

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Oral Hearing:
September 18, 2013

Mailed:
November 13, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Midwestern Pet Foods, Inc.

Serial No. 85128946

Timothy D. Pecsénye and Megan E. Spitz of Blank Rome LLP for Midwestern Pet Foods, Inc.

Esther Borsuk, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).¹

Before Kuhlke, Lykos and Shaw, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Midwestern Pet Foods, Inc. (applicant) filed this application to register on the Principal Register the mark EARTHBORED HOLISTIC in standard characters for goods identified as “cat food” in International Class 31.²

The examining attorney refused registration pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. § 1056(a), based on applicant’s failure to comply with the requirement to disclaim the word “HOLISTIC” on the ground that the wording is

¹ James Griffin argued the case at oral hearing on behalf of the Office.

² Application Serial No. 85128946, filed September 14, 2010, alleging a *bona fide* intent to use the mark in commerce pursuant to Section 1(b) of the Trademark Act.

merely descriptive of applicant's goods within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6(a). A "disclaimer" is a statement that applicant does not claim exclusive rights to an unregistrable component of a mark:

[A] disclaimer of a component of a composite mark amounts merely to a statement that, in so far as that particular registration is concerned, no rights are being asserted in the disclaimed component standing alone, but rights are asserted in the composite; and the particular registration represents only such rights as flow from the use of the composite mark.

Sprague Electric Co. v. Erie Resistor Corp., 101 USPQ 486, 486-87 (Comm'r Pats. 1954).

Merely descriptive terms are unregistrable, under Trademark Act Section 2(e)(1) and, therefore, are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is ground for refusal of registration. See *In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395 (Fed. Cir. 2006); *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087 (Fed. Cir. 2005); *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (CCPA 1975); *In re Ginc UK Ltd.*, 90 USPQ2d 1472 (TTAB 2007); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977); and *In re Pendleton Tool Industries, Inc.*, 157 USPQ 114 (TTAB 1968).

The issues presented in this case are whether the examining attorney has met the burden of establishing that the term HOLISTIC as applied to "cat food" is

merely descriptive, and if so, whether applicant's mark, EARTHBORN HOLISTIC, constitutes a unitary expression so as to remove the descriptive significance of that term, or if applicant's prior registration precludes the disclaimer requirement.

Is the term HOLISTIC Merely Descriptive of Cat Food?

A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used. In re Chamber of Commerce of the U.S., 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) quoting In re Bayer Aktiengesellschaft, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007). The determination of whether a mark is merely descriptive must be made in relation to applicant's goods, 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. Id. See also In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) (determination of mere descriptiveness must be made not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services).

The test for determining whether a term is merely descriptive is whether it immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979).

It is not necessary, in order to find a term merely descriptive, that the term describe each feature of the goods or services, only that it describe a single, significant ingredient, quality, characteristic, function, feature, purpose or use of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

In support of her position that the term HOLISTIC is merely descriptive of applicant's "cat food," the examining attorney submitted the following dictionary definitions for the word "holistic":

1) of or relating to holism 2) relating to or concerned with wholes or with complete systems rather than with the analysis of, treatment or, or dissection into parts <holistic medicine attempts to treat both the mind and the body> <holistic ecology views humans and the environment as a single system>³; and

1) based on the idea that you should take care of your whole body and mind, rather than just treating a part of the body that is ill 2) thinking about the whole of something, and not just dealing with particular aspects.⁴

In addition, in her March 30, 2012 Office Action, she submitted copies of excerpts from third-party websites that show the word "holistic" used to describe the pet food as addressing the complete needs of the pet.⁵ A few examples are set forth below:

³ Merriam Webster Dictionary retrieved on August 23, 2011 from www.merriam-webster.com, attached to August 23, 2011 Office Action.

⁴ MacMillan Dictionary retrieved on March 30, 2012 from www.macmillandictionary.com, attached to March 30, 2012 Office Action.

⁵ The search engine results of third-party Internet websites submitted by the examining attorney are of little probative value inasmuch as typically there is insufficient text to show the context within which a term is used. Bayer Aktiengesellschaft, 82 USPQ2d at 1833; TBMP § 1208.03.

Innova ... Holistic health food for your pet;⁶

Holistic Dog Care ... Take loving care of your dog with natural holistic pet care products. We offer holistic products to treat a variety of health conditions ... (offering nutritional supplements and herbal remedies);⁷ and

Blue for Dogs ... All of our healthy and holistic dog foods are made with the finest natural ingredients.⁸

Finally, the examining attorney submitted several use-based third-party registrations for marks that include the word HOLISTIC for pet food or dog food where the term is either disclaimed on the Principal Register, registered on the Principal Register under Section 2(f) based on acquired distinctiveness, or registered on the Supplemental Register. See, e.g., Reg. No. 3805194 for the mark SOLID GOLD HOLISTIQUE BLENDZ, the term “Holistic Blends” disclaimed; Reg. No. 3533637 for the mark HOLISTIC SELECT registered under Section 2(f); Reg. No. 3727602 for the mark ULTRA HOLISTIC NUTRITION, the term “Holistic Nutrition” disclaimed; and Reg. No. 3651149 for the mark HOLISTIC BLEND registered under Section 2(f). In re Finisar Corp., 78 USPQ2d 1618, 1621 (TTAB 2006).

It is the examining attorney’s position that the term HOLISTIC describes a significant feature of the goods. Specifically, the examining attorney argues that “HOLISTIC, in connection with cat food, refers to the fact that the cat food treats the entire body of the cat. In fact, applicant’s own website states that applicant has

⁶ Natura Pet, www.naturapet.com, attached to March 30, 2012 Office Action.

⁷ Only Natural Pet, www.onlynaturalpet.com, attached to March 30, 2012 Office Action.

⁸ Blue Buffalo, <http://bluebuffalo.com>, attached to March 30, 2012 Office Action.

‘developed a natural holistic approach to nutrition with high quality ingredients to nourish the whole cat. Every ingredient is formulated to provide nutrition to every part of your cat’s system naturally.’” Examining Attorney Br. p. 5 quoting Earthborn Holistic, www.earthbornholistic.com, attached to March 30, 2012 Office Action. Thus, she explains that applicant “has clearly used HOLISTIC to describe an essential characteristic of its cat food -- the food treats the entire body of a cat.” Id. The examining attorney points to the evidence of other manufacturer’s use of the term HOLISTIC in connection with pet food and concludes that it “is clearly a word that is used throughout the cat food industry and is necessary to describe cat food in the marketplace [and] [a]pplicant should not be allowed to have a competitive advantage in the rights of this word.” Id.

Applicant argues that it is suggestive rather than merely descriptive in that HOLISTIC “can be said to embody so many of the varied definitions provided by the Examining Attorney ... the word ‘HOLISTIC’ can hardly be said to immediately describe any one significant feature or characteristic of Midwestern’s cat food.” App. Br. p. 15. Rather, applicant asserts that it simply “conveys Midwestern’s ability to provide healthy, healthful foods that aim to keep your whole cat in good shape” and “connotes a sophisticated level of pet food formulation, catered to the needs of a demanding pet owner clientele.” Id.

Based on this record, we find that the examining attorney has demonstrated that HOLISTIC is merely descriptive of a significant feature of applicant’s cat food, namely, that it, in applicant’s words, “nourish[es] the whole cat. Every ingredient is

formulated to provide nutrition to every part of your cat's system naturally.”⁹ No imagination is needed to connect the word HOLISTIC with cat food; it immediately informs the consumer of a significant feature of the cat food, that it nourishes the whole cat. While the term may be more widely used in connection with health care related goods or services, the examples in the record of third-party uses in the pet food industry confirm that this term is also used in this industry to describe a significant feature of pet food, including cat food. Applicant's reference to one third-party registration for pet food where the mark includes the word HOLISTIC without a disclaimer, is not sufficient to rebut the examining attorney's showing of mere descriptiveness.¹⁰

Is the Mark EARTHBOEN HOLISTIC unitary?

Applicant argues that a disclaimer is inappropriate here because 1) its mark is unitary and 2) it owns a prior valid and subsisting incontestable registration for the mark EARTHBOEN HOLISTIC in typed form for “dog food” in International 31.¹¹ We address each argument in turn.

⁹ Printout of applicant's website www.earthbornholisticpetfood.com, attached to March 30, 2012 Office Action.

¹⁰ See Reg. No. 2598131 for the design and word mark HOLISTIC DOG for pet food with the word DOG disclaimed, attached to June 24, 2011 Response. We further note that this registration was cancelled on March 1, 2013 under Section 8 and, as such, is of limited probative value. *Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1653 n.6 (TTAB 2002).

¹¹ Reg. No. 3202464, issued on January 23, 2007, Sections 8 and 15 combined declaration accepted and acknowledged.

Whether or not a mark is unitary is a factual determination. In *re Slokevage* 78 USPQ2d at 1397. As explained in *Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991):

A unitary mark has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent elements. In other words, a unitary mark must create a single and distinct commercial impression.

Ultimately, the “test for unitariness requires the Board to determine ‘how the average purchaser would encounter the mark under normal marketing of such goods and also ... what the reaction of the average purchaser would be to this display of the mark.’” *Dena Corp.*, 21 USPQ2d at 1052 quoting *In re Magic Muffler Serv.*, 184 USPQ 125, 126 (TTAB 1974).

A mark may be unitary where it is: 1) a compound word mark comprised of an unregistrable component and a registrable component combined into a single word; 2) a telescoped mark comprised of two or more words that share letters; 3) a compound word comprised of an unregistrable component and a registrable component formed with a hyphen or other punctuation; 4) a unitary phrase such that “the whole is something more than the sum of its parts” (*Dena Corp.*, 21 USPQ2d at 1052); 5) a slogan that is not itself merely descriptive; 6) a double entendre; 7) composed of sound patterns such as alliteration and rhyming; 8) incongruous; or 9) composed of words and design that form a unitary whole.

Applicant argues that is mark is unitary because:

The coined term “EARTHBOURN” (meaning a part of the earth) has nothing to do with and is incompatible with the term “HOLISTIC” (meaning concerned with wholes rather than parts). A particular food is not normally described as being “EARTHBOURN” and “HOLISTIC” at the same time, in other words a food cannot be part of something and also be the whole of itself. By their very natures the two terms are incongruous or opposites that cancel one another out. In fact, Applicant chose the mark EARTHBOURN HOLISTIC because the terms “EARTHBOURN” and “HOLISTIC” are new age sounding terms suggestive of a new age lifestyle that are in fact linguistic opposites. Cat food cannot be concerned only with the whole and then also be part of the earth. The trademark significance of EARTHBOURN HOLISTIC is not the individual meanings of the terms but their suggestive and incongruous commercial impressions. As an incongruity, EARTHBOURN HOLISTIC is a unitary whole from which no component need or should be disclaimed ...¹²

Applicant relies on the case *In re J.R. Carlson Labs, Inc.*, 183 USPQ 509 (TTAB 1974) wherein the requirement to disclaim the letter “E” in the mark E GEM for bath oil was reversed. In that case, in reversing the requirement, the Board found that the mark was a compound mark and noted that “registration of a compound mark is merely recognition of rights in the mark as a whole and does not create or recognize any proprietary rights in the components apart from each other.” *Id.* at 511. As explained in the Trademark Manual of Examining Procedure, a “compound word mark is comprised of two or more distinct words (or words and syllables) that are represented as one word (e.g., BOOKCHOICE, PROSHOT,

¹² App. Br. p. 9. In support of its argument in its request for reconsideration, applicant referenced several third-party registrations for marks applicant asserts are “syntactically awkward combinations of adjectives that form unitary marks due to their incongruous structures.” We first point out that a listing of registrations is not sufficient to make the registrations of record. See *In re Hoefflin*, 97 USPQ2d 1174, 1177 (TTAB 2010). Further, out of six examples only two contain just two words. Finally, it is well-established that we must make our determination on the record before us and allowance of other marks (e.g., SHINY BRITE, SMART FAST or SAFE SIMPLE SMART) has little to no bearing on our determination here. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

MAXIMACHINE, and PULSAIR) or “is formed by hyphenating two words or terms, one of which would be unregistrable alone.” TMEP §§ 1213.05(a) and 1213.05(a)(ii). Based on these guidelines, we find that the mark EARTHBORN HOLISTIC is not a compound mark.¹³

“[I]f the elements are so merged together that they cannot be regarded as separable elements, the mark is a single unitary mark and not a composite mark and no disclaimer is necessary.” In re EBS Data Processing, Inc., 212 USPQ 964, 966 (TTAB 1981). See also TMEP § 1213.05. Here, the words EARTHBORN and HOLISTIC are not “so merged together” such that they are not perceived as separable elements. We find that the individual words do not “cancel one another out.” The words EARTHBORN (“of earthly origin”) and HOLISTIC (focusing on the interdependence of the diverse parts within the total entity) each retain their separate but congruent meanings. Thus, the mark does not present an incongruity such that the merely descriptive meaning of HOLISTIC is lost or eclipsed by some combined meaning or double entendre.

Finally, applicant relies on its prior registration (Reg. No. 3202464) for the mark EARTHBORN HOLISTIC in typed form for dog food which does not include a disclaimer for the word HOLISTIC and is over five years old. Applicant argues that the unitariness of its mark was already recognized in its prior registration and the need for consistency weighs in favor of allowing registration absent a disclaimer.

¹³ We further note that although the decision in *J.R. Carlson* references the applied-for mark as E GEM, the mark depicted on what appears to be the ultimately issued registration contains a hyphen and is clearly a traditional compound mark E-GEM. See Reg. No. 1018587, filed on February 16, 1973, issued on August 19, 1975 and cancelled on January 12, 1982 under Section 8.

In support of its argument, applicant relies on *In re The American Sail Training Association*, 230 USPQ 879 (TTAB 1986) wherein the Board reversed the disclaimer requirement for TALL SHIPS in the mark RETURN OF THE TALL SHIPS for “organizing, arranging and sponsoring sailing races” in view of the incontestable prior registration for the mark TALL SHIPS for “organizing, arranging and sponsoring sailing races.” Applicant argues that while the goods in this case are not identical, “they could not be more similar without being identical” and, therefore, similar to TALL SHIPS, the disclaimer requirement should be withdrawn. App. Br. p. 18.

It is settled that a “registered mark is incontestable only in the form registered and for the goods or services claimed.” *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1779, 1782 (Fed. Cir. 2001). In recent decisions, the Board has required identical goods in order to apply the TALL SHIPS doctrine. For example in *In re Best Software Inc.*, 63 USPQ2d 1109 (TTAB 2002), the Board affirmed the disclaimer requirement for the word BEST in the mark BEST! IMPERATIV HRMS for “computer software for human resource, payroll, W-2 and tax processing and employee management” despite the applicant’s prior incontestable registration for BEST! for “goods such as computer programs for accounting, tax preparation, generating office reports and manuals, electronic filing and facsimile transmission, human resource management, financial management, computer network management, and for office administration and file management.” *Id.* at 1110-11. The Board explained that “the statute clearly states

that the incontestability provided applies specifically to the use of the registered mark, rather than registration. ... ownership of an incontestable registration does not allow an applicant to obtain, by that fact alone, another registration for the same or similar mark for somewhat different goods or services.” *Id.* The Board noted that the services in TALL SHIPS were identical. The Board concluded that “ownership of an incontestable registration does not give [an] applicant a right to register the same or similar mark for different goods or services, even if they are closely related to the goods or services set forth in the incontestable registration.” *Id.* at 1113.

In *In re Outdoor Recreation Group*, 81 USPQ2d 1392 (TTAB 2006) applicant sought to register the mark OUTDOOR PRODUCTS in standard character form on the Principal Register with a claim of acquired distinctiveness under Section 2(f) as to the word OUTDOOR and a disclaimer of the word PRODUCTS for “duffle bags, backpacks, tote bags, soft packs comprised of backpacks or hikers’ bags constructed of soft material which packs do not have a rigid frame for supporting the bag, adjustable belly bands used for backpacks, shoulder pad straps and accessory bands and straps sold separately from the bags heretofore mentioned, fanny packs, shoulder bags and belt pouches,” in International Class 18 and “clothing, consisting of down booties, ponchos, gaiters which are protective, covers for footwear, chaps, parkas, pants, jackets and rain suits,” in International Class 25. Applicant owned

an incontestable prior registration for



for “fanny packs, back

packs, duffle bags, shoulder bags and belt pouches,” in International Class 18 and

“parkas, pants, jackets, rain suits, ponchos, chaps and gaiters,” in International Class 25. Because the application recited goods that were not included in the prior incontestable registration, although certainly closely related and within the same category of goods, the TALL SHIPS doctrine did not apply.

Applying these guidelines, while dog food and cat food are similar insofar as they fall under the general category of pet food, they are distinct products. As explained on applicant’s website these respective goods are comprised of different formulations. See Earthborn Holistic, www.earthbornholisticpetfood.com, attached to March 30, 2010 Office Action. In view thereof, the TALL SHIPS doctrine does not apply in this case. As noted by the Court of Appeals for the Federal Circuit, the statute does not provide “a right *ipso facto* to register a mark for additional goods when items are added to a company’s line or substituted for other goods covered by a registration.” *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 869 (Fed. Cir. 1985) (DURANGOS for cigars does not preclude refusal of DURANGO for chewing tobacco as primarily geographically deceptively misdescriptive).

In sum, we find that the Office has met its burden of proof that the term HOLISTIC as it appears in the mark EARTHBORN HOLISTIC when used in connection with “cat food,” is merely descriptive, and, therefore, subject to the disclaimer requirement.

Decision: The refusal to register the mark EARTHBORN HOLISTIC in the absence of a disclaimer of HOLISTIC is affirmed. However, if applicant submits the required disclaimer to the Board within **two months** of the mailing date of this

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decision, this decision will be set aside as to the affirmance of the disclaimer requirement.¹⁴ See Trademark Rule 2.142(g), 37 C.F.R. § 2.142.

¹⁴ The standardized printing format for the required disclaimer is as follows: “No claim is made to the exclusive right to use the word ‘Holistic’ apart from the mark as shown.” TMEP § 1213.08(a).