

This Opinion is Not a
Precedent of the TTAB

Mailed: September 23, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Healthy Directions, LLC
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Serial No. 85485512
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Mark B. Harrison and Scott M. Oslick of Venable LLP,
for Healthy Directions, LLC.

Ellen J.G. Perkins, Trademark Examining Attorney, Law Office 110,
Chris A.F. Pedersen, Managing Attorney.

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Before Bucher, Lykos and Gorowitz,
Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Healthy Directions, LLC (“Applicant”) seeks registration on the Principal Register of the mark **KETOSIS ESSENTIALS** (*in standard character format*) for “nutritional supplements” in International Class 5.¹

¹ Application Serial No. 85485512 was filed on December 2, 2011, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. Applicant filed its Amendment to Allege Use (AAU) on July 5, 2012, claiming first use anywhere and use in commerce since at least as early as March 5, 2012. No claim is made to the exclusive right to use the word “Ketosis” apart from the mark as shown.

The Trademark Examining Attorney has refused registration of Applicant's mark under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), alleging that the mark is merely descriptive of a quality, characteristic or feature of Applicant's goods.

When the refusal was made final, Applicant appealed and requested reconsideration. After the Trademark Examining Attorney denied the request for reconsideration, the appeal was resumed. We reverse the refusal to register.

Section 2(e)(1) of the Lanham Act precludes registration of a mark that, "when applied to the goods of the applicant, is merely descriptive of them." 15 U.S.C. § 1052(e)(1) (2006). Whether a particular term is merely descriptive is determined in relation to the goods for which registration is sought and the context in which the term is used. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). 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 goods or services in connection with which it is used, or intended to be 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); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

A mark is suggestive, and therefore registrable on the Principal Register without a showing of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. *See In re*

Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (**APPLE PIE** merely descriptive of potpourri mixture: “Whether a given mark is suggestive or merely descriptive depends on whether the mark ‘immediately conveys ... knowledge of the ingredients, qualities, or characteristics of the goods ... with which it is used,’ or whether ‘imagination, thought, or perception is required to reach a conclusion on the nature of the goods.’”). *See also In re MBNA America Bank N.A.*, 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003).

Applicant contends that this Board has in the past recognized that the term “Essentials” is “highly suggestive,” not “merely descriptive”; that the Office has allowed numerous composite marks including the word “Essentials” to issue to third parties for a variety of goods including nutritional supplements, as well as ten registrations involving marks that include the term “Essentials” previously issued to Applicant for nutritional supplements, without a disclaimer of that word; and that at the very least, these facts must certainly create some doubt as to the descriptiveness of the word “Essentials” as applied to goods of the type offered by Applicant.

In response, the Trademark Examining Attorney contends that in the cases cited by Applicant, the goods at issue were clothing, and on those records, the word “Essentials” was found to be suggestive of enumerated items of clothing that were a basic part of a consumer’s wardrobe. The Trademark Examining Attorney also points to other third-party registrations demonstrating that the Office has considered the word “Essentials” to be merely descriptive for supplements.

Evidence that a term is merely descriptive to the relevant purchasing public “may be obtained from any competent source, such as dictionaries, newspapers, or surveys.” *In re Bayer*, 82 USPQ2d at 1831, quoting *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986). In this context, the Trademark Examining Attorney has made of record several dictionary definitions. The first word in Applicant’s mark is “Ketosis,” a medical term for which the Trademark Examining Attorney supplied several dictionary entries, as follows:

Ketosis A condition characterized by an abnormally elevated concentration of ketone bodies in the body tissues and fluids. It is a complication of diabetes mellitus and starvation. (Dorland, 27 th ed)	2
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Ketosis A condition of having ketone bodies build up in body tissues and fluids. The signs of ketosis are nausea, vomiting, and stomach pain. Ketosis can lead to <u>ketoacidosis</u> .	3
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Ketosis is poisoning by ketones. Ketosis can occur in severe diabetes or starvation when the normally <u>broken</u> down ketones occurring during <u>combustion</u> of fat in the <u>body</u> are not <u>broken</u> down and accumulate in the <u>blood</u> .	4
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ke-to-sis noun \kē-'tō-səs\ : an abnormal increase of <u>ketone</u> bodies in the body	5
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Hence, the word “ketosis” refers to a medical condition where the body produces an excess of ketone, often as a complication of diabetes.

In an attempt to overcome the Trademark Examining Attorney’s refusal on the basis that the mark in its entirety is merely descriptive, Applicant disclaimed the term “Ketosis.” In these circumstances, the disclaimer may be viewed as Applicant’s

² <http://www.medicaldictionaryweb.com/Ketosis-definition/>

³ <http://www.childrenwithdiabetes.com/dictionary/k.htm>

⁴ <http://www.probertencyclopaedia.com/cgi-bin/xphrase.pl?keyword=ketosis>

⁵ <http://www.merriam-webster.com/dictionary/ketosis>

acknowledgement that the term “Ketosis” is descriptive as applied to the involved nutritional supplements. Based upon the dictionary evidence and Applicant’s disclaimer, we find that the term “Ketosis” is descriptive. Therefore, the remaining issues are the distinctiveness of the word “Essentials” and where on the spectrum of distinctiveness the composite term **KETOSIS ESSENTIALS** falls.

It is in this context that we turn to the dictionary entries of the word “Essentials” proffered by the Trademark Examining Attorney:

es-sen-tial (ĭ-sĕn’shəl)

adj.

1. Constituting or being part of the essence of something; inherent.
2. Basic or indispensable; necessary.
3. Of, relating to, or being a dysfunctional condition or a disease whose cause is unknown: *essential hypertension.*
4. *Of, relating to, or being* a substance that is required for normal functioning but cannot be synthesized by the body and therefore must be included in the diet: *essential amino acids.*

n.

1. Something fundamental.
2. Something necessary or indispensable.

6

es-sen-tial [uh-sen-shuh l]

adjective

1. absolutely necessary; indispensable: *Discipline is essential in an army.*
2. pertaining to or constituting the essence of a thing.
3. noting or containing an essence of a plant, drug, etc.

7

⁶ *THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE*, as reproduced in The Free Dictionary by Farlex, <http://www.thefreedictionary.com/Essentials>, attached to the Office Action of March 13, 2012, at 10 of 43.

⁷ Dictionary.com, based on the *RANDOM HOUSE DICTIONARY*, <http://dictionary.reference.com/browse/essentials?s=t>.

In further support of the descriptiveness refusal, the Trademark Examining Attorney has provided the following third-party registrations to demonstrate that the Office has treated the term “Essentials” as being descriptive for supplements. The following marks are all registered for supplements, and each has, at a minimum, the word “Essentials” (or in one case, “Essential”) disclaimed:⁸

DAILY ESSENTIALS ⁹	LIFE ESSENTIALS ¹⁰	Coded Essentials ¹¹
DIABETES ESSENTIALS NUTRITION TO GO ¹²		TRUE ESSENTIALS ¹³
SCD ESSENTIAL PROBIOTICS ¹⁴		CORE 6 ESSENTIALS ¹⁵
MIRACLE ESSENTIALS ¹⁶		
Chain Essentials ¹⁷	ARBONNE ESSENTIALS ¹⁸	

Furthermore, the Trademark Examining Attorney contends that inasmuch as the record shows that both of the individual words herein, “Ketosis” and “Essentials,” are merely descriptive, the question of the registrability of the

⁸ The Trademark Examining Attorney submitted two additional registrations, one of which has expired and one of which was cancelled under Section 8; we have given them no probative weight.

⁹ Registration No. 2200775 issued on the Supplemental Register on October 27, 1998; renewed.

¹⁰ Registration No. 2271447 issued on August 24, 1999; renewed.

¹¹ Registration No. 3818868 issued on July 13, 2010.

¹² Registration No. 3583999 issued on March 3, 2009.

¹³ Registration No. 3163693 issued on October 24, 2006; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

¹⁴ Registration No. 3884894 issued on December 7, 2010.

¹⁵ Registration No. 4090052 issued on January 24, 2012.

¹⁶ Registration No. 4115692 issued on March 20, 2012.

¹⁷ Registration No. 4258563 issued on December 11, 2012.

¹⁸ Registration No. 4136385 issued on May 1, 2012.

combined term depends upon whether a new and different commercial impression is created, or whether, for example, the composite mark imparts an incongruous meaning as used in connection with the goods. *See In re Tower Tech, Inc.*, 64 USPQ2d 1314 (TTAB 2002) (**SMARTTOWER** held merely descriptive of commercial and industrial cooling towers); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (**AGENTBEANS** merely descriptive of computer programs); *In re Gagliardi, Bros., Inc.*, 218 USPQ 181, 184 (TTAB 1983) (**BEEFLAKES** for frozen thinly sliced beef merely descriptive).

The Trademark Examining Attorney argues that inasmuch as Applicant is providing supplements that contain *essential* vitamins, minerals and/or other nutrients for individuals dealing with elevated ketone levels, or *ketosis*, no imagination is required to understand the nature of the goods, and hence, the mark is merely descriptive.

Applicant counters with the following registrations that it owns on the Principal Register without benefit of § 2(f) of the Act and without any disclaimers of the word “Essentials”:

ENERGY ESSENTIALS	for “multi-mineral and nutritional supplement” in International Class 5; ¹⁹
JOINT ESSENTIALS	for “nutritional supplements” in International Class 5; ²⁰

¹⁹ Registration No. 1979761 issued on June 11, 1996, renewed.

²⁰ Registration No. 2239656 issued on April 13, 1999; renewed. No claim is made to the exclusive right to use the word “Joint” apart from the mark as shown.

MEMORY ESSENTIALS	for “dietary and nutritional supplements” in International Class 5; ²¹
CRANBERRY ESSENTIALS	for “dietary and nutritional supplements containing cranberry extracts” in International Class 5; ²²
GLUCOSE ESSENTIALS	for “nutritional food supplements; vitamins” in International Class 5; ²³
BP ESSENTIALS	for “vitamins and nutritional food supplements” in International Class 5; ²⁴
METABOLIC ESSENTIALS	for “nutritional supplements” in International Class 5; ²⁵
RESTFUL NIGHT ESSENTIALS	for “mineral, herbal and nutritional food supplements” in International Class 5; ²⁶
CHOLESTEROL ESSENTIALS	for “nutritional supplements” in International Class 5; ²⁷
PHYTONUTRIENT ESSENTIALS	for “nutritional supplements” in International Class 5. ²⁸

²¹ Registration No. 2278025 issued on September 14, 1999; renewed.

²² Registration No. 2565886 issued on April 30, 2002; renewed. No claim is made to the exclusive right to use the word “Cranberry” apart from the mark as shown.

²³ Registration No. 2680246 issued on January 28, 2003; renewed. No claim is made to the exclusive right to use the word “Glucose” apart from the mark as shown.

²⁴ Registration No. 2858840 issued on June 29, 2004; renewed. No claim is made to the exclusive right to use the term “BP” apart from the mark as shown.

²⁵ Registration No. 3248187 issued on May 29, 2007; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. No claim is made to the exclusive right to use the word “Metabolic” apart from the mark as shown.

²⁶ Registration No. 3283862 issued on August 21, 2007; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged.

²⁷ Registration No. 3480655 issued on August 5, 2008; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. No claim is made to the exclusive right to use the word “Cholesterol” apart from the mark as shown.

²⁸ Registration No. 3759344 issued on March 9, 2010. No claim is made to the exclusive right to use the term “Phytonutrient” apart from the mark as shown.

In its reply brief, Applicant notes that, although the Trademark Examining Attorney “summarily dismissed the probative value of those registrations to the issue of descriptiveness in the present case,” the Trademark Examining Attorney “in the very next paragraph” continued to rely upon an equal number of “third-party registrations in which the term ESSENTIALS has been disclaimed or [the composite mark was] registered on the Supplemental Register as proof that the U.S. Patent and Trademark Office (‘USPTO’) has held the term descriptive of supplements,” with the Trademark Examining Attorney concluding on the basis of these registrations that “the evidence of record leaves no doubt that the mark is merely descriptive.” Applicant finds this position to be “completely illogical and inconsistent”:

If Applicant’s own existing registrations for marks that are identical in form to the “Ketosis Essentials” mark are not conclusive as to the issue of whether “Ketosis Essentials” is descriptive, then it stands to reason that the third-party registrations referenced by the Examining Attorney are certainly also not conclusive. In fact, if anything, the United States Patent and Trademark Office’s past treatment of the term “Essentials” in Applicant’s own registrations for highly similar marks, used in connection with goods similar to those in the present case, [is] of *more* probative value than third-party registrations.

Applicant’s reply brief at 2 (*emphasis* in original).

Applicant also contends that it is important that this Board, in several precedential decisions, has recognized that the term “Essentials” is suggestive, *not* merely descriptive. *Cf. Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005) (this *inter partes* case was actually a likelihood of confusion case focusing on whether that applicant’s **NORTON MCNAUGHTON ESSENTIALS** mark was

confusingly similar to the cited registrant's **ESSENTIALS** mark). The Board had also stated, in a case prior to *Knight Textiles*, that "[a]s to the meaning of the word "Essentials," we find it to be no more than suggestive." See *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991).

As noted above, the Trademark Examining Attorney points out that the goods at issue in the cases cited by Applicant were clothing. On the records in *Knight Textile* and *Melville*, the word "Essentials" was found to be suggestive of enumerated items of clothing that were a basic part of a consumer's wardrobe. Furthermore, in spite of Applicant's ten previously issued registrations where the word "Essentials" appears to have been treated as inherently distinctive, the Trademark Examining Attorney continues to point to third-party registrations demonstrating that the Office has also treated the word "Essentials" as descriptive for supplements.

The fourth dictionary entry for the word "essential" taken from *THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE*, *supra*, defines "essential" as a substance that is not synthesized by the body in a quantity sufficient for normal health and growth and that must be obtained from the diet. This is a singular form of the adjective "essential" which would be used to modify a noun, as in the example that follows that dictionary entry, namely, "*essential amino acids*." This usage immediately conveys information about the involved substance, i.e., that the substance or element is necessary. However, this is not the same connotation presented by the pluralized form of the word, "essentials," used not as an adjective, but as a noun. Although in certain situations involving pluralizations, we have made the point that the presence or absence of an "s" does not affect the commercial

impression of a mark,²⁹ in this case the addition of an “s” to the descriptive word “Essential” changes the word from an adjective to a noun. Neither the Trademark Examining Operation nor this Board apply to a given § 2(e)(1) refusal any *per se* rules about how to handle a particular word or composite mark. That is, each case must be determined on its own unique set of facts. Accordingly, in this particular case, with the word “Essentials” as the second component in the composite mark **KETOSIS ESSENTIALS** sought to be registered for nutritional supplements, the information conveyed is not so immediate.

Judging from the glimpses of the Trademark Register provided by the Applicant and Examining Attorney,³⁰ it appears that the Office has sometimes required a disclaimer of the word “Essentials” within composite marks for vitamins and supplements, but other times it has not. We acknowledge that Applicant is the owner of at least ten prior registrations of composite marks having the structure of a modifier followed by the word “Essentials” for supplements, in which no disclaimer was required of the term “Essentials.” Moreover, consistent with Applicant’s disclaimer herein of the word “Ketosis,” these registrations often contain

²⁹ See *e.g.*, *Wilson v. Delaunay*, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) (finding no material difference between the singular and plural forms of **ZOMBIE** such that the marks were considered the same mark).

³⁰ The Board does not make its own search of the Federal Trademark Register and re-examine a refused application, but relies upon the record created during examination. Accordingly, when evidence is presented in support of an argument about what the evidence shows in regard to the state of the Principal and Supplemental Registers, it is useful for the proffering party to explain the search that was done, what was found, and whether the evidence of record constitutes all records responsive to the search or is representative of a larger body of similar records.

a disclaimer of the other/leading descriptive terms (e.g., joint, cranberry, glucose, BP, metabolic, cholesterol, phytonutrient, etc.).

The specific facts in the record in this case leave us with a not insignificant level of residual doubt that when the words “Ketosis” and “Essentials” are combined into **KETOSIS ESSENTIALS**, the mark immediately describes a quality, characteristic or feature, etc., of the goods. Given our doubt as to whether this mark is merely descriptive under the fact pattern herein, we resolve this doubt in favor of Applicant and reverse the § 2(e)(1) refusal. *See, e.g., In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1144 (Fed. Cir. 1987); *In re Box Solutions*, 79 USPQ2d 1953, 1955 (TTAB 2006).

Decision: The Trademark Examining Attorney’s refusal to register Applicant’s mark **KETOSIS ESSENTIALS** (with the word “Ketosis” disclaimed) under Section 2(e)(1) of the Lanham Act is hereby reversed.