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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 85008626

MARK:



CORRESPONDENT ADDRESS:

PHI LAN M TINSLEY
K&L GATES LLP
STATE STREET FINANCIAL CENTER ONE LINCOLN STREET
BOSTON, MA 02111-2901

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

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APPLICANT: G. Pohl-Boskamp GmbH & Co. KG

CORRESPONDENT'S REFERENCE/DOCKET NO:

GPB-615

CORRESPONDENT E-MAIL ADDRESS:

tmboston@klgates.com

EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant has appealed the Examining Attorney's refusal to register the proposed mark, the scent of peppermint, for use in connection with "medicines, namely, pharmaceutical formulations of nitroglycerin." Registration was refused under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051-1052, 1127, on the grounds that the applied-for mark does not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate the source of applicant's goods. It is respectfully requested that the refusal to register be affirmed.

FACTS

On April 7, 2010, the applicant, G. Pohl-Boskamp GmbH & Co. KG, applied to register the scent of peppermint for use in connection with "medicines, namely, pharmaceutical formulations of nitroglycerin."

On July 14, 2010, the examining attorney issued an Office Action refusing registration under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. Sections 1051-1052, and 1127, on the grounds that the mark does not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate the source of applicant's goods, and Sections 1 and 45 of the Trademark Act, 15 U.S.C. Sections 1051 and 1127, on the grounds that the specimen did not show use of the mark in commerce.

On January 14, 2011, the applicant filed a response amending the application to seek registration under Section 2(f) of the Trademark Act, 15 U.S.C. Section 1052(f), on the grounds that the applied-for mark has acquired distinctiveness. Applicant also provided a substitute specimen identified as a placebo version of the nitroglycerin formulation (and subsequently sent another sample directly to the examining attorney) bearing the scent sought to be registered.

On March 11, 2011, the examining attorney maintained the refusals under Sections 1, 2 and 45 of the Trademark Act, but withdrew the specimen refusal under Sections 1 and 45 in light of the substitute specimen. After applicant responded and presented additional arguments in support of registration, the examining attorney, on October 4, 2011, issued a final refusal under Sections 1, 2 and 45 on the grounds that the applied-for mark did not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate the source of applicant's goods.

On April 4, 2012, the applicant filed a Notice of Appeal and a Request for Reconsideration. Because the Request for Reconsideration did not provide any new or compelling evidence with regard to the outstanding issues in the final Office action, the examining attorney denied the Request. On June 25, 2012, the applicant filed its brief, and on June 27, 2012, jurisdiction was restored to the examining attorney for his appeal brief.

ISSUES

The sole issue on appeal is whether the proposed mark, the scent of peppermint, functions as a trademark to identify and distinguish applicant's goods from those of others and to indicate the source of applicant's goods.

ARGUMENT

Registration was refused because the applied-for mark, as used on the specimen of record, does not function as a trademark to identify and distinguish applicant's goods from those of others and to indicate the source of applicant's goods. Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§1051-1052, 1127; *see In re Remington Prods., Inc.*, 3 USPQ2d 1714 (TTAB 1987); TMEP §§904.07(b); 1202 *et seq.*

Not every word, design, symbol or slogan used in the sale or advertising of goods and/or services functions as a mark, even though an individual may have adopted it with the intent to do so. The USPTO will not register a designation unless purchasers would be

likely to regard it as a source-indicator for the goods. *In re Manco, Inc.*, 24 USPQ2d 1938 (TTAB 1992); TMEP §1202. Scent marks may be registrable if the scent is used in a non-functional manner. However, even if the mark is found to be non-functional, the trade dress is not registrable without a showing of acquired distinctiveness as a trademark under Section 2(f) to identify the applicant's goods and distinguish them from others. *In re Owens-Corning Fiberglas Corp.*, 227 USPQ 417 (Fed. Cir. 1985); TMEP §1202.13.

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, and the ultimate test in determining acquired distinctiveness under 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).

It is clear from the record herein that the applicant has not established that the applied-for trade dress has acquired distinctiveness as a trademark to identify applicant's goods and distinguish them from others.

The application indicates that the mark has been in use in commerce since November 1989, and the applicant claims acquired distinctiveness on that basis. However, it is clear that use for 23 years is not sufficient in this instance as applicant has not been using the

applied-for flavor “as a mark.” Further, because the applied-for mark is comprised of matter that is not inherently distinctive because of its nature, actual evidence that the trade dress is perceived as a mark for the relevant goods or services is required to establish distinctiveness. *See generally In re Owens-Corning Fiberglas Corp.*, 227 USPQ 417 (Fed. Cir. 1985) (color pink as uniformly applied to applicant’s fibrous glass residential insulation); *Nextel Commc’ns, Inc. v. Motorola, Inc.*, 91 USPQ2d 1393, 1401 (TTAB 2009) (noting that “the evidence required is in proportion to the degree of nondistinctiveness of the mark at issue” in relation to a sound mark emitted by cellular telephones in their normal course of operation); TMEP §1212.05(a). Moreover, the amount of evidence required to establish that a scent or fragrance functions as a mark is substantial. *See, e.g., In re Owens-Corning Fiberglas Corp.*, 227 USPQ 417 (Fed. Cir. 1985); TMEP §1202.13. The record does not demonstrate this required showing.

Applicant also claims that its use is substantially exclusive. However, even assuming that applicant is the only source of peppermint-scented nitroglycerin (which is not the case as demonstrated by the record herein), use alone does not automatically represent trademark recognition and acquired distinctiveness. *See, e.g., J. Kohnstam, Ltd. v. Louis Marx & Co.*, 280 F.2d 437, 440, 126 USPQ 362, 364 (C.C.P.A. 1960); *In re G. D. Searle & Co.*, 143 USPQ 220, 223 (TTAB 1964), *aff’d*, 360 F.2d 650, 149 USPQ 619 (C.C.P.A. 1966); TMEP §1212.06(e)(i).

The applicant has provided advertising and sales figures relating to the pharmaceutical formulation that is marketed and sold under its Nitrolingual® mark. Applicant states that “Applicant and its licensees (i) have spent over 75 million dollars in advertising and

promoting the product and Mark in the past ten plus years (ii) amassed at least 100 million dollars in revenue from sales of the underlying goods, and (iii) have sold approximately five million units of product bearing the Mark.” Applicant’s Response of September 12, 2011. Applicant’s assertion is that such figures clearly demonstrate sales success and therefore trademark recognition. The record herein, however, does not demonstrate such recognition. Applicant does not dispute that its sales and advertising figures relate to the Nitrolingual® product in general and not the specific trade dress which is the subject of the instant application. Applicant states that its mark is part and parcel of a pharmaceutical product sold to consumers and thus it cannot provide sales and advertising figures that relate solely to the claimed trade dress. Applicant’s Request for Reconsideration of April 4, 2012.

However, the mere statement of sales volume and advertising figures by applicant does not establish distinctiveness because there is no evidence in the record that the figures and expenditures have had any impact whatsoever on a purchaser’s association of the peppermint scent with applicant. *In re Kwik Lok Corp.*, 217 USPQ 1245, 1247-48) (TTAB 1983); *see also Duraco Products Inc. v. Joy Plastic Enterprises Ltd.*, 32 USPQ2d 1724, 1731 (3rd Cir. 1994)(“advertising expenditures ‘measured primarily with regard to those advertisements which highlight the supposedly distinctive, identifying feature’ of the product configuration”). There is no evidence that the applicant has spent any money advertising or promoting the fact that the goods have a scent, that the scent is created by adding a particular ingredient, or that other sublingual formulations of nitroglycerin do not have the same scent. Likewise, there is no evidence that a particular number of units of Nitrolingual® have been sold because the scent is so unique and distinctive that

customers would recognize it and prefer applicant's goods over other formulations because of that scent, or that consumers would recognize a particular scent as identifying applicant as the source. Rather, the applicant would have the Board simply conclude that because it has sold a specified number of units of nitroglycerin and advertised the word mark under which it is sold that the scent component must necessarily be recognized as a mark. The sales and advertising figures provided by applicant simply do not support this leap of logic, and if applicant itself cannot determine the effectiveness of its advertising and sales figures as they relate specifically to the applied-for scent, it is clear that an ordinary consumer with no trademark knowledge or experience cannot determine it either. Thus, because the figures do not relate to the claimed trade dress at all, but to an entirely different trademark, the probative value of said figures is virtually nil, and applicant has not satisfied its burden of establishing that the peppermint scent functions as a trademark.

Similarly, the advertising material of record provided by applicant uniformly points to its nitroglycerin formulation sold under the Nitrolingual® word mark, and promotes the efficacy of the named product, its purposes, and methods of use. That same advertising material, however, does not promote the applied-for peppermint scent as a trademark. There is simply no evidence in the record that applicant promotes or advertises the scent of the goods as a trademark. The advertisements do not promote the applicant's goods as being different from other formulations because of the scent, what makes the scent distinctive, what makes the goods superior to similar goods of others because of that scent, or even that the goods have any scent at all. The record is devoid of any "look for" advertisements or other materials designed to create consumer association between the

applied-for peppermint scent and the goods for which registration is sought, much less establish that an association has successfully been made. Therefore, applicant's advertising materials have very little, if any, probative value. *See, e.g., Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1723-1724 (TTAB 2010); *In re Chevron Intellectual Property Group LLC*, 96 USPQ2d 2026, 2031 (TTAB 2010).

In response, applicant asserts that the Internet and each box of Nitrolingual® indicate that the goods contain peppermint oil, but the record does not contain "look for" advertising promoting the scent as a trademark, or asserting that its goods are different than others because of this distinctive scent. Applicant has provided no evidence whatsoever that consumers associate the simple act of adding an ingredient to an odorless pharmaceutical as a trademark for a distinctive scent or, again, indicate that the goods are scented at all such that it is recognized as a source indicator. Applicant's further assertion that the mark has acquired distinctiveness because its own advertising materials state that it is claiming the scent as a trademark is also clearly insufficient to constitute "look for" advertising. *Mag Instrument Inc. v. Brinkmann Corp.*, *supra*, at 1723-1724, n. 26; *see also In re Remington Prods., Inc.*, 3 USPQ2d 1714 (TTAB 1987). Again, applicant would have the Board believe that consumers would recognize the scent as a separate trademark just because it is advertising a particular word mark. The evidence in the record clearly does not establish that any such recognition or association has occurred, and the burden is on applicant to demonstrate same by evidence, not by mere speculation, conjecture or a leap of faith. Therefore, applicant's claim of distinctiveness must fail.

In addition, it is clear from the record herein that medicines are commonly scented, including numerous formulations of nitroglycerin designed to relieve symptoms of angina. For example, the record clearly indicates that vasodilators similar to applicant's Nitrolingual® formulation commonly contain peppermint oil and thus possess a peppermint scent. Such medications include Mylan-Nitro, Procardia®, Suscard, and Rho-Nitro. Further, the nitroglycerin formulation Nitromist® is sold in the United States, is a direct competitor of applicant, and contains peppermint oil as an ingredient, as is the case with the other competing nitroglycerin formulations listed above. Applicant dismisses such use and states that it believes the owner of Nitromist® infringed its mark, has sued them in Federal court on that basis, and has settled with them. It is beyond question that any such infringement proceeding, any allegations made therein, and any alleged settlement between those parties is not relevant in this *ex parte* proceeding to determine registrability. *In re Dana Corporation*, 12 USPQ2d 1748, 1750 (TTAB 1989) (settlement agreement shows only that parties did not want to risk litigation, and does nothing to enhance registrability).

Further, applicant's allegations of intentional copying of a product design by a third-party is not probative of acquired distinctiveness. "Where the proposed mark is a product design, the copier may be attempting to exploit a desirable product feature, rather than seeking to confuse customers as to the source of the product." *In re Van Valkenburgh*, 97 USPQ2d 1757, 1768 (TTAB 2011); TMEP §1212.06(e)(i). Certainly, because the evidence of record conclusively demonstrates that many formulations of nitroglycerin contain peppermint oil, other users obviously wish to and do include this ingredient for a particular reason. Thus, the fact that multiple entities commonly use peppermint oil to

provide a peppermint scent to nitroglycerin renders it less likely that applicant's trade dress would be perceived as a trademark, and more likely that a consumer would perceive the scent merely as a common feature or intrinsic component of the goods.

It is also clear that scent perception is extremely subjective, and consumers may not find applicant's scent to be distinctive in any way. This is compounded by the evidence indicating that other manufacturers commonly use the identical ingredient to impart a scent to their nitroglycerin formulations. The applicant has not specified how it scents its medication or indicated what makes its scent distinctive, and thus applicant essentially seeks registration for all scents of peppermint in nitroglycerin formulations, not just a "unique scent." *In re N.V. Organon*, 79 USPQ2d 1639, 1650 (TTAB 2006). This in effect grants applicant a monopoly on all scents of peppermint used to scent medicines, and because other entities clearly use the identical scent for a particular reason, competition is hindered and applicant would have a competitive advantage in the marketplace.

Moreover, because the record shows that it is industry practice to provide flavor and scent to medicines, consumers expect pharmaceuticals to have a scent. The applicant has stated that its nitroglycerin product is sold as a unit and is otherwise odorless, i.e., it is scented during the manufacturing process, and because consumers do not have access to the scent before purchase, they are unable to distinguish applicant's goods from those of others on the basis of smell in making a purchasing decision. Because of this, consumers will conclude that the peppermint scent is merely an intrinsic component of the pharmaceutical product and not a trademark to indicate source. *In re N.V. Organon*,

supra at 1650-1651 (TTAB 2006). This is only compounded by the fact that the scent is not being promoted or advertised by applicant as a trademark.

The applicant also asserts that the applied-for trade dress has acquired distinctiveness based upon letters from health professionals. The record contains two versions of the letter, and each version of the letter is identical. Both versions of the letter state the following in regard to the applied-for trade dress:

“I am very familiar with the peppermint scent of Pohl-Boskamp’s pharmaceutical formulations of nitroglycerin, which is unique compared to other pharmaceutical formulations of nitroglycerin because currently there are no other formulations of nitroglycerin on the market that have a peppermint scent, and other formulations of nitroglycerin currently are odorless. When I encounter the scent of peppermint in connection with pharmaceutical formulations of nitroglycerin, I associate the scent with Nitrolingual® Pumpspray, and no one else.”

It does not appear that the letters were prepared in the signer's own words. Rather, it appears that the letters were not spontaneous statements, but rather form letters dictated by a third-party and then provided to the signatory for their signature. None of the letters provide information as to the qualifications of the individuals making the statements, their exposure to other medicines that may have the same effect, or how often they prescribe or have filled the relevant prescriptions. Each letter does nothing more than offer a vague and general statement regarding the source of the goods with little or no basis for this conclusion. *In re Lorillard Licensing Co.*, 99 USPQ2d 1312, 1320 (TTAB 2011). The probative value of these form letters is very low at best, especially considering that the vague and general statement is contradicted by the record. Most importantly, none of the individuals submitting the letters are identified as an end user, i.e., the individuals who would actually use and therefore smell the product and would actually be the one to associate the scent of the pharmaceutical with the provider of the

goods. *Mag Instrument Inc. v. Brinkmann Corp.*, *supra*, at 1723. Letters from retailers are not sufficient to establish distinctiveness, as “[i]t is well settled that the assertions of retailers, who know full well from whom they are buying, that they themselves recognize a particular designation as a trademark...cannot serve to establish that members of the purchasing public, who come to the marketplace without such specialized knowledge, would in fact recognize the designation as an indication of origin.” *In re Semel*, 189 USPQ 285, 288 (TTAB 1975).

The health provider form letters do not in any way indicate that the relevant consumer, i.e., the end purchaser, ascribes any trademark significance at all to the peppermint scent of the product or has been successfully educated to view the scent as a trademark such that it distinguishes applicant’s goods from others. The applicant asserts that it did not provide end user information as it does not possess it and cannot obtain it due to Federal privacy and security laws. Such information, however, could likely have been obtained and provided in a sanitized manner, with names and identities redacted. Because applicant has not provided relevant and probative end user declarations, the letters in the record have little persuasive value and do not demonstrate ultimate customer recognition of the scent as a trademark.

The amount of evidence required to establish that a scent functions as a mark is substantial, and the record does not contain sufficient evidence to establish that the peppermint scent has acquired distinctiveness as a trademark to identify the goods and distinguish them from others. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985); TMEP §1202.13. Applicant may be marketing and selling

its Nitrolingual® product, but the mere fact that the word mark represents a trademark and has been in use does not establish that consumers have concluded that the scent of such goods represents a separate trademark and that there is an immediate association with applicant as an indicator of source. Simply put, applicant has provided no evidence that its scent is distinctive, that the addition of peppermint oil creates this supposedly distinctive scent, that it has successfully educated consumers so as to create an association between the scent of the goods and the applicant, or that it is promoting the scent as a trademark. The burden is on applicant to provide evidence establishing that the peppermint scent itself has acquired distinctiveness so as to indicate source, and that burden has clearly not been met.

CONCLUSION

The facts and record of this case clearly demonstrate that the applicant has not provided sufficient evidence to establish that consumers have been successfully educated such to associate the scent of the goods with applicant so as to function as a trademark to identify applicant's goods and to distinguish them from those of others. The burden is on applicant to provide sufficient evidence to demonstrate consumer recognition of the scent as a trademark, and that burden has not been met.

For all the foregoing reasons, the refusal to register the mark under Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. Sections 1051-1052, 1127, should be affirmed.

Respectfully submitted,

/Michael P. Keating/
Trademark Attorney
Law Office 101
571-272-9177
Michael.Keating@uspto.gov (informal
inquiries only)

Ronald R. Sussman
Managing Attorney
Law Office 101