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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Procter & Gamble Company
v.
Colgate-Palmolive Company

Opposition No. 91110811
to application Serial No. 75265345
filed on March 27, 1997

Opposition No. 91110969
to application Serial No. 75291077
filed on May 13, 1997

Opposition No. 91113796
to application Serial No. 75512925
filed on July 2, 1998

Opposition No. 91115346
to application Serial No. 75468343
filed on April 15, 1998

Cancellation No. 92027735

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Palmolive Company.

Before Quinn, Kuhlke, and Bergsman, Administrative Trademark
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

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Defendant, Colgate-Palmolive Company, seeks registration of the following marks:

COLGATE ALL IN ONE (in typed form) - Application Serial No. 75265345 for goods identified as "oral care products, namely, toothpaste" in International Class 3 based on an allegation of a bona fide intention to use the mark in commerce;

ALL IN ONE (in typed form) - Application Serial No. 75291077 for goods identified as "oral care products, namely, toothpaste" in International Class 3 based on an allegation of a bona fide intention to use the mark in commerce;

ULTRA BRITE ALL IN ONE (in typed form) - Application Serial No. 75512925 for goods identified as "oral care products, namely, toothpaste" in International Class 3 based on an allegation of a bona fide intention to use the mark in commerce;

ALL IN ONE (in typed form) - Application Serial No. 75468343 for goods identified as "oral care products, namely, non-medicated mouthwash and rinse" in International Class 3 based on an allegation of a bona fide intention to use the mark in commerce.

In addition, defendant owns the following registration:

ALL IN ONE TOOTHPASTE (in typed form) - Registration No. 2102454 for goods identified as "toothpaste" in International Class 3, "toothpaste" disclaimed, issued on October 7, 1997.

Plaintiff, The Procter & Gamble Company, opposes registration and seeks cancellation of defendant's marks on the ground that, as used in connection with defendant's goods, the phrase ALL IN ONE is merely descriptive and is "the common, ordinary way to describe the nature of oral care goods such as" toothpaste, mouthwash or rinse which

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have multiple properties. In addition, in Opposition No. 91110811 opposer alleges that applicant "made no disclaimer of the 'ALL IN ONE' portion of the mark" and the "ALL IN ONE portion of applicant's mark [COLGATE ALL IN ONE], when applied to the toothpaste products of applicant is merely descriptive within the meaning of Section 2(e) of the Trademark Act, 15 U.S.C. 1052(e)." Notice of Opp. ¶¶5 and 6. While similar allegations do not appear in the Notice of Opposition (Opposition No. 91113796) against application Serial No. 75512925 for the mark ULTA BRITE ALL IN ONE, we are constrained to apply Section 2(e)(1) in the same manner as alleged in Opposition No. 91110811, as discussed infra.

By its answer in each case, defendant admits that plaintiff manufactures and sells toothpaste products and that plaintiff is a competitor of defendant. In addition, in its answer to the petition to cancel defendant also admitted that it brought an opposition based on the ground of descriptiveness against the underlying application of its registration, and upon assignment of the application to it, defendant withdrew the opposition and the subject registration issued. Defendant also admits that in its prior Notice of Opposition it alleged that it had a "bona fide intention to use the descriptive terms All In One, All In One Toothpaste, and All In One Mouthwash to describe the characteristics of its oral care products."

THE RECORD

By operation of Trademark Rule 2.122 the record includes the pleadings and the files of the subject applications and registration. In addition, plaintiff submitted various testimony depositions (with exhibits), including Hooman Shahidi, plaintiff's brand manager for oral care products, and notices of reliance on discovery depositions of applicant's officers, on printed publications, and on dictionary definitions.¹

Defendant did not take any testimony, file a notice of reliance or file a brief.

STANDING

To establish standing, opposer must show a real interest in the proceeding. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). Generally, where a claim of mere descriptiveness is asserted, it is sufficient for the plaintiff to establish that it is a competitor. *Montecash LLC v. Anzar Enterprises, Inc.*, 95 USPQ2d 1060 (TTAB 2010); *Plyboo America, Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633 (TTAB 1999) and *No Nonsense Fashions, Inc. v.*

¹ The timing of the taking of certain testimony depositions is unclear. It appears from the litigation history that some of plaintiff's testimony depositions were taken outside of its testimony period. However, defendant did not object to these depositions and participated in the depositions by cross examining the witnesses. In view thereof, we have considered these depositions; however, we add that plaintiff's claims are sufficiently supported by the evidence clearly submitted during its case-in-chief.

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Consolidated Foods Corp., 226 USPQ 502 (TTAB 1985). As noted above, in each case, defendant admitted that plaintiff is a competitor. In view thereof, plaintiff's standing is established.

MERE DESCRIPTIVENESS STATEMENT OF LAW

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in

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connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use or intended use. In re Tower Tech Inc., 64 USPQ2d 1314, 1316-17 (TTAB 2002).

A slogan, phrase or any other combination of words may be merely descriptive and, thus, unregistrable on the Principal Register in the absence of acquired distinctiveness, if it directly refers to a characteristic of the goods or services with which it is used. The mere descriptiveness analysis is the same for a slogan as it is with any other proposed mark. See In re Standard Oil Co., 275 F.2d 945, 125 USPQ 227 (CCPA 1960). See generally J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, §7:22 (4th ed. updated 2009).

Finally, a registration may be cancelled on the ground that an undisclaimed portion of the mark is merely descriptive of the identified goods and that the mark should not be registered without a disclaimer of that portion. Trademark Act Section 6, 15 U.S.C. §1056; Kellogg Co. v. Pack'Em Enterprises, Inc., 14 USPQ2d 1545 (TTAB 1990). However, if the purportedly unregistrable component is part of a unitary mark, a disclaimer is not required. TMEP 1213.05 (7th ed.

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2010). A composite mark is unitary when its components create a single and distinct commercial impression or an inseparable whole. *Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 221 USPQ2d 1047, 1052 (Fed. Cir. 1991) (the mark has a distinct meaning of its own independent of its component parts). Whether a composite mark is unitary is a subjective determination based on the commercial impression engendered by the mark. *In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981).

PLAINTIFF'S ARGUMENT AND EVIDENCE

It is plaintiff's position "that the purchasing public and oral care companies commonly use the terms 'all in one' to describe products 'which have multiple properties' or 'which have more than one function or characteristic.'" Br. p. 1. In support of its position, plaintiff submitted (1) dictionary definitions for the phrase "all in one"; (2) the filewrapper of defendant's prior proceeding in which, as plaintiff therein, defendant asserted the phrase "all in one" is descriptive; (3) voluminous printed publications in which the phrase "all in one" is used to describe multipurpose oral care products; and (4) examples of competitors' use of the phrase "all in one" to describe their products. Plaintiff did not present

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evidence regarding the other elements present in three of defendant's marks (i.e., COLGATE, ULTRA BRITE and TOOTHPASTE).

As indicated above, plaintiff provided several dictionary definitions for the phrase ALL IN ONE. Two are set forth below:

Doing the work of two or more usually separate parts: an all-in-one cleaner and polish.
Cambridge Advanced Learner's Dictionary
(Cambridge University Press, NY, 2005); and

Performing two or more functions or made up of two or more elements that are often separate.
Microsoft Encarta College Dictionary, (St. Martin's Press, NY, 2001).

In a prior opposition, defendant opposed a third-party's application for the mark ALL IN ONE TOOTHPASTE. In that case, defendant asserted the claim of mere descriptiveness, alleging that "the mark is an apt and common way in which to describe goods of the nature involved herein, i.e., oral care products having a wide range or all encompassing capacity in dealing with oral hygiene in only one product - 'All In One'." Pl. NOR (Filewrapper of Notice of Opposition in Opp. No. 91097134). While we do not consider statements made in another proceeding as admissions, we may consider them in evaluating the evidence. "That a party earlier indicated a contrary opinion respecting the conclusion in a similar proceeding involving similar marks and

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goods is a fact, and that fact may be received in evidence as merely illuminative of shade and tone in the total picture confronting the decision maker. To that limited extent, a party's earlier contrary opinion may be considered relevant and competent. Under no circumstances, may a party's opinion, earlier or current, relieve the decision maker of the burden of reaching his own ultimate conclusion on the entire record." Interstate Brands Corp. v. Celestial Seasonings, Inc., 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978).

In addition, under its notices of reliance, plaintiff submitted several excerpts from a variety of widely distributed printed publications, wherein the phrase "all in one" is repeatedly used to describe the multi-function aspect of oral care products. A few examples are set forth below (emphasis added).

A Brush Up Course ... Having more choices is better for the consumer, said Hitzelberger, 54. "I think it's great. Look at this," she said, her eyes sweeping the tiers of toothpaste. "This aisle is more than 10 feet long." There are two trends in toothpastes that you'll see. **All-in-one** toothpastes offer two or more features in one tube - like a comprehensive dental-care toothpaste. Colgate Total, for example, claims to fight cavities, tartar, bad breath, gingivitis and plaque. Aquafresh Whitening toothpaste claims to whiten teeth, protect against cavities, control tartar and freshen breath. "The Orange County Register" (March 31, 1999);

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Whiteners for Teeth Still Cause Controversy - A variety of new procedures and products is becoming available for whitening teeth, many of them sold over the counter ... The "all-in-one" solution now advertised as a combination whitener and ordinary toothpaste, contains still less peroxide but is recommended for twice a day, presumably for life. "Portland Oregonian" (December 23, 1998);

"Shine Those Pearly Whites" ... Ironically, Total may just be paving the way for the latest trend in toothpaste - the return to the all-in-one product. Procter and Gamble recently joined that trend with Crest's Multi-Care, a multi-action toothpaste. "York Daily Record" (March 20, 1998); and

"Young Inventors Create Marvels" ... "Mom and Dad are usually late for work," said David O'Donnell, 10. "So my all-in-one toothbrush was a time saver for them." "St. Petersburg Times" (October 25, 1991).

Finally, in addition to its own use of the phrase "all in one" to describe the multi-function aspect of its toothpaste, plaintiff provided examples of other competitors' use of "all in one" in connection with oral care products. See, e.g., Supplemental Notice of Reliance, PD 000976 Rembrandt website advertising "Rembrandt 9-in-1 Bleaching Gel, Toothpaste, & Mouthwash All-In-One," Aquafresh website advertising "Floss 'N' Cap ... It has the plaque fighting power of complete toothpaste and premium floss all in one"; and Shahidi Test. pp. 54-55 Exh. 69 Arm & Hammer PeroxiCare toothpaste with statement "Arm & Hammer PeroxiCare has the baking soda, peroxide and fluoride dentists recommend all in one convenient tube."

FINDINGS OF FACT/CONCLUSIONS OF LAW

In these consolidated proceedings, the marks in issue include three marks that consist of the single phrase ALL IN ONE by itself and three that combine the phrase with other matter, COLGATE, ULTRA BRITE and TOOTHPASTE. Based on the record, we find the following facts.

The phrase ALL IN ONE when used in connection with toothpaste and mouthwash describes a significant feature of such goods, specifically that they offer multiple properties and functions.

The combinations of COLGATE and ULTRA BRITE with the phrase ALL IN ONE do not result in phrases that are more than the sum of their parts and ALL IN ONE is severable from the word COLGATE in application Serial No. 75265345 and from the phrase ULTRA BRITE in application Serial No. 75512925.

Because plaintiff did not present argument or evidence as to COLGATE or ULTRA BRITE, we take them as inherently distinctive.

The disclaimed word TOOTHPASTE in Registration No. 2102454 is generic for the identified goods, toothpaste.

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The descriptive phrase ALL IN ONE and the generic word TOOTHPASTE do not lose their descriptive significance when combined.

In view of these findings we hold that ALL IN ONE is merely descriptive of applicant's goods in all of the subject applications and the registration. With regard to Registration No. 2102454 the mark ALL IN ONE TOOTHPASTE in its entirety is merely descriptive. With regard to application Serial Nos. 75265345 and 75512925 they may not go forward absent a disclaimer for the phrase ALL IN ONE. In re IBP, Inc., 228 USPQ 303 (TTAB 1985) (IBP SELECT TRIM for pork considered not unitary; refusal of registration in the absence of a disclaimer of "SELECT TRIM" affirmed); and EBS Data Processing, Inc., 212 USPQ at 966 (PHACTS POCKET PROFILE, for personal medication history summary and record forms, considered not unitary; refusal to register in the absence of a disclaimer of "POCKET PROFILE" affirmed).

Thus, plaintiff has met its burden to prove its claim of mere descriptiveness by a preponderance of the evidence. As noted above, applicant has not submitted any evidence, taken any testimony or presented any legal argument; thus, plaintiff's case stands un rebutted.

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Decision: The oppositions are sustained and the petition to cancel granted on the claims of mere descriptiveness. Registration No. 2102454 will be cancelled in due course.

Defendant is allowed until thirty days from the mailing date of this decision to file a disclaimer of the phrase "ALL IN ONE" for application Serial Nos. 75265345 and 75512925, in which event judgment will be set aside in Opposition Nos. 91110811 and 91113796 and the applications therein will go forward.