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

Proceeding	85257100
Applicant	Retail Royalty Company
Applied for Mark	HAPPY APOTHECARY
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Retail Royalty Company,)
Serial No. 85/257,100)
Mark: HAPPY APOTHECARY)
Appeal Filed: November 30, 2011)

APPLICANT'S REPLY APPEAL BRIEF

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I. INTRODUCTION

A term is descriptive if it "forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [and/or services]." *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 765 (2d Cir. 1976) (emphasis added); *see also In re Abcor Development Corp.*, 616 F.2d 525, 200 USPQ 215 (CCPA 1978). Moreover, in order to be descriptive, the word must immediately convey information as to the qualities, features or characteristics of the goods and/or services with a "degree of particularity." *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199, 1204-1205 (TTAB 1981); *see also In re Diet Tabs, Inc.*, 231 USPQ 587, 588 (TTAB 1986); *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949, 952 (TTAB 1981). Indeed, the Examining Attorney has admitted in his appeal brief that the question is whether "a term has a primary significance that is descriptive in relation to at least one of the cited goods" and, only then, is the term merely descriptive (citing TMEP § 1209.03(e)).

The primary meaning of "apothecary" in Applicant's HAPPY APOTHECARY mark is not cosmetics, nor even a store that carries cosmetics, nor does the term immediately and forthwith convey information regarding the source of cosmetics. Rather, as shown by the dictionary definitions before the Board, the primary meaning of an apothecary is a person who prepares and sells drugs or compounds for medicinal purposes, or a pharmacy (where drugs or compounds for medicinal purposes may be purchased). A consumer seeing the mark HAPPY APOTHECARY with Applicant's "cosmetics" will not immediately view the word "Apothecary" as somehow describing the source of the cosmetics, particularly as the word is paired with "Happy." Quite the contrary. To make any connection between "Apothecary" and cosmetics, the consumer must understand that an "apothecary" can describe a pharmacy or drug store (not

the primary meaning), and that pharmacies and drug stores can sell cosmetics, and so "apothecary" may describe a source of the cosmetics. Here, the significance of Applicant's mark, and specifically what it describes about the goods, is vague enough to render the mark at best suggestive as a multi-link chain or multi-stage reasoning process is required in order for consumers to associate Applicant's HAPPY APOTHECARY mark with the recited goods. *See, e.g., In re Tennis in the Round Inc.*, 199 USPQ 496, 498 (TTAB 1978).

II. ARGUMENT

A. The Word "Apothecary" is Not Descriptive of Applicant's Goods

In this case, the Examining Attorney, who first asserted the word "apothecary" meant a pharmacy, and now asserts it can mean a "drug store," argues that, because a definition of "apothecary" can be a drug store, and cosmetics can be carried by a drug store, then the term "apothecary" is descriptive of the cosmetics themselves.

The Examining Attorney relies upon a definition appearing in a single dictionary to now assert that "apothecary" means a drug store, which is contrary to the definitions previously submitted by both the Examining Attorney and Applicant that uniformly defined an "Apothecary" as either a person who prepares and sells drugs or compounds for medicinal purposes, or a pharmacy, where such drugs or compounds may be purchased. The single on-line dictionary definition cited by the Examining Attorney having a primary definition consistent with the above (druggist or pharmacist) and merely a secondary definition of a drug store is insufficient to show that the primary significance or meaning of "Apothecary" is a drugstore.¹

¹ The Examining Attorney refers to a handful of examples he located of "Apothecaries" that also sell cosmetics. However, these are not well known stores, and he provides no evidence as to the sales by these establishments, how long they have been in business, or the geographic reach of those establishments. As such, this evidence should be given, little, if any, weight.

Indeed, the Examining Attorney resorts to citing a definition of "drug store" (not of "apothecary") to show a connection to cosmetics.

Moreover, under the Examining Attorney's argument there would be virtually no goods for which the word "Apothecary" is not descriptive. Modern drug stores carry virtually every consumer product, from candy, to clothing, to paper products, to office supplies, to personal electronics, to appliances, to automotive accessories. This fact cannot convert the word "apothecary," whose primary definition is a person who prepares and sells drugs for medicinal purposes, into somehow being descriptive of any and all products sold at a drug store.

Still further, the Examining Attorney looks at the word "Apothecary" in isolation and divorced from the overall mark, which puts the term into context. Specifically, Applicant's mark is HAPPY APOTHECARY. The word "happy" modifies "apothecary". This makes clear that the primary meaning of "apothecary" as a person is the one that applies as a person may be "happy,; whereas a place, such as a drug store, is not referred to as being "happy". *See, e.g., In re Creative Goldsmiths of Washington, Inc.*, 229 USPQ 766, 768-69 (TTAB 1986) (finding that, although "GOLDSMITH" is a common descriptive term for an artisan who makes jewelry, it is not for retail jewelry store services).

The Board has noted on a number of occasions that there is a thin line of demarcation between a suggestive and a merely descriptive designation. If the evidence or arguments based thereon raise doubts about whether a word is merely descriptive, such doubts are to be resolved in applicant's favor and the mark should be published, thus allowing a third party to file an opposition and develop a more comprehensive record. *See, e.g., In re Box Solutions*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992); and *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981).

The word "Apothecary," as part of Applicant's HAPPY APOTHECARY mark, is not merely descriptive of "cosmetics" and the Examining Attorney's refusal to register the mark must be reversed.

B. Third Party And Applicant's Prior Registrations Do Not Require A Disclaimer of "Apothecary"

The Examining Attorney asks the Board to ignore registrations that Applicant noted wherein the word "Apothecary" was not disclaimed (see Exhibit 2 to Applicant's July 15, 2011 response)² and to give weight to those that he cites in which the word was disclaimed. However, there is no evidence as to why any of the owners of the registrations cited by the Examining Attorney disclaimed "Apothecary" (*i.e.*, voluntarily or required by the examining attorney). Thus, what these prior registrations confirm is the well-established rule that each case must be decided based on the record before the Board. And the record in this case, and in the cases submitted by Applicant where there was no disclaimer of "Apothecary," show that the word "Apothecary," at least as part of Applicant's HAPPY APOTHECARY mark, is not descriptive of "cosmetics".

² Each of the registrations cited by Applicant were for use in connection with goods in Class 3 only. The marks are THE APOTHECARY (Reg. No. 2,407,698), AYURVEDIC APOTHECARY (Reg. No. 3,092,807), MODERN APOTHECARY (Reg. No. 3,113,459), THE AMERICAN APOTHECARY (Reg. No. 3,168,773), GRAYSON'S APOTHECARY (Reg. No. 3,208,445) and THE ORGANIC APOTHECARY (Reg. No. 3,323,073).

III. CONCLUSION

For all the foregoing reasons, the Examining Attorney erroneously imposed a requirement that Applicant disclaim the term word "Apothecary" as part of the mark HAPPY APOTHECARY for use in connection with "cosmetics" in Class 3. The refusal to register the mark must therefore be reversed and remanded with instructions for the disclaimer requirement to be withdrawn.

Respectfully submitted,

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