

From: Struck, Robert

Sent: 2/10/2016 10:24:42 AM

To: TTAB EFiling

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 86009795 - THC ENERGY - N/A - EXAMINER BRIEF

Attachment Information:

Count: 1

Files: 86009795.doc

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86009795

MARK: THC ENERGY



CORRESPONDENT ADDRESS:

LUKE BREAN

BREANLAW LLC

PO BOX 4120

PORTLAND, OR 97208-4120

GENERAL TRADEMARK INFORMATION:

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

TTAB INFORMATION:

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

APPLICANT: Hinton, Christopher C.

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

tmsupport@breanlaw.com

EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

Applicant has appealed the Trademark Examining Attorney's final refusal to register the trademark THC ENERGY for "Energy drinks" on the ground that the mark is deceptively misdescriptive of a feature of the identified goods, Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1). It is respectfully requested that the refusal be affirmed.

STATEMENT OF FACTS

The applicant filed the instant application on July 14, 2013, to register the mark, THC ENERGY, for “Energy drinks.”

In the initial Office action dated August 15, 2013, the Examining Attorney required applicant to submit additional information and provide a disclaimer.

Applicant responded on February 13, 2014, and provided additional information and submitted a disclaimer.

On March 9, 2014, the Examining Attorney issued a second non-final Office action requiring applicant to submit additional information.

Applicant responded on September 10, 2014, provided the required information and amended the filing basis.

On November 6, 2014, the Examining Attorney¹ issued a subsequent non-final Office action refusing registration because the mark is deceptively misdescriptive of the identified goods, Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1).

Applicant submitted a response to the outstanding Office action on March 6, 2015, arguing against the refusal of registration.

On April 13, 2015, the Examining Attorney issued a final Office action maintaining the deceptively misdescriptive refusal.

On December 10, 2015, the applicant submitted its appeal brief, and the file was forwarded to the Examining Attorney on December 12, 2015.

ISSUE

The issue on appeal is whether the mark is deceptively misdescriptive of the identified goods under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1).

ARGUMENTS

¹ Prior to issuance of this Office action, the present application was reassigned to the current Examining Attorney.

THE APPLICANT'S MARK IS DECEPTIVELY MISDESCRIPTIVE IN CONNECTION WITH THE GOODS FOR WHICH THE MARK IS USED.

The applicant's mark is deceptively misdescriptive of the identified goods. The test for determining whether a mark is deceptively misdescriptive has two parts: (1) whether the mark misdescribes the goods and/or services; and if so, (2) whether consumers are likely to believe the misrepresentation. See *In re White Jasmine LLC*, 106 USPQ2d 1385, 1394 (TTAB 2013) (citing *In re Quady Winery, Inc.*, 221 USPQ 1213, 1214 (TTAB 1984)); TMEP §1209.04.

I. The proposed mark misdescribes features and ingredients of the applicant's goods.

The applicant's mark is misdescriptive of energy drinks that do not contain THC. A mark is misdescriptive when the mark merely describes a significant aspect of the goods and/or services that the goods and/or services could plausibly possess but in fact do not. See *In re Schniberg*, 79 USPQ2d 1309, 1312 (TTAB 2006); *In re Phillips-Van Heusen*, 63 USPQ2d 1047, 1048 (TTAB 2005); see TMEP §1209.04. To be merely descriptive, a mark must immediately convey knowledge of a quality, feature, function, or characteristic of an applicant's goods or services. See *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).

The Merriam-Webster Online Dictionary defines THC as “either of two physiologically active isomers C₂₁H₃₀O₂ from hemp plant resin; especially: one that is the chief intoxicant in marijuana.”² The term ENERGY means “a fundamental entity of nature that is transferred between parts of a system in the production of physical change within the system and usually regarded as the capacity for doing work”³ and “The capacity for work or vigorous activity.”⁴

When combined, these terms merely describe energy drinks that contain THC. Generally, if the individual components of a mark retain their descriptive meaning in relation to the goods and/or services, the combination results in a composite mark that is itself descriptive and not registrable. In re Phoseon Tech., Inc., 103 USPQ2d 1822, 1823 (TTAB 2012); TMEP §1209.03(d); see, e.g., In re Cannon Safe, Inc., 116 USPQ2d 1348, 1351 (TTAB 2015) (holding SMART SERIES merely descriptive of metal gun safes, because “each component term retains its merely descriptive significance in relation to the goods, resulting in a mark that is also merely descriptive”); In re King Koil Licensing Co., 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs, and pillows where the evidence showed that the term “BREATHABLE” retained its ordinary dictionary meaning when combined with the term “MATTRESS” and the resulting combination was used in the relevant industry in a descriptive sense); In re Associated Theatre Clubs Co., 9 USPQ2d 1660, 1663 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services, because such wording “is nothing more than a combination of the two common descriptive terms most applicable to applicant’s services which in combination achieve no different status but remain a common descriptive compound expression”).

² See TICRS pages 2-5 of the Office action dated November 6, 2014.

³ See TICRS pages 6-11 of the Office action dated November 6, 2014.

⁴ See TICRS pages 4-5 of the final Office action dated April 13, 2015.

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods and/or services is the combined mark registrable. See *In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013).

The previously attached evidence from Hemp.org demonstrates that consumers have encountered and are familiar with energy drinks that contain THC and marijuana. Indeed, this website contains information on a new product and states, “5 Hour High’ Cannabis Energy Drink Announced” and “5 Hour High is a shot-style drink, similar to the energy drinks found in convenience stores – with one big difference. This juice-like drink delivers a dose of THC, marijuana’s main psychoactive ingredient.”⁵

Likewise, the previously attached evidence from Examiner.com, MMJBusinessDaily.com, and Whaxy.com further demonstrates that energy drinks containing cannabis and THC are produced, available for sale, or soon to be brought to market. Examiner.com states, “There is only one legal marajuana (sic) energy drink in this country, put out by Keef Cola, a great company who’s (sic) energy drink contains a full supply of vitamin C, no alcohol, electrolytes and a good deal of THC along with your caffeine dosage too.”⁶ MMJBusinessDaily.com asserts, “Other new offerings are on the horizon, including a tonic (aka energy drink) that will come in two-ounce bottles and contain 60 milligrams (!!!) of active THC and cannabinoids.”⁷ Finally, Whaxy.com states, “One of the Keef Cola beverages – Flo Energy

⁵ See TICRS page 12 of the Office action dated November 6, 2014.

⁶ See TICRS page 16 of the Office action dated November 6, 2014.

⁷ See TICRS page 20 of the Office action dated November 6, 2014.

Drink – contains caffeine, ginseng, taurine and guarana extract on top of the 50 mg of CO2 extracted cannabis in a 12 ounce, one-serving bottle.”⁸

Lastly, the term ENERGY merely describes drinks that provide energy. Applicant has not provided any argument that this term is not descriptive of energy drinks. Indeed, applicant has conceded that this term is descriptive and has provided a disclaimer of the term ENERGY.⁹

The combination of the descriptive terms THC and ENERGY does not create a separate and distinct meaning but rather merely describes energy drinks that contain THC. As demonstrated above, it is plausible that energy drinks would be made with cannabis and contain THC. However, in this case, applicant contends that its energy drinks “absolutely (do) not contain THC.”¹⁰ By applicant’s own concession, the proposed mark is misdescriptive of the goods listed in the application.

II. THC does not have any other meanings when used in connection with energy drinks.

Contrary to applicant’s assertions, the term THC does not have any other meanings. Applicant contends that the wording THC stands for “tea honey care.”¹¹ However, applicant has not provided any argument or evidence to support its assertion. Nor has applicant provided any evidence that THC would be recognized in the industry or by consumers as meaning “tea honey care” with respect to energy drinks.

⁸ See TICRS pages 8-11 of the final Office action dated April 13, 2015.

⁹ See Applicant’s Response to Office Action filed on February 13, 2014.

¹⁰ See page 3 of Applicant’s Brief.

¹¹ *Id.*

Indeed, applicant's specimen does not contain any reference to this intended meaning and does not convey the contended alternative meaning.¹² The applicant's goods are merely identified as THC ENERGY.¹³

Moreover, the previously attached definition of THC states, "either of two physiologically active isomers C₂₁H₃₀O₂ from hemp plant resin; *especially*: one that is the chief intoxicant in marijuana."¹⁴ This definition clearly indicates that the term THC has only one recognized meaning. Indeed, the evidence of record clearly shows that THC, for energy drinks, has one recognized meaning, namely, energy drinks containing tetrahydrocannabinol, the chief intoxicant in marijuana.¹⁵

III. Consumers are likely to believe the misrepresentation.

Consumers are likely to believe the misrepresentation because cannabis and items containing cannabis have been legalized in some form in 23 states and the District of Columbia.¹⁶ The Trademark Act does not prohibit the registration of misdescriptive terms unless consumers who encounter the mark are likely to believe the misrepresentation. *Binney & Smith Inc. v. Magic Marker Indus., Inc.*, 222 USPQ 1003 (TTAB 1984); TMEP §1209.04.

¹² See TICRS page 3 of the initial application filed on July 14, 2013.

¹³ *Id.*

¹⁴ See TICRS pages 2-5 of the Office action dated November 6, 2014.

¹⁵ See *e.g.* TICRS pages 12-21 of the Office action dated November 6, 2014, and TICRS pages 6-16 of the final Office action dated April 13, 2015.

¹⁶ See TICRS pages 17-39 of the final Office action dated April 13, 2105.

While cannabis and items containing cannabis remain unlawful under Federal law, consumers are able to purchase cannabis, as well as energy drinks containing cannabis and THC, for both medical and recreational use in certain states and the District of Columbia. Applicant asserts, “THC, the controlled substance, is not used in any energy drink anywhere as the recreational use of THC is related to its mind altering qualities and calming effects.”¹⁷ However, the previously attached evidence from MMJMenu.com shows a commercially-available cannabis energy drink called Canna Energy described as “THC Energy drink, Mango flavor.”¹⁸ Likewise, the previously attached evidence from BudTender.com describes an energy drink called Cannapunch Mota Energy and states, “THC Infused energy drink in Citrus Blast flavor.”¹⁹

Contrary to applicant’s assertion, the average consumer may legitimately believe that energy drinks containing marijuana and THC are being offered for sale legally. Most consumers are not versed in conflict of laws and may believe that THC energy drinks are lawful because they have been approved on the state level. Moreover, consumers who have access to recreational marijuana may encounter THC energy drinks in grocery stores, gas stations, coffee shops and other places where energy drinks are sold.

Consumers are likely to believe the misrepresentation because goods that contain cannabis and THC are lawful under local laws and available in some areas.

¹⁷ See page 5 of Applicant’s Brief.

¹⁸ See TICRS page 12 of the final Office action dated April, 13, 2015.

¹⁹ See TICRS pages 14-16 of the final Office action dated April, 13, 2015.

MATERIALITY DOES NOT HAVE TO BE SHOWN FOR THE MARK TO BE DECEPTIVELY MISDESCRIPTIVE.

Applicant incorrectly contends that, as part of a prima facie case, the Examining Attorney must demonstrate that the misrepresentation is likely to affect a significant portion of the relevant consumers' decision to purchase the goods.²⁰

This contention, however, is not correct. As stated previously, the test for determining whether a mark is deceptively misdescriptive has two parts: (1) whether the mark misdescribes the goods and/or services; and if so, (2) whether consumers are likely to believe the misrepresentation. See *In re White Jasmine LLC*, 106 USPQ2d 1385, 1394 (TTAB 2013) (citing *In re Quady Winery, Inc.*, 221 USPQ 1213, 1214 (TTAB 1984)); TMEP §1209.04. Here, the proposed mark merely describes energy drinks that contain THC. Applicant asserts that its goods do not contain THC. And the evidence of record demonstrates that the misrepresentation is believable because energy drinks containing THC are available in certain markets where marijuana has been legalized. The applicant's mark is deceptively misdescriptive.

It is not necessary to demonstrate that the presence of THC in energy drinks is material or likely to affect a significant portion of the relevant consumers' decision to purchase the energy drinks.

CONCLUSION

²⁰ See page 3 of the Applicant's Brief.

As shown by the evidence in the record, it is plausible that energy drinks contain THC. Applicant has indicated that its goods do not contain THC. Accordingly, the proposed mark misdescribes applicant's goods. Because goods containing THC are lawful under local laws and available in some states and the District of Columbia, consumers are likely to believe the misrepresentation. For the foregoing reasons, it is respectfully submitted that the refusal of registration under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), be affirmed.

Respectfully submitted,

/Robert J. Struck/

Robert J. Struck

Trademark Examining Attorney

Law Office 109

Robert.Struck@uspto.gov

571-272-1513

Michael Kazazian

Managing Attorney

Law Office 109