

**This Opinion is Not a
Precedent of the TTAB**

Mailed: October 5, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Marabo North America Holdings Ltd.
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Serial No. 86464788
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Matthew H. Swyers of The Trademark Company PLLC
for Marabo North America Holdings Ltd.

Sean Crowley, Trademark Examining Attorney, Law Office 116,
Christine Cooper, Managing Attorney.

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Before Kuhlke, Adlin and Pologeorgis, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Marabo North America Holdings Ltd. (Applicant) seeks registration on the Principal Register of the standard character mark JOINTTMNMUSCLE for “Topical analgesic creams,” in International Class 5.¹

The Trademark Examining Attorney has refused registration of Applicant’s mark on the ground that JOINTTMNMUSCLE is merely descriptive of Applicant’s goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1).

¹ Application Serial No. 86464788, filed on November 25, 2014, based upon Applicant’s allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

When the refusal was made final, Applicant appealed. The Examining Attorney and Applicant filed briefs. We affirm the refusal to register.

Mere Descriptiveness

A mark is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it immediately conveys information of a quality, feature, function, or characteristic of the goods or services in connection with which it is used, or intended to be used. *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012). *See also In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015). The determination of whether a mark is merely descriptive must be made “in relation to the goods [or services] for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use.” *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (citing *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978)). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a “single feature or attribute” of the goods or services. *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219; *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987).

Where a mark consists of multiple words, the mere combination of descriptive words does not necessarily create a nondescriptive word or phrase. *In re Phoseon Tech., Inc.*, 103 UPQ2d 1822, 1823 (TTAB 2012); *In re Associated Theatre Clubs Co.*,

9 USPQ2d 1660, 1662 (TTAB 1988). If each component retains its merely descriptive significance in relation to the goods or services, the combination results in a composite that is itself merely descriptive. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004). However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a nondescriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods or services. *See generally In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968). *See also In re Shutts*, 217 USPQ 363, 364-65 (TTAB 1983).

The Examining Attorney contends that JOINT'NMUSCLE is “the phonetic equivalent of the wording ‘joint and muscle’” and that “‘joint and muscle’ would simply inform consumers of two of the types of pain treated by applicant’s topical analgesic creams.” Ex. Att. Br., 8 TTABVUE 4, 7. In support of his position that the term JOINT'NMUSCLE is merely descriptive of the applied-for goods, the Examining Attorney submitted evidence in the form of third-party webpages showing use of the terms “joint” and “muscle” together in connection with analgesic creams. A few examples are reproduced below:²



² October 19, 2015 Office action at 2, 4, 8.



In addition, the Examining Attorney’s request that we take judicial notice of the dictionary definition of “N” as an informal conjunction is granted.³

Applicant points to a variety of cases where the proposed mark that included merely descriptive terms was nonetheless found to be inherently distinctive. As is well established, we must make our decision in each case on its own merits “[e]ven if some prior registrations had some characteristics similar to” the current 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). Moreover, many of the marks in these cases (UNDERNEATH IT ALL, TENNIS IN THE ROUND, SUGAR & SPICE, HEARTWISE) present very different circumstances that create incongruity or evoke other phrases.

³ Dictionary.com based on THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE (5th ed. 2016). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

Applicant also argues that there is “no instantaneous connection as to the nature of the goods provided by Applicant” and that “competitors have numerous choices in regard to alternative language” such as “ARTICULATIO AND BRAVN or ARTICULATION & TISSUE.” App. Br., 6 TTABVUE 12.

To put it simply, there is no doubt of an instantaneous connection between the goods, analgesic (a remedy that relieves or allays pain)⁴ creams, and the wording JOINT’NMUSCLE areas commonly treated by analgesic creams to relieve pain. Applicant’s argument does not take into account the perception of the consumer as to meaning in the context of Applicant’s goods, *i.e.*, what meaning is relevant to analgesic creams. *In re RiseSmart Inc.*, 104 USPQ2d 1931, 1933 (TTAB 2012); *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984). In our analysis of the proposed term, JOINT’NMUSCLE, we must consider “the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use.” *Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219. Applicant’s broad identification encompasses analgesic creams for treating joints and muscles. *See Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219. *See also In re Bayer Aktiengesellschaft*, 82 USPQ2d at 1832 (Internet evidence may be considered for purposes of evaluating a trademark). Indeed, in response to a request for more information Applicant answered that its

⁴ Dictionary.com based on RANDOM HOUSE DICTIONARY (2016).

goods are joint and muscle creams intended to provide temporary relief of aches, pains and stiffness.⁵

As to the other proffered option for competitors' use, "ARTICULATION & TISSUE," it is difficult to imagine a consumer in the United States needing an analgesic cream for joint and muscle pain would look for something that addresses articulation and tissue.

Applicant contends that the "limited" evidence of competitor use "is most likely simply of infringing activity" and should not be considered to support a finding of descriptiveness. 6 TTABVUE 12. We have considered the examples of third-party use of the words "joint and muscle" to merely describe their respective creams and ointments and find them probative. There is nothing in the record to suggest these uses are "infringing" and the uses clearly describe the feature, function and characteristic of the goods, namely, that they are for the "joint and muscle." In response to Applicant's assertion that there are only limited examples of third-party use, we underscore that while the presence of third-party use could be probative on the question of competitive need, the absence thereof is not dispositive. The fact that an applicant may be the first or only user of a combination of merely descriptive terms does not obviate the refusal. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012); *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009) (competitor need is not the test for descriptiveness); *In re Sun Microsystems*

⁵ September 10, 2015 Response to Office action.

Inc., 59 USPQ2d 1084, 1086 (TTAB 2001); *In re Nat'l Shooting Sports Found., Inc.*, 219 USPQ 1018, 1020 (TTAB 1983).

The words “joint and muscle” immediately describe the type and location of the pain the analgesic creams are meant to treat. Further, there is nothing in the record to support a finding that the combination JOINTTMMUSCLE does not retain the same descriptive meaning when used in connection with analgesic creams. Applicant relies on a conveniently truncated quote from *In re Colonial Stores Inc.*, 157 USPQ 382 (SUGAR & SPICE held not merely descriptive of bakery products) and asserts that “although the terms in Applicant’s mark, namely JOINT and MUSCLE, may be deemed merely descriptive of Applicant’s products standing on their own, surely under the constraint announced in *Colonial Stores* the telescoping of the words by shortening the word ‘AND’ to a ‘N’ to connect the words JOINT and MUSCLE therewith must certainly draw this trademark under the protections of the *Colonial Stores* decision.” App. Br., 6 TTABVUE 13-14. We begin by noting the quote from *Colonial Stores* was based on a quote from another case *Ex parte Barker*, 92 USPQ 218, 219 (Com. Pat. 1952). Applicant omits the key passage in *Colonial Stores*, 157 USPQ at 385:

The immediate impression evoked by the mark may well be to stimulate an association of “sugar and spice” with “everything nice.” As such, on the record below, the mark, along with the favorable suggestion which it may evoke, seems to us clearly to function in the trademark sense and not as a term merely descriptive of goods. To the extent that the nursery rhyme is familiar to one seeing or hearing the mark, his recall is undoubtedly stimulated to make the association with “everything nice” but this in no

way defeats the distinctive nature of the composite word mark as applied to the listed products.

The issue in that case was the double entendre of the phrase SUGAR & SPICE evoking a nursery rhyme. There is no double entendre in this case, as shown above “N” simply means “and,” so we have here the clear and unambiguous meaning joint and muscle. The slight misspelling creating a phonetic equivalent does not create a unique or incongruous term. *In re ING Direct Bancorp*, 100 USPQ2d 1681, 1690 (TTAB 2011) (PERSON2PERSON PAYMENT generic for direct electronic funds transfers); *In re Carlson*, 91 USPQ2d 1198, 1203 (TTAB 2009) (holding URBANHOUSING, in standard character form, would be perceived by consumers as the equivalent of the descriptive term URBAN HOUSING, rather than as including the separate word ZING); *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1475 (TTAB 2007) (“The generic meaning of ‘togs’ not overcome by the misspelling of the term as TOGGS. . .”); and *In re Hubbard Milling Co.*, 6 USPQ2d 1239 (TTAB 1987) (holding MINERAL-LYX generic for mineral licks for feeding livestock). *See also In re Hercules Fasteners, Inc.*, 203 F.2d 753, 97 USPQ 355 (CCPA 1953) (FASTIE merely descriptive of tube sealing machines).

We conclude that the combination JOINT’NMUSCLE does not present a unique or incongruous term such that “the merely descriptive significance of the term[s] [joint, ’n and muscle] is lost in the mark as a whole.” *RiseSmart Inc.*, 104 USPQ2d at 1934 (quoting *In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983)). *See also In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002) and *In re Cryomedical Sciences Inc.*, 32 USPQ2d 1377, 1379 (TTAB 1994). In the context of these goods,

“topical analgesic creams,” the meaning of JOINTTMNMUSCLE is clear, an analgesic cream to treat joints and muscles; there is no incongruity or double entendre.

Decision: The refusal to register Applicant’s mark JOINTTMNMUSCLE as merely descriptive under Section 2(e)(1) is affirmed.