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Mailed:
November 20, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Retail Royalty Company

Serial No. 85257100

Theodore R. Remaklus of Wood, Herron and Evans, L.L.P. for Retail Royalty Company.

Fong Hsu, Trademark Examining Attorney, Law Office 115 (John Lincoski, Managing Attorney).

Before Quinn, Taylor and Greenbaum, Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

Retail Royalty Company has filed an application to register as a trademark on the Principal Register the standard character mark HAPPY APOTHECARY for “cosmetics” in International Class 3.¹ 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 APOTHECARY on the ground that it is merely descriptive of applicant’s goods

¹ Application Serial No. 85257100, filed March 3, 2011, based on an allegation of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b)(1).

within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs, and applicant filed a reply.

We affirm the refusal in the absence of a disclaimer.

An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6(a). 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 grounds for refusal of registration. *See 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 National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977); and *In re Pendleton Tool Industries, Inc.*, 157 USPQ 114 (TTAB 1968).

A term is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information regarding a function, purpose, or use of the goods or services. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). *See also In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1789 (Fed. Cir. 2003) (A “mark is merely descriptive if the ultimate consumers immediately associate it with a quality of characteristic of the product or service”); and *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). We look at the mark in relation to the goods or services, and not in the abstract, when we consider whether

the mark is descriptive. *Abcor*, 200 USPQ at 218. *See also MBNA*, 67 USPQ2d at 1783 (“Board correctly found MBNA’s emphasis on the regional theme through marketing promotions and picture designs provides circumstantial evidence of how the relevant public perceives the marks in a commercial environment”). Courts have long held that to be “merely descriptive,” a term need only describe a single significant quality or property of the goods or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

It is the examining attorney’s position that the term APOTHECARY merely describes the place in which applicant’s goods, i.e., “cosmetics”, are sold, and therefore it must be disclaimed. In this regard, the examining attorney contends that:

[a] word or term that identifies the source or provider of a product or service is merely descriptive under Trademark Act Section 2(e)(1). *See In re Major League Umpires*, 60 USPQ2d 1059 (TTAB 2001). Pharmacies are a common source or provider of cosmetic goods. See the internet evidence attached in the July 21, 2011 outgoing Office Action at p. 49-52, 54-60. Therefore, using the common dictionary meaning, a purchaser encountering applicant’s cosmetic goods in the marketplace would understand the word “apothecary” to merely describe that a pharmacy or drugstore is the source or provider of cosmetics.

In support of this position, the examining attorney referenced the following dictionary definitions:

APOTHECARY

1 : one who prepares and sells drugs or compounds for medicinal purposes

2 : PHARMACY

Merriam-Webster On-Line Dictionary (<http://www.Merriam-Webster.com>), attached to the May 24, 2011 Office action.

Apothecary

1. a druggist; a pharmacist.
2. a pharmacy or drugstore.
3. (especially in England and Ireland) a druggist licensed to prescribe medicine.

Dictionary.com (<http://dictionary.reference.com>) (attached to Ex. Att. Brief).²

Drugstore

The place of business of a druggist, usually also selling *cosmetics*, toothpaste, mouthwash, cigarettes, etc., and sometimes soft drinks and light snacks.

Infoplease.com, based on the Random House Dictionary, © Random House, Inc. 2012 (<http://dictionary.infoplease.com>) (attached to Ex. Att. Brief) (emphasis in Brief).

We also take judicial notice of the following additional definition:

Apothecary

1. druggist, pharmacist, pharmaceutist, pharmacologist, pharmaceutical chemist.
2. pharmacy, *U.S.* drugstore.

The Synonym Finder, Warner Books Ed., 1978 (emphasis in original)

In addition, the examining attorney attached to the July 21, 2011, Office Action printouts from websites of several businesses that refer to themselves as apothecaries. This evidence, which includes the following, demonstrates that apothecaries are a common source of cosmetics (emphasis supplied):

Mendham ***Apothecary*** has been serving the local community for over 20 years. We are an independent, family owned pharmacy, gift and candy store. In addition to the pharmacy, we offer gifts, toys, ***cosmetics***... www.mendhamapothecary.com

The Village ***Apothecary*** is a full service pharmacy, carrying health and beauty products, colognes, specialty ***cosmetics***... www.villageapothecary.com

² The Board may take judicial notice of dictionary definitions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006). See also *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1732, 217 USPQ 505 (Fed. Cir. 1983).

Part pharmacy and part *cosmetic* store, Town and Country ***Apothecary*** & Fine ***Cosmetics*** sells an eclectic mix of gifts, *cosmetics* and standard pharmacy items.
<http://ridgewood.patch.com/listings/town-country-apothecary>

We invite you to drop-in anytime for a complementary color-match, offered daily at Sky Meadow ***apothecary's*** fully stocked Jane Iredale *cosmetic* bar.
<http://skymeadowapothecary.com/cosmetics.html>

Aaron's ***Apothecary*** carries Malin+Goetz skin care and *cosmetics*, which are carefully formulated and naturally-based.... http://visitclarkstreet.com/aaron-s-apothecary-listing-127.php?subcategory_id=2

C.O. Bigelow Products...***Apothecary***...Skincare...Bath & Body...Hair...***Makeup***...www.bigelowchemists.com/apothecary-health.html

We find that the examining attorney has made a prima facie case that the word APOTHECARY is merely descriptive when used in connection with applicant's goods. The record demonstrates that the word APOTHECARY clearly and unambiguously describes a significant feature of the goods, namely that an apothecary, which is defined as a pharmacy or drugstore, is a place where cosmetics commonly are sold.³

³ The examining attorney also included printouts from the CVS/Pharmacy and Walgreens websites. With respect to those printouts, applicant argues that it is common knowledge that modern "pharmacies" sell a wide variety of goods, including school supplies and automotive supplies, but that does not necessarily mean the word "pharmacy" is merely descriptive of all those goods. We acknowledge that in the present day, some "big-box" stores, such as CVS/Pharmacy and Walgreens, call themselves "pharmacies," but they are more akin to the old-fashioned "general store," where most everyday items are sold. Accordingly, we do not find the internet evidence from those establishments probative.

Citing entries from four dictionaries,⁴ applicant argues that APOTHECARY does not describe applicant's goods because APOTHECARY is commonly used to refer to a person who makes and sells drugs for medicinal purposes, i.e., a pharmacist, rather than a pharmacy; that is, APOTHECARY defines the person and not the place. Applicant further argues that HAPPY modifies APOTHECARY, thus reinforcing the primary meaning of APOTHECARY as the person and not the place. Even if APOTHECARY is defined as a pharmacy, applicant contends that "pharmacy" is defined as a place "where drugs or compounds for medicinal purposes may be purchased" (App. Reply p.1), and that because applicant's goods are non-medicinal cosmetics, the term APOTHECARY, when used on applicant's cosmetics, "has no meaning and therefore need not be disclaimed." App. Br. p.2. Applicant insists that, in general, for a term to be merely descriptive, the examining attorney must rely upon a primary meaning, and that to rely on a secondary meaning to determine the nature of the goods requires imagination and thought.

As an initial point, we note that applicant has cited no authority, and we are aware of none, that limits us to considering only the first-listed definition when determining whether a term is merely descriptive, especially where, as here, it is readily apparent that the second-listed meaning is applicable, and not obscure. Accordingly, we feel free to consider all dictionary definitions for the term

⁴ *American Heritage Dictionary* (Second College Ed. 1982); *The New Oxford American Dictionary* (Second Ed. 2005); *Cambridge Dictionaries Online* (<http://dictionary.cambridge.org>); and *Merriam-Webster Student Dictionary* (www.wordcentral.com). Applicant attached a copy of the *American Heritage Dictionary* definition to its July 15, 2011 Response. We take judicial notice of the other dictionary definitions that applicant attached to its brief. *In re Red Bull GmbH*, 78 USPQ2d at 1378 (TTAB 2006)

APOTHECARY. From these definitions, it is clear that the term APOTHECARY may be considered synonymous with “pharmacy” or “drugstore,” and, as the dictionary definitions and internet evidence establish, that it is a place where cosmetics commonly are sold. No multi-stage reasoning or imagination is required on the part of the purchasing public upon encountering the mark HAPPY APOTHECARY to understand that an apothecary is a place that is a common source or provider of cosmetics.

We are not persuaded by applicant’s argument that the refusal should be reversed because there is “no evidence that the word ‘Apothecary’ is commonly used to describe cosmetics.” App. Br. pp.7-8. It is well established that a term which describes the source or provider of the goods is also merely descriptive of them. *In re E. I. Kane Inc.*, 221 USPQ 1203 (TTAB 1984) and cases cited therein. See also *Omaha Nat’l Bank*, 2 USPQ2d at 1861 (Fed. Cir. 1987) (rejecting argument that descriptiveness should be limited to a quality or characteristic of the good or service itself and holding that it includes a designation descriptive of the service provider); *cf. In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1301-02, 102 USPQ2d 1217, 1220 (Fed. Cir. 2012) (NATIONAL CHAMBER held descriptive of “traditional chambers of commerce activities” of “promoting the interests of businessmen and businesswomen”). Additionally, as the examining attorney correctly notes in his brief, there is no requirement that a mark which is descriptive of the provider of the goods also separately be descriptive of a different characteristic of the goods. *Major*

League Umpires, 60 USPQ2d 1059 (TTAB 2001) (MAJOR LEAGUE UMPIRE merely descriptive of clothing, face masks, chest protectors, and shin guards).

We distinguish this case from *In re Creative Goldsmiths of Washington, Inc.*, 229 USPQ 766 (TTAB 1986), where applicant sought to register CREATIVE GOLDSMITHS and design for retail jewelry store services under the provisions of Section 2(f) of the Trademark Act. Applicant was not required to disclaim the term GOLDSMITHS because it was not generic for the recited services. The tests for determining whether a term is generic or “simply” merely descriptive, are different.

We also distinguish this case from *In re Jim Crockett Promotions Inc.*, 5 USPQ2d 1455 (TTAB 1987), where the Board did not require a disclaimer of BASH because the primary significance of THE GREAT AMERICAN BASH for promoting, producing and presenting professional wrestling matches, was found to suggest something of desirable quality or excellence, rather than the geographic origins of the services. To the extent that there is any analogy between that case, which arose from a refusal under Section 2(e)(2) of the Trademark Act, and the instant case, which arose under Section 2(e)(1) of the Trademark Act, we do not find that HAPPY APOTHECARY has another meaning, is a unitary phrase, or is incongruous in any way.

Finally, both applicant and the examining attorney submitted third-party registrations to show that the USPTO has alternatively treated the words APOTHECARY or APOTHECARIES as descriptive or not descriptive in Class 3 by sometimes requiring a disclaimer of the term and sometimes not requiring a

disclaimer. This competing evidence is, at most, inconclusive, and therefore of little probative value in determining whether the word APOTHECARY is merely descriptive. As is often stated, each case must stand on its own record and, in any event, the Board is not bound by the actions of prior examining attorneys. *See Nett Designs*, 57 USPQ2d at 1566 (“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.”). *See also In re International Taste Inc.*, 53 USPQ2d 1604, 1606 (TTAB 2000) (“With respect to third-party registrations which include disclaimers...we do not have before us any information from the registration files as to why an Examining Attorney required and/or why the applicant/registrant offered such disclaimers.”).

Applicant correctly states that in cases of refusals under Section 2(e)(1), we must resolve doubt in favor of applicant; however, we have no such doubt in this case.

Thus, the disclaimer requirement is appropriate. In view of the above, the requirement to provide a disclaimer for the word APOTHECARY is affirmed.

DECISION: The refusal to register based on the requirement for a disclaimer of APOTHECARY is affirmed. However, if applicant submits the required disclaimer of APOTHECARY to the Board within thirty days, this decision

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will be set aside as to the affirmance of the disclaimer requirement.⁵ See Trademark Rule 2.142(g), 37 C.F.R. §2.142.

⁵ The standardized printing format for the required disclaimer text is as follows: “No claim is made to the exclusive right to use APOTHECARY apart from the mark as shown.” TMEP §1213.08(a)(i) (8th ed., rev. 1, October 2012).