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APOTHECARY - RVI-1360 / 1 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 85257100

MARK: HAPPY APOTHECARY



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GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: Retail Royalty Company

CORRESPONDENT'S REFERENCE/DOCKET NO:

RVI-1360 / 1

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant has appealed the trademark Examining Attorney's final refusal to disclaim the descriptive wording "APOTHECARY" because it merely describes an ingredient, quality, characteristic, function, feature, purpose or use of applicant's goods. *See* 15 U.S.C. §§1052(e)(1), 1056(a).

FACTS

Applicant filed a trademark application on March 3, 2011 for the mark “**HAPPY APOTHECARY**” in standard characters in International Class 003 for “cosmetics.” An Office Action was issued on May 24, 2011 requiring a disclaimer for the descriptive wording “APOTHECARY” apart from the mark as shown because it merely describes an ingredient, quality, characteristic, function, feature, purpose or use of the goods. *See* 15 U.S.C. §§1052(e)(1), 1056(a).

Applicant responded to the Office Action on July 15, 2011, arguing against the disclaimer requirement. A Final Office Action was issued on July 21, 2011 maintaining the disclaimer requirement. Applicant timely appealed and its brief was forwarded to the Examining Attorney on January 24, 2012.

ISSUE

THE SOLE ISSUE ON APPEAL IS WHETHER THE REQUIREMENT TO DISCLAIM “APOTHECARY” FOR USE IN CONNECTION WITH “COSMETICS” IS APPROPRIATE.

ARGUMENT

An applicant may be required to disclaim an unregistrable component of a mark otherwise registrable. *See* 15 U.S.C. §§1052(e)(1), 1056(a). The purpose of a disclaimer is to permit the registration of a mark that is registrable as a whole but contains matter that would not be registrable standing alone, without creating a false impression of the extent of the registrant’s right with respect to certain elements in the mark. *See Horlick’s Malted Milk Co. v. Borden Co.*, 295 F. 232, 234 (D.C. Cir. 1924). Matter that is merely descriptive of the goods is unregistrable. *See* TMEP §1209.01(b), 1213.03(a). Failure to comply with a requirement to disclaim is a basis for refusal to register a mark. *See* TMEP §1213.01(b).

- I. THE WORDING “APOTHECARY” IN APPLICANT’S MARK REQUIRES DISCLAIMER BECAUSE IT IS MERELY DESCRIPTIVE OF THE GOODS.

Descriptiveness must be determined in relation to the goods or services for which registration is sought. Therefore, the fact that a term may have a different meaning(s) in a different context is not controlling. *See In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984). If a term has a primary significance that is descriptive in relation to at least one of the recited goods, and does not create any double entendre or incongruity, then the term is merely descriptive. *See* TMEP §1209.03(e).

The issue of descriptiveness is considered in the context of the likely effect of the mark on purchasers as they encounter the goods in the marketplace. *In re Tennis in the Round Inc.*, 199 U.S.P.Q. 496 (TTAB 1978). Evidence of the public's understanding of a term can be obtained from any competent source, including dictionary definitions. *See In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985). One definition of the word "apothecary" is "pharmacy." See dictionary definition attached in the May 24, 2011 outgoing Office Action at p. 2. Other definitions of "apothecary" define it as a "drug store." Apothecary. (n.d.). *Dictionary.com Unabridged*. Retrieved March 14, 2012, from Dictionary.com website: <http://dictionary.reference.com/browse/Apothecary> ¹

As noted in the attached definition from the Random House Unabridged Dictionary, a "drugstore" is "the place of business of a druggist, usually also selling *cosmetics*, stationery, toothpaste, mouthwash, cigarettes, etc., and sometimes soft drinks and light meals."

¹ The Examining Attorney respectfully asks the Board to take judicial notice of the additional definition pursuant to TBMP § 1208.04. The Dictionary.com website is a widely known reference and the definition attached hereto is described on the webpage as being "based on the Random House Dictionary, © Random House, Inc. 2012.

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.

Moreover, the record contains real world evidence that businesses holding themselves out to the public as an "apothecary" also commonly provide cosmetics. Specifically, see the internet evidence attached in the July 21, 2011 outgoing Office Action at p. 53-62 (emphasis added):

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

Part pharmacy and part *cosmetic* store, Town & Country *Apothecary* & Fine *Cosmetics* sells and 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

This real world evidence demonstrates that an “apothecary,” as currently used in the marketplace, is a place where cosmetics are sold. Therefore, upon encountering the word “apothecary” used in connection with cosmetics, a consumer is likely to understand that term to be merely the source or provider of the goods.

In addition, third-party registrations featuring the same or similar goods as applicant's goods are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on a showing of acquired distinctiveness, or registered on the Supplemental Register. *See Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1564-65, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987). See the third-party registrations attached in the July 21, 2011 outgoing Office Action at p. 2-48 featuring the same or similar goods with the terms “APOTHECARY” or “APOTHECARIES” disclaimed, most notably:

“WALGREENS APOTHECARY”, for Class 003 goods only, “APOTHECARY”
disclaimed. (Reg. No. 3235706).

“SWADE MERCANTILE AND APOTHECARY”, for Class 003 goods only,
“MERCANTILE AND APOTHECARY” disclaimed. (Reg. No. 3717224).

“SOBO APOTHECARY”, for Class 003 goods only, “APOTHECARY”
disclaimed. (Reg. No. 3389428).

“MUGWORT MAGGIES APOTHECARY”, for Class 003 goods only,
“APOTHECARY” disclaimed. (Reg. No. 3401421).

“J.R. WATKINS NATURAL APOTHECARY SINCE 1868”, for Class 003
goods only, “NATURAL APOTHECARY” disclaimed. (Reg. No. 3800154).

“APOTHEKERRI”, for Class 003 goods only, “APOTHECARY” disclaimed.
(Reg. No. 3836710).

“CONTEMPORARY APOTHECARY”, for Class 003 goods only,
“APOTHECARY” disclaimed. (Reg. No. 3923834).

“APOTHECARY ROSE TIME HONORED HEALING BEAUTY”, for Class
003 goods only, “APOTHECARY” disclaimed. (Reg. No. 3801166).

“URBAN APOTHECARY”, for Class 003 goods only, “APOTHECARY”
disclaimed. (Reg. No. 3167800).

“ORGANIC APOTEKE”, “apoteke” meaning “apothecary” or “pharmacist” in the Serbian language, for Class 003 goods only, “APOTHECARY” disclaimed. (Reg. No. 3366017).

Applicant’s appears to contend that in order to be descriptive, the term “apothecary” must be used to describe the cosmetics goods themselves. However, as stated above, it is well established that a term which describes the source or provider of goods or services is also merely descriptive of those goods and services. *In re E. I. Kane Inc.*, 221 USPQ 1203 (TTAB 1984). The evidence of record clearly demonstrates that “apothecaries” provide cosmetics. To the extent that applicant is contending that a mark which is descriptive of the provider of the goods or services must also separately be merely descriptive of a different characteristic of the goods or services, such a requirement would appear to be unnecessary. *In re Major League Umpires*, 60 USPQ2d 1059 (TTAB 2001). Therefore, the general rule enunciated in *Kane* does not require that the term “apothecary” be descriptive of some characteristic of the cosmetic goods themselves. It is sufficient for purposes of finding the mark descriptive that the term “apothecary” describes a source or provider of “cosmetics.” The evidence in this case so demonstrates.

II. CONCLUSION

The term “apothecary” is descriptive of the source or provider of the applied for “cosmetics” goods. Accordingly, the requirement to disclaim “apothecary” under Trademark Act Section 2(e)(1) and 15 U.S.C. §§1052(e)(1), 1056(a) is proper and should be affirmed.

Respectfully submitted,

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noun, plural -car-ies.

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

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Origin:
1325-75; Middle English (< Old French) < Medieval Latin *apothēcarius* seller of spices and drugs, Late Latin: shopkeeper, equivalent to Latin *apothēc* (*a*) shop, storehouse (< Greek *apothēkē*,

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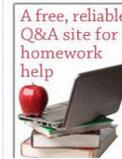
—n. the place of business of a druggist, usually also selling cosmetics, stationery, toothpaste, mouthwash, cigarettes, etc., and sometimes soft drinks and light meals. Also, **drug' store**."

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