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Sent: 12/11/2015 12:17:59 PM

To: TTAB E filing

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Subject: U.S. TRADEMARK APPLICATION NO. 78691247 - NAG CHAMPA - 80171.4000.0 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 78691247

MARK: NAG CHAMPA



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GENERAL TRADEMARK INFORMATION:

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TTAB INFORMATION:

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

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CORRESPONDENT'S REFERENCE/DOCKET NO:

80171.4000.0

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Examining Attorney's final refusal to register the proposed trademark NAG CHAMPA for use with "incense sticks." The examining attorney refused registration on the grounds that the mark NAG CHAMPA is merely descriptive of the identified goods under Section 2(e)(1) of the

Trademark Act, 15 U.S.C. Section 1052(e) and on the grounds that applicant had not demonstrated that its mark acquired distinctiveness under Section 2(f) of the Lanham Act.

FACTS

On August 12, 2005, Applicant applied to register the mark NAG CHAMPA for “incense sticks” in International Class 3. Subsequently, action on the application was suspended pending disposition of a prior pending application not relevant to this appeal and again during a cancellation proceeding not relevant to this appeal.

On October 19, 2012, the examining attorney issued a non-final Office Action refusing registration under Section 2(e)(1) of the Trademark Act based on the proposed mark’s descriptive nature as applied to the identified goods. Following applicant’s unpersuasive response, on June 10., 2013, the examining attorney issued a Final Office Action refusing registration under Section 2(e)(1) of the Trademark Act based on the proposed mark’s descriptive nature.

On December 10, 2013, Applicant filed notice of appeal, as well as a Request for Reconsideration after Final Office Action attempting to assert, for the first time, an unsupported claim, in the alternative, of acquired distinctiveness pursuant to Section 2(f) of the Trademark Act. This raised a new issue and on March 3, 2014, the examining attorney issued a non-final Office Action rejecting the attempted claim of acquired distinctiveness and maintaining and continuing the final refusal based on descriptiveness under Section 2(e)(1) of the Trademark Act.

On September 3, 2014, Applicant filed its response to the non-final Office Action, again raising the claim of acquired distinctiveness, that claim now properly supported and based on the five or more years’ use and providing additional evidence in support of the claim.

On November 24, 2014, the examining attorney issued a non-final Office Action refusing as insufficient the claim of acquired distinctiveness and maintaining and continuing the final refusal based on descriptiveness under Section 2(e)(1) of the Trademark Act and maintaining and continuing the Request for Reconsideration.

Following applicant's response, the examining attorney issued a final Office Action on July 13, 2014, refusing as insufficient the acquired distinctiveness claim and maintaining and continuing the final refusal based on descriptiveness under Section 2(e)(1) of the Trademark Act.

The present appeal was resumed and following the filing of applicant's appeal brief the case was forwarded to the Examining Attorney for submission of his brief.

ARGUMENT

Applicant's proposed mark is merely descriptive of the identified goods. As shown by the substantial evidence of record in this case, it must be refused registration under Section 2(e)(1) of the Trademark Act. Additionally, applicant's claim of acquired distinctiveness under Section 2(f) of the Trademark Act is insufficient to establish that that the proposed mark has acquired distinctiveness.

**APPLICANT'S PROPOSED MARK IS MERELY DESCRIPTIVE OF THE
GOODS IDENTIFIED UNDER SECTION 2(E)(1) OF THE TRADEMARK ACT.**

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods and/or services. TMEP §1209.01(b); *see, e.g., In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (*quoting In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)).

Determining the descriptiveness of a mark is done in relation to an applicant's goods and/or services, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. *See In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b). Descriptiveness of a mark is not considered in the abstract. *In re Bayer Aktiengesellschaft*, 488 F.3d at 963-64, 82 USPQ2d at 1831.

Applicant's proposed mark NAG CHAMPA is merely descriptive because it identifies a feature and/or characteristic of applicant's incense sticks. As shown by the evidence made of record in this case and discussed below, the wording identifies the name of a particular fragrance commonly used in incense, soap, perfume oil, essential oils, candles and other personal toiletries.

In support of the descriptiveness of the proposed mark the examining attorney initially provided screen shots from two websites which provided information regarding the origin and composition of Nag Champa. *See* Office Action dated October 19, 2012 at pages 2-9. Additionally, as shown on the *Sensia* website found at pages 7-9 of the Office Action dated October 19, 2012, the terms "Nag Champa" are used by third-parties to refer to a particular fragrance profile and not to applicant's particular goods. Furthermore, the *Sensia* website features an online store selling incense, beauty soaps, glycerin soaps "in the traditional classic earthy fragrance nag champa from India", and sachets, all

described as being scented with Nag Champa and all being products of the applicant. Moreover, the *Sensia* website also sells its own private label moisturizing body lotion, body spray and vegetable soup scented with Nag Champa under the tag line “the traditional Nag Champa fragrance of India in fabulous new body products from Sensia” along with a third-party’s perfume oil together with applicant’s Nag Champa scented products. See exhibits from the Office Action dated October 19, 2012 at pages 7-9.

Additional evidence was provided by the examining attorney consisting screen shots from EBay showing auctions and several individual websites. This evidence identifies at least fifteen third-party corporate manufacturers all using “Nag Champa” to describe the fragrance of their incense. See exhibits from the final Office Action dated June 10, 2013 identifying unrelated brands of Nag Champa incense, namely, “Vijayshree,” - pgs. 138-139; “Swagat,” - pgs. 183-187; “Madhuban,” - pgs. 91-92; “Yoga,” - pgs. 70-73; “Pooja,” - pgs. 66-67; “Shanthimalai,” – pgs. 55-56; “Nandita,” - pgs. 112-113; “Kamini,” - pgs. 116-117; “Namaste,” - pgs. 125-126; “Agarbathi,” - pgs. 27-28; “Spirualsky,” - pgs. 30-31; “Tibetan,” - pgs. 45-47; “Triloka,” pgs. 146-147; “OM,” pgs. 42-43; “Inscents,” pgs. 121-123. Also included in the record is a website showing Nag Champa fragrance oil being used in aromatherapy and as the base fragrance for the manufacture of incense sticks, cones and powders. And finally screenshots of other products scented with Nag Champa, including candles (See office actions dated March 3, 2014, at pages 14-15, 29, 31), aromatherapy and perfume oils (See office actions dated October 19, 2012, at page 7; June 10, 2013, at pages 10, 12; March 3, 2014, at page 16; November 24, 2014, at pages 32, 34 and 37), body oils and lotions (See office actions dated October 19, 2012, at page 7; June 10, 2013, at pages 10, 12; November 24, 2014, at pages 28, 30), and other scented products (See office actions dated October 19, 2012, at page 7; June 10, 2013, at page 12).

Further, it has long been held that third-party registrations featuring goods and/or services the same as or similar to applicant’s goods and/or services are probative evidence on the issue of

descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on acquired distinctiveness, or registered on the Supplemental Register. *See Inst. Nat'l des Appellations D'Origine v. Vintners Int'l Co.*, 958 F.2d 1574, 1581-82, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992). Additionally, third-party registrations are similar to dictionaries showing how language is generally used. *See, e.g., Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1976); TMEP §1207.01(d)(iii). Thus in further support of the office's position two United States Trademark Registrations were made of record showing the disclaimer of the wording NAG CHAMPA for "nag champa incense and incense sticks" and "incense and incense sticks, perfumes and perfumery, essential oils, hair lotions, hair oil and soaps". *See* Registration Nos. 40768175 and 3612441.

Lastly, the examining attorney provided Internet printouts, multiple LexisNexis® articles and an article from the online ProQuest Dialog database showing the highly descriptive use of the wording Nag Champa in relationship to incense and other fragrance-related products. *See* exhibits from the Office Action dated November 24, 2014. Of note are the glossary entries from www.nstperfume.com and www.theperfumedcourt.com showing that the wording "Nag Champa" refers to "perfume oil originally made in the Hindu and Buddhist monasteries of India and Nepal and used to perfume incense." - *See* exhibits from the Office Action dated November 24, 2014, at pages 25 and 42. Further, www.candle-science.com states that "Nag champa is an Indian fragrance popular in incense" and the www.patchoulogigarden.com website states "Our large candle is heavily scented with nag champa". *See* exhibits from the Office Action dated November 24, 2014, at pages 29 and 31. Additionally, the *Ehow.com* website states:

"Though often mistaken for a brand name, "Nag Champa" is really the name of a specific combination of natural fragrance ingredients associated with the Ayurvedic tradition. Though most famously known as a popular type of incense, Nag Champa scents are used in a variety of scent products ranging from practical items to various means of delivering

the ambient fragrance into the space of a room. If you're a fan of Nag Champa, you can easily incorporate it into many areas of your daily life.”

See Office Action dated November 24, 2014, at page 6.

Applicant argues that the examining attorney’s evidence was not obtained from a competent source. See Applicant’s Brief pages 6-14. However, material obtained from the Internet is generally accepted as competent evidence. See *In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1644-47 (TTAB 2015). (finding that articles from non-U.S. publications have some probative value because the case concerns the perception of the relevant consumers, i.e., the general U.S. public, regarding the identity of a celebrity who lives and travels outside of the United States). Additionally, material obtained from computerized text-search databases, such as LexisNexis®, is generally accepted as competent evidence. See *In re Lamb-Weston Inc.*, 54 USPQ2d 1190, 1192 (TTAB 2000) (accepting LexisNexis® evidence to show descriptiveness); TBMP §1208.01; TMEP §710.01(a)-(b).

Furthermore, even if the Board considered the examining attorney’s Internet evidence from www.wisegeek.com, www.ebay.com, www.ehow.com and www.ezinearticles.com akin to articles from the online Wikipedia® encyclopedia, the examiner has taken the “better practice” approach of corroborating such evidence with information from other reliable sources, including LexisNexis® and other online sources. *In re IP Carrier Consulting Grp.*, 84 USPQ2d 1028, 1032-33 (TTAB 2007); TBMP §1208.03; TMEP §710.01(b). The examiner simply cannot turn a blind eye to the evidence of record, including the LexisNexis® and ProQuest Dialog articles and Internet printouts showing highly descriptive use of the wording “Nag Champa” and “Nag Champa incense” by third parties. Therefore, applicant’s arguments regarding the competent nature and sufficiency of the evidence are misplaced.

Here the evidence of record clearly shows that NAG CHAMPA has a plain, distinct and commonly known and descriptive meaning in relationship to incense. Therefore, registration must be refused under Section 2(d) of the Lanham Act.

APPLICANT'S EVIDENCE IS INSUFFICIENT TO SHOW ACQUIRED DISTINCTIVENESS UNDER SECTION 2(f) OF THE TRADEMARK ACT.

In an attempt to obviate the descriptiveness refusal applicant amended the application to assert a claim of acquired distinctiveness under Section 2(f) of the Trademark Act. Initially, the claim was based on long use of at least five years in commerce with applicant later providing additional supporting statements and evidence. However, because "Nag Champa" is so highly descriptive of the applicant's incense identified, applicant's claim and evidence of acquired distinctiveness is insufficient.

It is axiomatic that when asserting a Trademark Act Section 2(f) claim, 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, 1578-79, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988); TMEP §1212.01. Thus, applicant must establish that the purchasing public has come to view the proposed mark as an indicator of origin. 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. *See Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 829, 166 USPQ 34, 39 (C.C.P.A. 1970); *In re Hehr Mfg. Co.*, 279 F.2d 526, 528, 126 USPQ 381, 383 (C.C.P.A. 1960); *In re Gammon Reel, Inc.*, 227 USPQ 729, 730 (TTAB 1985). The more descriptive a term is, the greater applicant's evidentiary burden to establish acquired distinctiveness becomes. *See, e.g., In re Bongrain Int'l (Am.) Corp.*, 894 F.2d at 1317 n.4, 13 USPQ2d at 1728 n.4 (quoting *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d at 1581, 6 USPQ2d at 1008). The following factors are generally considered when determining whether a proposed mark has acquired

distinctiveness based on extrinsic evidence: (1) length and exclusivity of use of the mark in the United States by applicant; (2) the type, expense, and amount of advertising of the mark in the United States; and (3) applicant's efforts in the United States to associate the mark with the source of the goods and/or services, such as unsolicited media coverage and consumer studies. *See In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005); *Bd. of Trs. of Univ. of Ala. v. Pitts, Jr.*, 107 USPQ2d 2001, 2016 (TTAB 2013). A showing of acquired distinctiveness need not consider all these factors, and no single factor is determinative. *In re Steelbuilding.com*, 415 F.3d at 1300, 75 USPQ2d at 1424; *see* TMEP §§1212.06 *et seq.*

The initial Section 2(f) claim based on at least five years use was determined to be insufficient on two grounds. First, because the evidence showed that "Nag Champa" was highly descriptive of the incense identified in the application and second, because the evidence demonstrated use of the proposed mark by applicant was not substantially exclusive as required. *In re Kalmbach Publ'g Co.*, 14 USPQ2d 1490, 1492 (TTAB 1989); TMEP §1212.05(a).

In response to the denial of the proposed mark based on the statutory five years use the applicant provided a single personal affidavit discussing the purported origin of NAG CHAMPA, dates of use and worldwide and North American sales figures over twenty years. *See* Response to Office Action dated September 3, 2014 referencing the Response to Office Action dated April 13, 2013, at pages 8-9. Affidavits or declarations asserting recognition of the mark as a source indicator are relevant in establishing acquired distinctiveness. However, the value of the affidavits or declarations depends on the statements made therein and the identity of the affiant or declarant. In this case the affidavit is from an interested party, namely, applicant's General Manager.

In the affidavit the applicant alleges use of the proposed mark for approximately 20 years in the United States. While this is a significant amount of time, evidence of record also shows

that this use has not been substantially exclusive, thus undermining the strength of applicant's 2(f) claim. *See* evidence in the Office Actions dated October 19 2012; June 6, 2013; March 3, 2014; and November 24, 2014. Additionally, the sales figure information provided, regardless of the amount, is not dispositive of whether NAG CHAMPA has acquired distinctiveness. Such sales information may demonstrate the commercial success of applicant's goods, but not that relevant consumers view the matter as a mark for such goods. *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).

Applicant also states that its mark has been registered in "numerous" countries. The evidence of record shows that four trademarks incorporating NAG CHAMPA have been registered in two countries by the applicant. *See* Applicant's Response Dated April 18, 2013, at pages 10-14. However, this factor is not relevant in the prosecution of an application based on Section 1(a) as it does not demonstrate how the mark is used or perceived in the United States. Further, it does not establish any finding or presumption of acquired distinctiveness, even when combined with applicant's commercial success. As to other evidence of acquired distinctiveness, the applicant has provided no advertising figures and no samples of advertising for consideration of the use of the proposed mark in establishing distinctiveness of the mark as an indicator of source. Nor has the applicant provided any consumer or dealer statements of recognition of the proposed mark as a source indicator or any other supporting evidence for consideration.

In rebuttal to applicant's assertion of substantially exclusive use, the examining attorney provided two third-party trademark registrations that incorporated the entirety of the proposed mark. *See* Registration Nos. 40768175 and 3612441. Contrary to applicant's assertions, the registrations were

provided to show that not only is the proposed mark merely descriptive by virtue of the wording being disclaimed, but also that the terms “Nag Champa” are used by third-parties to identify similar goods. In further support, the examining attorney provided significant evidence demonstrating current use of “Nag Champa” by multiple third-parties to identify their incense goods (See e.g., exhibits from the final Office Action dated June 10, 2013 identifying “Vijayshree,” - pgs. 138-139; “Swagat,” – pgs. 183-187; “Madhuban,” - pgs. 91-92; “Yoga,” – pgs. 70-73; “Pooja,” – pgs. 66-67; “Shanthimalai,” – pgs. 55-56; “Nandita,” - pgs. 112-113; “Kamini,” - pgs. 116-117; “Namaste,” - pgs. 125-126; “Agarbathi,” - pgs. 27-28; “Spirualsky,” – pgs. 30-31; “Tibetan,” - pgs. 45-47; “Triloka,” - pgs. 146-147; “OM,” pgs. 42-43; “Inscents,” pgs. 121-123) and well as the fragrance or scent of candles (See office actions dated March 3, 2014, at pages 14-15, 29, 31), aromatherapy and perfume oils (See office actions dated October 19, 2012, at page 7; June 10, 2013, at pages 10, 12; March 3, 2014, at page 16; November 24, 2014, at pages 32, 34 and 37), body oils and lotions (See office actions dated October 19, 2012, at page 7; June 10, 2013, at pages 10, 12; November 24, 2014, at pages 28, 30), and other scented products (See office actions dated October 19, 2012, at page 7; June 10, 2013, at page 12). This evidence clearly shows that the applicant’s use of the proposed mark is not substantially exclusive as required for a claim of acquired distinctiveness under Section 2(f). See TMEP § 1212.05(b).

Applicant acknowledged that the “examiner provided evidence of occasional third party use” and stated that it had “taken numerous steps to address and stop such third party activity, including sending demand letters to parties filing applications to register marks containing the Mark,...”. Applicant also claimed that the third party use does not precede that of applicant. See Request for Reconsideration dated December 12, 2013. While this may all be true, the record is replete with numerous examples of independent third-party use of the proposed mark for similar goods. The evidence shows that independent third-party use is in fact substantial and not just “occasional”. The existence of numerous

third party users of the mark, even if junior to the applicant's use, has a material impact on the Applicant's claim distinctiveness. See *Flowers Indus. Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580, 1588-89 (TTAB 1987) Therefore, under such circumstances, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking.

In summation, the evidence in this case demonstrates that "Nag Champa" is highly descriptive of a feature and/or characteristic of the incense goods identified. Furthermore, the applicant's evidence of record is wholly insufficient to show that "Nag Champa" has acquired distinctiveness. 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); TMEP §1212.01. An applicant must establish that the purchasing public has come to view the proposed mark as an indicator of origin. Here Applicant has submitted scant evidence in support of its acquired distinctiveness claim and has not presented any evidence to refute to showing of non-exclusivity of the use of the "Nag Champa" for incense.

CONCLUSION

For the reasons set forth above, the refusal of the proposed mark as being merely descriptive of a feature and/or characteristic of the incense goods and refusal as to the sufficiency of the acquired distinctiveness claim for "NAG CHAMPA" should be affirmed.

Respectfully submitted,

/JSD/

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