

This Opinion is Not a  
Precedent of the TTAB

Mailed: September 19, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

*In re Farmacia Drogueria San Jorge Ltda - Drogueria San Jorge*

---

Serial No. 87404726

---

Felipe Rubio of Rubio & Associates,  
for Farmacia Drogueria San Jorge Ltda - Drogueria San Jorge.

Mark Mullen, Trademark Examining Attorney, Law Office 111,  
Chris Doninger, Managing Attorney.

---

Before Shaw, Lynch, and English,  
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background

Farmacia Drogueria San Jorge Ltda - Drogueria San Jorge (“Applicant”) seeks

registration on the Principal Register of the mark



for the following goods:

(Based on Use in Commerce) Body and beauty care cosmetics; Body oil; Body scrub; Body splash; Hair lotions; Shampoo-conditioners; Antiperspirants and deodorants for personal use; Cosmetic preparations for body care; Face and body creams; Face and body lotions; Hair shampoo; Lotions for face and body care; Non-medicated herbal body care products, namely, body oils, salves, and lip balms; Skin and body topical lotions, creams and oils for cosmetic use (Based on Intent to Use) Body butter; Hair emollients; Hair oils; Hair pomades; Make-up for the face and body; Toning lotion, for the face, body and hands (Based on 44(e)) Body and beauty care cosmetics; Body butter; Body oil; Body scrub; Body splash; Hair emollients; Hair lotions; Hair oils; Hair pomades; Shampoo-conditioners; Antiperspirants and deodorants for personal use; Cosmetic preparations for body care; Face and body creams; Face and body lotions; Hair shampoo; Lotions for face and body care; Make-up for the face and body; Non-medicated herbal body care products, namely, body oils, salves, and lip balms; Skin and body topical lotions, creams and oils for cosmetic use; Toning lotion, for the face, body and hands in International Class 3.<sup>1</sup>

The Examining Attorney refused registration of Applicant's mark under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), as deceptive when used for the identified goods.<sup>2</sup> After the Examining Attorney made the refusal final, Applicant appealed and requested reconsideration.<sup>3</sup> The Examining Attorney denied

---

<sup>1</sup> Application Serial No. 87404726 has a filing date of April 10, 2017, and currently is based on Applicant's allegation of use of the mark in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), and on a Columbian registration under Trademark Act Section 44(e), 15 U.S.C. § 1126(e). The application includes the following description: "The mark consists of the word 'pili' in a special typeface with a characteristic element on the letters 'i' and a leaf at the end." Color is not claimed as a feature of the mark.

<sup>2</sup> Despite the guidance in Trademark Manual of Examining Procedure § 1203.02(e) (Oct. 2018), this case does not include an alternative deceptive misdescriptiveness refusal under § 2(e)(1), 15 U.S.C. § 1052(e)(1).

<sup>3</sup> 4 TTABVue.

reconsideration,<sup>4</sup> and then Applicant and the Examining Attorney filed briefs in the appeal. We reverse the refusal to register.

## II. Deceptiveness

Trademark Act Section 2(a) bars registration of a mark that “consists of or comprises ... deceptive ... matter.” 15 U.S.C. § 1052(a); *see also In re Budge Mfg. Co.*, 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988). A deceptive mark cannot be registered on the Principal or Supplemental Register, and neither acquired distinctiveness nor a disclaimer of the deceptive matter renders it registrable. *In re White Jasmine LLC*, 106 USPQ2d 1385, 1391 (TTAB 2013); *see also In re E5 LLC*, 103 USPQ2d 1578, 1584 (TTAB 2012). A proposed mark must be refused as deceptive if:

(1) it consists of or comprises a term that misdescribes the character, quality, function, composition, or use of the goods;

(2) prospective purchasers are likely to believe that the misdescription actually describes the goods; and

(3) the misdescription is likely to affect the purchasing decision of a significant or substantial portion of relevant consumers.

*In re Budge*, 8 USPQ2d at 1260; *see also In re Spirits Int’l, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1493, 1495 (Fed. Cir. 2009); *In re Tapco Int’l Corp.*, 122 USPQ2d 1369, 1371 (TTAB 2017).

---

<sup>4</sup> 4-10 TTABVUE.

To satisfy the first prong of the test, the Examining Attorney contends that “pili” refers to pili nut oil, an ingredient from the Philippines that misdescribes Applicant’s goods, which do not contain pili oil. Turning to the second and third prongs, according to the Examining Attorney, “the goods are of a type that are made with pili oil and are commonly available. Further, consumers of pili oil based cosmetics are purchasing these goods specifically because they contain pili oil.”<sup>5</sup> The record includes online articles and blogs discussing skincare products containing pili oil and screenshots from websites featuring these types of goods.<sup>6</sup> In further support of the alleged materiality of pili nut oil to a consumer’s purchasing decision, the Examining Attorney points out examples of pili oil and pili oil-based products that are more expensive than Applicant’s goods.<sup>7</sup>

While Applicant concedes that its goods do not contain pili oil,<sup>8</sup> it maintains that none of the three prongs of the deceptiveness test is met here. First, Applicant opines that pili oil as a cosmetic ingredient is so obscure as to be “essentially non-

---

<sup>5</sup> 14 TTABVUE 6 (Examining Attorney’s Brief).

<sup>6</sup> 5 TTABVUE 6-15; 6-10 TTABVUE; October 3, 2017 Office Action at 2-47; November 10, 2017 Office Action at 2-44; June 4, 2018 Office Action at 2-50.

<sup>7</sup> *E.g.*, November 10, 2017 Office Action at 43 (ebay.com listing for Pili Ani facial oil at \$98); June 4, 2018 Office Action at 8 (Bloomberg article lists Pili Ani prices at “\$110 for the lotion” and “\$125 for the oil.”).

<sup>8</sup> According to Applicant, its mark derives not from a reference to the pili nut, but from a commonly used nickname, short for “Pilar” in Columbia, Applicant’s country of origin. 12 TTABVUE 8 (Applicant’s Brief); May 10, 2018 Response to Office Action at 3 (Felipe Bernal Vazquez Declaration). In response to an inquiry from the Examining Attorney, Applicant responded, “PILI appearing in the mark has no significance nor is it a term of art in the relevant trade or industry or as used in connection with the goods/services/collective membership organization listed in the application, or any geographical significance. The word(s) PILI has no meaning in a foreign language.” TSDR July 11, 2017 Response to Office Action.

existent to the relevant U.S. consumer.”<sup>9</sup> Second, Applicant argues consumers would not believe that the goods at issue contain pili oil because of its rarity in the cosmetics field in the U.S. Addressing the Examining Attorney’s evidence of pili oil as a cosmetic ingredient, Applicant points out that much of it comes from foreign websites and should be deemed irrelevant, while other evidence actually suggests the obscurity of pili oil with references such as “the Beauty Secret You Never Knew About”<sup>10</sup> and “relatively new to Western culture.”<sup>11</sup> Third, Applicant contends that because the relevant consumer would not be familiar with pili, the presence of pili oil as an ingredient in Applicant’s goods would not be material to a purchasing decision.

Applicant provided supporting evidence in the form of two declarations, one from its Director, Felipe Bernal Vasquez,<sup>12</sup> and another from Abraham Menasche, a longtime U.S. beauty store manager who states that pili oil “is not known as an ingredient used in the beauty or cosmetic industry,” and who has sold Applicant’s products since 2012 without any inquiries about whether they contain pili.<sup>13</sup> Mr. Bernal Vasquez’s declaration details and includes his Internet searches of the websites of Forbes’ list of top 10 beauty and cosmetic companies, such as Neutrogena, L’Oreal, Estee Lauder, and Nivea, with no “hits” for “pili” on any of the

---

<sup>9</sup> 12 TTABVUE 8 (Applicant’s Brief).

<sup>10</sup> October 3, 2017 Office Action at 10 (preen.inquirer.net).

<sup>11</sup> June 4, 2018 Office Action at 11 (trustedhealthproducts.com).

<sup>12</sup> May 10, 2018 Office Action at 3-76.

<sup>13</sup> May 10, 2018 Office Action at 77.

sites.<sup>14</sup> Applicant also later submitted additional negative search results for “pili” on the websites of a large volume of skincare companies, including those ranked among the top skincare brands, as well as negative search results on the websites of major retail chains that sell skincare products, such as Ulta, Sephora, Walgreens and CVS, with corroborating Alexa Internet search rankings suggesting relatively high traffic.<sup>15</sup> Applicant also notes that the Philippines-based Pili Ani brand of skincare states on its website that it is “The Only Skincare Line made with Powerful Pili Tree Oils.”<sup>16</sup> Finally, to further counter the Examining Attorney’s assertions and evidence regarding the commonplace nature of pili as a skincare ingredient in the U.S., Applicant offered Alexa Internet search rankings suggesting that some of the sites relied on by the Examining Attorney have relatively low traffic,<sup>17</sup> and thus little consumer exposure.

Having considered all the arguments and evidence, even if we assume that the first prong of the deceptiveness test is met, such that “pili” misdescribes Applicant’s goods, on this record we cannot find that the second prong is met. The evidence does not suffice to show that prospective purchasers would believe the misdescription because the record does not show that the relevant U.S. consumer generally would be familiar with pili as an ingredient in such goods.

---

<sup>14</sup> May 10, 2018 Office Action at 3-76.

<sup>15</sup> 4 TTABVUE 49-164 (third-party websites); 165-496 (alexa.com).

<sup>16</sup> Another article on the Asian Fusion website refers to Pili Ani as “the only producer of luxury Pili powered natural skin care in the world.” 9 TTABVUE 4 (asianfusion-mag.com).

<sup>17</sup> 4 TTABVUE 497-528 (alexa.com).

First, most of the evidence of the supposedly commonplace nature of pili-based skincare products comes from foreign websites, primarily from the Philippines. For example, “Expatriate Philippines -- Your Local Guide” at [expatphilippines.ph](http://expatphilippines.ph)<sup>18</sup> and the Business Mirror at [businessmirror.com.ph](http://businessmirror.com.ph)<sup>19</sup> use the Philippines country code “ph” in their web addresses. The content of the article and surrounding advertising on the Business Mirror site further confirm that it emanates from the Philippines.<sup>20</sup> As another example, the Manila Times, from which another article in the record comes, is based in the capitol of the Philippines.<sup>21</sup> “The Macho Mom by Kikaysikat” blog includes the statement, “This is your source for the best in makeup reviews, skincare, gadget reviews, fitness, food, fashion, and lifestyle in the Philippines.”<sup>22</sup> The Preen Inquirer notes that pili oil “is locally made” by “a Bicol-based company” and encourages consumers to “support[] our local industry.”<sup>23</sup> The Trixie Reyna website describes itself as “Curating Lifestyle Essentials for Filipinos Online Since 2008,” and shows pricing in Philippine currency.<sup>24</sup> Other sites also show pricing in this foreign currency, reflecting that U.S. customers are not the target audience.<sup>25</sup>

*Contrast In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1052 (TTAB 2006)

---

<sup>18</sup> October 3, 2017 Office Action at 7 ([expatphilippines.ph](http://expatphilippines.ph)).

<sup>19</sup> October 3, 2017 Office Action at 22-26 ([businessmirror.com.ph](http://businessmirror.com.ph)).

<sup>20</sup> October 3, 2017 Office Action at 22-26 ([businessmirror.com.ph](http://businessmirror.com.ph)).

<sup>21</sup> October 3, 2017 Office Action at 46-51 ([manilatimes.net](http://manilatimes.net)).

<sup>22</sup> October 3, 2017 Office Action at 34-40 (quote at 40) ([kikaysikat.com](http://kikaysikat.com)).

<sup>23</sup> October 3, 2017 Office Action at 10-12 ([preen.inquirer.net](http://preen.inquirer.net)).

<sup>24</sup> 7 TTABVUE 4 ([Trixiereyna.com](http://trixiereyna.com)); *id.* at 4-10 (currency).

<sup>25</sup> The Beauty MNL website and the Calyxta website, 6 TTABVUE 5 ([calyxta.com](http://calyxta.com)), show prices in Philippine currency.

“Again, prices are denominated in dollars, and again, we find that this is a web site that would be accessible by prospective consumers in the United States searching for products available in the United States.”). In this context, given the nature of the website evidence at issue, and absent indications that these sites are widely used by U.S. consumers, we find the foreign website evidence to have minimal probative value to show what U.S. consumers would be familiar with and believe. *Contrast In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1835 (Fed. Cir. 2007) (holding that “the probative value, if any, of foreign information sources must be evaluated on a case-by-case basis” and according some probative value to foreign sites providing information on “news, medical research results, and general medical information”); *In re Remacle*, 66 USPQ2d 1222, 1224 n.5 (TTAB 2002) (“[I]t is reasonable to consider a relevant article from an Internet web site, in English, about medical research in another country, Great Britain in this case, because that research is likely to be of interest worldwide regardless of its country of origin”). Particularly because information on, and sales of, beauty and skincare products generally are so prevalent on the Internet, the lack of comparable evidence from U.S.-based sites seems telling.

Second, we agree with Applicant that statements on many of the websites actually corroborate the obscurity of pili as a skincare ingredient. In addition to the examples above cited by Applicant, other examples from the Examining Attorney’s evidence include:



The StyleCraze website article states that “Pili nuts are the world’s **best kept secret** ‘nut,’ but that doesn’t mean they are loony at all!”<sup>26</sup>

The NewsInfo.Inquirer.net website article states that the Philippines is the only source for pili resin, and “[t]he recent state of the Manila elemi [pili] resin production is **not yet as developed** as compared to the pili nut confectionary industry where more than 256 entrepreneurs are involved in the region.”<sup>27</sup>

A 2018 article on the Calyxta website states that “the pili’s oil extract just happens to be one of the **recent breakthroughs** in the beauty market.”<sup>28</sup>

The Trixie Reyna website and the KidWolfX website both refer to “the **under-appreciated potential of the local [to the Philippines] pili tree,**” with Trixie Reyna also stating that “you probably only knew [pili] as a candied delicacy.”<sup>29</sup>

The Pili Ani website touts itself as “the **only** luxury beauty brand that crafts products using pili oil.”<sup>30</sup>

The BES Skincare site refers to the pili tree as an anti-aging “**secret**” in the Philippines.<sup>31</sup>

A 2018 Bloomberg article is titled “This Nut Oil from the Philippines Is the **New Secret** to Beautiful Skin.”<sup>32</sup>

The Manila Times article refers to a Philippine manufacturer of pili skincare products as “choosing to share the Philippines precious beauty **secret.**”<sup>33</sup>

---

<sup>26</sup> October 3, 2017 Office Action at 28 (stylecraze.com) (emphasis added).

<sup>27</sup> November 10, 2017 Office Action at 15 (newsinfo.inquirer.net) (emphasis added).

<sup>28</sup> 6 TTABVUE 4 (calyxta.com) (Denial of Reconsideration) (emphasis added).

<sup>29</sup> 7 TTABVUE 10 (trixiereyna.com) (emphasis added); 8 TTABVUE 9 (kidwolfx.com) (emphasis added).

<sup>30</sup> June 4, 2018 Office Action at 29 (pilianicom.com) (emphasis added).

<sup>31</sup> June 4, 2018 Office Action at 3 (bessskincare.com) (emphasis added).

<sup>32</sup> June 4, 2018 Office Action at 7 (Bloomberg.com) (emphasis added).

<sup>33</sup> October 3, 2017 Office Action at 43 (manilatimes.net) (emphasis added).

Moreover, we find persuasive Applicant's submission of Alexa Internet traffic rankings to show the relatively low consumer exposure of some of the Examining Attorney's other evidence regarding pili as a skincare ingredient.<sup>34</sup> "On balance, we find that the data obtained from the www.Alexa.com web site measuring Internet traffic confirms the comparatively obscure nature of the third-party usages." *In re Country Music Ass'n, Inc.*, 100 USPQ2d 1824, 1830 (TTAB 2011).

While the record shows some availability of skincare products with pili to U.S. consumers, the evidence does not show that this is common, or that the products have much consumer exposure. For example, the Philippines-based Pili Ani skincare company, which appears to offer products in the U.S., has a Facebook page with a total only of 4,736 followers.<sup>35</sup> Additionally, Amazon.com sells a "My Prime Anti-Aging Transformative Night Cream with Pili and Moringa Oils," but the page displays only four customer reviews.<sup>36</sup> Similarly, the page for Amazon's "My Prime Anti-Aging Skin Recovery and Brightening Formula with Pili and Moringa Oils" only has nine customer reviews.<sup>37</sup> Given these indications of minimal consumer exposure, the mere availability of these products to U.S. consumers does not suffice to show that consumers would be familiar with pili as an ingredient in skincare products.

---

<sup>34</sup> 4 TTABVUE 497-528 (alexa.com).

<sup>35</sup> June 4, 2018 Office Action at 51 (facebook.com/pilianibeauty/).

<sup>36</sup> November 10, 2017 Office Action at 27 (amazon.com). Applicant's "Pili Natural Calendula Cream" is shown below as "Sponsored products related to this item." *Id.* at 34.

<sup>37</sup> *Id.* at 28.

Ultimately, on this record, we cannot find that the relevant U.S. consumer would believe that Applicant's goods contain pili oil because the evidentiary record does not convince us that this ingredient would be known to the consumer. Thus, the evidence falls short of establishing the second prong of the deceptiveness test. For the same reason, the presence of pili oil would not be material to the relevant U.S. consumer purchasing Applicant's goods. Thus, the record also fails to establish the third prong of the deceptiveness test.

**Decision:** The refusal to register the mark on the ground that it is deceptive of Applicant's goods under Trademark Act Section 2(a) is reversed.