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Subject: U.S. TRADEMARK APPLICATION NO. 85892404 - EAR NATURAL - N/A - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

<p>U.S. APPLICATION SERIAL NO. 85892404</p> <p>MARK: EAR NATURAL</p>	
<p>CORRESPONDENT ADDRESS: TARA CHAND INTERNET PROMISE GROUP LLC 2390 CRENSHAW BLVDSTE 239 TORRANCE, CA 90501-3300</p>	<p>GENERAL TRADEMARK INFORMATION: http://www.uspto.gov/trademarks/index.jsp</p> <p>TTAB INFORMATION: http://www.uspto.gov/trademarks/process/appeal/index.jsp</p>
<p>APPLICANT: Internet Promise Group LLC</p>	
<p>CORRESPONDENT'S REFERENCE/DOCKET NO: N/A</p> <p>CORRESPONDENT E-MAIL ADDRESS: chand@InternetPromise.com</p>	

EXAMINING ATTORNEY'S APPEAL BRIEF

INTRODUCTION

Internet Promise Group LLC (hereinafter, "Applicant") has appealed the trademark examining attorney's final refusal under Section 2(e)1of the Trademark Act, 15 U.S.C. § 1052(e)(1) on the basis that it is merely descriptive of the identified goods and the requirement for an amendment to the identification of the particular goods that does not exceed the scope of the original claim in accordance with 15 U.S.C. §§1051(a)(2), 1051(b)(2), 1053, 1126(d)-(e), 1141f, and TMEP Sections 1402.06 *et seq.* and 1402.07.

STATEMENT OF THE CASE

On April 2, 2014 applicant filed the present application for the mark EAR NATURAL for "[a] packaging with a dropper that contains limited quantity of mustard oil, for dropping oil drops in the ear canal, for cure of middle ear infection, without use of antibiotics," which was classified by the Office in International Class 10. In the First Office Action dated July 16, 2013, registration was refused on the basis that the mark is descriptive of the goods, and the examining attorney required an amendment to the classification and identification because the goods were misclassified and the identification indefinite. Upon applicant's response on December 26, 2013, the examining attorney accepted the reclassification of the goods to International Class 5. On January 31, 2014 a Final Office Action was issued making the refusal and requirement for an acceptable identification of goods final. Applicant filed a Notice of Appeal on July 25, 2014. On October 10, 2014 the application was assigned to the undersigned examining attorney.

ISSUES

- I. Whether Applicant's mark is descriptive of the goods necessitating a refusal under 15 U.S.C. § 1052(e)(1) .
- II. Whether the amendment to the identification of goods is indefinite and beyond the scope of the original identification in accordance with 15 U.S.C. § 1051(b)(2) and TMEP Sections 1402.06 *et seq.* and 1402.07.

ARGUMENTS

I. REFUSAL UNDER TRADEMARK ACT SECTION 2(e)1

Trademark Act Section 2(e)(1) bars registration of an applied-for mark that is merely descriptive of some aspect of the Applicant's goods. A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). TMEP §1209.01(b); *see, e.g., DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920)).

"A mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services." *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (citing *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1346, 57 USPQ2d 1807,

1812 (Fed. Cir. 2001)); TMEP §1209.01(b). It is enough if a mark describes only one significant function, attribute, or property. *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b).

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 the 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). In other words, “[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them.” *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002).

The record clearly establishes that EAR NATURAL is descriptive of the goods, namely, a packaging with a dropper that contains limited quantity of mustard oil, for dropping oil drops in the ear canal, for cure of middle ear infection, and is not suggestive.

The identification of goods shows that in the context of the goods, the wording EAR is descriptive of the goods in that it specifies the purpose/use of the goods, namely, dropping oil drops in the ear canal and curing middle ear infections. Applicant argues that the word "ear" as used in common English refers to the outer ear and does not refer to the middle-ear. As shown in the evidence of record, the word "ear"

is used to refer to all portions of the ear including the middle ear. Mommyotamus, *Natural Remedies for Ear Infections*, <http://www.mommyotamus.com/natural-remedies-for-ear-infections/> (accessed Jan. 31, 2014) [Attachment to Office Action dated 1/31/14 at pages 26 and 28]

The wording "NATURAL" immediately tell consumers that the goods are free of artificial ingredients. The dictionary evidence of record shows that NATURAL means "being made of organic material; not synthetic" and "existing in or produced by nature." Collins Dictionary Online, search of "natural," <http://www.collinsdictionary.com/dictionary/english/natural> (July 16, 2013) and Merriam-Webster Online, search of "natural," <http://www.merriam-webster.com/dictionary/natural> (July 16, 2013) [Attachments to the Office Action dated 7/26/13 at pages 5 and 9] Also, the evidence of record shows that NATURAL is used to describe ear remedies consisting of natural products such as oil and devices for dropping oil into the ear without the use of antibiotics or pharmaceuticals. Mommyotamus, *Natural Remedies for Ear Infections*, <http://www.mommyotamus.com/natural-remedies-for-ear-infections/> (accessed Jan. 31, 2014); Kitchen Stewardship, *Kid's Ear Infections: A Home Remedy?*, <http://www.kitchenstewardship.com/2010/01/18/kids-ear-infections-a-home-remedy/> (accessed on Jan. 31, 2014); and Whole New Mom, Adrienne, *An Unbelievable Natural Ear Infection Remedy*, <http://wholenewmom.com/health-concerns/natural-treatment-for-ear-infectio/> (accessed on Jan. 31, 2014) [Attachments to Office Action dated 1/31/14 at pages 29, 61, and 90] Further, the third-party registrations of record (registration nos. 2763421, 3976971, 4076762, 4159011, 4101976, 4335961, 4304549, 4386956, and 4447236) confirm that in relation to the specified goods, the wording immediately conveys a natural remedy for the treatment of ear ailments. Search of USPTO X-Search (Jan. 31, 2014). The search of the register that appears in TICRS on January 31, 2014 reveals that of the 485 registrations in class 5 containing the word NATURAL, 281 of the registrations have the word

NATURAL disclaimed including registration nos. 2763421, 3976971, 4076762, 4159011, 4101976, 4335961, 4304549, 4386956, and 4447236. [Attachments to the Office Action dated 1/31/14 at pages 2-25] Third-party registrations featuring goods and/or services that are the same as or similar to applicant's goods and/or services 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 acquired distinctiveness, or registered on the Supplemental Register. *See Inst. Nat'l des Appellations D'Origine v. Vintners Int'l Co.*, 958 F.2d 1574, 1581-82, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006).

Applicant argues that "NATURAL" has a large number of different and/or abstract meanings.

Descriptiveness is considered in relation to the relevant goods and/or services. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). "That a term may have other meanings in different contexts is not controlling." *In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1087 (TTAB 2012) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)); TMEP §1209.03(e).

The full mark at issue, EAR NATURAL, therefore "imparts or conveys an immediate idea" of a characteristic, purpose, or use of Applicant's package including a dropper that contains mustard oil – that such goods are free of artificial ingredients and used in the ear canal to cure middle ear infections. See *In re George Weston Ltd.*, 228 U.S.P.Q. 57 (T.T.A.B. 1985).

Applicant argues that the words EAR NATURAL, whether taken alone or in combination, does not necessarily specify the purpose or use of the goods, i.e., to cure middle ear infections. "Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). The question is not whether someone presented only with the mark could guess what the goods and/or services are, but "whether someone who knows what the goods and[/or] services are will understand the mark to convey information about them." *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)); *In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1087 (TTAB 2012).

Further, applicant argues that the mark EAR NATURAL is incongruous and is hitherto unused to describe applicant's good. The evidence of record clearly demonstrates that the combination of EAR and NATURAL is used to describe natural oils and devices for curing ear infection. The internet article evidence from MommyPotamus is entitled "Natural Remedies for Ear Infections" and describes the use of oil, droppers, and other oil administrating devices such as capsules for use in curing ear infections. Mommypotamus, *Natural Remedies for Ear Infections*, <http://www.mommypotamus.com/natural-remedies-for-ear-infections/> (accessed Jan. 31, 2014) [Attachment to Office Action dated 1/31/14 at pages 26, 29-31, 30, 49, and 50] The evidence from Kitchen Stewardship and Whole New Mom describe using drops of oil to cure ear infections. Kitchen Stewardship, *Kid's Ear Infections: A Home Remedy?*, <http://www.kitchenstewardship.com/2010/01/18/kids-ear-infections-a-home-remedy/> (accessed on Jan. 31, 2014) and Whole New Mom, Adrienne, *An Unbelievable Natural Ear Infection Remedy*, <http://wholenewmom.com/health-concerns/natural-treatment-for-ear-infectio/> (accessed on Jan. 31, 2014) [Attachments to Office Action dated 1/31/14 at pages 61-62 and 89] Moreover, even if the precise

wording EAR NATURAL is not widely used to describe applicant's goods, the fact that an applicant may be the first or only user of a merely descriptive designation does not necessarily render a word or term incongruous or distinctive; as in this case, the evidence shows that EAR NATURAL is merely descriptive. See *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012); *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001); TMEP §1209.03(c).

II. IDENTIFICATION

An applicant may only amend an identification to clarify or limit the goods, but not to add to or broaden the scope of the goods. 37 C.F.R. §2.71(a); see TMEP §§1402.06 *et seq.* & 1402.07.

Applicant's original identification claimed "[a] packaging with a dropper that contains limited quantity of mustard oil, for dropping oil drops in the ear canal, for cure of middle ear infection, without use of antibiotics." Applicant agreed to classify the goods in International Class 5 and amended the identification. Although applicant's amendment further clarified how the mustard oil is contained (in a sachet with a dropper) and how it is prepared, applicant impermissibly broadened the scope of the identification by removing the method of use ("dropping oil drops in the ear canal") and removing the limiting language "without the use of antibiotics."

Applicant argues that the goods are the medical devices and not the mustard oil. Because the device contains mustard oil to cure middle ear infections, the essence of the goods is the oil. The fact that they are sold in pre-filled sachets will not change the class. Applicant's arguments that the goods are a medical device are unpersuasive because medical devices are actually in class 10. Here we have a

package, whether described as just a “dropper” or as a “sachet with dropper,” that is sold pre-filled with mustard oil. It is the mustard oil that is the active ingredient and is thus classified by its nature as a preparation (albeit herbal/botanical) for medical purposes in class 5 and not as a device in class 10. For example, syringes sold empty are classified in class 10 as medical devices while syringes filled with a pharmaceutical contained in the syringe are classified in class 5.

CONCLUSION

The examining attorney respectfully submits that the attached evidence and applicant's own description of the goods support the finding that the proposed mark EAR NATURAL is merely descriptive of a characteristic, purpose, or use of the goods— a device that contains oil for use in dropping oil drops in the ear canal and for curing middle ear infections. The examining attorney further submits that applicant's amendment to the identification is impermissible in accordance with 37 C.F.R. §2.71(a) and TMEP Sections 1402.06 *et seq.* and 1402.07 because it is indefinite and beyond the scope of the original identification. For the foregoing reasons, the examining attorney requests that the Trademark Trial and Appeal Board affirm the refusal to register the proposed mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1) and affirm the requirement for an acceptable amendment to the identification of goods.

Respectfully submitted,

/Q Queen/

Examining Attorney

Law Office 111

571-272-6695

Esther.Queen@uspto.gov

Robert L. Lorenzo

Managing Attorney

Law Office 111