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OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Super-Pharm (Israel) Limited

Serial No. 85521587

Joel Karni Schmidt of Cowan Liebowitz & Latman PC, for  
Super-Pharm (Israel) Limited.

Edward Nelson, Trademark Examining Attorney, Law Office 106  
(Mary I. Sparrow, Managing Attorney).

Before Kuhlke, Ritchie, and Masiello, Administrative  
Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Super-Pharm (Israel), Limited, applicant herein  
("applicant"), seeks registration on the Principal Register  
of the mark "SUPER-PHARM," and design<sup>1</sup> as shown below:

<sup>1</sup> Serial No. 85521587, filed on January 20, 2012, under Trademark  
Act Section 44(e).



for the services identified as:

1. International Class 35: Retail store services and retail drug store services, and retail store services via online electronic communications featuring a wide variety of consumer products, cosmetics, personal care products, hygiene products, food and beverages, clothing, footwear, headgear, underwear, eye glasses, contact lenses, sunglasses, toys, household care products, cleaning products, pharmaceutical products, vitamins, nutritional and dietary supplements, batteries, small home appliances, lighting and electrical supplies, consumer electronics, custom jewelry, hair accessories, watches, perfumery, toiletries, baby products, bags and cases, CDs and DVDs; retail pharmacy services and pharmacies; and
2. International Class 44: Preparation of pharmaceutical, medical and natural preparations for the treatment of various physical and mental conditions, according to a given prescription or formula; counseling services in the fields of pharmaceuticals, medical and natural preparations for the treatment of various physical and mental conditions, according to a given prescription or formula and nutrition; optometry services; hearing tests; medical examination.

The trademark examining attorney made final a requirement that applicant disclaim the term "Super-Pharm" apart from the mark as shown on the ground that it is merely descriptive of the identified services pursuant to Section 6 of the Trademark Act and within the meaning of Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1).

Both applicant and the examining attorney filed briefs, and applicant filed a reply brief.

### **Disclaimer Requirement**

A term must be disclaimed apart from the mark as shown if it is deemed to be merely descriptive of the subject goods or services. See *In re Grass GmbH*, 79 USPQ2d 1600, 1603 (TTAB 2006); Trademark Manual of Examining Procedure §1213.08(b) (8<sup>th</sup> ed. 2011) (TMEP Oct. 2013). A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012), citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); see also *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have

other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). A composite term consisting of merely descriptive terms is registrable only if as a unitary mark it has a separate, non-descriptive meaning. *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (holding SUGAR & SPICE not merely descriptive of bakery products).

The determination of descriptiveness for the formation of "SUPER" + [term] has been discussed by various Board cases, including the recent case of *In re Positec Group Ltd.*, 108 USPQ2d 1161, 1172 (TTAB 2013). Applying the guidance set forth in *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1052 (TTAB 2002), the Board noted:

A general proposition which may be distilled from the foregoing cases is that if the word "super" is combined with a word which names the goods or services, or a principal component, grade or size thereof, then the composite term is considered merely descriptive of the goods or services, but if such is not strictly true, then the composite mark is regarded as suggestive of the products or services.

Our task thus is to determine whether the term "PHARM" is descriptive. There are two relevant dictionary definitions of "pharm" of record:

pharm. Or Phar. Or pharm. Or Pharm.: abbreviation for 1. pharmaceutical 2. pharmacist 3. pharmacopoeia 4. Pharmacy. Collins Dictionaries

(2011); [www.collindictionary.com](http://www.collindictionary.com). (Attached to May 4, 2012 Office Action, p.2).

Pharm: abbr; pharmaceutical; pharmacology; pharmacopoeia; pharmacy. New Oxford American Dictionary. (6/6/01) (Attached to Ex. B-13 of Butters decl.).

There are also two definitions as follows:

pharM: abbr. Masters of Pharmacology; New Oxford American Dictionary. (6/6/01) (Attached to Ex. B-13 to Butters decl.).

pharma: a pharmaceutical company. Merriam-Webster Unabridged Medical Dictionary. (12/6/12) (Attached to Ex. B-14 to Butters decl.).

The examining attorney submitted a copy of one U.S. service mark registration with "PHARM" disclaimed:

WEST RIVER PHARM, disclaiming PHARM, for "wholesale pharmacy services." Registration No. 3894284.<sup>2</sup>

Applicant argues that the term is not merely descriptive as applied to its services. Applicant submitted the declaration of expert witness, Professor

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<sup>2</sup> We note that both the examining attorney and applicant submitted competing registrations with "super" either disclaimed or not, and either on the Principal or the Supplemental Register. Given the case law, we do not find these to be relevant to our analysis. As the Board in *Positec* noted, we are faced with a task of deciding the descriptiveness (or not) of the term that follows "SUPER." To the extent the third party registrations do not meet this level of consistency, they are not relevant. *In re Positec Group Ltd.*, 108 USPQ2d 1161, 1172, ftnt. 54 (TTAB 2013), citing *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Ronald R. Butters, Ph.D., dated February 7, 2013. Dr. Butters states that his "field of expertise includes the structure of modern English and present-day usage; the history of the English language; and linguistics." (Butters decl., at para 5). Dr. Butters testified that the term "pharm" does not appear in any "established dictionaries" as an abbreviation for "pharmacy" or "pharmaceutical" (Butters decl. at para. 17), except for some "primarily older" dictionaries. (*Id.*, at para. 19). However, Dr. Butters' conclusions are belied by the record, including some of his own exhibits, as noted in the definitions above. Second, applicant argues that the term "PHARM" has been registered without disclaimer on the Principal Register for numerous third-party registrations for goods and services similar to those that applicant seeks.<sup>3</sup> Third, applicant argues that it has established a degree of fame in Israel, where it is based. *See Reitblatt* decl. at para. 5, *et. al.* The fact that applicant has established fame in Israel is not relevant to our determination, which concerns consumer perception in the United States. Moreover, even if applicant's sales and

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<sup>3</sup> Although there are a number of examples in the record of instances where the Office has not required a disclaimer of the term "PHARM" for goods or services similar to those sought by applicant in the current application, as we have noted in the prior footnote, these actions are not binding on the Board.

fame were in the United States it would only be relevant to a determination of acquired distinctiveness (which applicant has not sought in this case). See *Yamaha Intern. Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988); see also *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420 (Fed. Cir. 2005).

Finally, applicant argues that it has shown via two surveys conducted by Empirica Research PTY Ltd. ("Empirica Research") that consumers do not consider SUPER-PHARM to be "merely descriptive" for "drugstore retail," the category tested. To this end, applicant commissioned Empirica Research to conduct a Teflon-style survey. The survey was a double-blind process, conducted online, between January 8 and 14, 2013. (Empirica report p.2). In order to qualify, consumers "needed to indicate that they bought from retail drugstores at least once every two months. In addition, they needed to indicate it was at least somewhat likely that they would buy from a retail drugstore in the next two months." *Id.* at p.2. To further qualify, in line with a Teflon-style survey, participants were told the difference between a brand and a "merely descriptive" term as follows:

A MERELY DESCRIPTIVE TERM describes an ingredient, quality, characteristic, function, feature, purpose, or use of products or services without identifying one company in particular.

Examples were given of TARGET as a brand and FOOD AND BEVERAGE ONLINE as merely descriptive. *Id.* at 7

In the Teflon-style format, participants were given a mini-test, to see if they understood what merely descriptive means. Only those who correctly identified THE GAP (for clothing) as a brand and LOOSE FIT JEANS (for clothing) as a merely descriptive term proceeded with the survey. Participants were then asked about nine terms in relation to specific goods or services and asked whether they were a "Brand name," "Merely Descriptive term," or "I'm not Sure." The results are as follows:

TERM:	Brand	Merely Descr.	Don't Know
J&R (electronics)	76.4%	7.2%	16.5%
ACTIVISION (video game publishing)	75.1%	13.1%	11.8%
MACY's (general retail)	97.0%	2.1%	0.8%
<b>SUPER-PHARM (drugstore retail)</b>	<b>45.1%</b>	<b>35.4%</b>	<b>19.4%</b>
PERSONAL CARE (banking services)	1.3%	96.6%	2.1%
HOME SAVINGS (banking services)	14.3%	78.5%	7.2%



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DUANE READE	73.0%	6.8%	20.3%
(drugstore retail)			
BED & BREAKFAST REGISTRY	13.9%	79.3%	6.8%
(lodging reservation services)			
SECURITY CENTER	3.4%	89.9%	6.8%
(storage services)			

From this data, the report concluded that "the most common conclusion reached by consumers is that 'SUPER-PHARM is a brand name." (Empirica report at p. 4).

Empirica Research conducted a second consumer survey whereby potential consumers were asked to come up with their own "open ended" ideas of descriptive terms for drugstore services. Specifically, participants were tasked as follows:

We'd like you to think for a moment about one particular industry - retail drugstores. Imagine that someone you know asks you for a recommendation about a retail drugstore they could use. You make a recommendation for a particular store, such as CVS, Rite Aid or Walgreens, etc. Your task is to come up with a two-word phrase that DESCRIBES THE DRUGSTORE'S PRODUCTS/SERVICES IN A POSITIVE WAY to your friend. Your phrase needs to make clear, in a general way, what products or services the drugstore sells. Please do not name the actual store in your response - just describe its products/services in a positive way to your friend.

Due to the extremely open-ended nature of the survey and the innumerable possible answers, we do not give any

weight to this open-ended survey. Indeed, although no consumers came up with the term "SUPER-PHARM" in response to the question, that does not at all indicate that it is not merely descriptive of any of applicant's services; indeed, the survey did not set forth before the participants all of the services for which applicant seeks registration.

The Director and Founding Partner of Empirica Research, Dr. David T. Neal, Ph.D., opined, based on the two surveys, that "The term 'SUPER-PHARM' (in relation to retail drugstore products and services) is substantially more likely to be perceived by consumers as a brand name than a merely descriptive term." (Neal decl. at para. 7(a)).

As noted above, we give no probative value to the open-ended survey. Further, we give little to no probative value to the Teflon-style survey. First, while a Teflon survey, typically used in the context of a genericness inquiry, may be of assistance in determining whether a term has acquired distinctiveness, it is less certain what relevance, if any, it may have for purposes of establishing inherent distinctiveness. *In re Country Music Association, Inc.*, 100 USPQ2d 1824, 1834 (TTAB 2011). As noted above, applicant does not seek to register its mark

under Trademark Act § 2(f) based on acquired distinctiveness, and the question before the Board is whether the term PHARM used in connection with these services is merely descriptive, not whether it has acquired distinctiveness. We expect that the average consumer is not an expert in parsing through the legal nuances of mere descriptiveness, including those of "SUPER" + [term] at issue with applicant's proposed mark. Indeed, mere descriptiveness is a legal conclusion, one which an average person is not competent to determine. To that extent, the survey results are not a reliable guide in reaching a legally correct decision in this case in accordance with applicable law and precedents.

However, to the extent the Teflon-style survey has any probative value, less than half the participants thought SUPER-PHARM to be a drugstore brand, compared with 73% for competitor DUANE READE. Taken together with the definitions of "pharm" as abbreviations for "pharmacy," "pharmacist," or "pharmaceutical," we find that, looking at the entirety of the record, there is no doubt that a consumer would understand SUPER-PHARM in relation to applicant's services as conveying information about them.

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*See In re Abcor*, 200 USPQ at 217-218. The requirement to disclaim the term "SUPER-PHARM" for services in both International Class 35 and 44 is affirmed.

**Decision:** We affirm the requirement for a disclaimer of the term "SUPER-PHARM," as well as the refusal to register in absence of a disclaimer. However, if applicant submits the required disclaimer to the Board within two months of the mailing date of this decision, then the decision will be set aside, and the application will proceed to publication.