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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Wellnx Life Sciences Inc.

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Serial No. 85181815

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Catherine M. Clayton of Gibbons P.C. for Wellnx Life Sciences Inc.

Elissa Garber Kon, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

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Before Grendel, Taylor, and Hightower, Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

On November 20, 2010, applicant Wellnx Life Sciences Inc. filed an application to register on the Principal Register the term DESIGNED FOR WOMEN, in standard character form and with “WOMEN” disclaimed, for goods ultimately identified as:

Dietary supplements; dietary supplements, namely, powder drink mixes, vitamins and minerals, capsules, tablets and caplets for promoting weight loss and for promoting weight management; nutritional supplements; nutritional supplements, namely, energy drinks used as a meal replacement, vitamins and minerals, capsules,

tablets and caplets for supplementing nutritional dietary supplements, in International Class 5.¹

The examining attorney has refused registration under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§ 1051, 1052, and 1127, on the ground that the proposed mark is merely informational matter and fails to function as a trademark on the specimen of record. The examining attorney also has refused registration because the designation DESIGNED FOR WOMEN is merely descriptive of the goods pursuant to Section 2(e)(1), 15 U.S.C. § 1052(e)(1), and has not acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f). Applicant timely appealed and, after requesting and receiving a three-month extension of time to file its appeal brief due to the appointment of new counsel,² timely filed its appeal brief on January 2, 2013.

Failure to Function as a Trademark

The Trademark Act defines a “trademark” in relevant part as “any word, name, symbol, or device, or any combination thereof used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” Trademark Act Section 45, 15 U.S.C. § 1127. “It is settled that not every designation that is placed or used on or in connection with a product necessarily functions or is recognized as a trademark for said product; not every designation adopted with the intention that it

¹ Application Serial No. 85181815, based on allegations of first use and first use in commerce in September 2007, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

² See Applicant’s Request for an Extension of Time to File Appeal Brief, filed September 24, 2012, and Board Order of September 27, 2012 granting extension.

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performs a trademark function and even labeled as a trademark necessarily accomplishes that purpose; and there are certain designations that are inherently incapable of functioning as trademarks to identify and distinguish the source of the products in connection with which they are used.” *American Velcro, Inc. v. Charles Mayer Studios, Inc.*, 177 USPQ 149, 154 (TTAB 1973).

Terms that are considered to be merely informational in nature, or common statements that would ordinarily be used in business or in the particular trade or industry, are not registrable. *See In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056, 1058-59 (Fed. Cir. 1999). *See also In re Eagle Crest Inc.*, 96 USPQ2d 1227, 1232 (TTAB 2010) (ONCE A MARINE, ALWAYS A MARINE would not be perceived as a trademark but rather as an informational slogan “to express support, admiration or affiliation with the Marines”); *In re T.S. Designs Inc.*, 95 USPQ2d 1669, 1671 (TTAB 2010) (CLOTHING FACTS will be perceived as informational matter, not as a source identifier for shirts); *In re Volvo Cars of N. Am., Inc.*, 46 USPQ2d 1455, 1460-61 (TTAB 1998) (DRIVE SAFELY not registrable because it would be perceived as an everyday, commonplace safety admonition and not as a trademark for “automobiles and structural parts therefor”); *In re Manco, Inc.*, 24 USPQ2d 1938, 1942 (TTAB 1992) (THINK GREEN and design would be perceived only as an informational slogan encouraging environmental awareness and not as a trademark for weather stripping and paper products).

The critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public. To make this determination we look to the specimens and other

evidence of record showing how the designation is actually used in the marketplace. . . . The more commonly a phrase is used, the less likely that the public will use it to identify only one source and the less likely that it will be recognized by purchasers as a trademark.

In re Eagle Crest Inc., 96 USPQ2d at 1229 (citations omitted).

We first examine how applicant’s proposed mark is used on its specimens:³



Applicant asserts that it uses the term DESIGNED FOR WOMEN “prominently and with trademark notice. The mark is not used together with explanatory narrative, and is set off in a manner that conveys to consumers that it indicates the source of the goods.”⁴

³ Applicant’s actual specimens are quite blurry, so much so that its asserted mark is illegible on the first. The images above are attached to applicant’s June 13, 2011 response to Office action and represented as “clearer copies of packaging.” *Id.* at 2, 4-5. They appear to show packaging identical to that in applicant’s actual specimens.

⁴ Appeal Brief at 9.

We do not view use of the phrase the same way applicant does. Although the phrase appears on its own line at or near the top of each package, it is not displayed prominently, but in very small type – smaller even than the similarly informational phrase “for women” on the hoodia product packaging. That applicant uses the “TM” symbol after the phrase does not transform it into a trademark. *In re Aerospace Optics Inc.*, 78 USPQ2d 1861, 1864 (TTAB 2006); *In re Brass-Craft Mfg. Co.*, 49 USPQ2d 1849, 1853 (TTAB 1998); *In re Remington Prods. Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987). Nor does applicant’s intent that the phrase function as a mark:

[T]he mere fact that applicant’s slogan appears on the specimens, even separate and apart from any other indicia which appear on them, does not make it a trademark. To be a mark, the term, or slogan, must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods in question. Mere intent that a term function as a trademark is not enough in and of itself, any more than attachment of the trademark symbol would be, to make a term a trademark.

Id. Rather, the relative placement, prominence, and meaning of the phrase DESIGNED FOR WOMEN on the packaging indicate to us that the public will view it as indicating not the source of the goods, but their intended consumers: women.

The examining attorney also has made of record evidence demonstrating significant informational use of the phrase “designed for women” (as well as “designed for men”) on product packaging, in news stories, and in text on third-party websites, including in reference to applicant’s own products. For example, use of the phrase “designed for women” on packaging for dietary supplements other than applicant’s includes:

- GNC Women's Ultra Mega, "Premium multivitamin designed for women"⁵



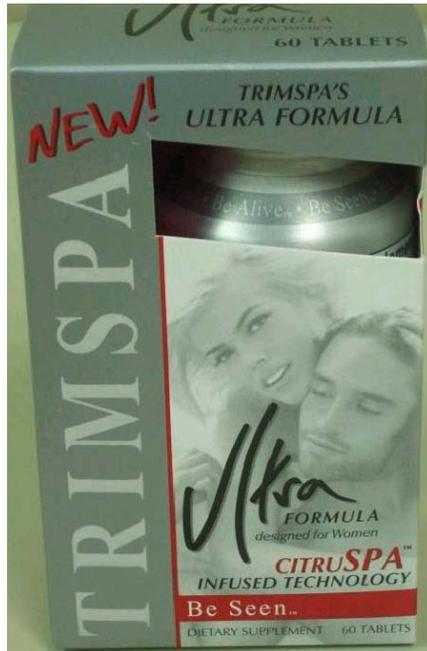
- Berkley & Jensen Women's "Premium Multivitamin Designed for Women"⁶



⁵ February 1, 2012 final Office action at 2.

⁶ *Id.* at 5.

- TrimSpa Ultra Formula “designed for Women”⁷



Similarly, the examining attorney submitted screenshots of a page titled “Supplements Designed for Women” from the website www.supplements101.com⁸ and of a page titled “Discover the Best Multivitamins for Women” and subtitled “See Comparison of 100 Multivitamin Brands Designed for Women” from www.multivitaminguide.org.⁹ Applicant itself has described its products in text on its websites as “designed specifically for women,” “designed specifically for a woman’s body,” and “designed with females in mind.”¹⁰

This evidence demonstrates that consumers are accustomed to seeing “designed for women” used in a merely informational manner, as well as in

⁷ *Id.* at 120. The cached image from the website www.extremebargains.net states that this package is “past date” and apparently expired in February 2009, *id.* at 119, nearly 1½ years after applicant’s first use.

⁸ *Id.* at 97-98.

⁹ *Id.* at 57-61 (discussing “vitamin supplements”).

¹⁰ July 6, 2011 Office action at 1.

association with items similar to applicant's from different sources. As a result, consumers will not perceive this wording as applied to applicant's goods as a source indicator uniquely identifying applicant.

In support of its argument that DESIGNED FOR WOMEN is capable of trademark significance, applicant points to four registrations on the Supplemental Register for DESIGNED FOR SENIORS;¹¹ DESIGNED BY WOMEN, FOR WOMEN;¹² and SAFETY DESIGNED FOR WOMEN.¹³ Only one of these registrations is for Class 5 goods,¹⁴ and the latter two of these phrases incorporate wording in addition to DESIGNED FOR _____, which may have influenced whether they were viewed as capable of acquiring trademark significance. Moreover, the specimens of use for these registrations are not of record, so we cannot determine how the terms are actually used. Finally, while the Office strives for consistency, we must decide each case on its own record and merits. "Even if some prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board" *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

We affirm the refusal to register DESIGNED FOR WOMEN on the ground that it is merely informational matter and fails to function as a trademark under Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§ 1051, 1052, and 1127.

¹¹ Registration No. 3614183.

¹² Registration Nos. 3846721 and 3846722.

¹³ Registration No. 3407595.

¹⁴ Registration No. 3846722.

Mere Descriptiveness

A term is deemed to be merely descriptive of 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 services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). “The question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them.” *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); *see also In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Applicant does not dispute that its dietary and nutritional supplements are intended for use by women. Rather, applicant argues that the phrase DESIGNED FOR WOMEN is suggestive because it “might equally convey any one of a number of meanings as applied to dietary and nutritional supplements.”¹⁵ Applicant cites two of the definitions for the word “design” submitted by the examining attorney:

1. To intend for a definite purpose; and
2. To plan and fashion artistically or skillfully.¹⁶

Applicant argues:

By virtue of the first definition, Wellnx’s DESIGNED FOR WOMEN could convey that the dietary and

¹⁵ Applicant’s Brief at 7 (footnote omitted).

¹⁶ March 2, 2011 Office action at 56-59, retrieved from dictionary.com (definitions 2 and 3).

nutritional supplements are “designed” or “intended” for use by women, as opposed to men or children.

In view of the second definition, DESIGNED FOR WOMEN could also convey that the shape or size of the products were “designed” or “fashioned” to make them uniquely suited to women, such as by using a smaller pill size or a shape intended to appeal to female consumers. It could also convey that the specific ingredients of the product were chosen to address needs unique to the physiology of adult females. Equally, the mark could convey that something about the color or other aesthetic properties of the products were designed to appeal particularly to women.¹⁷

We agree with the examining attorney that “[t]he fact that the phrase does not elaborate on the specific aspects of the product that makes them more suitable for consumption by women than men is irrelevant.”¹⁸ A term need not immediately convey an idea of each and every specific feature of the applicant’s goods in order to be considered merely descriptive; it is enough that the term describes one single, significant feature or attribute. *See In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (“A mark may be merely descriptive even if it does not describe the full scope and extent of the applicant’s goods or services.”) (quotation omitted); *In re H.U.D.D.L.E.*, 216 USPQ 358, 359 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338, 339 (TTAB 1973). Consistent with applicant’s argument, we find that the phrase DESIGNED FOR WOMEN advises consumers that applicant’s dietary and nutritional supplements are

¹⁷ Applicant’s Brief at 6-7 (footnote omitted).

¹⁸ Examiner’s brief at unnumbered p. 18.

“designed’ or ‘intended’ for use by women, as opposed to men or children.”¹⁹ We further note that each of these definitions, when used in connection with applicant’s goods, is merely descriptive of the goods and does not present a double entendre or incongruous meaning. *See In re RiseSmart Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012). We therefore hold that the applied-for phrase is merely descriptive in association with applicant’s goods pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1).

Acquired Distinctiveness

Applicant asserts in the alternative that its mark has acquired distinctiveness pursuant to Trademark Act Section 2(f), 15 U.S.C. § 1052(f). The burden of establishing that a mark has acquired distinctiveness is on the applicant. *See Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 122 USPQ 372, 375 (CCPA 1959). “To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.” *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n.11 (1982).

The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case and particularly on the nature of the mark sought to be registered. *Roux Labs., Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34, 39 (CCPA 1970); *see also In re Hehr Mfg. Co.*, 279 F.2d 526, 126 USPQ

¹⁹ Applicant’s Brief at 6.

381, 383 (CCPA 1960); *In re Gammon Reel, Inc.*, 227 USPQ 729, 730 (TTAB 1985).

Typically, more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the named goods or services would be less likely to believe that it indicates source in any one party. *See, e.g., In re Bongrain Int'l (Am.) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1728 n.4 (Fed. Cir. 1990); *In re Seaman & Assocs., Inc.*, 1 USPQ2d 1657, 1659 (TTAB 1986); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 919 (TTAB 1984). The applicant may present any competent evidence to establish that a mark has acquired distinctiveness. We consider the evidence applicant provided in support of its claim.

A. Sales, Advertising, and Commercial Impressions

Applicant submitted a declaration from director Derek Woodgate dated June 8, 2011 stating that its mark has become distinctive of its goods:

- “1. through the applicant’s substantially exclusive and continuous use thereof as a trademark, in commerce, for at least the 3½ years immediately before the filing date of this statement;
2. through applicant’s reported media spend of over \$100,000,000.00 (one hundred million dollars) over the past 3½ years;
3. through applicant’s advertising expenditures of over \$50,000,000 (fifty million dollars) over the past 3½ years;
4. through applicant’s sales of over 10 million units of product in packaging bearing the trademark; and
5. through an estimated 5,000,000,000 (5 billion) ‘impressions’ of the mark upon consumers.”²⁰

These numbers obviously are large. Applicant, however, provided no examples or other evidence concerning the nature of its advertisements. Nor did applicant

²⁰ June 13, 2011 response to Office action at 3.

provide any evidence whatsoever regarding the source of the consumer “impressions” of its mark. It is therefore impossible to determine how the phrase DESIGNED FOR WOMEN is used in applicant’s advertising, and particularly whether the phrase is used in a manner sufficient to create secondary meaning among consumers. *See* Trademark Rule 2.41(a), 37 C.F.R. § 2.41(a) (stating that an applicant may submit evidence of advertising expenditures “identifying types of media and attaching typical advertisements”). Evidence of the amount of applicant’s advertising expenditures, without more, merely substantiates its efforts to develop distinctiveness and does not prove that the advertising has been effective. *See In re Pennzoil Prods. Co.*, 20 USPQ2d 1753, 1760 (TTAB 1991); *In re Redken Labs., Inc.*, 170 USPQ 526, 529 (TTAB 1971) (“It is necessary to examine the advertising material to determine how the term is being used therein, what is the commercial impression created by such use, and what would it mean to purchasers.”). The fact that 10 million “units” of product have been sold in packaging bearing the phrase does not result in acquired distinctiveness unless purchasers view that phrase as a source indicator. Applicant provides no evidence that its efforts to establish acquired distinctiveness in the phrase DESIGNED FOR WOMEN have succeeded.

The only evidence applicant submitted, in addition to the Woodgate declaration and the two images of packaging referenced *supra*, is what appears to be the front and back of a third package of applicant’s product:²¹

²¹ *Id.* at 6-7. The declaration refers to “additional specimens substituted herewith.” *Id.* at 3.



We view use of the applied-for phrase on this package as similar to that of the other two packages discussed *supra*.

In view of the highly descriptive nature of the phrase DESIGNED FOR WOMEN and the incomplete nature of the evidence of secondary meaning, applicant's evidence falls short of establishing acquired distinctiveness.²²

B. Request for Remand to Provide Statement of More Than Five Years' Use

Finally, at pages 7-8 of its appeal brief, applicant asks the Board to “remand the proceeding to permit Wellnx to submit additional evidence, including a claim based on five years’ use and evidence of promotional expenditures and sales from

²² We also point out that, in any event, no amount of Section 2(f) evidence would suffice to overcome the “merely informational” refusal under Sections 1, 2 and 45 of the Trademark Act. *In re Tilcon Warren, Inc.*, 221 USPQ 87, 87-88 (TTAB 1984).

June 2011 to the present”²³ should we find its Section 2(f) evidence insufficient. Applicant correctly states that it could not have made a claim of acquired distinctiveness based on five years’ use during prosecution because its first use date is alleged to be September 2007.²⁴

The record in an application should be complete prior to filing an appeal, and the Board ordinarily will not consider additional evidence submitted after the appeal is filed. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). “After an appeal is filed, if the appellant or the examiner desires to introduce additional evidence, the appellant or the examiner may request the Board to suspend the appeal and to remand the application for further action.” *Id.* Such a request should be made by way of separate motion rather than buried in the appeal brief.²⁵ Applicant’s request contemplates a final decision on the merits of its claim before the Board considers remand and, as such, is untimely. An application may not be reopened after final decision except for entry of a disclaimer. Trademark Rule 2.142(g), 15 U.S.C. § 2.142(g).

Moreover, remand in an ex parte appeal is a matter of discretion with the Board, and a request to remand for additional evidence must be accompanied by the additional evidence sought to be introduced. Trademark Trial and Appeal Board Manual of Procedure (TBMP) §§ 1205.01, 1207.02 (3d ed. rev. June 2012).

Applicant did not submit any such evidence.

²³ Appeal Brief at 8.

²⁴ *Id.* at 7.

²⁵ We also note that this claim of five years use had matured and a request for remand could have been made at the time applicant’s brief was originally due on October 1, 2012.

Even if applicant's request was not untimely, we find the request to submit "evidence of promotional expenditures and sales from June 2011 to the present" does not constitute good cause for remand. "[I]f the applicant requests remand to make of record its most recent monthly sales or advertising figures in support of a Trademark Act § 2(f), 15 U.S.C. § 2(f), claim, the request may be denied. There is a point at which prosecution or examination must come to an end." TBMP § 1207.02(1).

Turning to applicant's request to assert that it has acquired distinctiveness based on five years' use of the term DESIGNED FOR WOMEN, we agree with the examining attorney that such a claim would not be sufficient. Although such a statement may be accepted as prima facie evidence that a mark has acquired distinctiveness, Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), and Trademark Rule 2.41(b), 37 C.F.R. § 2.41(b), state that reliance on a claim of five years' use to establish secondary meaning is acceptable in "appropriate cases," depending largely on the nature of the mark in relation to the specified services. If a mark is highly descriptive of the services named in the application, the statement of five years' use alone will be deemed insufficient to establish acquired distinctiveness. See *In re Crystal Geyser Water Co.*, 85 USPQ2d 1374, 1379 (TTAB 2007); *In re Kalmbach Publ'g Co.*, 14 USPQ2d 1490, 1492 (TTAB 1989); *In re Gray Inc.*, 3 USPQ2d 1558, 1559 (TTAB 1987). Given the highly descriptive and informational nature of applicant's asserted mark, a statement of more than five years' use would be insufficient to establish acquired distinctiveness.

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Such a statement, furthermore, must claim not just continuous use by the applicant in commerce for at least the preceding five years, but that such use has been substantially exclusive. The evidence of record indicates that applicant's use of the term "designed for women" has not been substantially exclusive.

For these reasons, we decline to exercise our discretion to suspend the appeal and remand for submission of additional evidence as requested by applicant.

Decision: The refusal of registration is affirmed.