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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Naturopathic Laboratories International Inc.**

Serial No. 76305377

Dennis H. Cavanaugh of Ullman, Shapiro & Ullman for **Naturopathic Laboratories International Inc.**

Ronald McMorrow, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before **Simms**, **Seeherman** and **Hohein**, Administrative Trademark
Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

Naturopathic Laboratories International Inc. has filed
an application to register the term "PATCH4PAIN" for "topical
analgesics."¹

Registration has been finally refused under Section
2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the
ground that, when used in connection with applicant's goods, the
term "PATCH4PAIN" is merely descriptive of them.

¹ Ser. No. 76305377, filed on August 25, 2001, which is based on an
allegation of a bona fide intention to use such term in commerce.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. See, e.g., *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. Moreover, 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, the context in which it is being used or is intended to be 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 such use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). 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).

Applicant contends that the term "PATCH4PAIN" is suggestive rather than merely descriptive of its topical analgesics, arguing that such term fails to convey information as to the ingredients, qualities or characteristics of its goods with the required degree of particularity. According to applicant:

[C]onsumers must engage in a multi-stage reasoning process in order to connect the mark to the particular goods. Upon hearing or seeing the term ..., consumers are unlikely to make the immediate connection between the mark and a topical analgesic delivered transdermally via a skin patch. Furthermore, the term "patch for pain" has been used to describe many different types of goods, thereby precluding a finding of [mere] descriptiveness. [Citation omitted.] A recent internet search for "patch for pain" revealed the term is currently being used to describe a variety of products including animal tranquilizers, magnetic pain patches for arthritis, bandages, wraps, and plaster patches. Therefore, the connection between "PATCH4PAIN" and topical analgesics is not an immediate one. The degree of particularity with which Applicant's mark describes the identified goods, namely topical analgesics, is lacking here. The mark does not indicate what type of pain is being relieved, how the patch works, how or where it is to be applied, what ingredients are present, or how the analgesic is being released. The ambiguity of the mark and the lack of information about key characteristics of the goods indicates that Applicant's mark is suggestive.

In addition, applicant maintains that in view of the "level of fancifulness" inherent in the term "PATCH4PAIN," such term is suggestive rather than merely descriptive of its goods inasmuch as "competitors can still use the words 'patch for pain' to describe their [topical analgesic] products without infringing on Applicant's mark." Specifically, applicant asserts that

because "'PATCH4PAIN' is a composite mark made up of three components, 'PATCH,' '4,' and 'PAIN,'" in which the words "PATCH" and "PAIN" are separated by the number "4," "a suggestive mark is created."² Furthermore, applicant maintains that, even if the individual components of the composite term "PATCH4PAIN" are

² Applicant, in its initial brief, also argues that "[n]umerous marks related to Applicant's goods have been allowed for registration using the word 'PATCH' and other descriptive components," listing as examples thereof the following: "ALLERPATCH" for an asthma patch; "SPRAY-PATCH" for cosmetics and medicated dermatological products; "MEDIPATCH" for medical bandages; and "DENTIPATCH" for an oral patch for delivering anesthetics and analgesics. In view thereof, and because, according to applicant, several other "marks have also been found to be non-descriptive," including "INVISIBLE PATCH" for medicinal and nutritional skin gel and skin lotion for use as nutritional supplements, applicant essentially contends that the term "PATCH4PAIN" should likewise be "allowed for registration." However, in his brief, the Examining Attorney "respectfully requests that the Board not consider the applicant's arguments regarding third-party registrations and applications because copies of the registrations [and applications] were not properly made of record." In particular, because the information applicant furnished consisted only of a listing of various marks and the goods associated therewith, the Examining Attorney states that he "is aware that objection to this improper evidence should have been made previously and respectfully requests that the [B]oard waive this requirement in light of the assignment of this application to a new examining attorney after issuance of the final refusal."

The Examining Attorney's request is denied. While it is true that as a general proposition, a mere listing of information concerning third-party registrations and applications is insufficient to make such properly of record and that copies thereof, obtained from the official records of the United States Patent & Trademark Office must instead be furnished, see, e.g., In re Duofold Inc., 184 USPQ 638, 640 (TTAB 1974), the failure of the previous Examining Attorney to object to the nature of the evidence furnished by applicant, coupled with her having treated such evidence as being of record, constituted a waiver of any objection thereto which is binding on the current Examining Attorney. In consequence thereof, while the limited information furnished by applicant is considered to be of record (although the copies of the third-party applications and registrations submitted with applicant's reply brief are clearly untimely under Trademark Rule 2.142(d) and have been given no consideration), it is nonetheless pointed out that each case ultimately must be determined on its own merits and that allowance of prior third-party marks is not determinative of the registrability of applicant's mark. See, e.g., In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to [applicant's] application, the ... allowance of such prior registrations does not bind the Board or this court"].

considered as being merely descriptive of its goods, the combination thereof "does not necessarily result in a descriptive composite mark." Any doubt in such regard, applicant insists, should be resolved in its favor, citing *In re Morton-Norwich Products, Inc.*, 209 USPQ 791 (TTAB 1981); and *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972).

The Examining Attorney, relying on dictionary definitions which he requests that the Board take judicial notice of,³ argues on the other hand that "[t]he proposed mark is clearly descriptive based on the ordinary meanings of the terms combined." Specifically, noting that The American Heritage Dictionary of the English Language (3rd ed. 1992) defines, in relevant part, the word "patch" as signifying "[a] transdermal patch," lists the preposition "for" as being "[u]sed to indicate the object, aim, or purpose of an action or activity" and sets forth the noun "pain" as meaning "[a]n unpleasant sensation occurring in varying degrees of severity as a consequence of injury, disease, or emotional disorder," the Examining Attorney contends that:

The applicant has conceded that the term PATCH is descriptive when used on or in connection with the relevant goods. The applicant's response to the first Office Action states that "it is not disputed that the word 'PATCH' is a descriptive term for a

³ Such request is granted inasmuch as it is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 n. 7 (TTAB 1981).

device to transmit some substance to the skin, such as an analgesic." For a mark that combines descriptive terms to be registrable, the composite must create a unitary mark with a separate, nondescriptive meaning. *In re Ampco Foods, Inc.*, 227 USPQ 331 (TTAB 1985). The applicant believes that it has created such a mark by using the number 4 to separate the terms "PATCH and PAIN. However, the use of the number "4" to replace the word "for" does not alter or obviate the descriptiveness of the mark as a whole because the two are phonetic equivalents. See *In re Hubbard Milling Co.*, 6 USPQ2d 1239 (TTAB 1987). The mark "PATCH4PAIN" does not have a separate, nondescriptive meaning apart from the meanings of the individual terms [combined].

The applicant has argued that the proposed mark is merely suggestive because it "does not indicate what type of pain is being relieved, how the patch works, how or where it is applied, what ingredients are present, or how the analgesic is released." However, it is not necessary that a term describe all of the purposes, functions, characteristics or features of the goods to be merely descriptive. It is enough if the term describes one attribute of the goods. *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982).

Rather than being suggestive, the proposed mark is so highly descriptive that relevant consumers would immediately ascertain the nature and use of the goods without even considering the mark in context with the goods since it quite clearly indicates that the goods are patches used to treat pain. The promotional materials made of record via the applicant's response to the first Office Action and the applicant's statements made in conjunction therewith verify that this is in fact the case. Therefore, since the proposed mark immediately indicates both the nature and use of the goods, it is merely descriptive within the meaning of Section 2(e)(1) of the Trademark Act.

As stated in its response to the initial Office Action, the promotional materials made of record by applicant and

referred to above by the Examining Attorney consist of "printouts from the Internet showing THERAPATCH ... products." The goods which are the subject of the present application, as noted by applicant, are "intended to be marketed in the same manner and for the same use as THERAPATCH [products]," which are "generally sold over-the-counter in drug stores and pharmacies." The "THERAPATCH" products are referred to in such promotional materials as, *inter alia*, a "PAIN RELIEF PATCH" which "provides temporary relief directly on the site of pain or discomfort."

In addition, the record contains various excerpts taken from a search of the "NEXIS" database which show that patches are commonly used to apply or deliver analgesics. Representative examples thereof are reproduced below (emphasis added):

"The use of external **patches** ... has helped boost sales in the external **analgesics** sector." -- Chain Drug Review, July 2, 2001;

"For instance, the company was among the first suppliers to bring external **analgesic patches** to the United States market when it introduced the Mentholatum **Pain Patch** in the mid-1990s.

....
Sokol and Nash say that **patches** represent the future of external **analgesics**."
-- Chain Drug Review, July 2, 2001;

"Alza developed the opioid **analgesic** Duragesic in transdermal **patch** form now marketed by Janssen" -- Medical Marketing & Media, May 1, 2001;

"'... all the new **patch** products, that's starting to fuel the growth of this category.' Citing data from Information Resources Inc., Quinn pegged the patch piece of the **analgesic** business at \$25.5 for the year ending in December 2000.

The TheraPatch line includes two non-medicated SKUs, as well as a couple of

analgesic offerings that utilize the **patch** as a drug delivery device." -- Drug Store News, April 9, 2001 (article headlined: "EXTERNAL **ANALGESIC PATCHES** SPELL RELIEF FOR AILING **PAIN RELIEF** CATEGORY");

"Alza specializes in drug delivery systems, such as Duragesic (fentanyl transdermal system), an **analgesic patch** licensed by J&J." -- Drug Topics, April 2, 2001;

"Much of the positive momentum in the topical **analgesics** category these days is coming from **patch** products, items that are winning increasing trial and acceptance from consumers.

....
... retailers generally display the entire line in the **analgesics** section, because **patches** can be presented as an effective complementary therapy when combined with internal **pain relievers**." -- Chain Drug Review, February 26, 2001 (article headlined: "**Patch** products gain ground among consumers; topical **analgesics**"); and

"Absorbine Jr. **Pain Relieving Patch** ... capitalizes on the growth potential of the hottest new segment in the external **analgesics** category.

... segment will continue to grow because of the effectiveness of the **patch** as a delivery system and its ability to provide sustained treatment over time. **Analgesic patches** have been used for well over a decade in Asia, but they are just building momentum in the American market." -- Business & Industry, February 5, 2001.

Upon consideration of the above evidence and arguments, we agree with the Examining Attorney that the term "PATCH4PAIN" is merely descriptive of applicant's "topical analgesics." In particular, as the record shows, the word "patch" is defined as signifying "[a] transdermal patch" and thus, as applicant admits, "the word 'PATCH' is a descriptive term for a device to transmit some substance to the skin, such as an analgesic." The numeral

"4" in the term "PATCH4PAIN" is clearly the phonetic equivalent of the word "FOR" and is akin to a slight misspelling of such word; it plainly has no significance in the context of applicant's goods as literally either the number "4" or the word "FOUR." Furthermore, the word "PAIN" in the term "PATCH4PAIN" is descriptive of the unpleasant sensation or condition applicant's goods are used to reduce or alleviate.

Clearly, when the terms "PATCH," "4" and "PAIN" are combined to form the term "PATCH4PAIN," such term conveys forthwith, without speculation or conjecture, that a significant purpose, function or use of applicant's topical analgesics is that the goods are a patch for pain relief. Actual and prospective purchasers of applicant's goods would therefore immediately understand the nature of its topical analgesics and what it is that such goods do. Nothing in the term "PATCH4PAIN" is incongruous, ambiguous or suggestive, nor is there anything about such term which requires the exercise of imagination, cogitation or mental processing or which necessitates the gathering of further information in order for the merely descriptive significance thereof to be readily apparent. Additionally, the fact that potential competitors of applicant may be able to describe their topical analgesics by terms other than "PATCH4PAIN" (or the phonetic equivalent thereof, "PATCH FOR PAIN,") does not mean that such term is not merely descriptive of applicant's goods. See, e.g., Roselux Chemical Co., Inc. v. Parsons Ammonia Co., Inc., 299 F.2d 855, 132 USPQ 627, 632 (CCPA 1962).

Moreover, while it is true that, in order for a term to be held merely descriptive, it must describe an attribute of the associated goods with some particularity, there is no requirement that the term describe the goods exactly or in all respects. See, e.g., In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990) [term "OATNUT" held merely descriptive of bread containing oats and hazelnuts because it "readily informs purchasers, with the required degree of particularity, of two not inconsequential ingredients" of the product, even though the kind of nut is not specified by such term]. Here, as indicated previously, the term "PATCH4PAIN" immediately informs customers for applicant's topical analgesics that a significant purpose, function or use of the goods is that of a patch for pain relief. That such term "does not indicate what type of pain is being relieved, how the patch works, how or where it is to be applied, what ingredients are present, or how the analgesic is being released," as argued by applicant, does not mean that "PATCH4PAIN" is ambiguous or otherwise lacking in specific information about key aspects of applicant's goods. Rather, such term possesses the requisite degree of particularity and is accordingly merely descriptive of applicant's goods within the meaning of the statute.

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