

This Opinion is Not a Precedent of the TTAB

Mailed: August 8, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Medtech Products Inc.

Serial No. 86836486

Micheline Kelly Johnson of Baker Donelson Bearman, Caldwell & Berkowitz, P.C.
for Medtech Products, Inc.

Kevin G. Crennan, Trademark Examining Attorney, Law Office 113,
Odette Bonnet, Managing Attorney.

Notice of Correction

By the Board:

On July 24, 2017, the Board mailed a final decision in this proceeding. The Application Serial Number was missing in the caption and there was a typographical error in the Serial Number in the header and in footnote one.

Attached hereto is a corrected form of the July 24, 2017 decision.

The time for filing an appeal or commencing a civil action by either party regarding the Board's decision continues to run from the mailing date of the decision.

See Trademark Rule 2.145(d)(1), 37 C.F.R. § 2.145(d)(1).

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Before Mermelstein, Gorowitz and Coggins
Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

Medtech Products, Inc. (“Applicant”) seeks registration on the Principal Register
of the mark WARTSEAL (in standard characters), for:

Wart removing preparations, in International Class 5.¹

The Trademark Examining Attorney has refused registration of the mark
WARTSEAL under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on

¹ Application Serial No. 86836486 was filed on December 2, 2015, based upon Applicant’s
allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the
Trademark Act.

the ground that the mark is merely descriptive of Applicant's wart removing preparations. After the Examining Attorney made the refusal final, Applicant appealed and requested reconsideration. The request for reconsideration was denied, after which the appeal was resumed. The appeal has been fully briefed. We affirm the refusal to register.

Descriptiveness Refusal

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. *DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012); *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Abcor Dev. 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 for which registration is sought, the context in which it is being used on or in connection with the goods, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use; that a term may have other meanings in different contexts is not controlling. *In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219 (citing *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

The burden is on the Examining Attorney to make a prima facie showing that the mark in question is merely descriptive. *See In re Stereotaxis Inc.*, 429 F.3d 1039, 77

USPQ2d 1087, 1090 (Fed. Cir. 2005) (citing *In re Abcor Dev.*). The Examining Attorney has met this burden.

It is evident that the word “wart” is merely descriptive of “wart removing preparations;”² and Applicant did not question the descriptive nature of the word “wart” for the goods. However, the descriptive nature of the word “seal” was contested.

The Examining Attorney submitted dictionary definitions of “seal” as “an airtight closure”³ or “to cover, secure, or fill up (an opening).”⁴ Applicant argues the these definitions do not render the word “seal” merely descriptive of its goods because contrary to the definition “its goods do not form ‘an airtight closure’ over a wart; rather, they rely on salicylic acid as the sole active ingredient to remove the wart, in which the salicylic acid would soften the skin cells, break down the top layer of infected skin, and eventually peel off the wart.” Appeal Brief, 7 TTABVUE at 8. In addition, Applicant asserts that:

[t]he Examining Attorney also failed to substantiate his claim that because Applicant’s goods, which are in the form of liquids or gels, operate to *cover* a wart reflects that they mean to *seal* something and thus still renders the term “seal” merely descriptive.

²A “wart” is “a small hard lump on the skin cause by a virus.” January 7, 2016 Office Action, definition of “wart,,” Merriam-Webster.com, TSDR p. 5. (All citations to the Trademark Status and Document Retrieval (TSDR) database are to the PDF version of the documents.)

³ *Id.*, definition of “seal.” American Heritage Dictionary, “Seal.” AHDictionary.com, TSDR p. 6.

⁴ *Id.*

Id. Further, Applicant discounts evidence introduced by the Examining Attorney about home remedies but acknowledges that:

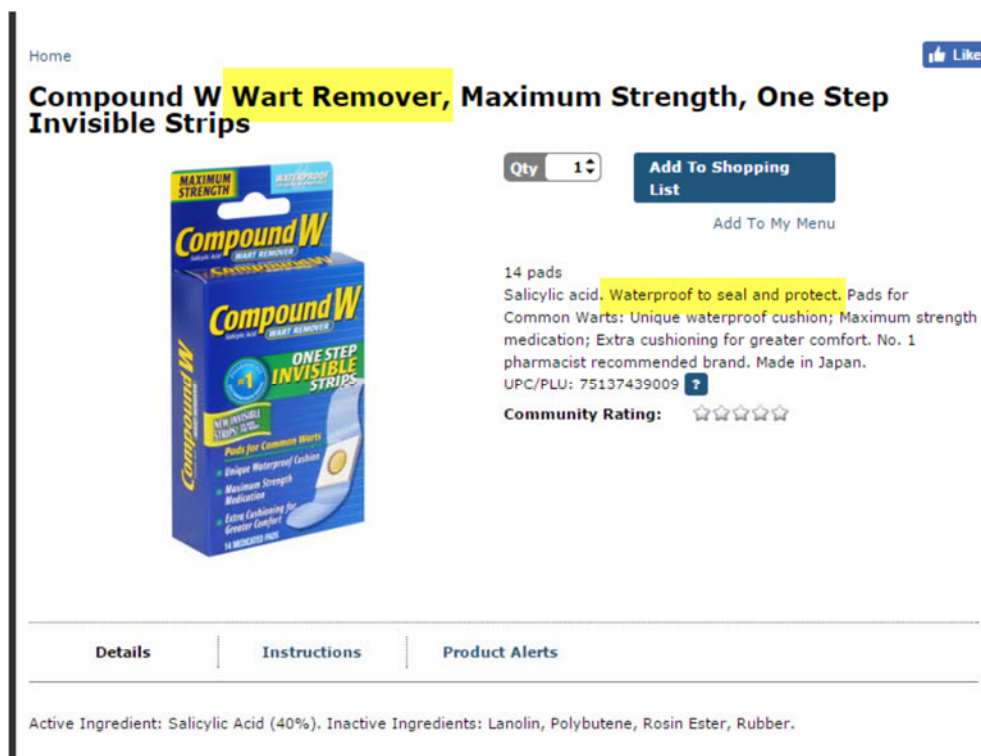
[s]ome of the cited websites do apply to wart-removing products in trade, but they can still be distinguished by the fact that most relate to bandages, pads, or strips ... Due to the nature of a ‘bandage,’ ‘pad,’ or ‘strip,’ the definition of ‘seal’ – ‘an airtight closure’ – may apply descriptively to these products; however, one cannot say the same about Applicant’s goods, as Applicant’s goods operate in a substantially different manner.”

Id., at 12.

The identification of goods in the subject application does not identify a specific type of wart removing preparation or limit the way Applicant’s wart removing preparations may be delivered. *See Paula Payne Prods. Co. v. Johnson Publ’g Co.*, 473 F.2d 901, 177 USPQ 76, 77-78 (CCPA 1973) (“Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.). Applicant’s goods must therefore be construed to cover all such types or formulations, notwithstanding the actual goods on which Applicant offers or intends to offer under the applied-for mark, including wart removing preparations delivered in liquid form as well as in bandages, pads, or strips.

Further, contrary to Applicant’s assertion, the evidence establishes that Applicant’s wart removing preparations are available in strips which create an airtight closure and contain salicylic acid, the sole active ingredient discussed by

Applicant in describing its wart removal products. *See* listing for Applicant's Compound W Wart One Step Invisible Strips (reproduced below)⁵:



In addition to the product description claiming the strips are “waterproof to seal and protect,” the product packaging itself touts a “Unique Waterproof Cushion.” The Examining Attorney also submitted evidence of other wart removal strips, which also create seals and contain the same active ingredient (i.e., salicylic acid). *See* up & up Wart Remover Strips, which are compared to Applicant's Compound W Wart Remover Strips, (reproduced below)⁶:

⁵ July 25, 2016 Office Action, from website www.gianteagle.com, TSDR p. 11.

⁶ *Id.*, www.target.com, TSDR p. 12.



Wart Remover Strips - 14 ct - up & up™

highlights

Compare to Compound W® Wart Remover Strips

up & up™ Maximum Strength Wart Remover Strips help remove common warts without the mess of liquids. Each strip delivers the fast-acting, maximum strength salicylic acid formula directly to the wart and is **waterproof to seal and protect.**

For Use On: Hands, feet

Product Form: Patch

Travel Size: Yes

TCIN: 14363647

UPC: 034197009324

Store Item Number (DPCI): 245-06-0305

And see Walgreen's Clear Wart Remover Medicated Bandages, also compared to Compound W active ingredient, (reproduced below)⁷:

⁷ *Id.*, www.walgreens.com, TSDR p. 21.



While this evidence alone is sufficient to establish that the word “seal” is descriptive of a characteristic of wart removing preparations delivered by adhesive strip, the Examining Attorney submitted additional evidence establishing that the application of wart removers without strips may also create a seal. For example, there is a review of Applicant’s Compound W Fast Acting Gel on the ReviewStream.com blog:⁸

Compound W fast acting gel wart remover is a great product. It works quickly, is easy to apply and priced nicely. The gel is so much nicer that [sic] the liquid acid which runsall [sic] over the wart and onto the surrounding skin. The gel stays exactly where you place it and dries quickly. It forms a very nice seal over the wart and you can feel a gentle sting that lets you know it is working! We all know that wars are annoying and seem to keep coming back, but this product alloys [sic] you to deal with them in the privacyof [sic] your own home with great results. No more

⁸ January 17, 2016 Office Action, www.reviewstream.com, TSDR p. 7.

going to the doctor and having painful freezing treatments to remove them. If you have a need for a wart remover give this product a try!

Applicant submitted its product packaging for the wart removing preparation that it intends to sell under the mark WARTSEAL:⁹



This appears to be the same “fast acting gel” product reviewed in the ReviewStream blog, wherein it was described as forming “a very nice seal over the wart.”¹⁰

⁹ December 16, 2015 Request for Reconsideration, 4 TTABVUE 8.

¹⁰ See n. 9.

The word “seal” also describes a feature of prescription wart treatments, e.g., UltraSal-ER, which is promoted as “the strongest prescription salicylic acid wart treatment available” and “has a tailored brush built right into the bottle cap for neat and precise application. Once applied the antiviral solution covers warts with a protective water-resistant seal so that no bandage is needed.”¹¹

Based on the evidence of record, we find that the word “seal” describes a feature of wart removing preparations, namely, a protective, waterproof seal created by either a bandage or other formulation of the goods, i.e., gel or liquid.

We look next at the combination of the terms “wart” and “seal” to determine whether the mark WARTSEAL in its entirety is merely descriptive of Applicant’s goods. When two descriptive terms are combined, the determination of whether the composite mark also has a descriptive significance turns upon the question of whether the combination of terms evokes a new and unique commercial impression. If each component retains its descriptive significance in relation to the goods, the combination results in a composite that is itself descriptive. *See DuoProSS Meditech Corp.*, 103 USPQ2d 1753 (SNAP SIMPLY SAFER merely descriptive for medical devices); *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004) (PATENTS.COM merely descriptive of computer software for managing a database of records that could include patents and for tracking the status of the records by means of the Internet).

¹¹ July 25, 2016 Office Action, www.ultrasal-er.com, TSDR pp. 9-10.

In this case we find that as used in connection with Applicant's goods, each of the words "wart" and "seal" retains its descriptive significance when combined to create the term WARTSEAL, and, therefore, that the composite term WARTSEAL is merely descriptive of Applicant's goods.

Finally, we note that Applicant referred to the ten third-party registrations submitted with its Request for Reconsideration, for marks containing the word SEAL, to establish that the word SEAL is not treated as descriptive by the Office. These registrations do not affect our determination in this case, particularly since none of the registrations covered wart removing preparations or closely related goods. Moreover, trademark rights are not static, and eligibility for registration must be determined on the basis of the facts and evidence of record that exist at the time registration is sought. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982); *In re Thunderbird Prods. Corp.*, 406 F.2d 1389, 160 USPQ 730 (CCPA 1969); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001); *In re Styleclick.com Inc.*, 58 USPQ2d 1523 (TTAB 2001); *In re Styleclick.com Inc.*, 57 USPQ2d 1445 (TTAB 2000).

Having reviewed all of the evidence of record, whether discussed herein or not, we find the mark WARTSEAL to be merely descriptive of Applicant's wart removing preparations.

Decision: The refusal to register Applicant's mark WARTSEAL is affirmed.