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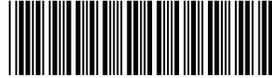
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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

U.S. APPLICATION SERIAL NO. 86506207

MARK: E



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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: Gulf Coast Pharmacy, Inc.

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EXAMINING ATTORNEY'S APPEAL BRIEF

Applicant, Gulf Coast Pharmacy, Inc., appeals the examining attorney's refusal to register the mark "É" for dietary and nutritional supplements. The examining attorney refused registration under Section 2(a) of the Trademark Act, 15 U.S.C. Section 1052(a), on the ground that the mark includes matter that is deceptive in relation to the goods. Alternately, the examining attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1), because the mark is deceptively misdescriptive of the goods.

I. FACTS

On January 16, 2015, applicant applied to register the stylized mark “É” for “dietary and nutritional supplements” in International Class 5. The examining attorney required a disclaimer of the letter “E,” requested additional information about the goods, and required applicant to amend its identification of goods to indicate that the goods contain vitamin E as an ingredient, if accurate, to avoid a deceptiveness refusal. In its response, applicant indicated that the goods do not contain vitamin E as an ingredient. The examining attorney then refused registration under Trademark Act Sections 2(a), on the grounds that the proposed mark contains matter that is deceptive in relation to the goods. The examining attorney also issued a deceptively misdescriptive refusal under Section 2(e)(1) in the alternative. This appeal follows the examining attorney’s final refusal.

II. ISSUES ON APPEAL

The issues on appeal are (1) whether the letter “É” in the mark is deceptive in relation to the identified goods pursuant to Trademark Act Section 2(a), 15 U.S.C. §1052(a) and alternatively, (2) whether the letter “É” in the mark is deceptively misdescriptive of applicant’s goods pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1).

III. TRADEMARK ACT SECTION 2(a) DECEPTIVE REFUSAL ARGUMENT

A mark is deceptive if the following criteria are met:

- (1) The applied-for mark consists of or contains a term that misdescribes the character, quality, function, composition, or use of the goods.
- (2) Prospective purchasers are likely to believe that the misdescription actually describes the goods.
- (3) The misdescription is likely to affect a significant portion of the relevant consumers’ decision to purchase the goods.

See *In re Budge*, 857 F.2d at 775, 8 USPQ2d at 1260; *In re White Jasmine LLC*, 106 USPQ2d 1385, 1391-92 (TTAB 2013); TMEP §1203.02(b); see also *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1353, 1356, 90 USPQ2d 1489, 1492-93, 1495 (Fed. Cir. 2009) (holding that the test for materiality incorporates a requirement that a “significant portion of the relevant consumers be deceived”).

Additionally, use of a term that is the phonetic equivalent of a deceptive term is also deceptive. *Tanner’s Council of Am., Inc. v. Samsonite Corp.*, 204 USPQ 150, 154 (TTAB 1979). Marks that are deceptive under §2(a) are not registrable on either the Principal Register or on the Supplemental Register under any circumstances. TMEP § 1209.04.

A. The applied-for mark contains a term that misdescribes the character, quality, and composition of the goods

The applicant’s mark contains the stylized letter “É,” which will indicate to consumers that the goods contain vitamin E as an ingredient. “Vitamin E” is defined as “any of several fat-soluble vitamins consisting of tocopherols, especially alpha-tocopherols, that are found chiefly in vegetable oils, nuts, and seeds, wheat germ, leafy green vegetables, and milk and act as antioxidants in the body” (See definition from *The American Heritage Dictionary of the English Language*, attached at p. 2 of the April 27, 2015 Office action).

Vitamin E is a common ingredient in nutritional and dietary supplements, and supplements that contain vitamin E are commonly marked with a prominent capital letter “E.” The following evidence demonstrates this use:

- An informational website featuring information about supplements and herbs at www.drweil.com which states, “Dr. Weil recommends supplementing with vitamin E that provides a minimum daily dose of 80 mg of the whole complex, including mixed tocopherols and mixed tocotrienols.” (See June 9, 2015 Office action, pp. 5-7, p. 6)

- An informational website about drugs and supplements available from www.mayoclinic.org that features general information about vitamin E and states “Vitamin E supplements are available in natural or man-made forms.” (See June 9, 2015 Office action, pp. 8-9, p. 8)
- A screenshot showing nearly thirty types of vitamin E supplements for sale on the internet via www.google.com’s shopping feature (See June 9, 2015 Office action, pp. 11-14)
- An example of one such supplement, namely, Solgar® Natural Vitamin E supplements containing 400 IU of vitamin E per softgel, for sale at www.iherb.com (See June 9, 2015 Office action, pp. 15-19, p. 15)

In its response dated May 4, 2015, applicant responded to the examining attorney’s information request by stating that the goods do not, in fact, contain vitamin E. Accordingly, the letter “É” appearing in applicant’s mark misdescribes a character, quality and composition of the goods, namely, that the goods contain vitamin E.

B. Prospective purchasers are likely to believe that the misdescription actually describes the goods

Prospective purchasers are likely to believe that the misdescription actually describes the goods because “E” is a generic term widely used by the dietary and nutritional supplement industry and the supplement-consuming public to refer to vitamin E, or to medicinal products that contain vitamin E. The following evidence of record demonstrates use of the letter “E” by others for dietary and nutritional supplements and other similar medicinal products that contain vitamin E. This appears to be true even when the “E” appearing on the goods is stylized. Like applicant’s proposed mark, all of the following examples show a stylized letter “E” appearing on packaging for vitamin E supplements and medicinal products:

- 4 SPECTRUM Natural Vitamin E Complex, a supplement containing “natural” vitamin E, with a label that features a large capital letter “E” in red block lettering surrounded by a stylized circle (See July 27, 2015 Office action, pp. 2-11, p. 2)

- UNIQUE E dietary supplement that contains “mixed tocopherols” (vitamin E), with packaging that features a large capital letter “E” in green block lettering covering the bottle (See July 27, 2015 Office action, pp. 12-14)
- DHC supplements that contain vitamin E, with packaging showing a prominent capital letter “E” surrounded by a blue circle (See July 27, 2015 Office action, pp. 15-16)
- MYRA e capsules that contain vitamin E, with packaging featuring a stylized letter “e,” as well as an image showing the letter “E” being stamped on the capsules themselves (See July 27, 2015 Office action, p. 17)
- SUPER E natural vitamin E ointment, with a large capital “E” in a stylized square featured prominently on the packaging (See July 27, 2015 Office action, pp. 18-19)
- DERMA e, a vitamin E topical cream with packaging featuring a conspicuous stylized letter “e,” (See July 27, 2015 Office action, pp. 24-25)

Thus, because consumers are accustomed to seeing the letter “E” displayed prominently on products that contain vitamin E, they will likely believe that applicant’s supplements bearing the applied-for mark contain vitamin E.

i. The degree of stylization of the proposed mark would not dissuade consumers from believing the goods contain vitamin E

Applicant argues that the applied-for mark’s degree of stylization, which comprises the stylized “É”, an arrow design and an accent aigu contained within a blue circle, is such that consumers would not be deceived into believing the goods actually contain vitamin E. Applicant further states its proposed mark “would simply be seen as a logo (and in fact it is associated with its ‘Elan’ mark that uses an identical ‘E’).” (See Applicant’s Brief at p. 2)

These arguments are unconvincing. First, the examining attorney notes that a mark is deceptive even if only a portion of the mark is deceptive. See *Am. Speech-Language-Hearing Ass’n v. Nat’l Hearing Aid Soc’y*, 224 USPQ 798, 808 (TTAB 1984). Trademark Act Section 2(a) prohibits registration of

deceptive matter, not merely deceptive marks. See *In re White Jasmine LLC*, 106 USPQ2d 1385, 1391 (TTAB 2013); TMEP §1203.02.

The letter “E” is arguably separable from other design elements in the applied-for mark. Though applicant’s mark is comprised of a letter “E” topped with an accent aigu and a stylized arrow on the middle cross mark of the letter, all contained within a blue circle carrier, the letter “E” alone is clearly the dominant portion of the mark. What’s more, “E” and “É” standing alone are phonetic equivalents, and consumers will call for the goods by simply saying “E,” or in phonetic terms, “eee.” Further, consumers will likely assume the accent aigu, the arrow and the colored circle carrier are merely surplus design elements, meant solely to distinguish applicant’s vitamin E supplements from other vitamin E supplements on the market.

Next, even if consumers associate the proposed mark “É” with applicant’s mark “ÉLAN” (pending Application Serial No. 86506204), this fact would be irrelevant. Explanatory matter appearing elsewhere, such as on applicant’s specimen or on other evidence of use (such as another trademark), does not serve to overcome deceptiveness in a mark. *In re E5 LLC*, 103 USPQ2d 1578, 1581 (TTAB 2012); see *In re Budge Mfg. Co.*, 857 F.2d 773, 776, 8 USPQ2d 1259, 1261 (Fed. Cir. 1988). The statute bars registration of a mark comprising deceptive matter; thus, the mark standing alone must pass muster. *In re Budge Mfg. Co.*, 857 F.2d at 776, 8 USPQ2d at 1261; see *In re E5 LLC*, 103 USPQ2d at 1581.

In sum, when seeing the proposed stylized mark “É” appearing on dietary and nutritional supplements, consumers are much more likely to believe that the goods actually contain vitamin E as an ingredient than they are to believe the proposed mark is merely “a logo.”

C. The misdescription is likely to affect a significant portion of the relevant consumers’ decision to purchase the goods

A misdescriptive ingredient would be material to the purchasing decision of a significant portion of the relevant consumers when the evidence demonstrates that the misdescription would make the product more appealing or desirable to prospective purchasers. See *In re White Jasmine LLC*, 106 USPQ2d at 1392 (citing *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1698-99 (TTAB 1992)); TMEP §1203.02(d).

In this case, the ingredient vitamin E is important to a significant portion of the relevant consumers' purchasing decision because significant health benefits are associated with vitamin E. Such health benefits include strong immunity, healthy skin and eyes, and the purported prevention and treatment of many health conditions, including vitamin E deficiency, heart disease, cancer, Alzheimer's disease, diabetes, etc. (See pages from www.webmd.com which provide an overview of the benefits of vitamin E, attached at pp. 4-6 of the April 27, 2015 Office action). The following additional evidence of record demonstrates the numerous desirable characteristics of vitamin E:

- The evidence of record from www.drweil.com identifies the following attributes and benefits of vitamin E:
 - (1) "Vitamin E is a powerful, fat-soluble antioxidant that helps protect cell membranes against damage caused by free radicals and prevents the oxidation of LDL cholesterol."
 - (2) "Vitamin E is necessary for structural and functional maintenance of skeletal, cardiac and smooth muscle."
 - (3) "It [vitamin E] may have a positive effect on immune health, protect against the oxidative damage that can lead to heart disease, have preventative effects against cancer, help relieve symptoms of Alzheimer's disease, and may help prevent some diabetes-related damage, particularly to the eyes."

(See June 9, 2015, Office action, pp. 5-7)

- The evidence of record from www.webmd.com, which identifies the following additional attributes and benefits of vitamin E:

- (1) "Some people use vitamin E for treating and preventing diseases of the heart and blood vessels including the hardening of the arteries, heart attack, chest pain, leg pain due to blocked arteries, and high blood pressure."
- (2) "Vitamin E is also used for treating diabetes and its complications. It is used for preventing cancer, particularly lung and oral cancer in smokers; colorectal cancer and polyps; and gastric, prostate and pancreatic cancer."
- (3) "Some people use vitamin E for diseases of the brain and nervous system including Alzheimer's disease and other dementias, Parkinson's disease, night cramps, restless leg syndrome, and for epilepsy, along with other medications. Vitamin E is also used for Huntington's chorea, and other disorders involving nerves and muscles."
- (4) "Women use vitamin E for preventing complications in late pregnancy due to high blood pressure (pre-eclampsia), premenstrual syndrome (PMS), painful periods, menopausal syndrome, hot flashes associated with breast cancer, and breast cysts."
- (5) "Vitamin E is sometimes used for improving physical endurance, increasing energy, reducing muscle damage after exercise, and improving muscle strength."

(See June 9, 2015, Office action, pp. 2-4)

- "Natural Vitamin E is an essential nutrient and is the body's primary, fat-soluble antioxidant. Vitamin E provides nutritional support for the cardiovascular system, skin, prostate, and the immune system. It helps fight cell-damaging free radicals that cause oxidative stress in the body, which may contribute to the premature aging of cells." (See June 9, 2015, Office action, pp. 15-17, p. 16)
- "Natural Vitamin E and other antioxidants protect the cells of the body from the effects of free radicals, the potentially damaging by-products of the body's metabolism. Free radicals have been known to cause cell damage which can contribute to the development of circulatory problems, even cancer." (See July 27, 2015 Office action, pp. 2-11, p. 2)

Because of the numerous potential health benefits of taking vitamin E, whether or not a supplement contained vitamin E as an ingredient would clearly affect a significant portion of the relevant consumers' decision to purchase such goods. Put another way, a supplement that includes vitamin E as an ingredient would be much more desirable to prospective purchasers looking to treat or prevent any of the health conditions listed above. As such, use of the proposed mark consisting of the stylized letter "É" on dietary and nutritional supplements that do not contain vitamin E is deceptive, and the applied-for mark cannot proceed to registration on either the Principal or Supplemental Registers.

IV. ALTERNATIVE TRADEMARK ACT SECTION 2(e)(1) DECEPTIVELY MISDESCRIPTIVE REFUSAL ARGUMENT

In the alternative, registration was refused under Trademark Act Section 2(e)(1) because the applied-for mark is deceptively misdescriptive of applicant's goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); see *In re Hinton*, 116 USPQ2d 1051, 1051-52 (TTAB 2015) (holding THCTea deceptively misdescriptive of tea-based beverages not containing THC); *In re Schniberg*, 79 USPQ2d 1309, 1312 (TTAB 2006) (holding SEPTEMBER 11, 2011 deceptively misdescriptive of history books and entertainment services not pertaining to the events of September 11, 2001); TMEP §1209.04.

The test for determining whether a mark is deceptively misdescriptive has two parts: (1) whether the mark misdescribes the goods; 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.

Regarding the first part of the test, a mark is misdescriptive when the mark merely describes a significant aspect of the goods that the goods could plausibly possess but in fact do not. *In re Hinton*, 116 USPQ2d 1051, 1052 (TTAB 2015); *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. *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).

Regarding the second part of the test, the Board has applied the reasonably prudent consumer test in assessing whether consumers are likely to believe the misrepresentation. *In re Hinton*, 116

USPQ2d 1051, 1052 (TTAB 2015) (citing *R. J. Reynolds Tobacco Co. v. Brown & Williamson Tobacco Corp.*, 226 USPQ 169, 179 (TTAB 1985)).

A. The applied-for mark contains a term that misdescribes the character, quality, and composition of the goods

The applicant's mark contains the stylized letter "É," which will indicate to consumers that the goods contain vitamin E as an ingredient. "Vitamin E" is defined as "any of several fat-soluble vitamins consisting of tocopherols, especially alpha-tocopherols, that are found chiefly in vegetable oils, nuts, and seeds, wheat germ, leafy green vegetables, and milk and act as antioxidants in the body" (See definition from *The American Heritage Dictionary of the English Language*, attached at p. 2 of the April 27, 2015 Office action).

Vitamin E is a common ingredient in nutritional and dietary supplements, and supplements that contain vitamin E are commonly marked with a prominent capital letter "E." The following evidence demonstrates this use:

- An informational website featuring information about supplements and herbs at www.drweil.com which states, "Dr. Weil recommends supplementing with vitamin E that provides a minimum daily dose of 80 mg of the whole complex, including mixed tocopherols and mixed tocotrienols." (See June 9, 2015 Office action, pp. 5-7, p. 6)
- An informational website about drugs and supplements available from www.mayclinic.org that features general information about vitamin E and states "Vitamin E supplements are available in natural or man-made forms." (See June 9, 2015 Office action, pp. 8-9, p. 8)
- A screenshot showing nearly thirty types of vitamin E supplements for sale on the internet via www.google.com's shopping feature (See June 9, 2015 Office action, pp. 11-14)
- An example of one such supplement, namely, Solgar® Natural Vitamin E supplements containing 400 IU of vitamin E per softgel, for sale at www.iherb.com (See June 9, 2015 Office action, pp. 15-19, p. 15)

In its response dated May 4, 2015, applicant responded to the examining attorney's information request by stating that the goods do not, in fact, contain vitamin E. Accordingly, the letter "É" appearing in applicant's mark misdescribes a character, quality and composition of the goods, namely, that the goods contain vitamin E.

B. Reasonably prudent prospective purchasers are likely to believe that the misdescription actually describes the goods

Prospective purchasers who are reasonably prudent are likely to believe that the misdescription actually describes the goods because "E" is a generic term widely used by the dietary and nutritional supplement industry and the supplement-consuming public to refer to vitamin E, or to medicinal products that contain vitamin E. The following evidence of record demonstrates use of the letter "E" by others for dietary and nutritional supplements and other similar medicinal products that contain vitamin E. This appears to be true even when the "E" appearing on the goods is stylized. Like applicant's proposed mark, all of the following examples show a stylized letter "E" appearing on packaging for vitamin E supplements and medicinal products:

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- UNIQUE E dietary supplement that contains "mixed tocopherols" (vitamin E), with packaging that features a large capital letter "E" in green block lettering covering the bottle (See July 27, 2015 Office action, pp. 12-14)
- DHC supplements that contain vitamin E, with packaging showing a prominent capital letter "E" surrounded by a blue circle (See July 27, 2015 Office action, pp. 15-16)
- MYRA e capsules that contain vitamin E, with packaging featuring a stylized letter "e," as well as an image showing the letter "E" being stamped on the capsules themselves (See July 27, 2015 Office action, p. 17)
- SUPER E natural vitamin E ointment, with a large capital "E" in a stylized square featured prominently on the packaging (See July 27, 2015 Office action, pp. 18-19)

- DERMA e, a vitamin E topical cream with packaging featuring a conspicuous stylized letter “e,” (See July 27, 2015 Office action, pp. 24-25)

Thus, because consumers are accustomed to seeing the letter “E” displayed prominently on products that contain vitamin E, they will likely believe that applicant’s supplements bearing the applied-for mark contain vitamin E.

i. The degree of stylization of the proposed mark would not dissuade reasonably prudent consumers from believing the goods contain Vitamin E

Applicant argues that the applied-for mark’s degree of stylization, which comprises the stylized “É”, an arrow design and an accent aigu contained within a blue circle, is such that consumers would not be deceived into believing the goods actually contain vitamin E. Applicant further states its proposed mark “would simply be seen as a logo (and in fact it is associated with its ‘Elan’ mark that uses an identical ‘E’).” (See Applicant’s Brief at p. 2)

Again, these arguments are unconvincing. Though applicant’s mark is comprised of a letter “E” topped with an accent aigu and a stylized arrow on the middle cross mark of the letter, all contained within a blue circle carrier, the letter “E” alone is clearly the dominant portion of the mark. What’s more, “E” and “É” standing alone are phonetic equivalents, and consumers will call for the goods by simply saying “E,” or in phonetic terms, “eee.” Further, consumers will assume the accent aigu, the arrow and the colored circle carrier are merely surplus design elements, meant solely to distinguish applicant’s vitamin E supplements from other vitamin E supplements on the market. As such, use of the proposed mark consisting of the stylized letter “É” on dietary and nutritional supplements that do not actually contain vitamin E as an ingredient is deceptively misdescriptive under Section 2(e)(1) of the Trademark Act.

V. CONCLUSION

Based on the foregoing arguments and evidence of record, the applied-for mark includes deceptive matter in relation to the identified goods. Therefore, registration should be refused under Trademark Act Section 2(a), 15 U.S.C. §1052(a). In the alternative, the letter “É” in the mark is deceptively misdescriptive of applicant’s goods. As such, registration should alternately be refused under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1).

Respectfully submitted,

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