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**THIS DISPOSITION
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Paper No. 10
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Professional Product Research, Inc.

Serial No. 75/461,701

William H. Cox of Janvey, Gordon, Herlands, Randolph,
Rosenberg & Cox, LLP for Professional Product Research,
Inc.

Kelley L. Williams, Trademark Examining Attorney, Law
Office 115 (Tomas Vlcek, Managing Attorney).

Before Seeherman, Quinn and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

An application has been filed by Professional Product
Research, Inc. to register on the Principal Register the
mark TEA TREE FOR TOES for "fungal medications, namely,
creams, ointments and sprays for foot care purposes
containing Tea Tree Oil" in International Class 5.¹
Applicant included a disclaimer of the words "tea tree" in
its original application.

¹ Application Serial No. 75/461,701, filed April 3, 1998, in
which applicant alleges a bona fide intention to use the mark in
commerce.

Registration has been refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that the mark TEA TREE FOR TOES, when applied to the goods of the applicant, is merely descriptive of them.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm.

The Examining Attorney contends that the mark TEA TREE FOR TOES is merely a combination of the descriptive words "tea tree" referring to "tea tree oil," which is an ingredient in applicant's fungal medications, and "for toes" which identifies the body part on which applicant's goods are to be applied; that these ordinary descriptive terms convey an immediate idea to potential purchasers that applicant's goods consist of a fungal medication which has "tea tree oil" as an ingredient and it is for the toes and the foot.

In support of the refusal to register, the Examining Attorney submitted (i) several excerpts from a Nexis search to establish that tea tree oil is applied to toes to treat fungal conditions; and (ii) several third-party registrations containing disclaimers of words in marks which identify the body parts for which the goods (relating

to medication or treatment) were intended (e.g., "hand(s)," "foot" or "feet," and "skin").

A few examples of the excerpted Nexis stories submitted by the Examining Attorney are reproduced below (emphasis added):

- (1) Headline: This Just In, What's New? **Tea Tree** for **toes** and feet, **Tea tree** oil may not be advertised during the evening news, but it is a hot-selling remedy, according to its promoters, "Sarasota Herald-Tribune," May 3, 1999;
- (2) Headline: How to keep your feet well-heeled, Avoid sharing towels with people, as warm, moist areas are ideal for the spread of infections. Apply **tea tree** oil between the **toes** to treat and prevent athlete's foot, "The Gloucester Citizen," July 21, 1999; and
- (3) Headline: Indian summer; Ayurvedic remedies for summertime ailments, **Tea Tree** Oil: The first solution to this annoying problem is to clean the feet with **tea tree** oil. Rub this natural antiseptic oil between your **toes** with a cotton swab, "Natural Health," May 15, 1998.

Applicant argues that its mark is suggestive and not merely descriptive because (i) "tea tree is not one of the ingredients" of applicant's product, rather applicant's product is "tea tree oil in solution," but it is not tea tree branches, leaves, bark, roots, etc., and (ii)

applicant's product can be used "all over the body," not just on the feet; that in this case the combination of descriptive terms "creates a unique commercial impression" (brief, pp. 2-4); and that there are three² third-party registrations which include the words 'TEA TREE' in the mark and are for goods which include tea tree oil, but are registered on the Principal Register. Further, applicant argues that the mark is suggestive of or "brings to mind sandals or shoes made of tea tree wood, toe cushions, plasters or bandages made of tea tree leaves, socks woven from parts of a tea tree, jewelry to adorn the foot, such as rings, could be made of a part of a tea tree or a foot or nail brush made of tea tree." (Brief, p. 3.)

The test for determining whether a mark is merely descriptive is whether the term immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); and *In re Bright-Crest, Ltd.*, 204

² In its brief on appeal applicant included a reference to a fourth registration. Despite the untimeliness thereof under Trademark Rule 2.142(d), and the improper mere listing of same [see *In re Duofold, Inc.*, 184 USPQ 638 (TTAB 1974)], the Examining Attorney stated that she did not object thereto. Thus, we have considered all four third-party registrations, discussed *infra*.

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USPQ 591 (TTAB 1979). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991). The question is not whether someone presented with only the mark could guess what the goods are. Rather, the question is whether someone who knows what the goods are will understand the mark to convey information about them. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990).

In the present case, we agree with the Examining Attorney that TEA TREE FOR TOES is merely descriptive of fungal medications containing tea tree oil for foot care. The ordinary, commonly understood meanings of the words "tea tree" and "for toes," combined in the mark TEA TREE FOR TOES, and used in the context of applicant's goods, immediately inform prospective purchasers that applicant's fungal medication is intended as a product for the

treatment of conditions of a person's feet, and specifically the toes. The mark names an ingredient in applicant's product and the part of the body that the goods are intended to be used on. Thus, the mark TEA TREE FOR TOES provides straight-forward information about the goods.

Applicant's argument that the purchasing public would think of other possible meanings (e.g., jewelry, sandals, or other products which might have been made from a tea tree) would require considering the mark in a vacuum. These meanings would clearly not come to mind when the mark is viewed in connection with fungal medication. Thus, in the context of applicant's goods ("fungal medications, namely, creams, ointments and sprays for foot care purposes containing Tea Tree Oil"), the mark merely describes the goods to the purchasing public.

Applicant's mark is not incongruous, creates no double meaning, takes no imagination or thought as to meaning, and does not create a commercial impression or meaning which relates to anything except an ingredient of the goods and a part of the foot.³

³ The case now before us is distinguishable from cases that involve marks which are suggestive of a desired *result* of the use of the goods such as, *In re Nalco Chemical Company*, 228 USPQ 972 (TTAB 1986) (*VERI-CLEAN* held not merely descriptive when used on anti-fouling additives for use in refineries), and the cases cited therein, including *In re Pennwalt Corporation*, 173 USPQ 317

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Applicant's argument regarding four third-party registrations, all for marks which include the words "TEA TREE," is not persuasive. Those registrations include words or elements which were considered not to be merely descriptive, as a result of which the registrations were issued with a disclaimer of "TEA TREE." In the present case, however, the mark as a whole, including all of the elements, is merely descriptive.

Decision: The refusal to register under Section 2(e)(1) is affirmed.

(TTAB 1972) (DRI-FOOT held not merely descriptive when used on anti-perspirant deodorant for feet).