

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
February 23, 2010

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**  
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International Flora Technologies, Ltd.

v.

Desert Whale Jojoba Company, Inc.

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Cancellation No. 92048102  
\_\_\_\_\_

Gregory S. Kerksmar and Gregory B. Collins of Kerksmar & Feltus PLLC for International Flora Technologies, Ltd.

Dale F. Regelman and Nikia L. Fico of Quarles & Brady for Desert Whale Jojoba Company, Inc.

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Before Seeherman, Hairston and Cataldo, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Desert Whale Jojoba Company is the owner of a registration on the Supplemental Register for JOJOBA BUTTER BEADS, in standard character format, for "semi-solid wax for use in the manufacturing of other products in the field of personal care, cosmetics and cosmeceutical formulations and

preparations.”<sup>1</sup> International Flora Technologies, Ltd. has petitioned to cancel this registration on two grounds: that the registered term is generic and that it is likely to cause confusion with petitioner’s registered marks.<sup>2</sup> In particular, petitioner alleges that since prior to respondent’s alleged date of first use, it has been using the marks JOJOBUTTER, JOJOBEADS, FLORABEADS, METABEADS and AQUABEADS, and owns registrations on the Principal Register for JOJOBUTTER for “jojoba oil for use in the manufacture of cosmetics and sun care products,” for JOJOBEADS for “hydrogenated jojoba wax for use in cosmetics,” for FLORABEADS for “wax esters in microspherical form useful in the manufacture of cosmetics,” for METABEADS for “chemical additives for use in the manufacture of cosmetics,” and AQUABEADS for “chemical additives prepared from natural products for use in the manufacture of cosmetic and pharmaceutical products”; that respondent’s mark JOJOBA BUTTER BEADS so resembles petitioner’s previously used and registered marks as to be likely, when used in connection with respondent’s goods, to cause confusion; that “jojoba” is a plant and jojoba oil and jojoba derivatives are commonly used in the manufacture of topical applications

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<sup>1</sup> Registration No. 3209825, issued February 13, 2007, from an application filed on November 17, 2005, and asserting first use in commerce on December 7, 2004.

<sup>2</sup> Petitioner added the ground of genericness in its amended petition.

such as personal care, cosmetic and cosmeceutical preparations; botanical butter such as "jojoba butter" is a generic term for a wax and is commonly used in the manufacture of topical applications such as personal care, cosmetic and cosmeceutical preparations; that "jojoba butter" is known to refer to a wax material comprising jojoba derivatives by the relevant consuming public; that "bead" is a generic term for a spherical wax ingredient for use in the manufacture of topical applications such as personal care, cosmetic and cosmeceutical preparations; that "bead" is known to be a generally spherical wax particle by the relevant consuming public; that respondent's mark JOJOBA BUTTER BEADS is generic and/or entirely descriptive of the goods identified as being used in conjunction with the mark; and that respondent's mark JOJOBA BUTTER BEADS is generic for "jojoba butter" that is formulated into particulate "beads."

In its answer respondent admitted that jojoba is a shrub, and that jojoba oil and/or jojoba derivatives are used in the manufacture of various topical compositions, and otherwise denied the salient allegations of the petition for cancellation.

Record and Procedural Matters

The record includes the pleadings; the file of the registration sought to be cancelled; and ten testimony

depositions, with exhibits, of petitioner's and respondent's witnesses and two rebuttal testimony depositions, as set forth at page 1 of respondent's brief.<sup>3</sup> Petitioner has made of record, by notice of reliance, dictionary definitions of "beads," "butter" and "jojoba," and status and title copies of its pleaded registrations.<sup>4</sup>

We must first address some procedural matters, as follows:

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<sup>3</sup> Both petitioner and respondent chose to take the testimony of their adversaries as testimony depositions, rather than as discovery depositions, as is normally the case. As a result, in her testimony deposition of September 18, 2008, respondent's president appeared as petitioner's witness, while the testimony deposition taken on January 16, 2009 of David Ashley, a chemist for petitioner, was taken as respondent's witness. Where multiple depositions of witnesses were taken, we have referred to them by Roman numerals in the order in which they were taken. For example, the testimony deposition of David Ashley taken during petitioner's testimony period is Ashley I; his testimony deposition taken during respondent's testimony period is Ashley II; and the testimony deposition taken during petitioner's rebuttal testimony period is Ashley III.

<sup>4</sup> Registration No. 1891878 for FLORABEADS for "wax esters in microspherical form useful in the manufacture of cosmetics," issued May 2, 1995 from an application filed February 14, 1994; renewed.

Registration No. 2553803 for METABEADS for "chemical additives for use in the manufacture of cosmetics," issued March 26, 2002 from an application filed March 28, 2000; Section 8 affidavit accepted; Section 15 affidavit acknowledged.

Registration No. 1194173 for JOJOBUTTER for "jojoba oil for use in the manufacture of cosmetics and sun care products," issued April 27, 1982 from an application filed January 4, 1982; renewed.

Registration No. 2895195 for AQUABEADS for "chemical additives prepared from natural products for use in the manufacture of cosmetic and pharmaceutical products," issued October 19, 2004 from an application filed November 16, 2002.

Registration No. 1529171 for JOJOBEADS for "hydrogenated jojoba wax for use in cosmetics," issued March 14, 1989 from an application filed July 18, 1988. The registration was renewed after petitioner filed the status and title copies. In accordance with Board policy, we have ascertained the updated status of the registration.

A. In its trial brief, respondent objects that petitioner's brief on the case is untimely.<sup>5</sup> The brief was filed on July 9, 2009. Trademark Rule 2.128 provides that the brief of the party in the position of plaintiff is due not later than sixty days after the date set for the close of rebuttal testimony. Respondent, in its motion for an extension of its testimony period, asked that dates be reset so that petitioner's rebuttal testimony period would close on May 9, 2009. May 9, as petitioner points out, was a Saturday. Accordingly, petitioner argues that the 60-day period for petitioner to file its brief should be calculated as starting to run on May 11, 2009, (the next business day after May 9), such that petitioner had until July 10, 2009 to file its brief. Trademark Rule 2.196 provides that when the last day for taking any action fixed by the statute or regulation falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the action may be taken on the next day that is not a Saturday, Sunday or Federal holiday. Thus, if petitioner had wished to take a rebuttal testimony deposition or submit a rebuttal notice of reliance on May 9, 2009, the extension provided by the rule would have applied.

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<sup>5</sup> The better practice would have been for respondent to file a separate motion to strike petitioner's brief, rather than to include its objection as part of the argument section of its brief. That way, the interlocutory motions attorney handling this proceeding would have been aware of the motion and could have acted on it before the case was ready for a final decision.

We are not, however, persuaded that petitioner's interpretation regarding future scheduling is correct. Petitioner has not provided any case law that the rule has been applied to future dates that are set by the rules, and we are not aware of any such instances. Moreover, great confusion could result from petitioner's interpretation of the rule, since that would affect the due date for the respondent's brief and the petitioner's reply brief. Accordingly, the due date for petitioner to file its trial brief was July 8, 2009, and the brief was one day late. However, because of the minimal delay in filing the brief, and the possible confusion caused by respondent's setting the close of the rebuttal testimony period on a Saturday, we have exercised our discretion to consider the brief.

B. Respondent has objected to the description of the record in petitioner's brief as "noncompliant" with TBMP § 801.03 because it does not comprise a list of the evidence introduced by both parties. Although it is helpful to the Board and the parties that a list of all the evidence of record be included with the brief, in order to insure that the Board is in receipt of all such evidence, Trademark Rule 2.128 does not mandate that such a list be included, and TBMP § 801.03 makes a distinction between the alphabetical listing of cases, which *must* be included, see Rule 2.128(b), and the listing of evidence, which *should* be included. In

any event, there is no disagreement between the parties as to what evidence is properly of record, and we have followed the listing of evidence contained in respondent's brief at page 1 as it includes the evidence introduced by both parties.<sup>6</sup>

C. Respondent has argued that the two grounds for cancellation asserted by petitioner are internally inconsistent, and therefore petitioner's position is "fatally flawed as a matter of law." Brief, p. 7. Specifically, respondent claims that a mark cannot be both generic and likely to cause confusion, because if a term is generic it cannot be a mark, and likelihood of confusion can only occur through the defendant's use of a mark. We are not persuaded by this argument. A plaintiff may assert grounds in the alternative, and these grounds may be inconsistent. See Fed. R. Civ. P. 8(e).

D. In its main brief petitioner asserted, in the "Introduction" section, that respondent's mark is confusingly similar to petitioner's "family of marks" which included the marks pleaded in the petition for cancellation.

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<sup>6</sup> Although not raised by petitioner (perhaps because petitioner did the same thing), we note that respondent itself has failed to follow the directions of the TTAB Manual of Procedure in listing cases in its brief. TBMP § 801.03, the very section that respondent claims petitioner did not comply with, also provides that when cases are cited in a brief, the case citation should include a citation to *The United States Patent Quarterly* (USPQ) if the decision has appeared in that publication. Respondent failed to include the USPQ cite for many of the decisions it cited that were reported in the Federal Reporter.

However, petitioner did not allege a family of marks in its petition to cancel, asserting use and ownership only of the individual marks. Thus, in order for us to consider likelihood of confusion with petitioner's asserted family of marks claim, we must find that this issue was tried by the consent of the parties. See Fed. R. Civ. P. 15(b). The only testimony that petitioner relies on in its briefs (at p. 22 of both briefs) in support of its claim that it has a family of marks is an exchange between its counsel and Dr. Wickett, a professor of pharmaceuticals and cosmetic science, and one of petitioner's expert witnesses. He first responded in the affirmative to questions about whether in preparing for his testimony he had discovered that petitioner had registered the marks JOJOBUTTER, JOJOBEADS, FLORABEADS, METABEADS and AQUABEADS, and that he saw in reviewing the materials that petitioner had used these marks in commerce. He was then asked, "Given these five marks that [petitioner] has, is it likely that some of [petitioner's] customers may be confused by the JOJOBA BUTTER BEADS mark?" He responded, "In my opinion, it is likely that some customers could be confused" because "Well, I guess, a possibility, you have got beads, butter beads, Flora beads, you have got jojoba butter [sic], I mean, those



are fairly similar to [JOJOBA BUTTER BEADS]." Wickett test., p. 83.<sup>7</sup>

Such testimony (including the testimony of Mr. Dwyer, reported in footnote 6) is insufficient to alert respondent that petitioner was claiming a family of marks or even to indicate what was the surname of a family. Thus, we find that the ground of likelihood of confusion with respect to a purported family of marks was not tried.

E. On February 17, 2009, respondent filed a "notice of related cases," by which it advised the Board that on February 16, 2009, it had filed petitions to cancel, on the ground of abandonment, two of the registrations that had been asserted by petitioner in the instant proceeding, for JOJOBUTTER and JOJOBEBADS. Respondent stated that it did so because the scheduling order for this proceeding required that if parties became involved in another Board proceeding or a civil action involving related marks, they should notify the Board. It appears that the only reason that respondent filed this paper was to comply with an instruction in the scheduling order; respondent did not

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<sup>7</sup> The only other evidence we can identify that could go to a family of marks claim is the testimony of Robert Dwyer, petitioner's Vice President for Sales, responding to whether, if a cosmetics formulator or buying agent were aware of JOJOBUTTER, FLORABEADS, METABEADS and AQUABEADS as petitioner's marks, he or she would assume that JOJOBA BUTTER BEADS is a product petitioner sells. He answered that it is likely they would "because of their prior experience with us and the vast number of marks that we do have that include any one or more of those names and our leadership position in jojoba particle technology." Test, p. 61.

request that proceedings in the instant cancellation action be suspended, nor did respondent move to consolidate the proceedings.<sup>8</sup> Therefore we treat the registrations which are the subject of the other cancellation proceedings as being in full force.<sup>9</sup>

Standing

The record shows that both petitioner and respondent sell jojoba products to cosmetics manufacturers for inclusion into finished products that are then sold to the general public, and that they are competitors. See, e.g., Ashley test. I, p. 23, Rohde test. I, p. 42. In addition, petitioner has made of record its pleaded registrations for, inter alia, JOJOBEADS and JOJOBUTTER. Therefore, petitioner

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<sup>8</sup> In any event, Trademark Rule 2.114(b)(2)(ii) provides that an attack on the validity of a registration pleaded by a petitioner will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration. Further, a defense attacking the validity of a registration that has been pleaded in a petition for cancellation is a compulsory counterclaim if grounds for the counterclaim exist at the time the petition is filed, and if grounds for the counterclaim are learned during the course of the cancellation proceeding, the counterclaim must be pleaded promptly after the grounds therefor are learned. Trademark Rule 2.114(b)(2)(i). As noted, respondent has given no reason in this proceeding as to why it waited until February 16, 2009 to file petitions to cancel petitioner's pleaded registrations for JOJOBUTTER and JOJOBEADS. In briefs filed in connection with those cancellation proceedings, respondent referred to exhibits petitioner introduced in connection with testimony depositions on June 17, 2008 and July 14, 2008, and exhibits introduced by respondent through the direct testimony of its own witnesses.

<sup>9</sup> We note that, as a result of respondent's notice of related proceedings filed in Cancellation Proceedings Nos. 92050549 and 92050550, the Board suspended action in those proceedings pending a decision in the instant case, the June 17, 2009 order pointing out that testimony in the instant proceeding had been completed and the proceeding was in the briefing stage.

is not a mere intermeddler, but has established that it has a real interest in the proceeding. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). We find that plaintiff has standing.

Genericness

We turn first to the ground of genericness. We point out that the registration sought be cancelled is on the Supplemental Register. Section 24 of the Trademark Act, 15 U.S.C. § 1092, provides that a registration on the Supplemental Register may be cancelled if the registrant is found by the Board not to be entitled to registration. A mark is entitled to registration on the Supplemental Register if it is *capable* of distinguishing the applicant's goods or services and is not prohibited from registration by Section 2(a), (b), (c), (d) and (e)(3) of the Trademark Act. While a Supplemental Registration may be cancelled if the "mark" is or becomes a generic term, because such a term is not capable of distinguishing a party's goods or services, descriptive marks are permitted on that register. Thus, any arguments by petitioner that respondent's mark is descriptive, as opposed to the common descriptive term for the goods, or that it lacks distinctiveness, have been given no consideration. Further, because obtaining a registration on the Supplemental Register is an admission by the registrant that the mark is not inherently distinctive

(inherently distinctive marks are not registrable on the Supplemental Register, see Section 23(a) of the Act), respondent's arguments that its mark is an oxymoron or play on words cannot be considered.

The determination of whether a term is generic involves a two-step inquiry: First, what is the genus (category or class) of goods or services at issue and second, is the registered term understood by the relevant public primarily to refer to that genus of goods or services. See *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). It is petitioner's burden to show by a preponderance of the evidence that JOJOBA BUTTER BEADS is generic. *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1554 (Fed. Cir. 1991).

In general, the genus is defined by the goods or services identified in the registration, which in this case is "semi-solid wax for use in the manufacturing of other products in the field of personal care, cosmetics and cosmeceutical formulations and preparations." See *Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007); *Magic Wand Inc. v. RDB Inc.*, 19 USPQ2d at 1552 (Fed. Cir. 1991) (a proper genericness inquiry focuses on the description of services set forth in the certificate of registration). Petitioner argues that respondent's

identification "conveys everything but the form that the jojoba butter is sold in," and that "for this part of the genus, the Board must look to extrinsic evidence or even to the trademark itself." Brief, p. 12. We disagree that to determine whether the genus of the goods is in "bead" form, we must look to either extrinsic evidence or to the trademark itself. In fact, as respondent points out, to use the trademark to define the genus would almost always result in a finding of genericness, because the trademark would automatically name the genus. However, because the identification in respondent's registration is not limited to any particular shape of the wax, the genus of goods includes semi-solid wax *in bead form* for use in the manufacturing of other products in the field of personal care, cosmetics and cosmeceutical formulations and preparations.

This brings us to whether the relevant public will perceive respondent's mark as primarily referring to this genus of goods. Respondent's good are ingredients that are sold to, inter alia, cosmetics manufacturers for use in making cosmetics that are sold to the general public. In large cosmetics companies, such as Estee Lauder, the decision to purchase such ingredients is normally made by cosmetics formulators who are chemists who are part of the research and development department, and it goes through an

approval process. The formulators may also be told, when they are given the brief to create a product, that the finished product should contain a particular ingredient.<sup>10</sup> Thus, the relevant public includes sophisticated purchasers who may be scientifically trained people who work for large cosmetics companies or those familiar with the marketing of cosmetic products.

In addition, the semi-solid wax identified in respondent's registration, comprising the genus of the goods at issue, may be purchased by home "crafters" who make cosmetic products for themselves. We note that respondent does not sell its product in the small quantities that would normally be bought by "crafters," but the genus of goods cannot be limited by extrinsic evidence. Because the genus of goods, as identified in the registration, is semi-solid wax for use in the manufacturing of, inter alia, cosmetics, the relevant public is anyone who might use such wax to manufacture cosmetics.

In determining how the relevant public would perceive respondent's mark, we must consider how technically trained people, such as chemists, would view JOJOBA BUTTER BEADS in connection with the identified goods. However, their perception is not limited to merely a technical assessment of the term, such that only a scientific meaning can be

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<sup>10</sup> See, generally, testimony of Marrs and Kaufmann.

considered. Manufacturers of cosmetic products would also be aware of generic usage reaching the consumers of such goods. Formulators would be interested in the products they create in terms of public reaction to them, while marketing staff who direct formulators to devise a particular product would know trends affecting cosmetic products, and are likely to require that a particular ingredient be included in a cosmetic product because of the marketing value.<sup>11</sup>

Compare, Magic Wand, in which the Court affirmed the Board's denial of a petition to cancel TOUCHLESS for automobile washing services because, although the petitioner had submitted evidence that car wash manufacturers used the term generically, it failed to show that the mark was generic in the mind of the general public consumers of the identified services. Accordingly, in the present case, we may consider advertisements and other materials that are directed to the consumers of finished cosmetic products, because such materials would inform the perceptions of the purchasers of the ingredients for such products.

The individual words, JOJOBA, BUTTER and BEADS, are respectively defined, inter alia, as:

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<sup>11</sup> See, for example, the testimony of Peter Kauffmann, one of petitioner's expert witnesses, who stated that when he worked at cosmetics companies, and he did so from 1963 until 2002, he made an active effort to know what the competition was selling in order to develop products that would be able to compete successfully in the marketplace. p. 70.

Jojoba: a shrub or small tree of the box family of southwestern North America with edible seeds that yield a valuable liquid wax used esp. in cosmetics"

Butter: 2. a buttery substances as, A. any of the various fatty oils remaining nearly solid at ordinary temperatures

Bead: 4. a small ball-shaped body as a. a drop of sweat or blood, b. a bubble formed in or on a beverage, c. a small metal knob on a firearm used as a front sight, d. a blob or a line of weld metal.<sup>12</sup>

In addition, there are listings for various jojoba ingredients as shown in the CFTA's (now Personal Care Products Council) International Cosmetic Ingredient Dictionary and Handbook, 12<sup>th</sup> ed., published in 2008. This book summarizes "INCI" names which are the ingredient names that are accepted for FDA cosmetics labeling. The International Nomenclature Committee of that organization assigns ingredient nomenclature to ingredients that are used in cosmetics. One of the listings is for "simmondsia chinensis (jojoba) butter". Mr. Kauffmann, who was the chairman of the CFTA's International Nomenclature Committee for five years, and is still a member of that committee, explained the use of the parenthetical, testifying that this entry lists the scientific name genus and species, with the

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<sup>12</sup> Definitions taken from Merriam-Webster Collegiate Dictionary, 11<sup>th</sup> ed., and read at first Ashley testimony deposition, pp. 20, 28 and 38. Mr. Ashley also testified that the inclusion of jojoba in the box family had been changed, and that it was no longer a Buxaceae. Ashley I, p. 20.



parenthetical "jojoba" being the common name or material that consumers would recognize.<sup>13</sup> This listing states that the chemical class for the ingredient is "waxes" and the "technical/other name" is "jojoba butter." It also lists, under the heading "trade name mixtures," "Jojoba Butter Beads (Desert Whale)," thereby indicating that respondent is the source of the product sold under the trade name Jojoba Butter Beads, and that this product contains jojoba butter. Mr. Kauffman also testified that the International Nomenclature Committee does not examine the trade names that are part of the ingredient submissions, and that the inclusion in the Dictionary of a particular trade name simply indicates that this is the trade name that the entity uses in selling the product.

There are also third-party generic uses of "jojoba butter":

Creme de Corps Light Weight Body Lotion  
with SPF 30  
Rich in skin-nurturing ingredients ideal  
for hydrating dry skin. This formula  
with shea and jojoba butter and sweet  
almond oil is blended with ground luffa  
fruit to exfoliate skin without drying.  
Unique, skin-soothing ingredients  
derived from nature jojoba butter, olive  
fruit oil, and sweet almond oil.  
Shopping.msn.com, Ashley I exhibit 7

Olay Ribbons Body Wash bottle states  
"with jojoba butter"

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<sup>13</sup> In a similar manner, there is a listing for "sesamum indicum (sesame) seed oil" (Kaufmann exhibit 14) and "helianthus annuus (sunflower) seed extract" (Kaufmann exhibit 13).

Ashley I exhibit 13

Respondent itself uses "jojoba butter" as a generic term. A printout from respondent's website, www.desertwhale.com, (Ashley I exhibit 8) lists, under "jojoba derivatives," "Iso Jojoba™ -35 (Jojoba Butter)" and "Iso Jojoba™ -50 (Jojoba Butter)." Also, while several of the products listed include a "™" or a "®" symbol, "Jojoba Butter-HM" "Jojoba Butter-LM" have no such symbol. Further, respondent's description of its "Iso Jojoba™ -35 (Jojoba Butter)" states: "non-greasy, oxidative stable jojoba butter that has a melting point very close to body temperature (35° C)," while the description for "Iso Jojoba™ -50 (Jojoba Butter)" and "Jojoba Butter-HM" is "non-greasy, oxidative stable jojoba butter that has a melting point of approximately 35° C." In addition, respondent's advertising materials list products with respondent's trademark followed by what appears to be the generic name in parentheses, including the generic use of "jojoba butter." See, for example, Rohde I, exhibit 45, which lists, inter alia, JOJOBA GLAZE® (JOJOBA GEL), ISO JOJOBA™ (JOJOBA BUTTER), JOJOBA AQUA SOL (WATER-SOLUBLE JOJOBA), and Rohde exhibits 46-52, listing "Jojoba Butter" in parentheses after ISO JOJOBA™.

Petitioner has also made of record third-party generic uses of "beads," including such use in connection with jojoba:

BathLife™ SugarKiss™ Lip Scrub delivers gentle and truly effective exfoliation and moisture straight to your precious pout with jojoba beads, brown sugar, mango and avocado butters, and Riesling grapeseed oil.  
www.etsy.com, Ashley I exhibit 6.

www.lemelange.com website, Ashley I exhibit 9, lists Jojoba Beads as an item name, along with other generic terms such as grapeseed oil, jojoba oil, lanolin and mango butter. Further, under the heading "Jojoba Beads" it states: "Visual as well as functional, our Jojoba Beads can be used alone or combined with other colors. These gentle exfoliating Jojoba Beads will enhance many skin cleansing products. These gentle exfoliating beads are the perfect alternative to polyethylene beads or ground shell exfoliants, which can scratch or irritate the skin. The beads can be incorporated into clear or pearlized skin cleansers. ... Our hydrogenated Jojoba Beads are available in ten different colors. Our Jojoba Beads are completely unscented. These jojoba beads can be used in Melt and Pour Soap... Ashley I exhibit 10. Another webpage, headed "Foaming Bath Butter," lists various ingredients that can be added to the product, including sugar, salt and jojoba beads. In connection with the jojoba beads, it states: "We found that by adding jojoba beads to uncolored whipped Foaming Bath Butter, we were able to produce a visually pleasing product that had the consistency of icing with dots of color in it.

Body Essence

Sweet Vanilla Cream Ultra Moisturizing  
Body Wash

Deeply hydrating Shea Butter beads, a  
blend of tea extracts and antioxidants  
plus nourishing Soy Extract.

www.body-essence.com, Dwyer exhibit 29

Bottle of CVS hand sanitizer features,  
on the bottle, the statement "With  
moisture beads."

Ashley I exhibit 16

Moreover, respondent uses "bead" to describe generically its

JOJOBA BUTTER BEADS product:

Product Description: This multi-  
purpose, crushable jojoba bead offers  
gentle exfoliation and moisturization,  
while releasing actives.

Listing for Jojoba Butter Beads™ under  
"Our Products" on respondent's website,  
www.desertwhale.com

Ashley I exhibit 1

There are also advertisements by third parties showing  
their use of "jojoba butter beads" as an ingredient name.

See, for example:

Our enriched, gentle microdermabrasion  
cream contains natural silica, crushed  
bamboo powder and jojoba butter beads to  
boost renewing power and promote cell  
renewal. It's formulated with nurturing  
sunflower oil and shea butter to soothe  
and condition skin ...

Jafra product booklet, Ashley I exhibit  
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An advertisement for Jafra  
Microdermabrasion Cream, using the same  
text, appears on the shopit website,  
www.shopit.com

Ashley I exhibit 24

Microdermabrasion products by Jafra are  
also advertised at the url  
vickiehedding.com, and also use Jojoba  
Butter Beads in the same manner as other

generic terms: "natural Silica & Bamboo Powder; Natural emollients of Jojoba Butter Beads, Shea Butter & Sunflower oil to condition & soften. Ayurvedic brightening blend of Licorice, Winter Cherry & Emblica for brightening, clarity & glow"  
Ashley I exhibit 12

Dermelect Cosmeceuticals Thermaj Self Heating Body Polish  
...The jojoba butter beads sets off our "total body facial" with a release of "all goodness" nourishment.  
Mio mia webpage, [www.shopmiomia.com](http://www.shopmiomia.com),  
Ashley I exhibit 21  
The same product is advertised on the website for SkinStore.com, [www.skinstore.com](http://www.skinstore.com), with the same copy, including the reference to jojoba butter beads, Ashley I exhibit 22, while the website for Dermelect, [www.dermelect.com](http://www.dermelect.com), lists in its glossary, "Jojoba Butter Beads: mineral releasing beads dissolve for total-moisture treatment." The term is listed in the same manner as such generic terms as "lemon oil" and "licorice extract," although other terms appear with a "™" symbol. Ashley I exhibit 23

Jojoba Butter Beads  
Description  
Partially and Fully hydrogenated Jojoba Wax Esters. These Butter Beads are soft, malleable spherical particles that offer gentle exfoliation while moisturizing the skin. The [sic] melt into the skin and may be used in both rinse off and leave on products.  
Aromatics & More Ltd. website, [www.aromaticsandmore.com](http://www.aromaticsandmore.com), Ashley I exhibit 3

Petitioner asserts that JOJOBA BUTTER BEADS is generic for three reasons: it describes a primary characteristic or ingredient of the goods, citing such cases as J. Kohnstam,

Ltd. v. Louis Mark & Co., 280 F.2d 437, 126 USPQ 362 (CCPA 1960) (Matchbox for toy vehicles generic because that category of toy cars was sold in matchbox-sized boxes), and In re Central Sprinkler Co., 49 USPQ 1194 (TTAB 1998) (ATTIC generic for sprinklers used in attics); it is used generically in the cosmetic market; and the dictionary definitions of the individual words show that the phrase is nothing but a combination of generic words that, when combined, have nothing but a generic meaning, citing In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE found generic for pre-moistened anti-static cloth for cleaning computer and television screens). Respondent discusses only the third argument in its brief, contending that petitioner's reliance on the "dictionary definition" test is misplaced because JOJOBA BUTTER BEADS is not a compound term. In holding SCREENWIPE generic, the Court stated that the applicant "has simply joined the two most pertinent and individually generic terms applicable to its product, and then attempts to appropriate the ordinary compound thus created as its trademark," and "that the terms remain as generic in the compound as individually, and the compound thus created is itself generic." 5 USPQ2d at 1112. The Court provided further guidance about this decision in In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), stating that "Gould provides

additional assistance in determining the genericness of compound words only, and holds that if the PTO can prove (1) the public understands the individual terms to be generic for a genus of goods and species; and (2) the public understands the joining of the individual terms into one compound word to lend no additional meaning to the term, then the PTO has proven that the general public would understand the compound term to refer primarily to the genus of goods or services described by the individual terms." 51 USPQ2d at 1837. Thus, the phrase SOCIETY FOR REPRODUCTIVE MEDICINE could not be proven generic by showing that the elements "society" and "reproductive medicine" within that phrase were generic.

Applying the teachings of the Court to the present case, we would agree with respondent that one cannot take the individual words, jojoba, butter and beads, obtain evidence that the separate words are generic, and determine solely on this basis that the term JOJOBA BUTTER BEADS as a whole is generic. However, the evidence shows that the term "jojoba butter," and not merely the individual words in that term, is generic as well, i.e., that it is a unitary generic term. "Jojoba butter" is the generic name of an ingredient that is used in the manufacture of cosmetics. Although the "official" INCI name that would be used in an ingredient list to comply with FDA labeling is "simmondsia chinensis

(jojoba) butter," even the INCI dictionary recognizes that the "technical/other name" for this material is "jojoba butter" and, as Dr. Kaufmann testified, the official name includes "jojoba" in parentheses because this is the commonly recognized term for "simmondsia chinensis." Moreover, a product or material may have more than one generic name. In re Eddie Z's Blinds and Drapery Inc., 74 USPQ2d 1037, 1942 (TTAB 2005). The record also shows that "beads" is used as a generic term for the shape of particles that are used in the manufacture of cosmetic products. Thus, the question is whether "jojoba butter," which is a single term that is recognized as the generic name for an ingredient in the manufacture of cosmetics, when combined with the generic word "beads," is a compound term. We think that "jojoba butter beads" is analogous to "milk chocolate bar," as combining the primary ingredient of the product with the shape, and that it is appropriate to treat it as a compound term. That is, the generic nature of the individual elements "jojoba butter" and "beads" remains, and the combination of them lends no additional meaning to the term. Instead, the separate generic elements "jojoba butter" and "beads" retain their generic significance when joined to form a compound that has "a meaning identical to the meaning common usage would ascribe to those words as a compound." Gould, 5 USPQ2d at 1111-12. The space between the generic



terms "jojoba butter" and "beads" does not disqualify the mark from the Gould analysis. "Whether compounded as "screen wipe" -- two words -- or "screenwipe" -- one word -- either is ordinary grammatical construction." 5 USPQ2d at 1112. If anything, the terms appearing as they should in normal usage make it even more recognizable as a generic term.

Moreover, the evidence of record is not limited to dictionary definitions of the individual elements in the mark. As set forth in this opinion, petitioner has submitted evidence that respondent and third parties use the terms "jojoba butter" and "beads" generically, and that third parties use the entire phrase "jojoba butter beads" generically as well. Thus, under the American Fertility analysis, the JOJOBA BUTTER BEADS must be found to be a generic phrase. See *In re Active Ankle Systems Inc.*, 83 USPQ2d 1532 (TTAB 2007) (DORSAL NIGHT SPLINT found generic for orthopedic splints for the foot and ankle based on record that included third-party use of the entire phrase).

Respondent argues that the goods it sells under the mark JOJOBA BUTTER BEADS are different from the goods it sells as "jojoba butter," and therefore its mark cannot be generic for goods that are not jojoba butter. We acknowledge that the respondent's JOJOBA BUTTER-LM is identified by the INCI ingredient name hydrogenated jojoba

oil, and that respondent's product sold under the mark JOJOBA BUTTER BEADS is composed of ingredients with the INCI names hydrogenated jojoba oil and isomerized jojoba oil, and that the two products respondent sells are not the same.

However, these facts do not serve to avoid a finding that respondent's mark is generic. First, as respondent itself points out at pages 12 and 13 of its brief, one should not normally look to extrinsic evidence in determining the genus of the goods. Rather, the genus is defined by the identification in the registration, and the genus includes all the goods encompassed by the identification. Thus, respondent cannot, on the one hand, take the position that the genus is determined solely by the identification when it suits its purposes in arguing that its mark is not generic, but then argue that extrinsic evidence as to the particular nature of the goods it sells under the mark must be considered in order to avoid a finding of genericness. Second, although respondent sells hydrogenated jojoba oil as jojoba butter, the INCI dictionary states that jojoba butter is obtained by the isomerization of jojoba oil. As noted, isomerized jojoba oil is one of the two ingredients used in respondent's JOJOBA BUTTER BEADS product. One cannot obtain exclusive rights to a generic term merely by combining another ingredient with the generically named ingredient.

Respondent also disputes the probative value of some of the evidence showing generic usage of "jojoba butter beads." For example, it points out that some of the advertisements are directed to "crafters," rather than the formulators that work for major cosmetics manufacturers. These persons, though, are part of the relevant purchasing public for the genus of goods at issue here, and therefore the advertisements are relevant to how the mark would be perceived. Respondent also suggests that some of the third parties that sell jojoba butter beads or products featuring jojoba butter beads are resellers of products manufactured by others. Even if they are, this is immaterial to the determination of whether the term is generic. If these third parties are using jojoba butter beads in a generic manner, it shows their own perception that the term is generic, and the exposure of the term in this manner influences the perception of those who see the advertisements, such that they would believe that jojoba butter beads is a generic term.<sup>14</sup>

After reviewing all the evidence of record, we conclude that petitioner has met its burden of proving that JOJOBA

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<sup>14</sup> Respondent also questions the conclusions of petitioner's expert witness, Dr. Wickett, with respect to the advertising material of third parties because Dr. Wickett did not personally download the material. (Mr. Ashley testified that he did, and he was the person who authenticated this material.) Although Dr. Wickett did not download the advertisements, he can still give

BUTTER BEADS is a generic term for the genus of goods listed in respondent's registration, namely, "semi-solid wax for use in the manufacturing of other products in the field of personal care, cosmetics and cosmeceutical formulations and preparations." Accordingly, the petition for cancellation on this ground is granted, and respondent's registration will be cancelled in due course.

Likelihood of confusion

In view of our finding that respondent's registration must be cancelled on the ground of genericness, we need not decide the ground of likelihood of confusion that was also pleaded in the petition for cancellation.

Decision

The petition to cancel on the ground of genericness is granted.

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his views as to the manner in which the companies use the phrase "jojoba butter beads" in the webpages.