

5/31/01

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Paper No. 10
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Calpis Co., Ltd.

Serial No. 75/621,635

David Toren of Brown & Wood, LLP for Calpis Co., Ltd.

Carol A. Spils, Trademark Examining Attorney, Law Office 101
(Jerry Price, Managing Attorney).

Before Wendel, Bucher and Holtzman, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Calpis Co., Ltd. seeks to register LACTO TRIPEPTIDE for
"milk, namely cows' milk, sheep milk, goat milk, milk powder,
butter, sour milk beverages, lactic acid beverages and
fermented milk," in International Class 29.¹

Registration has been finally refused on the ground that
the mark LACTO TRIPEPTIDE is merely descriptive within the

¹ Application Serial Number 75/621,635, filed on January 14, 1999. The application is based upon applicant's claim of a *bona fide* intention to use the mark in commerce. Although the original application contained additional goods classified by the Trademark Examining Attorney in two other classes (i.e., International Classes 30 and 32), it appears as if applicant has never paid the required application fees for these additional classes. Similarly, with its notice of appeal, applicant approved fees for only a single class on appeal. Accordingly, this application, on appeal, is being handled in every respect as if a single class application in International Class 29 alone, the lowest numbered class in ascending order.

meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). Applicant and the Trademark Examining Attorney have filed briefs, but an oral hearing was not requested.

It is well settled that a term is considered to be merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately conveys information about an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services with which it is being used. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. On the other hand, the immediate idea must be conveyed with some "degree of particularity." In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd 90-1495 (Fed. Cir. Feb. 13, 1991); In re TMS Corporation of the Americas, 200 USPQ 57, 59 (TTAB 1987).

Furthermore, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought. Thus, "[w]hether consumers could guess what the product [or service] is from

consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985). We must look to the context in which the term is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. In re Bright-Crest Ltd., 204 USPQ 591, 593 (TTAB 1979).

However, a mark is suggestive if, when the goods or services are encountered under the mark, a multistage reasoning process, or the utilization of imagination, thought or perception, is required in order to determine what attributes of the goods or services the mark indicates. See In re Abcor Development Corp., *supra* at 218, and In re Mayer-Beaton Corp., 223 USPQ 1347, 1349 (TTAB 1984). As has often been stated, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See In re Atavio, 25 USPQ2d 1361 (TTAB 1992) and In re TMS Corporation of the Americas, *supra* at 58. The distinction, furthermore, is often made on an intuitive basis rather than as a result of precisely logical analysis susceptible of articulation. See In re George Weston Ltd., 228 USPQ 57, 58 (TTAB 1985).

The Trademark Examining Attorney maintains that the mark LACTO TRIPEPTIDE immediately conveys information with respect to an ingredient of applicant's goods.

In support of her interpretation of the term LACTO, the Trademark Examining Attorney attached to the original Office action LEXIS/NEXIS® excerpts referring to the "lacto vegetarian" in dietary terms as one who avoids all animal produce but consumes milk products. Consistent with this contextual usage, we take judicial notice from multiple dictionary entries that the prefix "lacto-" in the combined form indicates "milk," and not surprisingly, shares the same Latin stem "lact" as the words "lactate," "lactation" and "lactose."²

In response, applicant argues that this scientific or technical meaning of the term "lacto" with regard to the milk products listed above " ... is not likely to be appreciated by the average customer." (applicant's brief, p. 2).

Furthermore, applicant cited to a number of third-party registrations in its response to the first Office action, and to some additional registrations in its brief, where the term "Lacto," makes up the initial component of composite marks

² The American Heritage Dictionary of the English Language, ©1975, p. 732.

used in connection with milk products and the term "Lacto," was not disclaimed.³

In the second Office action, the Trademark Examining Attorney attached multiple NEXIS® excerpts which mention "tripeptide" molecules. This usage pertains broadly at the level of molecular biology to the break down of essential amino acids from all types of protein molecules, including but not limited to those molecules found in milk products.

Similar to its arguments as to the word "lacto," applicant admits that the term TRIPEPTIDE might well describe one of many different amino acid compounds contained in these goods. According to applicant:

"[A]rguing that TRIPEPTIDE describes the goods is akin to arguing that "cement powder" describes houses. The word TRIPEPTIDE does not carry any meaning for the average customer and would be appreciated by the consumer to represent source and not an ingredient of the goods."

(applicant's brief, p. 3).

Furthermore, applicant argues that even if the individual components of its mark are descriptive, here the combination

³ Because the Trademark Examining Attorney has not objected to the form of submission of these listed registrations, we consider them to be of record. However, in many of the composite marks cited by applicant, the absence of a disclaimer is of little probative value herein. This is true because in many of the listed marks, the "LACTO-" portion of a mark is merged so as to be considered unitary, in which case no disclaimer of a descriptive element is required. See TMEP §1213.06(a).

of words is stronger than the sum of the two components. Applicant contends that the Trademark Examining Attorney has failed to meet her burden of proof with respect to the mere descriptiveness of the mark LACTO TRIPEPTIDE, as a whole. Applicant points to the fact that the Trademark Examining Attorney has made of record no evidence of competitors' descriptive use of the term or, in fact, of any third-party usage of the term "lacto tripeptide." Rather, applicant argues that one must conduct a multistage reasoning process to connect the term LACTO TRIPEPTIDE to the listed dairy products.

We find that each of these words is highly suggestive, if not merely descriptive, of an attribute of these goods. However, the combination of these two words creates a new term for which, on this record, we must conclude there is no use in the scientific literature. The Trademark Examining Attorney has produced no evidence of usage in the United States of the combined term "lacto tripeptide" by others in the food or beverage field, in the scientific community or in the general media.⁴

⁴ The one exception is a publication for food manufacturers published in the United Kingdom. This article lists dietary supplements and "functional food products" acknowledged by the Japanese Ministry of Health and Welfare. Clearly, even if this reflects a single instance of usage in Europe and/or Japan, this does not reflect usage in the United States.

The Examining Attorney's position appears to be little more than speculation about the nature of the feature and/or the ingredient of applicant's goods referenced by the term "Lacto Tripeptide." Accordingly, on the basis of the limited record before us, we find insufficient evidence to hold the term LACTO TRIPEPTIDE, as a whole, merely descriptive when used in connection with applicant's dairy products. Based upon this record, a multistage reasoning process or imagination would be necessary in order for customers or prospective purchasers of these milk-based products to conclude anything meaningful about the features or ingredients of such goods. The term LACTO TRIPEPTIDE, when used in connection with foods and beverages derived from animal milk, has not been shown to immediately or directly describe any significant aspect of applicant's particular goods.

Moreover, to the extent that there may be any doubt as to whether applicant's mark is merely descriptive or suggestive of its goods, we consider it appropriate to resolve such doubt in the favor of applicant. Then upon publication of applicant's mark, any person who believes that she would be damaged by the registration of the mark will have the opportunity to file an opposition thereto. See In re Merrill Lynch, Pierce, Fenner, and Smith inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); In re Morton-Norwich Products, Inc.,

209 USPQ 791 (TTAB 1981); and In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972).

Decision: The refusal to register under Section 2(e)(1) is hereby reversed, but a Notice of Allowance should issue for this mark as to the goods listed in International Class 29, the only class for which a filing fee appears to have been paid.