded by the purchasing public as nothing more than a descriptive designation. *In re Digital Research, Inc.*, 4 USPQ2d 1242, 1243 (TTAB 1987); *In re Int'l Spike, Inc.*, 190 USPQ 505, 507 (TTAB 1976). Thus, trademark rights are not static, and eligibility for registration must be determined on the basis of the facts and evidence in the record at the time registration is sought, which includes during examination and any related appeal. *In re Chippendales USA Inc.*, 622 F.3d 1346, 1354, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1344, 213 USPQ 9, 18 (C.C.P.A. 1982); *In re Thunderbird Prods. Corp.*, 406 F.2d 1389, 1391, 160 USPQ 730, 732 (C.C.P.A. 1969).

The record in this case also dates back nearly three years, to September of 2009. And the evidence made of record makes it clear that numerous competitors are using the phrase CHILDREN'S DHA on and in connection with their children's DHA supplements and have been doing so for the duration of this case. *See*, attachments to the September 9, 2009, March 13, 2010, October 4, 2010, and June 29, 2011 Office actions. Yet applicant has not made any evidence of record showing that it has been policing use of the phrase CHILDREN'S DHA nor has it made any evidence of record showing that it has attempted to enforce its rights in the phrase against purported "infringing uses." Further, there is no indication that applicant has taken action to stop even the retailers of its *own* products from using the phrase CHILDREN'S DHA in a generic manner in connection with the sale of its *own* goods. (Attachments to the June 29, 2011 Office action, pages 93 – 122).

Accordingly, the widespread third party use of the phrase CHILDREN'S DHA seems to merely show applicant's competitors using the generic designation in

combination with their trademarks to indicate to consumers what the goods are, namely, children's DHA supplements:

Spectrum Naturals Children's DHA
(Attachment to the March 13, 2010 Office action, page 12)

Go Fish Brainy Kidz Children's DHA Soft Chews
(Attachment to the March 13, 2010 Office action, page 14)

Nutri-West Complete Children's DHA/EPA
(Attachment to the March 13, 2010 Office action, page 19)

Vitamin Shoppe Children's DHA
(Attachment to the March 13, 2010 Office action, page 21)

Faith and Family Nutrition Children's DHA
(Attachment to the March 13, 2010 Office action, page 22)

Nature's Plus – Animal Parade Children's DHA for Kids
(Attachment to the March 13, 2010 Office action, page 24)

Berry Keen Children's DHA Strawberry
(Attachment to the March 13, 2010 Office action, page 30)

Catalo Children's DHA
(Attachment to the March 13, 2010 Office action, page 32)

The widespread use of the phrase CHILDREN'S DHA by applicant's competitors and by others with no mention of Nordic Naturals starkly contrasts with the evidence of record in *Merrill Lynch*, where the "voluminous evidence of usage" in that case referred to the "Cash Management Account" as having been "offered by Merrill Lynch" and "pioneered by Merrill Lynch." *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 4 USPQ2d 1141, 1143, 828 F.2d 1567, 1570 (Fed. Cir. 1987). The Court in that case also stated that the evidence "...does 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.* at 1571. But here, unlike in *Merrill Lynch*, the record is replete with clear evidence of use of the phrase CHILDREN'S DHA on and in reference to nutritional supplements containing DHA, including generic use of the phrase in the sale and

advertising of applicant's own goods. See, attachments to the June 29, 2011 Office action, pages 93 – 122.

B. APPLICANT HAS NOT DEMONSTRATED THAT ITS MARK HAS ACQUIRED DISTINCTIVENESS.

In the alternative, if the applied-for mark is ultimately determined to be merely descriptive and not generic, the applicant has failed to demonstrate that the proposed mark has acquired distinctiveness for the identified goods.

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. The ultimate test in determining acquisition of distinctiveness under Trademark Act Section 2(f) is not applicant's efforts, but applicant's success in educating the public to associate the claimed mark with a single source. TMEP §1212.06(b); see *In re Packaging Specialists*, 221 USPQ at 920; *In re Redken Labs., Inc.*, 170 USPQ 526 (TTAB 1971).

Because there is extensive use of the proposed mark by competitors and other third-parties, the proposed mark is, at best, characterized as a highly descriptive mark. The amount and character of evidence needed to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (C.C.P.A. 1970); see *In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ 381 (C.C.P.A. 1960); TMEP §1212.05(a).

More evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods 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).

With respect to applicant's claim of acquired distinctiveness, the following evidence was provided in support of such claim: eight years' use, excerpts from trade journals, affidavits from "industry professionals," sales and advertising figures, chat

room excerpts, and an affidavit by the Chief Executive Officer of Nordic Naturals. *See* 37 C.F.R. §2.41.

The trade journal articles submitted by applicant do not show that consumers, who are presumably not members of the nutritional supplement industry, have seen the articles and now view the phrase CHILDREN'S DHA as a source indicator for applicant's identified goods. Similarly, with regard to the affidavits from "industry professionals," these affidavits are from retailers only and are not from any consumers. Accordingly, these affidavits fail to show that the purchasing public has come to view the phrase CHILDREN'S DHA as an indicator of source.

Although applicant has used the proposed mark for eight years, such use does not demonstrate that during that period of time, consumers have come to view CHILDREN'S DHA as a source indicator, especially where the mark at issue here is at least highly descriptive of the identified goods and where there is pervasive use of the phrase as a generic designation.

With regard to the chat room excerpts, many of the excerpts actually show generic usage of the phrase CHILDREN'S DHA and DHA supplements rather than recognition of the applied-for phrase as a trademark.

Applicant has also provided evidence of high sales figures and significant advertising expenditures for the goods at issue; however, such evidence is not dispositive of whether the proposed mark has acquired distinctiveness. Such extensive sales and promotion may demonstrate the commercial success of applicant's goods, but not that relevant consumers view the matter as a mark for such goods particularly when retailers advertising applicant's products for sale use the phrase CHILDREN'S DHA in a generic manner. *See In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999); *In re Busch Entm't Corp.*, 60 USPQ2d 1130, 1134 (TTAB 2000).

Similarly, applicant's advertising expenditures are merely indicative of its efforts to develop distinctiveness; not evidence that the mark has acquired distinctiveness. *See In re Pennzoil Prods. Co.*, 20 USPQ2d 1753 (TTAB 1991).

C. THE STYLIZATION OF APPLICANT'S PROPOSED MARK DOES NOT RENDER THE PROPOSED MARK REGISTRABLE.

Applicant contends that

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. (App. Br. at 18).

"It has been held that while an entire mark cannot be disclaimed and also registered, nevertheless where the unregistrable components of a mark are combined in a design or display which is so distinctive as to create a commercial impression separate and apart from the unregistrable components, it is possible to disclaim those unregistrable components and still have a mark which is registrable as a whole." *In re Carolyn's Candies, Inc.*, 206 USPQ 356, 360 (TTAB 1980) (internal citations omitted).

It is noted, as a preliminary matter, that applicant has not submitted a disclaimer of both words in its mark and has only submitted a disclaimer of DHA. It is also noted that, unlike in *Carolyn's Candies* and unlike in *In re Wella*, referenced by applicant, applicant has applied to register the proposed mark on the Principal Register and not on the Supplemental Register. *See, In re Wella Corp.*, 193 USPQ 585 (TTAB 1977). Moreover, the stylization of the letters in the proposed mark is arguably much less fanciful and eye-catching than the marks at issue in *Carolyn's Candies*, *In re Wella*, and in *Jackson Hole Ski Corp.*, 190 USPQ 175 (TTAB 1976), cited by applicant. Though applicant's proposed mark consists of letters displayed in stylized font and in colors, there is extensive evidence of record here that indicates that for children's supplements and medications, it is common practice to display the wording CHILDREN'S or KID'S and other label wording in "handwritten" format and font like that in the applied-for mark, and to display the letters in several different colors. *See*, attachments to September 9, 2009 Office action, pages 4 and 18, attachment to March 13, 2010 Office action, page 21, attachment to June 29, 2011 Office action, page 57, attachments to January 20, 2012 denial of request for reconsideration, pages 2, 3, 4, 5, 7, 8, 9, 10, 11, 12, 13, 16, 17, 18, 19, 20, 24, 26, 28, 30, 32, 34, 36, and 50. There was no such evidence of marketplace usage of the same stylization at issue in the aforementioned cases.

Accordingly, as it is commonly used in connection with children's supplements and medications, the stylization and coloration of the proposed mark used on children's nutritional supplements is not so distinctive as to create a commercial impression separate and apart from the wording CHILDREN'S DHA in the mark as to be registrable on the Principal Register, even with a disclaimer of CHILDREN'S DHA.

Although applicant has submitted a claim of acquired distinctiveness under Section 2(f) in the alternative, none of the evidence submitted by applicant in support of its Section 2(f) claim addresses or even mentions whether the stylization and coloration of the applied-for mark is viewed by consumers as creating a commercial impression separate and apart from the wording in the mark and is perceived as a source indicator. While applicant has been using the stylized mark for eight years, where, as here, the evidence shows that the same stylization and coloration as in the proposed mark is in widespread use by competitors on the same and similar goods, that period of use alone is insufficient to establish that consumers have come to view that stylization and coloration as having acquired distinctiveness such that it would be viewed as an indicator of source.

IV. CONCLUSION

The evidence of record shows that applicant's proposed mark is generic, and therefore, incapable of functioning as a source-indicator for applicant's goods. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987); *In re Pennzoil Prods. Co.*, 20 USPQ2d 1753 (TTAB 1991); *see* TMEP §§1209.01(c) *et seq.*, 1209.02(a). Moreover, even if the proposed mark is ultimately determined to be merely descriptive and not generic, it is so highly descriptive that applicant's evidence in support of its Section 2(f) claim is insufficient because the evidence does not demonstrate the relevant purchasing public views the mark as a source-identifier. Finally, the stylization and coloration of applicant's proposed mark is not so distinctive as to create a commercial impression separate and apart from the wording in the mark to render the mark registrable with a disclaimer. Accordingly, it is respectfully requested that the refusal to register be affirmed.

Respectfully submitted,

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