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Subject: U.S. Trademark Application Serial No. 87631770 - ORGANIC NATURAL ENERGY - N/A - EXAMINER BRIEF

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United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 87631770

Mark: ORGANIC NATURAL ENERGY

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Reference/Docket No. N/A

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EXAMINING ATTORNEY'S APPEAL BRIEF

STATEMENT OF THE CASE

Applicant seeks to register



for “Meal replacements being a nutritional supplement in the form of bars, snacks, and shakes consisting primarily of organic and natural ingredients adapted for functional health benefit” in International Class 005 and “Organic nut based food bars; organic fruit based ready to eat food bars also containing organic cacao, organic seeds, organic coffee and organic yerba mate; organic vegetable based food bars; vegetable, nut and fruit based food beverages, all the foregoing consisting primarily of organic and natural ingredients; vegetable, nut and fruit based powders for making vegetable, nut and fruit based food beverages and shakes consisting primarily of organic and natural ingredients, also containing organic seeds, organic cacao, organic coffee and organic yerba mate” in International Class 029. Applicant has appealed the Trademark Examining Attorney’s final requirement to disclaim the wording ORGANIC NATURAL ENERGY.

FACTS

Applicant seeks registration on the Principal Register of the mark ORGANIC NATURAL ENERGY in design form for the following goods:

International Class 005: Meal replacements being a nutritional supplement in the form of bars, snacks, and shakes consisting primarily of organic and natural ingredients adapted for functional health benefit

International Class 029: Organic nut based food bars; organic fruit based ready to eat food bars also containing organic cacao, organic seeds, organic coffee and organic yerba mate; organic vegetable based food bars; vegetable, nut and fruit based food beverages, all the foregoing consisting primarily of organic and natural ingredients; vegetable, nut and fruit based powders for making vegetable, nut and fruit based food beverages and shakes consisting primarily of organic and natural ingredients, also containing organic seeds, organic cacao, organic coffee and organic yerba mate

On October 3, 2017, applicant filed the application.

On January 19, 2018, the Examining Attorney issued an Office action requiring a clarification of the goods, a disclaimer of ORGANIC NATURAL ENERGY, and a new drawing.

On July 19, 2018, applicant filed a response satisfying the drawing requirement.

On August 23, 2018, the Examining Attorney issued a final refusal requiring the disclaimer and a clarification of the goods.

On December 13, 2018, applicant filed a request for reconsideration.

On January 14, 2019, the Examining Attorney denied the request for reconsideration.

On February 7, 2019, applicant filed a request for reconsideration.

On March 19, 2019, the Examining Attorney accepted the amended identification of goods and denied the request for reconsideration as to the disclaimer requirement.

On August 8, 2019, the case was forwarded to the Examining Attorney for brief. Due to a transmission error, only one page of applicant's brief was forwarded.

On August 29, 2019, applicant's full brief was forwarded to the Examining Attorney.

ISSUE

The sole issue on appeal is whether a disclaimer of ORGANIC NATURAL ENERGY should be required.

ARGUMENT

BECAUSE THE WORDING "ORGANIC NATURAL ENERGY" IS NOT INHERENTLY DISTINCTIVE, THE WORDING IS NOT ELIGIBLE FOR REGISTRATION ON THE PRINCIPAL REGISTER ABSENT A DISCLAIMER

Applicant must provide a disclaimer of the unregistrable parts of the applied-for mark even though the mark as a whole appears to be registrable. See 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a). A disclaimer of an unregistrable part of a mark will not affect the mark's appearance. See *Schwarzkopf v. John H. Breck, Inc.*, 340 F.2d 978, 979-80, 144 USPQ 433, 433 (C.C.P.A. 1965).

In this case, applicant must disclaim the wording ORGANIC NATURAL ENERGY because it is not inherently distinctive. These unregistrable terms at best are merely descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of applicant's goods. See 15 U.S.C. §1052(e)(1);

DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd., 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012); TMEP §§1213, 1213.03(a).

The wording ORGANIC NATURAL ENERGY is descriptive of the goods in that it immediately informs consumers of the type of ingredients found in the goods as well as a main characteristic and purpose of the goods. According to the evidence of record, “organic food or drink is produced using no or only a small number of artificial chemicals and methods.” The word “natural” is defined as “existing in or produced by nature: not artificial; relating to or being natural food.” Finally, energy means “a supply of physical power that you have for doing things that need physical effort.” See the evidence from www.macmillandictionary.com and www.merriam-webster.com attached to the January 19, 2018 Office action. Combined, this wording immediately informs consumers that the goods are made from organic and natural ingredients and provide consumers with nutrition to supply the physical power to do things that require physical effort.

The descriptive finding is further supported by the identification of goods listed in the application. Applicant’s identification states that the goods consist “primarily of organic and natural ingredients.” Thus, applicant’s own wording clearly indicates the terms “organic” and “natural” merely describe the ingredients in the goods.

Finally, certain supplements and food products are consumed to increase energy. See the evidence from www.womansday.com, www.eatthis.com, www.everydayhealth.com, www.healthline.com, and www.gnc.com attached to the January 14, 2019 Office action. This evidence

shows that fruits, vegetables, nuts and supplements can boost energy. As applicant's goods are nutritional supplements and food bars, food beverages, and powders containing vegetables, nuts and fruits, consumers will understand that applicant's goods are used to boost energy.

Applicant argues that the words are not merely descriptive and stated "Natural Energy is something a person may have, such as for example a natural athlete" and "organic may have its meaning of relating to a body organ or organs or may have its ordinary meaning of "derived from living matter"." See Applicant's brief at Page 4. This argument is unpersuasive. Descriptiveness is considered in relation to the relevant goods and/or services. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012). "That a term may have other meanings in different contexts is not controlling." *In re Franklin Cnty. Historical Soc'y*, 104 USPQ2d 1085, 1087 (TTAB 2012) (citing *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979)); TMEP §1209.03(e). "It is well settled that so long as any one of the meanings of a term is descriptive, the term may be considered to be merely descriptive." *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1590 (TTAB 2018) (quoting *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984)).

"Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). The question is not whether someone presented only with the mark could guess what the goods and/or services are, but "whether someone who knows what the goods and[or] services are will understand the mark to convey information about them." *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012) (quoting *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002)); *In re Mueller Sports. Med., Inc.*, 126 USPQ2d 1584, 1587 (TTAB 2018).

Here, the wording ORGANIC NATURAL ENERGY is used in connection with goods containing organic and natural ingredients and comprised of ingredients shown to boost energy. Thus, when viewed in connection with the goods, this wording is merely descriptive.

Applicant further argues “the Examining Attorney has stated an opinion without providing any evidence. There is simply no evidence that ORGANIC NATURAL ENERGY is descriptive.” See Applicant’s brief at Page 6. This argument is unpersuasive. The dictionary evidence and third-party websites, combined with applicant’s own wording in the identification of goods, clearly demonstrates ORGANIC NATURAL ENERGY is descriptive of applicant’s goods.

THE PROPOSED MARK IS NOT UNITARY AND A DISCLAIMER OF ORGANIC NATURAL ENERGY IS REQUIRED

A term or phrase is unitary if it consists of elements that create a single commercial impression or have a distinct commercial impression independent of the constituent elements. TMEP §1213.05, (b). The test for determining whether a mark is unitary focuses on whether the elements of a mark are so integrated or merged together that they cannot be regarded as separable. TMEP §1213.05; *see In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983). However, if the elements are considered separable, the matter is not unitary and the unregistrable constituent elements may be disclaimed. *See In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1477 (TTAB 2007); *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1288 (TTAB 2006); TMEP §1213.05(b)(iv), (g), (g)(i).

The Court of Appeals for the Federal Circuit has set forth the elements of a unitary mark:

A unitary mark has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent elements. In other words, a unitary mark must create a single and distinct commercial impression.

Dena Corp. v. Belvedere Int'l, Inc., 950 F.2d 1555, 1561, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991).

In the present case, the applied-for mark is not unitary. Therefore, the wording ORGANIC NATURAL ENERGY is separable from the design elements and must be disclaimed.

The leaf design inside of the “O” in “ORGANIC” is not sufficiently integrated as to render the wording inseparable from the design. Indeed, as stated in TMEP Section 1213.05(g)(i), “Marks with a distinctive design that replaces a letter or part of a letter are registrable on the Principal Register with a disclaimer of the merely descriptive, generic, or primarily geographically descriptive wording.” The leaf design merely replaces a part of the letter “O” and thus the term “ORGANIC” is subject to a disclaimer requirement to be registrable on the Principal Register.

Moreover, the box surrounding the first letter of each word is merely a carrier. Most common geometric shapes, such as circles, ovals, triangles, diamonds, or stars, when used as a background for word or letter marks are not considered inherently distinctive. *See In re Benetton Grp. S.p.A.*, 48 USPQ2d 1214, 1216 (TTAB 1998). As the Board explained,

The rationale . . . is that designs of this character have been so commonly employed as background devices for word marks that composite marks of this type create but a single commercial impression with the result that purchasers would normally utilize the word portions of the marks to identify and distinguish the goods sold thereunder

In re Wendy's Int'l, Inc., 227 USPQ 884, 885 (TTAB 1985) (quoting *Permatex Co. v. Cal. Tube Prods., Inc.*, 175 USPQ 764, 766 (TTAB 1972)).

Accordingly, the wording in the proposed mark is separable from the design elements and a disclaimer is necessary.

Applicant argues that the visual presentation of the mark, forming the word "ONE", "is such that the words form a unitary whole." See Applicant's brief at Page 2. This argument is unpersuasive. A consumer viewing the proposed mark would pull out the wording ORGANIC NATURAL ENERGY when reading the wording from left to right.

Applicant further argues that the "design element of the mark creates a distinct commercial impression." See Applicant's brief at Page 2. This argument is unpersuasive. As discussed above, the box design around the first letter in each word is a mere carrier. Furthermore, the leaf design forms a part of the letter O, but remains separable from the term ORGANIC as a whole.

Applicant also argues that the proposed mark forms a syllabic meter with a syllabic rhythm. See Applicant's brief at Page 3. This argument is unpersuasive as applicant has not pointed to any evidence or precedence that a syllabic rhythm would overcome a disclaimer requirement.

Applicant further argues that the "mark is a coined mark in the nature of a collective anagram and a crossword puzzle arrangement." See Applicant's brief at Page 3. The Examining Attorney respectfully disagrees. Applicant's depiction of the proposed mark is misleading, as the words are not stacked in such a way that the letters form uniform vertical rows. The wording is written with its natural spacing rather than in a crossword puzzle formation. Therefore, it is unlikely consumers will separate any vertically written terms from the mark as a whole. Conversely, it is likely that consumers will read the wording in the traditional way, from left to right.

As the literal elements are separable from the design elements, the proposed mark is not unitary and the words must be disclaimed.

CONCLUSION

In a unitary mark, the descriptive wording must be so integrated with the design elements or other words as to lose its descriptive significance. In the present case, the wording ORGANIC NATURAL ENERGY in the proposed mark is descriptive and is separable from the other elements in the mark. For these reasons, the proposed mark is not unitary and the requirement to disclaim ORGANIG NATURAL ENERGY should be affirmed.

Respectfully submitted,

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