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Subject: U.S. TRADEMARK APPLICATION NO. 77758863 - PROBIOTIC - N/A -
EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77758863

MARK: PROBIOTIC



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TTAB INFORMATION:

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

APPLICANT: Shamma, Milo

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF

I. STATEMENT OF THE CASE

The applicant, Milo Shamma, has appealed the trademark examining attorney's final refusal to register the proposed trademark PROBIOTIC, in standard character form, for "ammonium chloride fertilizer; ammonium nitrate fertilizer; ammonium sulphate fertilizer; blood powder; bone meal; brewers' grain; calcined potassium fertilizer; calcium silicate fertilizer; calcium superphosphate fertilizer; chemical fertilizers; chemically converted compound fertilizers; compost; double or triple superphosphate fertilizer; fertilizers; fertilizers and manures; fertilizers for agricultural use; fertilizers for domestic use; fertilizing preparations; leaf mold; manganese fertilizer; marine fertilizer; mixed fertilizers; natural fertilizers; non-chemical bio-fertilizers; omplex fertilizers; peat; potassium chloride fertilizer; potassium sulphate fertilizer; rice bran; sodium nitrate fertilizer; thomas phosphatic fertilizer; urea fertilizer" 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 12, 2009, the applicant applied to register the mark PROBIOTIC, in standard characters, based on use of the mark in commerce under Section 1(a) of the Trademark Act in connection with “ammonium chloride fertilizer; ammonium nitrate fertilizer; ammonium sulphate fertilizer; blood powder; bone meal; brewers' grain; calcined potassium fertilizer; calcium silicate fertilizer; calcium superphosphate fertilizer; chemical fertilizers; chemically converted compound fertilizers; compost; double or triple superphosphate fertilizer; fertilizers; fertilizers and manures; fertilizers for agricultural use; fertilizers for domestic use; fertilizing preparations; leaf mold; manganese fertilizer; marine fertilizer; mixed fertilizers; natural fertilizers; non-chemical bio-fertilizers; omplex fertilizers; peat; potassium chloride fertilizer; potassium sulphate fertilizer; rice bran; sodium nitrate fertilizer; thomas phosphatic fertilizer; urea fertilizer.”

In an Office action dated September 14, 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 application was then abandoned on April 12, 2010 because no response was received to the September 14, 2009 Office action within the six-month response period.

A petition to revive and response were received from the applicant on August 30, 2010 in which it argued against the refusal under Section 2(e)(1) of the Trademark Act and argued that its mark had acquired distinctiveness due to long use.

The application was revived to pending status on September 8, 2010.

On February 24, 2011, 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.

The application was reassigned to the undersigned trademark examining attorney, and on May 24, 2011, a non-final Office action was issued in which the refusal under Section 2(e)(1) was maintained and continued, applicant was required to submit a

verified Section 2(f) claim, and the applicant was required to clarify its dates of use, as the dates of use in the application did not support a claim of acquired distinctiveness of its mark under Trademark Act Section 2(f) based on length of use.

In a response received in the Office on June 6, 2011, applicant submitted a claim of acquired distinctiveness under Section 2(f) of the Trademark Act based on length of use and submitted amended dates of use.

On July 12, 2011, 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 response from applicant was received on August 18, 2011 in which it argued against the Section 2(e)(1) refusal.

The refusal of registration because the proposed mark is generic, and in the alternative, that the Section 2(f) evidence is insufficient, was made final by the examining attorney via an Office action sent September 16, 2011.

On October 18, 2011, applicant filed a Notice of Appeal along with its Appeal Brief.

III. OBJECTION TO NEW EVIDENCE

The examining attorney objects to new evidence submitted by the applicant at the time of appeal. Specifically, applicant refers to and discusses U.S. Registration No. 3895671, which it specifically states is “not on the prosecution record.” (applicant’s Appeal Brief at 9-10, hereinafter, “(App. Br. at ___)”). The Trademark Trial and Appeal Board does not take judicial notice of third-party registrations. TBMP §§1208.02, 1208.04; *see* Fed. R. Evid. 201; 37 C.F.R. §2.122(a); *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). To make third party registrations part of the record, an applicant must submit copies of registrations from the USPTO’s database prior to appeal. *In re Ruffin Gaming*, 66 USPQ2d at 1925 n.3; *In re Carolina Apparel*, 48 USPQ2d at 1543 n.2; TBMP §1208.02; TMEP §710.03. Accordingly, the third-party registration referred to by applicant in its appeal brief should not be considered.

IV. ARGUMENT

A. THE PROPOSED MARK IS GENERIC FOR THE IDENTIFIED GOODS.

1. The evidence of record is sufficient to show that the public understands PROBIOTIC to be generic for a genus or class of FERTILIZER.

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(b).

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).

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?

In re 1800Mattress.com IP LLC, 586 F. 3d 1359, 1363, 92 USPQ2d 1682, 1684 (Fed. Cir. 2009) (quoting *H. Marvin Ginn Corp.*, 782 F.2d at 990, 228 USPQ at 530); TMEP §1209.01(c)(i).

Applicant seeks to register the mark PROBIOTIC, in standard character form, for use in connection with "ammonium chloride fertilizer; ammonium nitrate fertilizer; ammonium sulphate fertilizer; blood powder; bone meal; brewers' grain; calcined potassium fertilizer; calcium silicate fertilizer; calcium superphosphate fertilizer; chemical fertilizers; chemically converted compound fertilizers; compost; double or triple superphosphate fertilizer; fertilizers; fertilizers and manures; fertilizers for agricultural use; fertilizers for domestic use; fertilizing preparations; leaf mold; manganese fertilizer; marine fertilizer; mixed fertilizers; natural fertilizers; non-chemical bio-fertilizers;

omplex fertilizers; peat; potassium chloride fertilizer; potassium sulphate fertilizer; rice bran; sodium nitrate fertilizer; thomas phosphatic fertilizer; urea fertilizer.”

The class or genus of goods at issue is thus fertilizer. The term PROBIOTIC is defined, in part, as a “substance containing beneficial microorganisms.” *Encarta® World English Dictionary [North American Edition]*, 2007 (definition attached to the September 14, 2009 Office action). The excerpt from the applicant’s website attached to the May 24, 2011 and September 14, 2009 Office actions indicate that applicant’s identified goods contain “beneficial soil bacteria” and/or “beneficial soil microbes and mycorrhizae.” *See*, excerpts from applicant’s website attached to the May 24, 2011 and September 14, 2009 Office actions. The proposed mark is therefore the generic designation for an ingredient in applicant’s identified goods. A word or term that is the name of a key ingredient, characteristic or feature of the goods can be generic for those goods and thus, incapable of distinguishing source. A term does not need to be the name of the goods to be found incapable of serving as an indicator of origin. *In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718 (C.C.P.A. 1970) (holding CUSTOM BLENDED generic for gasoline); *In re Helena Rubenstein, Inc.*, 410 F.2d 438, 161 USPQ 606 (C.C.P.A. 1969) (holding PASTEURIZED generic for face cream); *Roselux Chem. Co. v. Parsons Ammonia Co.*, 299 F.2d 855, 132 USPQ 627 (C.C.P.A. 1962) (holding SUDSY generic for ammonia); *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); *In re Ricci-Italian Silversmiths, Inc.*, 16 USPQ2d 1727 (TTAB 1990) (holding ART DECO generic for flatware); *In re Hask Toiletries*, 223 USPQ 1254 (TTAB 1984) (holding HENNA ‘N’ PLACENTA generic of ingredients for hair conditioner); *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 1 USPQ2d 1364 (3d Cir. 1986) (holding CHOCOLATE FUDGE generic for diet sodas); *see* TMEP §§1209.01(c) *et seq.*

The examining attorney has also attached numerous internet excerpts to the Office actions mailed February 24, 2009, May 24, 2011, and September 16, 2011 showing the term PROBIOTIC in widespread use to identify a class or genus of fertilizers.

Finally, applicant's own evidence supports PROBIOTIC being a generic designation for the identified goods, as the Wikipedia® entry submitted by applicant indicates that "[p]robiotics are live microorganisms thought to be beneficial to the host organism." (App. Br. at Exhibit B). Applicant is mistaken in the belief that the host organism must be a human being or even an animal at all. Rather, here, the host organism is the plant that receives the live microorganisms through applicant's fertilizer products. The term PROBIOTIC thus aptly identifies the class or genus for those fertilizers that contain live organisms that benefit the plants to which the fertilizer is administered. In addition, applicant's "affidavit" from Dr. Mike Amaranthus, includes the statement that "...until Dr. Earth brought the [DESCRIPTIVE] word 'probiotic' to the lawn and garden industry, it was never used..." (App. Br. at Exhibit C). Dr. Amaranthus goes on to state in his "affidavit" that applicant has taught "...gardeners at the nursery level to sell probiotic fertilizers and soils..." and that applicant "...has made probiotic a common word now in the lawn and garden industry. *Id.* Accordingly, even applicant's own "expert" indicates that the proposed mark is at least merely descriptive, uses the term PROBIOTIC as a generic term rather than as a source indicator, and confirms that the applied-for mark to be a common term in the lawn and garden industry.

2. The fact that the term PROBIOTIC is applicable to other products does not mean it is not generic with regard to applicant's identified goods.

The applicant argues in its response that "...as far as the general public is concerned, the word probiotic refers to an orally taken supplement to the body to restore beneficial bacteria." (App. Br. at 6). While applicant may be correct that the term PROBIOTIC is applicable to dietary and nutritional supplements that are taken orally, the evidence attached to the February 24, 2009, May 24, 2011, and September 16, 2011 Office actions indicates that the term is not used only to refer to those goods and is also in widespread use with regard to fertilizers. Further, as probiotic supplements and probiotic fertilizers all contain beneficial microorganisms, the meaning of the term in each context is the same. Accordingly, the fact that the term PROBIOTIC is also applicable to dietary

and nutritional supplements does not prevent or preclude the term from also being used to identify a genus or class of fertilizer.

3. Even if applicant was the first user of the term PROBIOTIC with regard to fertilizer, the term is now generic for fertilizer.

Applicant contends in its Appeal Brief that "...prior to Applicant's first use of the mark in 1992 (See Exhibit A, which is a copy of an invoice to Applicant for creation of the mark in 1992), the word PROBIOTIC did not have any association with fertilizers at all." (App. Br. at 4). Applicant also refers to an "affidavit" of Dr. Mike Amaranthus who "...provides an expert opinion that it is the Applicant that first introduced the use of the word PROBIOTIC to the lawn and garden industry and that prior to that, it was never used." (App. Br. at 4).

But 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 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).

Further, 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).

B. THE APPLICANT HAS NOT ESTABLISHED THAT THE PROPOSED MARK HAS ACQUIRED DISTINCTIVENESS.

If the applied-for mark is ultimately determined to be merely descriptive and not generic, the applicant has failed to establish 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 & Wenhe, 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).

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 and/or 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).

Here, the only evidence provided by applicant in support of its claim of acquired distinctiveness is eleven years' use of the mark in commerce. But this evidence fails to show that consumers view PROBIOTIC as a trademark for applicant's goods. Accordingly, with a mark as highly descriptive as PROBIOTIC, eleven years' use alone is insufficient to support the applicant's claim of acquired distinctiveness.

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, which consisted primarily of eleven years' use, is insufficient because such use does not indicate whether the relevant purchasing public views the mark as a source-identifier. Accordingly, it is respectfully requested that the refusal to register be affirmed.

Respectfully submitted,

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