ESTTA Tracking number: **ESTTA479980**
Filing date: **06/25/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85008626
Applicant	G. Pohl-Boskamp GmbH & Co. KG
Correspondence Address	PHI LAN M TINSLEY K&L GATES LLP 1 LINCOLN STREET BOSTON, MA 02111-2901 UNITED STATES tmboston@klgates.com, philan.tinsley@klgates.com
Submission	Appeal Brief
Attachments	Appeal_Brief_-_SCENT.pdf (8 pages)(29464 bytes)
Filer's Name	Emily Cunningham Tseng
Filer's e-mail	tmboston@klgates.com, pitrademarks@klgates.com, emily.tseng@klgates.com
Signature	/emily cunningham tseng/
Date	06/25/2012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

APPLICANT: G. Pohl-Boskamp GmbH & Co. KG
SERIAL NO.: 85/008,626
FILED: April 7, 2010
MARK: Scent of Peppermint In Connection With Nitroglycerin
EXAMINING ATTORNEY: Michael Keating
LAW OFFICE: 101

APPLICANT'S APPEAL BRIEF IN SUPPORT OF REGISTRATION

Applicant hereby appeals from the Examining Attorney's final refusal of October 4, 2011 to register the above-identified mark and respectfully requests that the Trademark Trial and Appeal Board reverse the Examining Attorney's decision.

I. APPLICANT'S MARK

Applicant has filed this application to register on the Principal Register its mark Scent of Peppermint in Connection with Nitroglycerin, as used with "Medicines, namely, pharmaceutical formulations of nitroglycerin" in Class 5. The application was filed on April 7, 2010 based on actual use in commerce in connection with the identified goods. Applicant's mark was first used anywhere at least as early the year 1924, and the mark was first used in commerce at least as early as November 19, 1989.

II. PROSECUTION AND FINAL REJECTION

In an initial Office Action, dated July 14, 2010, the Examining Attorney refused registration under Trademark Act Sections 2(e)(5) and 1, 2, and 45 on the grounds that the proposed mark (i) was a functional feature of the goods, (ii) that the specimen did not show use of the mark, and (iii) that the mark failed to function as a trademark to identify and distinguish Applicant's goods from those of others and to indicate the source of Applicant's goods.

Applicant responded to this initial Office Action with a Response dated January 14, 2011. In this Response, Applicant submitted arguments that the mark is not functional and functions as a trademark because it has acquired distinctiveness under Section 2(f) of the Trademark Act. Applicant requested that the application be amended to include a claim under 2(f). With its Response, Applicant submitted (among other evidence illustrating secondary meaning) a number of declarations in support of its 2(f) claim, including declarations of (i) the Chief Executive Officer of G. Pohl-Boskamp GmbH & Co. KG, (ii) Shionogi Pharma, Inc. (Applicant's U.S. distributor), and (iii) medical and healthcare professionals. In the absence of non-bulky alternatives, on January 24, 2011 and again on March 4, 2011, Applicant also directly sent the Examining Attorney a substitute specimen consisting of a placebo version of Applicant's pumpspray product bearing the mark.

On March 11, 2011, the Examining Attorney issued a second Office Action, withdrawing both the functionality refusal under Section 2(e)(5) of the Trademark Act and the specimen objection under Sections 1 and 45, but maintaining the refusal under Sections 1, 2 and 45, asserting that Applicant's evidence was insufficient to prove that the mark had acquired distinctiveness and functions as a trademark. Applicant, on September 12, 2011, submitted a second Response to Office Action, submitting additional arguments and evidence of the acquired distinctiveness of Applicant's mark.

On October 4, 2011, the Examining Attorney issued a third Office Action, making final the prior refusal under Sections 1, 2 and 45. On April 4, 2012, Applicant submitted a Request

for Reconsideration (denied by the Examining Attorney on April 23, 2012) and a simultaneous Notice of Appeal, appealing the Examiner's final action.

III. ISSUE ON APPEAL

The issue on appeal is whether Applicant's mark functions as a trademark when used in connection with the identified goods in order to distinguish Applicant's goods from those of others and to indicate the source of Applicant's goods.

IV. ARGUMENT

1. The Record Shows That the Designation Scent of Peppermint in Connection with Nitroglycerin is Associated Exclusively with Applicant's goods, Based on Applicant's Continuous and Substantially Exclusive Use for Over 22 Years, Extensive Promotional Activities, and Substantial Revenue and Sales Figures

On more than one occasion, the Trademark Trial and Appeal Board and the United States Patent & Trademark Office have recognized that sensory marks like Applicant's are capable of serving as source indicators. See In re Clarke, 17 U.S.P.Q. 1238, 1240 (T.T.A.B. 1990) (holding plumeria scent for sewing thread registrable); In re N.V. Organon, 79 U.S.P.Q.2d 1639, 2006 WL 1723556 (2006) (scent may be registrable upon adequate showing of acquired distinctiveness); see also U.S. Reg. No. 2,463,044 (cherry scent for synthetic lubricants). A mark is capable of functioning as a source indicator where it has acquired distinctiveness under Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f); TMEP §1202.13 (scent, if non-functional, may be registrable under Section 2(f)). Factors to be considered in determining whether Applicant's scent mark has acquired distinctiveness, and is therefore entitled to registration, include: (i) the length and manner of use of the mark by the applicant; (ii) the nature and extent

of advertising and promotion of the mark; and (iii) efforts made to promote a conscious connection, in the consumer's mind, between the mark and a particular product or service. Pebble Beach Co. v. Tour 18 I Ltd., 942 F. Supp. 1513, 1538 (S.D. Tex. 1996) (citing Boston Beer Co. v. Slesar Bros. Brewing Co., 9 F.3d 175, 181 (1st Cir. 1993)). Acquired distinctiveness may be inferred by circumstantial evidence, such as use of the mark for a number of years, significant revenue figures and extensive advertising. See In Re Ennco Display Systems, Inc., 56 U.S.P.Q.2d 1279, 1283 (T.T.A.B. 2000); Florida Breckenridge Inc. v. Solvay Pharmaceuticals Inc., 43 U.S.P.Q.2d 1878 (S.D. Fla. 1997) (finding pharmaceutical manufacturer established substantial likelihood of success on merits of claim that trade dress of prescription estrogen-androgen supplement acquired secondary meaning where product had been on market for over 30 years, been sold in present trade dress since 1975, since manufacturer had sold over $220 million worth of product since 1987, and spent over $90 million marketing product).

(a) **Length of Time on the Market**

Applicant's mark Peppermint Scent in Connection with Nitroglycerin has been in continuous use as a mark in commerce for more than twenty (20) years, since 1989. The mark was first used anywhere since at least as early as December 31, 1924. Applicant's use of the mark also has been substantially exclusive. Currently, there is only one other user of a peppermint scent with nitroglycerin pharmaceuticals in the United States, and it is a competitor and late-comer to the market. This competitor's recent use of a peppermint scent is merely indicative of a junior user's attempt to copy Applicant's successful mark and product. In 2011,

Applicant filed suit in the District Court of Massachusetts against this user, alleging, among other things, copyright and trademark infringement, false advertising and unfair competition. The parties subsequently settled. Applicant's substantially exclusive use of the mark for such a significant length of time, when considered in light of the additional factors set forth below, is more than sufficient to weigh in favor of finding that Applicant's mark has acquired distinctiveness.

(b) **Sales Success**

Sales success evidences that a product has acquired distinctiveness, indicating that a product has become popular among consumers and is therefore likely to be recognized as a symbol for the source of the product. See Philip Morris USA Inc. v. Cowboy Cigarette Inc., 70 U.S.P.Q.2d 1092 (S.D.N.Y. 2003). Since 1999, G. Pohl-Boskamp GmbH & Co. KG has sold a total of approximately five (5) million units of the product bearing the mark. See Declaration of Marianne Boskamp ("Boskamp Decl.") at ¶ 18 and Declaration of Ray Russo ("Russo Decl.") at ¶ 17 (submitted with Applicant's January 14, 2011 Response to Office Action). Collectively, Applicant and its distributor have amassed over one hundred (100) million dollars in revenue from sales of the underlying goods. See Boskamp Decl. at ¶ 17 and Russo Decl. at ¶ 16 (submitted with January 14, 2011 Response to Office Action). In addition to the United States, Applicant has offered and sold goods bearing the mark in at least Canada, the United Kingdom, the Benelux region, Germany, Austria, Australia and New Zealand. Until recently, Applicant had 100% market share of the nitroglycerin sublingual pharmaceutical market in the United States. Currently, Applicant has a 97% share of the U.S. market. Such success indicates that

Applicant's promotional efforts have been highly successful. It supports a finding of acquired distinctiveness because it indicates that consumers are likely to recognize the Scent of Peppermint in Connection with Nitroglycerin as a symbol for the nitroglycerin pharmaceuticals provided by Applicant.

(c) **Advertising and Promotional Efforts**

Extensive advertising can create conditions conducive to the birth of secondary meaning. See, e.g., Faberge, Inc. v. Saxony Products, Inc., 605 F.2d 426, 428, 204 U.S.P.Q. 359, 360-361 (9th Cir. 1979). Since 1999, Applicant and its distributor have spent in excess of seventy-five (75) million dollars in advertising and marketing expenditures in connection with the mark and product. See Boskamp Decl. at ¶ 16 and Russo Decl. at ¶ 15 (submitted with January 14, 2011 Response to Office Action). Every product box indicates that the goods include peppermint. Applicant's website at <nitrolingual.com> also notes on every page that the Peppermint Scent of the goods is a trademark of Applicant. Since at least as early as 2004, Applicant has operated a website at the <nitrolingual.com> domain. The website is an important resource for consumers. In the past year, the website has had nearly 51,000 page views and nearly 33,000 visits. Close to 90% of these visits have been new (versus repeat) visits. Highly trained sales representatives also regularly visit doctors' offices, hospitals, pharmacies and trade conventions to promote the mark.

The goods underlying Applicant's mark have been the subject of YouTube videos that have received thousands of hits. The goods also have been featured on the hit TV series, ER, which had approximately 22 million viewers in the applicable season. Numerous medical

journals and websites have featured Applicant's product. Taken in conjunction with Applicant's significant sales figures, Applicant's large scale advertising expenditures and promotional efforts strongly create the inference of secondary meaning.

(d) **Third Party Recognition**

Applicant also has presented *actual* evidence of acquired distinctiveness in the form of trade declarations. Recognition of trade dress by physicians and pharmacists has been held to be "*highly persuasive*" evidence of secondary meaning. See Boehringer Ingelheim G.m.b.H. et al. v. Pharmadyne Laboratories, Inc. et. al, 211 U.S.P.Q. 1163, 1184 (D.N.J. 1980). Moreover, form format letters are considered competent evidence of secondary meaning. See, e.g., In re Black & Decker Corp., 81 U.S.P.Q.2d 1841 (T.T.A.B. 2006).

Here, because Applicant's goods are by prescription only, physicians and pharmacists are the ones who must recall and recommend the brand, and ultimately are responsible for a consumer's purchase of the goods. Brand recognition by the healthcare professionals is imperative. With its prior Responses to Office Actions, Applicant provided a significant number of declarations of qualified healthcare professionals indicating that they view the mark as a trademark and immediately associate the Scent of Peppermint in Connection with Nitroglycerin with Applicant alone. The individuals making the representations have treated patients for angina pectoris for a number of years, are very familiar with different nitroglycerin pharmaceuticals and regularly prescribe nitroglycerin as a treatment regimen. See Declarations of Physicians, submitted with Applicant's January 14, 2011 Response to Office Action. These

declarations constitute direct evidence of secondary meaning. Applicant has clearly created a favorable and recognizable link between the mark and Applicant.

Due to the Health Insurance Portability and Accountability Act of 1996 (HIPAA), privacy and security laws, Applicant, for the purpose of securing this trademark, does not have access to the names and identities of those using Applicant's product. Accordingly, Applicant is unable to submit end-user consumer declarations.

V. CONCLUSION

Based upon all of the above, it is earnestly submitted that Applicant's trademark Scent of Peppermint in Connection with Nitroglycerin has acquired distinctiveness and functions as a trademark to identify and distinguish Applicant's goods from those of others and to indicate Applicant as the source of the goods. Accordingly, Applicant respectfully requests that the refusal to register Applicant's mark be reversed and that such mark be approved for registration.

Respectfully submitted,

/s/ Emily Cunningham Tseng

Phi Lan M. Tinsley
Emily Cunningham Tseng
K&L Gates LLP
State Street Financial Center
One Lincoln Street
Boston, MA 02111-2950
Tel: 617-261-3100
Fax: 617-261-3175
Attorneys for Applicant

Date: June 25, 2012