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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Physician Endorsed, LLC

Serial Nos. 78975107 and 78976952

Timothy D. Pecsénye, David M. Perry, Alison P. Grossman and Jennifer L. Miller of Blank Rome for applicant.

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Before Quinn, Hairston and Holtzman, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Applications were filed by Physician Endorsed, LLC to register the mark PHYSICIAN ENDORSED for "sunglasses" (in International Class 9) and "hats and caps" (in International Class 25).¹

¹ Applicant originally filed application Serial No. 78138870 on June 26, 2002, based on an allegation of a bona fide intention to use the mark in commerce. The application originally included goods in Classes 3, 9, 18 and 25. Pursuant to applicant's request, Classes 9 and 25 were divided out from the "parent" application into "child" application Serial No. 78975107. Pursuant to another request to divide filed by applicant, application Serial No. 78975107 was divided as follows: the Class 9 goods remained in application Serial No. 78975107 and the Class 25 goods were placed into "child" application Serial No.

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The trademark examining attorney refused registration in each application under Section 2(e)(1) of the Trademark Act on the ground that applicant's mark, if used in connection with applicant's goods, would be merely descriptive of them.

When the refusals were made final, applicant appealed. Applicant and the examining attorney filed briefs.²

The appeals involve common issues of law and fact. Accordingly, we will decide the appeals in a single opinion.

At the outset, it should be noted that the Board, in a final decision dated January 3, 2006, affirmed the same Section 2(e)(1) mere descriptiveness refusal in applicant's co-pending original "parent" application Serial No. 78138870. Applicant neither filed a request for reconsideration nor an appeal of the Board's earlier decision. In the earlier application, applicant sought registration of the mark PHYSICIAN ENDORSED for "non-medicated skin care preparations" (in International Class 3) and "duffel bags and travel bags" (in International Class 18). The Board concluded that PHYSICIAN ENDORSED

78976952. As was the case with the original "parent" application, the present applications are based on an allegation of a bona fide intention to use the mark in commerce.

² Pursuant to applicant's request, applicant's late briefs are accepted. Further, although applicant requested an oral hearing, the request subsequently was withdrawn.

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immediately describes, without conjecture or speculation, a significant characteristic or feature of applicant's skin care preparations and duffel and travel bags, namely, that the goods are recommended, approved or endorsed by physicians. At the time of the Board's earlier decision, the present "parent" application was under a final refusal. The applications involved herein, which were not divided until the briefing stage, are essentially identical to the original "parent" application in terms of the evidentiary record and arguments.

Applicant contends that its mark is only suggestive, and that the examining attorney has engaged in "mental leaps" and "syllogistic approximations" in finding the mark to be merely descriptive. (Brief, p. 10). Applicant states that its mark suggests "the goods are used in connection with a healthy lifestyle and are beneficial to consumers" (Brief, p. 12), and that the mark was chosen to convey "applicant's heightened level of attention to consumer health, as well as the consumer's healthy lifestyle." (Brief, p. 14). Further, according to applicant, it is unusual for physicians to endorse the types of goods marketed by applicant. In urging that the refusal be reversed, applicant submitted copies of third-party registrations of marks that, applicant claims, are

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similar to applicant's marks showing that "applicant's mark is a registrable addition to this group of suggestive marks." (Brief, p. 16).

The examining attorney maintains that applicant's mark is merely descriptive, pointing to the fact that applicant's products are approved or endorsed by a medical advisory board comprising physicians. In support of the refusal, the examining attorney relied upon dictionary definitions of the terms "physician" and "endorse," as well as excerpts from applicant's website on the Internet and an article about applicant retrieved via a link on this website.

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or

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services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use or intended use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). It is settled that:

....the question of whether a mark is merely descriptive must be determined not in the abstract, that is, not by asking whether one can guess, from the mark itself, considered in a vacuum, what the goods or services are, but rather in relation to the goods or services for which registration is sought, that is, by asking whether, when the mark is seen on the goods or services, it immediately conveys information about their nature.

In re Patent & Trademark Services Inc., 49 USPQ2d 1537, 1539 (TTAB 1998).

The term "physician" means "a person licensed to practice medicine; a medical doctor," and the term "endorse" is defined as "to give approval of or support to,

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especially by public statement; sanction: endorse a political candidate." The American Heritage Dictionary of the English Language (3d ed. 1992).

Although applicant obviously takes issue with the refusal to register, and contrary to the gist of some of its arguments, applicant does not appear to seriously dispute that, in point of fact, physicians recommend applicant's products: "Further, the goods produced and sold by Applicant are accessories that serve the primary purpose of being fashionable, while also being healthful. The fact that *such goods are also recommended by doctors* is secondary in nature and is not necessarily a significant aspect of the goods." (Response, 4/28/03, p. 9) (emphasis added). And, "[t]he fact that the goods might be 'endorsed by a physician' does not represent a 'significant characteristic.' The significant characteristic of the goods would be the actual characteristic for which the physician is endorsing." (Request for reconsideration, 3/17/04, p. 3). Applicant argues, in pertinent part, as follows:

Upon reviewing the mark in connection with the goods, consumers will ask themselves, "what is it that is being endorsed by the physician?" Is it that the products are lightweight? Is it that they provide adequate protection from the sun? Could it be that the

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hats prevent hair loss? Do the glasses block the sun's harmful UVA and UVB rays? The fact that the goods may be endorsed by physicians does not immediately convey a significant characteristic of the goods due to the mental leap that consumers will have to take, namely, the leap to determine what it is that the physician is endorsing. The mental leap requires consumers to begin at the mark, PHYSICIAN ENDORSED; look to Applicant's sunglasses and hats; and then determine the reason that the goods are endorsed by physicians. Such reason, whether it is sun protection, hair protection, or eye protection, is the actual significant and descriptive characteristic of the goods. (Request for Reconsideration, pp. 4-5).

In this connection, applicant contends, "if the mark was 'SUN BLOCK,' 'LIGHT ADJUSTING,' 'CANVAS' or 'HAIR FRIENDLY,' then there would be a strong basis for a descriptiveness refusal." (Request for Reconsideration, p.3).

Applicant's promotional efforts point to the fact that its goods are, in essence, endorsed by physicians who are members of applicant's medical advisory board. Contrary to applicant's arguments regarding suggestiveness, we find that physician endorsement of the goods is a significant characteristic or feature of the goods.

The record includes a product catalog covering applicant's hats, caps and "Nevada Tortoise" sunglasses.

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The cover of the catalog shows applicant's proposed mark PHYSICIAN ENDORSED prominently displayed immediately above the phrase "WEAR WITH CONFIDENCE." Page 2 of the catalog reads, in pertinent part, as follows:

It's no secret that the sun protection industry has blossomed...Physician Endorsed specializes in providing stylish hats and accessories that offer 90 to 99 percent UVA and UVB protection. How do we accomplish this? **First, all our products are endorsed by our medical advisory board, made up of skin care specialists from around the country.** (emphasis added).

An Internet article on applicant indicates that applicant "has a Medical Advisory Board on its roster along with its hat designer." www.focusonstyle.com.

Applicant's own website, www.physicianendorsed.com, states that applicant has a "Medical Advisory Board" and that applicant offers "dermatologist recommended" sunscreen. Applicant, on its website, describes its Medical Advisory Board as follows:

We have established a Medical Advisory Board that includes professionals who are the top experts in their field with diverse specialties.

The mission of [the] Medical Advisory Board is to provide guidance and advice on new and innovative approaches to sun protection products. Their oversight will help ensure our products meet our clients' needs. The board members are committed to advancing sophisticated

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approaches in sun protection and will also play a critical role in increasing public awareness of sun risk to skin.

Applicant then proceeds to list the members of the board; while the examining attorney has provided only one page of this section of the website, the first two listed members are doctors.

Applicant's own press release (dated July 15, 2002), found on its website, is revealing:

Physician Endorsed company founders, Michael Ross, Elissa Margulies and Natalie Redka, took the words "just what the doctor ordered" and turned them literally into a prescription for success.

For years, physicians have warned adults and children alike about the dangerous long-term effects of sun exposure....But does being protected from the sun necessarily mean foregoing style for safety? Physician Endorsed executives say no.

Founded in 2002, this new and innovative company is gaining a reputation among industry insiders for its eye-catching hats and eyewear, packaged conveniently with dermatologist recommended sunscreen lotion.

"All of our products come stamped with a seal of approval from our medical advisory board," says Michael Ross, president of Physician Endorsed. "We want our customers to feel confident that the products we offer are of the highest quality and are made with the consumer's protection in mind."

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According to the Centers for Disease Control and Prevention, skin cancer is the most prevalent form of cancer found in the United States, with one million new cases confirmed each year. Physicians Endorsed created its new lines of hats and sunglasses with this [in] mind. All company products will provide between 90 and 99 percent UVA and UVB protection. Each hat will be made with sun-smart products, ensuring the highest possible coverage. Additionally, dermatologist recommended sunscreen lotion will be included in the packaging and offer PF 15 protection. To ensure consumer satisfaction, Physician Endorsed products are sold only after rigorous testing conducted by nationally recognized laboratories. (emphasis added).

We find that PHYSICIAN ENDORSED, when used in connection with goods that, according to applicant, "come stamped with a seal of approval from our medical advisory board," immediately describes this significant feature of applicant's sunglasses, hats and caps. That is to say, the term PHYSICIAN ENDORSED immediately describes, without conjecture or speculation, a significant characteristic or feature of the goods, namely, that the goods are recommended, approved or endorsed by physicians.

We have considered the third-party Principal Register registrations introduced by applicant. Examples include DOCTOR ENDORSED (Reg. No. 2795710 for retail store services featuring beds, mattresses and box springs); CHEF APPROVED

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(Reg. No. 1658344 for food items); WEATHERMAN APPROVED (Reg. No. 2801862 for wearing apparel); and PHYSICIAN DEVELOPED.PEOPLE APPROVED (Reg. No. 2629339 for nutritional supplements). To counter this evidence, the examining attorney relied upon one third-party registration of the mark PHYSICIAN APPROVED (Reg. No. 2503200 for nutritional supplements) issued on the Supplemental Register.

The third-party registrations submitted by applicant do not compel a different result herein. In *re* Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the board or this court."]. We recognize that the competing registration evidence submitted by applicant and the examining attorney shows the Office's somewhat inconsistent treatment of marks like the one involved in the present application. However, while uniform treatment under the Trademark Act is an administrative goal, our task in this appeal is to determine, based on the record before us, whether applicant's particular mark sought to be registered is merely descriptive. In *re* Stenographic Machines, Inc., 199 USPQ 313, 317 (Comm'r Pats. 1978) ["Consistency of Office practice must be secondary to

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correctness of Office practice."]. As is often stated, each case must be decided on its own merits. In re Best Software Inc., 58 USPQ2d 1314 (TTAB 2001).

We conclude that applicant's applied-for mark, when used in connection with applicant's sunglasses, hats and caps, is merely descriptive thereof.

Decision: The refusal to register in each application is affirmed.