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CC: TTAB EFiled; TM Clerical Support Request

Subject: remand request 78829207

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD ON APPEAL

TRADEMARK EXAMINING ATTORNEY'S REQUEST FOR REMAND

Re: Serial No. 78829207

The trademark examining attorney requests that the Trademark Trial and Appeal Board remand this case to the examining attorney under 37 C.F.R. §2.142(d) for the following reasons: further review of the file necessitates the following request for information and refusals of registration as follows:

#### Request for Information

For the record, applicant must explain whether cocaine or cocaine derivatives are an ingredient of its goods. 37 C.F.R §2.61(b).

#### Refusal – Mark is Merely Descriptive or Deceptively Misdescriptive of an Ingredient of the Goods

Registration is refused because the proposed mark merely describes an ingredient of applicant's goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); TMEP §§1209 et seq.

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); In re MetPath Inc., 223 USPQ 88 (TTAB 1984); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979); TMEP §1209.01(b).

In this specific case, the mark is COCAINE. The mark is descriptive of one of the ingredients of the goods. A term that describes an ingredient of the goods is merely descriptive, within the meaning of Section 2(e)(1). In re Andes Candies Inc., 478 F.2d 1264, 178 USPQ 156 (C.C.P.A. 1973) (CREME DE MENTHE merely descriptive of candy); In re Keebler Co., 478 F.2d 1264, 178 USPQ 155 (C.C.P.A. 1973) (RICH 'N CHIPS merely descriptive of chocolate chip cookies); In re Entenmann's Inc., 15

USPQ2d 1750 (TTAB 1990), *aff'd per curiam* 928 F.2d 411 (Fed. Cir. 1991) (OATNUT merely descriptive of bread containing oats and hazelnuts); *Flowers Industries, Inc. v. Interstate Brands Corp.*, 5 USPQ 2d 1580 (TTAB 1987) (HONEY WHEAT merely descriptive of bread containing honey and wheat); *In re International Salt Co.*, 171 USPQ 832 (TTAB 1971) (CHUNKY CHEESE merely descriptive of cheese flavored salad dressing); *In re Demos*, 172 USPQ 408 (TTAB 1971) (CHAMPAGNE descriptive of ingredient of salad dressing).

If the goods do not in fact have cocaine as an ingredient, then registration is refused because the proposed mark is deceptively misdescriptive of applicant's goods. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); TMEP §1209.04.

The mere fact that the true nature of the goods is revealed by other matter on the labels, advertisements or other materials to which the mark is applied does not preclude a determination that a mark is deceptively misdescriptive. See *R. Neumann & Co. v. Overseas Shipments, Inc.*, 326 F.2d 786, 140 USPQ 276 (C.C.P.A. 1964) (DURA-HYDE held deceptive and deceptively misdescriptive of plastic material of leather-like appearance made into shoes); *In re Woolrich Woolen Mills Inc.*, 13 USPQ2d 1235 (TTAB 1989) (WOOLRICH for clothing not made of wool found not to be deceptive under §2(a)); *Tanners' Council of America, Inc. v. Samsonite Corp.*, 204 USPQ 150 (TTAB 1979) (SOFTHIDE held deceptive within the meaning of §2(a) for imitation leather material).

Applicant should note the following additional ground for refusal.

#### Refusal – Mark is Immoral or Scandalous

Registration is refused because the proposed mark consists of or comprises immoral or scandalous matter. Trademark Act Section 2(a), 15 U.S.C. §1052(a); TMEP §1203.01. To be considered “scandalous,” a mark must be “shocking to the sense of truth, decency or propriety; disgraceful; offensive; disreputable; ... giving offense to the conscience or moral feelings; ... [or] calling out for condemnation,” in the context of the marketplace as applied to goods or services described in the application. *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371, 31 USPQ2d 1923, 1925 (Fed. Cir. 1994); *In re Wilcher Corp.*, 40 USPQ2d 1929, 1930 (TTAB 1996). Scandalousness is determined from the standpoint of “not necessarily a majority, but a substantial composite of the general public, ... and in the context of contemporary attitudes.” *Id.*

Applicant wishes to register COCAINE for carbonated and non-carbonated soft drinks and energy drinks. It is well known that cocaine is an illegal drug. A substantial composite of the general public would find it scandalous that a product called COCAINE is freely sold to their children.

A mark that is deemed scandalous under Section 2(a) is not registrable on either the Principal or Supplemental Register. TMEP §1203.01.

Although the trademark examining attorney has refused registration, applicant may respond to the refusals to register by submitting evidence and arguments in support of registration

Respectfully submitted,

/Michael Engel/  
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