

THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B

Mailed: August 13, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re HealthOne Medical Systems, Inc.

Serial No. 78911013

Damon A. Neagle of Design IP, P.C. for HealthOne Medical Systems, Inc.

Jason Eric Lott, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before Holtzman, Kuhlke and Cataldo, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

HealthOne Medical Systems, Inc., applicant, has filed an application to register the mark DISPENSE-A-PILL (in standard character form) on the Principal Register for "machines, and cartridges sold in connection therewith, for dispensing pre-determined dosages of medication in pill and capsule form" in International Class 9.¹

¹ Application Serial No. 78911013, filed on June 19, 2006, under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), alleging a bona fide intention to use the mark in commerce.

The examining attorney has refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C.

§1052(e)(1), on the ground that applicant's mark is merely descriptive of its goods. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

"A mark is merely descriptive if it 'consist[s] merely of words descriptive of the qualities, ingredients or characteristics of' the goods or services related to the mark." In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004), quoting, Estate of P.D. Beckwith, Inc. v. Commissioner, 252 U.S. 538, 543 (1920). See also In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003). The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant ingredient,

Serial No. 78911013

quality, characteristic, function, feature, purpose or use of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

Finally, while a combination of descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive meaning, In re Colonial Stores, Inc., 394 F.2d 549, 157 USPQ 382 (CCPA 1968), the mere combination of descriptive words does not necessarily create a nondescriptive word or phrase. In re Associated Theatre Clubs Co., 9 USPQ2d 1660, 1662 (TTAB 1988). If each component retains its descriptive significance in relation to the goods or services, the combination results in a composite that is itself descriptive. In re Oppedahl & Larson LLP, supra.

The examining attorney argues:

Applicant's mark "DISPENSE-A-PILL" merely describes the feature and function of Applicant's goods. The word "DISPENSE" is defined as "deal out in parts or portions; distribute" or "prepare and give out (medicines)." The word "PILL" is defined as "a small pellet or tablet of medicine, often coated, taken by swallowing whole or by chewing." By definition, then, the phrase "DISPENSE A PILL" describes the distributing or giving out of medicine.

Br. p. 4.²

The record in this case clearly supports a finding of mere descriptiveness of the phrase DISPENSE-A-PILL. As noted above, we determine the descriptiveness of a term in the context of the goods or services at issue, not in the abstract. In re Chopper Industries, 222 USPQ 258 (TTAB 1984); In re Bright-Crest, Ltd., supra.

Applicant does not dispute that its goods dispense pills or the descriptive significance of the individual words. Clearly, these terms separately have a descriptive significance in relation to applicant's goods. The question remains whether combined they present a unique or incongruous combination.

² Citations to both dictionary definitions are to The American Heritage Dictionary of the English Language (4th ed. 2000) attached to the November 22, 2006 Office Action. In addition, the examining attorney submitted excerpts from websites that use the phrase "dispense a pill" to describe the function of a pill dispenser. See, e.g., www.freepatentsonline.com attached to June 29, 2007 Final Office Action.

We find that when combined the terms DISPENSE and PILL do not lose their descriptive significance and, in fact, make clear that applicant's goods dispense pills. Thus, we are persuaded by the evidence of record that the words DISPENSE and PILL are merely descriptive of applicant's identified goods and that when combined do not present a unique or incongruous meaning. In re Tower Tech, Inc., 64 USPQ2d 1314 (TTAB 2002).

Applicant's arguments do not persuade us of a different result. The fact that applicant's goods may include other functions beyond its pill-dispensing functions does not obviate a refusal under Section 2(e)(1). A term need not be merely descriptive of all features of the goods, it is enough that it is merely descriptive of only one significant feature. Oppedahl, 71 USPQ2d at 1371 ([A] mark may be merely descriptive even if it does not describe the 'full scope and extent' of the applicant's goods or services.") Nor do we find that reversing the words PILL and DISPENSE, and adding hyphens and an A constitute a "creative play on words" such that the term is incongruous and distinctive. See, e.g., In re Vanilla Gorilla, 80 USPQ2d 1637, 1640 (TTAB 2006) (addition of hyphens does not change descriptive nature of term).

While applicant cites *In re TMS CORP. of the Americas*, 200 USPQ 57 (TTAB 1978) in support of its position, the facts here are very different. In that case, the Board found that the phrase "THE MONEY SERVICE" did not "directly or indirectly convey any vital purposes, characteristics or qualities of applicant's services." *Id.* at 59. Here, DISPENSE-A-PILL directly conveys a significant purpose of the goods, namely, to dispense pills. It would not take any speculation or mental leap to understand that DISPENSE-A-PILL describes goods that dispense pills.

Viewing DISPENSE-A-PILL as a whole, we find the evidence of record sets forth a prima facie case that such phrase is merely descriptive. Thus, we are persuaded that when applied to applicant's goods, DISPENSE-A-PILL immediately describes, without need for conjecture or speculation, a significant feature or function of applicant's goods. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for prospective consumers of applicant's goods to perceive readily the merely descriptive significance of DISPENSE-A-PILL as it pertains to applicant's goods.

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