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# UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

**U.S. APPLICATION SERIAL NO.** 85937447

**MARK:** LOTUS



**CORRESPONDENT ADDRESS:**

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**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**TTAB INFORMATION:**

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>

**APPLICANT:** Blue Lotus Lifestyle LLC

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

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## EXAMINING ATTORNEY'S APPEAL BRIEF

This is an appeal from a final refusal to register LOTUS (in standard character form) used on "drinking water with vitamins and botanicals." The proposed mark is refused registration under

Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), because it is merely descriptive of a feature of the applicant's goods.

### **STATEMENT OF FACTS**

On 20 May 2013, the applicant applied to register LOTUS ELIXIRS for use on "energy balancing drink" on the Principal Register under Section 1(a) of the Trademark Act. On 5 June 2013, the applicant submitted a preliminary voluntary amendment amending the identification of goods to "rejuvenation drink" and correcting a typographical error in its name. In the first Office Action issued on 16 September 2013, the examining attorney determined that the identification of goods was unacceptable and required an amendment thereof, that the mark on the drawing did not agree with the mark on the specimen, that the term ELIXIRS was to be disclaimed, and that the applicant was to submit information on its goods. On 17 September 2013, an Examiner's Amendment was issued amending the mark to LOTUS and amending the identification of goods to "drinking water with vitamins and botanicals."<sup>1</sup> Upon further review, on 28 October 2013 the examining attorney refused the applied-for-mark under Section 2(e)(1) of the Trademark Act as it presumably identified an ingredient thereof and requested information on the applicant's goods and on the significance of "lotus." Evidence demonstrating the use of various forms of the lotus plant, and parts thereof, as ingredients of beverages was attached therewith. In its response received on 10 February 2014, the applicant stated that "there is some lotus extract in some of the product"<sup>2</sup> and presented arguments and evidence in favor of registration. In the following Office Action issued on 21 March 2014, the refusal under Section 2(e)(1) was made FINAL. The applicant has filed an appeal.

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<sup>1</sup> As the mark was amended to LOTUS, the requirement for a disclaimer of ELIXIRS and the request for information were withdrawn.

<sup>2</sup> Incoming Communication of 10 February 2014, page 1.

## ISSUE ON APPEAL

Whether the applied-for-mark LOTUS when used on “drinking water with vitamins and botanicals” containing lotus extract as an ingredient is merely descriptive.

## ARGUMENT

**LOTUS is merely descriptive because it describes a feature of the applicant’s “drinking water with vitamins and botanicals” as it describes an ingredient thereof, per the applicant’s admission.**

The issue before the Board is whether the applied-for-mark immediately conveys knowledge of a quality, feature, function, or characteristic of [an applicant’s] goods or services. *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b); see *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978)).

Moreover, the determination of whether a mark is merely descriptive is made in relation to an applicant’s goods and/or services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *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); see, e.g., *In re Polo Int’l Inc.*, 51 USPQ2d 1061, 1062-63 (TTAB 1999) (finding DOC in DOC-CONTROL would refer to the “documents” managed by applicant’s software rather than the term “doctor” shown in a dictionary definition); *In re Digital Research Inc.*, 4 USPQ2d 1242, 1243-44 (TTAB 1987) (finding

CONCURRENT PC-DOS and CONCURRENT DOS merely descriptive of “computer programs recorded on disk” where the relevant trade used the denomination “concurrent” as a descriptor of a particular type of operating system). “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).

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant’s goods and/or services. 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)). In applying this standard to the applied-for-mark, it is clear that the term is merely descriptive. LOTUS forthwith describes an ingredient of the applicant’s “drinking water with vitamins and botanicals,” per the applicant’s admission<sup>3</sup> -- drinking water with vitamins and botanicals of all types and in all forms, including extracts of lotus. As set forth in the application, in the absence of any restriction regarding the vitamins and botanicals included in the applicant’s drinking water, the goods are presumed to encompass drinking water with vitamins and botanicals of all kinds and in all forms, including drinking water with lotus flowers in the form of lotus extracts. *See In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660 (TTAB 1988). Consequently, the presumption that the applicant’s drinking water consisting of vitamins and botanicals includes lotus flowers/botanicals and extracts thereof was not made in error, as the applicant asserts.

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<sup>3</sup> Incoming Communication of 10 February 2014, page 1.

The applicant's statement that there is some lotus extract in some of the products is sufficient to support the merely descriptive refusal with respect to the applied-for-mark LOTUS. Nevertheless, the evidence of record reinforces the instant determination and clearly establishes that the word "lotus" is merely descriptive of the applicant's goods. Specifically, the dictionary definition of "lotus" of record consists of the following definition: "a type of flowering plant that grows on the surface of water."<sup>4</sup> Moreover, the examining attorney has made of record evidence demonstrating that parts of the lotus flower, or extracts thereof, are used as ingredients in beverages of all types. The evidence, in part, consists of the following:

In addressing the benefits of the lotus flower and its leaves, an article entitled *Organic Herbs And Tea.com Because nature's way is the best way!* explains that the lotus leaves can be used in various manners in addition to making tea by stating that the "Lotus leaves are collected twice a year in the summer and fall. When they are collected some are dried and some are processed into an herbal extract"

Promotional material for VIVA ZEN, a new energy muscle replenishing supplement drink, in which white lotus is identified as an ingredient thereof

Promotional material for Japan's Tsubaki Perfect Beauty Drink lists Lotus seed germ extract as ingredient thereof

Material on Regulating Blood System Supplement manufactured by Wuhan Jiushengtang Bioengineering Co., Ltd. lists lotus leaf as a main ingredient thereof.<sup>5</sup>

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<sup>4</sup> Dictionary definition of "lotus" submitted with the applicant's incoming communication of 10 February 2014, page 16.

<sup>5</sup> Office Action issued on 28 October 2013.

Consequently, the applicant's statement identifying extracts of lotus as an ingredient of its drinking water along with the evidence of record directly contradict its assertion that the record is devoid of any evidence that the term "lotus" describes a feature of the instant goods.

The average prospective purchaser, from whose standpoint the issue of descriptiveness must be decided, *In re Abcor Development Corp.*, 200 USPQ 215 (CCPA 1978), would view LOTUS and would immediately understand that the applicant's "drinking water with vitamins and botanicals" contains botanical components or extracts thereof of all types, including lotus extract. In fact the instant drinking water contains lotus extract, or "a substance that has been taken from the lotus plant."<sup>6</sup> -- per the applicant's admission of "there is some lotus extract in some of the products." A term that describes an ingredient of the goods is merely descriptive. TMEP §1209.01(b); see *In re Keebler Co.*, 479 F.2d 1405, 178 USPQ 155 (C.C.P.A. 1973) (holding RICH 'N CHIPS merely descriptive of chocolate chip cookies); *In re Andes Candies Inc.*, 478 F.2d 1264, 178 USPQ 156 (C.C.P.A. 1973) (holding CREME DE MENTHE merely descriptive of candy); *In re Entenmann's, Inc.*, 15 USPQ2d 1750 (TTAB 1990) (holding OATNUT merely descriptive of bread containing oats and hazelnuts), *aff'd per curiam*, 928 F.2d 411 (Fed. Cir. 1991); *Flowers Indus., Inc. v. Interstate Brands Corp.*, 5 USPQ 2d 1580 (TTAB 1987) (holding HONEY WHEAT merely descriptive of bread containing honey and wheat); *In re Int'l Salt Co.*, 171 USPQ 832 (TTAB 1971) (holding CHUNKY CHEESE merely descriptive of cheese flavored salad dressing).

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<sup>6</sup> *MacMillan Dictionary*© Macmillan Publishers Limited 2009–2014. The TTAB is respectively requested to take judicial notice of the attached dictionary definition of "extract." See *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988); *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111 (Fed. Cir. 1983); *In re Analog Devices, Inc.*, 6 USPQ2d 1808 (TTAB 1988); affirmed in unpublished opinion, 10 USPQ2d 1879 (Fed. Cir. 1989); and *In re Anonia Associates, Inc.*, 223 USPQ 740 (TTAB 1984).

Yet despite the applicant's statement that "there is some lotus extract in some of the products," the evidence of record substantiating that lotus extract is often used as an ingredient in different types of beverages, the applicant argues that its applied-for-mark LOTUS is not descriptive when used on "drinking water with vitamins and botanicals" containing lotus extract as an ingredient for the following reasons: (1) LOTUS is arbitrary, (2) the existence of a number of registered marks including the term "lotus" establishes that this term has been treated as inherently distinctive of the respective goods or services, and (3) in order to maintain consistency in Office practice, the applicant's ownership of the registered mark BLUE LOTUS LIFESTYLE<sup>7</sup> establishes the term "lotus" alone as inherently distinctive. These arguments are not persuasive for the following reasons.

Contrary to the applicant's assertion, there is nothing vague about the use of the term "lotus" when used on drinking water containing lotus extract, thereby rendering the use of this term on the instant goods arbitrary. The test is not as the applicant suggests whether LOTUS creates an instant association with drinking water, or whether LOTUS automatically causes a consumer to think of drinking water, or even whether the term identifies the type of goods provided and their function. The test is simply whether LOTUS identifies an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods. For the reasons enumerated above, it is clear that because LOTUS describes an ingredient of the applicant's drinking water it is merely descriptive.

The applicant's argument that the term LOTUS was chosen because of its iconic symbol and the spirituality and philosophy that it invokes, and not because of a specific ingredient fails to obviate the merely descriptive nature of this term when used on the instant goods -- beverages that will have some lotus extract as an ingredient. The fact that a term may have different meanings in a context other than that relevant to the identified goods is not controlling on the question of

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<sup>7</sup> U.S. Registration No. 3714881, registered on 24 November 2009 for use on "energy drinks."

descriptiveness. *In re Bright-Crest, Ltd.* 204 USPQ 5891 (TTAB 1979). 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).

In other words, when consumers are faced with several possible meanings associated with the term “lotus” they will select the meaning that makes the most sense given the goods with which it is used in connection. In this instance, consumers are most likely to understand “lotus” to mean “a type of flowering plant that grows on the surface of water.”<sup>8</sup> As the applicant’s “drinking water with vitamins and botanicals” will have some lotus extract, they will understand it is identifying an ingredient therein. As the applicant has expressly stated that there is some lotus extract in the applicant’s products, it is difficult to imagine, as the applicant suggests, that consumers of its goods will understand the word “lotus” alone as meaning something other than an ingredient therein. No imagination, thought or perception must be exercised in order to reach a conclusion that LOTUS identifies an ingredient of the goods.

The applicant argues that the use of LOTUS on the instant goods is no less arbitrary than the use of AMAZON in connection with online retail store services based in California despite its significance as a geographic or potentially otherwise descriptive reference to a major region and river in the world. The facts at issue in this instance are however distinguishable. In this instance, the record clearly identifies that the applicant’s goods contain lotus extract. This fact is not presumed. The applicant’s statement identifying lotus extract as an ingredient is sufficient to establish that LOTUS when used on drinking water containing lotus extract is merely descriptive of an ingredient thereof.

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<sup>8</sup> Dictionary definition of “lotus” submitted with the applicant’s incoming communication of 10 February 2014.

Furthermore, the fact that the applicant states that there is some lotus extract in *some* of the products also fails to obviate the merely descriptive meaning of LOTUS when used on the instant goods. “A mark does not need to be merely descriptive of all the goods or services specified in an application. *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Franklin Cnty. Historical Soc’y*, 104 USPQ2d 1085, 1089 (TTAB 2012). “A descriptiveness refusal is proper ‘if the mark is descriptive of any of the [goods or] services for which registration is sought.’” *In re The Chamber of Commerce of the U.S.*, 675 F.3d at 1300, 102 USPQ2d at 1219 (quoting *In re Stereotaxis Inc.*, 429 F.3d 1039, 1040, 77 USPQ2d 1087, 1089 (Fed. Cir. 2005)).

The applicant’s argument that the existence of a number of registered marks including the term “lotus” establishes that this term has been treated as inherently distinctive of the respective goods or services fails to be persuasive. First, the fact that third-party registrations exist for marks allegedly similar to applicant’s mark is not conclusive on the issue of descriptiveness. *See In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977); TMEP §1209.03(a). An applied-for mark that is merely descriptive does not become registrable simply because other seemingly similar marks appear on the register. *In re Scholastic Testing Serv., Inc.*, 196 USPQ at 519; TMEP §1209.03(a). Second, the wording BLUE LOTUS CHAI has been disclaimed in U.S. Registration No. 4200886. This is consistent with the treatment in this instance – treating the term “lotus” as descriptive because it identifies an ingredient of the goods on which the word is used. And finally, the remaining referenced registrations, for the most, part include additional wording that serves to obviate the descriptive meaning of “lotus” as an ingredient and/or presumably do not have records that establish that the registered marks are used on goods/services that incorporate lotus, or extracts of lotus, as an ingredient thereof. Such is not the case in this instance. The instant record establishes that the applicant’s drinking water contains some lotus extract. As such, the use of LOTUS on the applicant’s drinking water is merely descriptive of an ingredient thereof.

Finally, the applicant argues that maintaining consistency in Office practice mandates registration of the instant applied-for-mark LOTUS in light of its ownership of the registered mark BLUE LOTUS LIFESTYLE. This argument also fails to be persuasive. Contrary to the applicant's assertion, its ownership of the prior registration does not establish the sole term "lotus" as inherently distinctive when used on drinking water containing lotus extract. Without additional wording or design element(s), the word "lotus" simply identifies the lotus botanical, or extract thereof. However, BLUE LOTUS LIFESTYLE communicates a different commercial impression, that of a lifestyle that is governed by the iconic symbol and the spirituality and philosophy of the "blue lotus." This is entirely different from the commercial impression created by the word "lotus" alone. As such, the applicant's ownership of the registered mark BLUE LOTUS LIFESTYLE is not inconsistent with the determination that the proposed mark in this instance, comprised solely of the term "lotus," is merely descriptive.

Moreover, it is well settled that each case must be decided on its own facts and the Trademark Trial and Appeal Board is not bound by prior decisions involving different records. *See In re Nett Designs, Inc.*, 236 F. 3d 1339, 1342, 57 USPQ2d 1564, 1566 ( Fed. Cir. 2001); *In re Lean Line, Inc.*, 229 USPQ 781, 783 (TTAB 1986); TMEP §1209.03(a). The question of whether a mark is merely descriptive is determined based on the evidence of record at the time each registration is sought. *In re theDot Commc'ns Network LLC*, 101 USPQ2d 1062, 1064 (TTAB 2011); TMEP §1209.03(a); *see In re Nett Designs, Inc.*, 236 F.3d at 1342, 57 USPQ2d at 1566.

And finally, the applicant argues that any doubt regarding the mark's descriptiveness should be resolved on applicant's behalf. *E.g., In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1571 4 USPQ2d 1141, 1144 (Fed. Cir. 1987); *In re Grand Forest Holdings, Inc.*, 78 USPQ2d 1152,

1156 (TTAB 2006). However, in the present case, the evidence of record leaves no doubt that the mark is merely descriptive.

### **CONCLUSION**

For the reasons stated above and for those stated in the Office Actions of 28 October 2013 and 21 March 2014, registration of LOTUS (in standard character form) is refused because it identifies a feature of the applicant's "drinking water with vitamins and botanicals" by describing an ingredient thereof. Thus, the proposed mark is merely descriptive of the applicant's "drinking water with vitamins and botanicals." The examining attorney therefore respectfully requests the Board to affirm the refusal to register the proposed mark LOTUS (in standard character form) under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

Respectfully submitted,

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