

A Trademark Primer for Food, Drugs, Cosmetics, and Related Goods

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INTRODUCTION

Trademark protection in the United States is based upon the dual system of federal and state protection.¹ The federal Trademark Act of 1946, commonly known as the "Lanham Act," provides for the federal registration of trademarks.² Such registration entitles the owner of the mark to legal benefits not afforded owners of unregistered marks.³

This article contains a general overview of the reasons for, and the process involved in obtaining, federal registration. It also focuses on the common pitfalls encountered in the prosecution of applications for the federal registration of trademarks for food, drugs, cosmetics, and related products.

FEDERAL REGISTRATION OF TRADEMARKS

At the outset, it must be stressed that trademark rights are acquired only by use and the use must ordinarily continue if the rights so acquired are to be preserved. Registration of a trademark in the Patent and Trademark Office (PTO) does not in itself create or establish any exclusive rights, but rather, constitutes recognition by the government of the right of the owner to use the mark in commerce to distinguish his goods from those of others.

Trademarks differ from trade and commercial names. The latter are used by manufacturers, industrialists, merchants, agriculturists, and others to identify

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¹ Generally, state statutes provide remedies for infringement of trademarks and provide for the state registration thereof. Common law remedies are also available. Discussion of these laws is not within the scope of this paper.

² The Trademark Act of 1946, 15 U.S.C. §§ 1051-1127 (1976). Section 1127 defines the term "trademark" as "[A]ny word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others."

³ Among the benefits that registration provides are (1) incontestability, (2) nationwide notice by publication of the mark, (3) nationwide scope of registration, (4) access to federal courts, and (5) right to treble damages for infringement of a registered mark.

their businesses, vocations, or occupations, or they are the names or titles lawfully adopted by persons, firms, associations, companies, unions, and other organizations.⁴ Trade names are not subject to registration unless actually used as trademarks.

In order to be eligible for federal registration a trademark must be used as a mark in commerce that may be lawfully regulated by Congress at the time the application is filed.⁵ Registration will be denied if the trademark:

(a) Consists of or comprises immoral, deceptive, or scandalous matter or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the PTO or a mark or trade name previously used in the United States by another and not abandoned, as to be likely when applied to the goods of another person, to cause confusion, or to cause mistake, or to deceive.⁶

The Lanham Act provides for the establishment of two registers, the Principal Register and the Supplemental Register.⁷ Registration on the Principal Register is constructive notice of the registrant's claim of ownership⁸ and prima facie evidence of the validity of the registration, registrant's ownership of the mark, and registrant's exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate, subject to any conditions and limitations stated therein.⁹ It gives the registrant the right to sue in federal courts¹⁰ and the right to prevent importation of goods bearing an infringing mark.¹¹ Registration on the Supplemental Register does not constitute constructive notice or prima facie evidence, or give the right to prevent importation of goods bearing an infringing mark, but it does give the right to sue in federal courts.¹²

⁴ 15 U.S.C. § 1127 (1976).

⁵ 15 U.S.C. § 1127 (1976) provides: for the purposes of this Act a mark shall be deemed to be used in commerce:

(a) on goods when it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto and the goods are sold or transported in commerce; and (b) on services when it is used or displayed in the same, or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in this and a foreign country and the person rendering the services is engaged in commerce in connection therewith.

⁶ 15 U.S.C. § 1052(a)-(d) (1976). See also discussion *infra* for application of these provisions to food, drug, and related products.

⁷ 15 U.S.C. §§ 1051, 1091 (1976).

⁸ 15 U.S.C. § 1072 (1976).

⁹ 15 U.S.C. § 1057(b) (1976).

¹⁰ 15 U.S.C. § 1121 (1976).

¹¹ 15 U.S.C. § 1124 (1976).

¹² See 15 U.S.C. § 1094 (1976).

A coined, arbitrary, fanciful, or suggestive mark, generally referred to as a "technical mark," may, if otherwise qualified, be registered on the Principal Register¹³ unless it consists of a mark which

(1) when applied to the goods or services of the applicant is merely descriptive or deceptively misdescriptive of them, or (2) when applied to the goods or services of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, except as indications of regional origin, or (3) is primarily merely a surname.¹⁴

Marks such as these may be registered on the Principal Register, however, if they have become distinctive as applied to the applicant's goods in commerce.¹⁵ The Commissioner may accept as prima facie evidence that the mark has become distinctive, proof of its substantially exclusive and continuous use by the applicant in commerce for the five years preceding the date of filing of the application for registration.¹⁶

Marks which do not qualify for registration on the Principal Register, but, nevertheless, are capable of distinguishing an applicant's goods and have been in lawful use in commerce for at least one year may be registered on the Supplemental Register.¹⁷ They may consist of any trademark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, device, or any combination of any of the foregoing.¹⁸

A thorough search should be made on a trademark prior to the application being filed with the PTO. Applications for federal registration are rejected when they are incorrectly filled out, but more often the rejection is caused by the failure to conduct a thorough preliminary search to see whether the proposed mark conflicts with preexisting rights. A preliminary search is not an absolute guarantee that no conflicts exist but it provides a greater degree of certainty than no search or an incomplete one.

The application for registration must be filed in the name of the owner of the mark. The owner may file and prosecute his own application for registration, or he may be represented by an attorney or other person authorized to practice in trademark cases. The PTO cannot aid in the selection of an attorney or other person.¹⁹

The application for federal registration of a mark consists of: (a) a written application; (b) a drawing or other identification of the mark; (c) an identification of the goods or services; (d) five specimens or facsimiles of the mark as actually used; (e) the required filing fee; (f) the date of first use of the mark in commerce.²⁰

¹³ 15 U.S.C. § 1052 (1976).

¹⁴ 15 U.S.C. § 1052(e) (1976).

¹⁵ *Id.*

¹⁶ *Id.*

¹⁷ 15 U.S.C. § 1091 (1976).

¹⁸ *Id.*

¹⁹ 15 U.S.C. § 1051 (1976) and 37 C.F.R. §§ 2.11, 2.12 (1982).

²⁰ 37 C.F.R. § 2.31 *et seq.* (1982). The written application must be in English and plainly written on only one side of the paper. Legal size paper, typewritten double spaced, with at least 1¹/₂-inch margin on the left-hand side and top of the pages is preferred.

The filing date of the application is the date on which all of the items are received in the PTO.

The written application must include a request for registration on either the Principal or the Supplemental Register and must specify:

- (1) The name of the applicant. If the applicant and the user are not the same, it must be explained whether the user is an operating division of the applicant, or a related company. The important question is: does the applicant have control over the nature and quality of goods or services sold or rendered under the mark?²¹
- (2) The citizenship of the applicant; if the applicant is a partnership, the names and citizenship of the general partners or, if the applicant is a corporation or association, the state or nation under whose laws it is organized.
- (3) The domicile and post office address of the applicant.
- (4) That the applicant has adopted and is using the mark shown in the accompanying drawing. In the dates-of-use clause the date of first use anywhere must be the same or earlier than the date of use in interstate commerce. The type of commerce must be specified—interstate, territorial (i.e., Puerto Rico), foreign—and there must be a statement that the mark is "now in use in such commerce."²²
- (5) The particular goods on or in connection with which the mark is used. The identification of goods or services should be simple and specific; overly broad and indefinite identifications will not be accepted. Identify goods according to their common commercial name or intended use.
- (6) The class of merchandise according to the official classification, if known to the applicant.²³ If the goods fall under more than one class, separate them according to class.²⁴

An affixation clause should be included indicating how the mark is affixed to the goods, i.e., tags, labels, etc. The specimens of use should be of the type specified in this clause.²⁵

The application must be signed and verified or include a declaration in lieu of oaths. If the verification form is used the notary must affix his signature, and seal and date the document. The declaration must also be dated and contain a statement to the effect that all the information is true or believed to be true and that the applicant is aware that willful false statements are punishable by fine or imprisonment.

The proper party must sign the declaration. It can be the proprietor, if the business is run as a sole proprietorship, or one of the partners may sign if the business is a partnership. An officer may sign if the business is a corporation, and all the joint owners sign if the business is operated by joint applicants. The papers must be received in the PTO within five weeks of execution plus mailing time. If the deadline is missed an affidavit of continuing use will be required.²⁶

The drawing must be a substantially exact representation of the mark as actually used in connection with the goods.²⁷ If the application is for registration of

²¹ Trademark Manual of Examining Procedures (T.M.E.P.) § 802 (1981).

²² T.M.E.P. § 806 (1981).

²³ The official classification of goods is listed in 37 C.F.R. §§ 2.33 and 2.85 (1982). For the numbers and names of the respective trademark classes, as well as relevant discussion, see T.M.E.P., Chapter 1400 (1981).

²⁴ T.M.E.P. § 804 (1981).

²⁵ T.M.E.P. § 808.09 (1981).

²⁶ T.M.E.P. § 803 (1981).

²⁷ 37 C.F.R. §§ 2.51–2.55 (1982). See Appendix.

a word, letter, or numeral, or any combination thereof, not depicted in special form, the drawing may consist of the mark typed in capital letters on paper, otherwise complying with the requirements. Photocopies are not acceptable. The mark in the drawing and on the specimens must agree; otherwise it may be considered unacceptable. The determination is within the discretion of the examiner.²⁸

The specimens must be duplicates of the actually used labels, tags, containers, or displays or portions thereof, when made of suitable material and capable of being arranged flat and of a size not larger than 8.5 × 13 inches. If the specimens are bulky, facsimiles or photographs will be accepted as long as they are clear and show the mark and other pertinent material. They should also indicate compliance with any other statutory requirements.

If the name of a person is used in a mark and that person is a living individual, a letter authorizing use and registration must accompany the application. Otherwise, there must be a statement indicating the person is deceased.²⁹

Lining, shading, or stippling in the drawing should be identified according to function. Foreign words in a mark must be translated and descriptive wording in a mark must be disclaimed.³⁰

A domestic representative must be appointed if the applicant is not domiciled in the United States. The application must be filed within six months of any foreign filing and the identification of goods must be within the scope of the foreign registration. Section 44 of the Lanham Act permits a foreign national to obtain a U.S. trademark registration without prior use of the mark in American interstate or foreign commerce. An application filed under section 44(d) (priority) or section 44(e) (without use in the United States) cannot be granted unless there is a certified copy of foreign registration on the record.³¹

If the mark is not entitled to registration the applicant will be notified and advised of the reasons therefor and of any formal requirements or objections. The applicant has six months from the mailing date of any PTO action to respond thereto. Failure to respond within this period will result in abandonment of the application. A response may be made with or without an amendment but must include such proper action by the applicant as the nature of the action and the condition of the case may require.³²

A registrant should give notice that his mark has been registered by displaying with the mark the words "Registered in U.S. Patent and Trademark Office," "Reg. U.S. Pat. and Tm. Off.," or the letter R enclosed within a circle. Notice given before the actual issuance of a certificate of registration for the mark is improper and may be the basis for refusal of registration.³³

²⁸ T.M.E.P. § 807 (1981).

²⁹ T.M.E.P. § 1204 (1981).

³⁰ T.M.E.P. § 807 (1981).

³¹ 15 U.S.C. § 1126(d),(e) (1976).

³² 15 U.S.C. § 1062(b) (1976).

³³ 15 U.S.C. § 1111 (1976).

II. POST REGISTRATION: SECTION 8 AND 15 AFFIDAVITS AND RENEWALS

The section 8 affidavit is a tidying up provision. It is designed to remove unused marks from the register, continue registration of sporadically used marks, and protect marks used continuously for five years. The owner of a federal registration must file a section 8 affidavit within the sixth year from issuance showing either continued use of the registered mark or special circumstances excusing nonuse. An actual specimen supporting continued use must be included. The goods need not be listed as the wording of the statute pertains to the use of the mark and not the particular items. Virtually anyone connected with the operation, except an agent or holder of the power of attorney, is authorized to sign the affidavit, but it must be in the name of the record owner of the registration. The PTO is not required to remind a registrant that the section 8 affidavit is due. If it is not filed the registration will be canceled at the end of the sixth year and notice of cancellation will be published in the *Official Gazette*.³⁴

The section 15 affidavit is optional unless the registrant wants the trademark registration to achieve incontestability. Like the section 8 affidavit it is filed within the sixth year of registration, except where litigation involving the mark is proceeding; in that instance a successful litigant may file after termination of the litigation.

The Act requires the owner to identify the certificate by registration number and date of registration; recite the goods or services in use in commerce for the five years subsequent to the date of registration; state that the mark is still in use on the goods in such commerce (thus excluding those with which the mark is not being currently used); specify that no final adverse decision as to the registrant's claim of ownership exists; and specify that there is no pending proceeding involving the registrant's rights. The person authorized to sign the affidavit is the owner of the mark.³⁵

A certificate of registration is good for twenty years, provided a section 8 affidavit has been filed, and can be renewed indefinitely for twenty-year periods. An application for renewal must be executed and filed by the owner of the registration six months before the end of the twenty-year period or within three months after expiration; premature filings are returned. The fee must be paid before the end of the grace period. An application must set forth the registration number and date, the name of the owner of the mark and the registrant, the type of commerce the mark is used in (regulated by Congress), and the goods or services on which the mark is used. It also must contain a current specimen showing current use of the mark.³⁶ The PTO does not remind the registrant that a renewal is due. If renewed, notice is printed in the *Official Gazette*.

³⁴ 15 U.S.C. § 1058 (1976).

³⁵ 15 U.S.C. § 1065 (1976).

³⁶ 15 U.S.C. § 1059 (1976).

III. SPECIAL REQUIREMENTS FOR FOOD, DRUG, AND COSMETIC TRADEMARKS

The PTO is authorized to inquire as to the lawful sale or transportation of a food, beverage, drug, cosmetic, biologic, medical device, or therapeutic product.³⁷ When an application for registration is taken up for examination to the examiner-attorney assigned to the case, he will look to the specimens of record for the following: (1) the common commercial name of the goods, (2) a statement of the ingredients, (3) the net weight, and (4) the name and address of the manufacturer, distributor, or packer of the goods.³⁸ If the article is meat or poultry, the PTO will look to see if the Agriculture Department (USDA) seal is affixed thereon.³⁹

In the event the specimen of record does not have one of the above required elements, the examining attorney will issue an Office Action requesting the applicant to state whether he was in compliance with the requisite act at least as early as the claimed date of first use of the mark in interstate commerce. An affirmative reply will generally satisfy the PTO requirement.

Should the applicant indicate noncompliance with the requirements of the Federal Food, Drug, and Cosmetic (FD&C) Act⁴⁰ when the goods were first used in commerce with the mark applied for, there is some doubt as to the next procedural step. The Trademark Manual of Examining Procedure (T.M.E.P.), a manual setting forth guidelines for the examining of applications, states that the examining attorney should ask whether the applicant was in compliance with the Act when the application was filed.⁴¹ This seems to contradict the case law, which generally looks to see if the applicant was in compliance as of the claim of first use in commerce.

The *Pepcom Industries, Inc.*⁴² case indicated that an applicant may amend the dates of use up to the filing date should the applicant appear to have not been in compliance with the required act as of the first use in commerce but subsequently complied with the required act prior to the filing of the amendment. Usually, the applicant complies with the required act prior to the filing of the application. The Board in *Pepcom* was considering the conforming materials bearing the mark "JIN SENG" (ginseng) as a trademark for soft drinks, and required the applicant not only to have its goods in conformity with the FD&C Act, but also to comply with the PTO requirement of a verified statement indicating such, which was not done. The Board thus indicated that the failure to prove lawful use of the mark

³⁷ 37 C.F.R. § 2.69 (1982) states: "When the sale or transportation of any product for which registration of a trademark is sought is regulated under an act of Congress, the Office may, before allowance, make appropriate inquiry as to compliance with such Act for the sole purpose of determining lawfulness of the commerce recited in the application."

³⁸ T.M.E.P. § 901.03(b) (2) (1981).

³⁹ T.M.E.P. § 901.03(a) (1981).

⁴⁰ 21 U.S.C. §§ 301-392 (1976 & Supps.).

⁴¹ T.M.E.P. § 901.03(a) (1981).

⁴² *Pepcom Indus., Inc.*, 192 U.S.P.Q. 400 (T.T.A.B. 1976). See also *Stellar Int'l, Inc.*, 159 U.S.P.Q. 48 (T.T.A.B. 168); *Clairol, Inc. v. Holland Hall Prod., Inc.*, 165 U.S.P.Q. 214 (T.T.A.B. 1970).

in commerce prior to the filing date of the application, or any subsequent date, would be a fatal deficiency requiring refusal of registration for the mark.

If an applicant seeks registration for a trademark which falls under either the FD&C Act or USDA requirements and the label on which the mark is placed is not in complete compliance, but compliance is found on a separate label which is attached to the same container, the applicant may submit the latter label. The applicant may, of course, indicate compliance with either Act in the application papers.⁴³ Generally, an applicant should include all relevant information from all labels, front and back. If the back label is not available, but compliance has been maintained, the applicant should execute a statement setting forth this fact in the application.⁴⁴

An exception to the labeling requirements exists if rather than selling packaged goods, the applicant is selling goods for consumption on or off the premises. For example, in a retail food chain where the goods are not prepackaged, the applicant may set forth that the goods are for consumption on or off the premises, such that the establishment does not necessarily have to comply with the labeling requirements of any federal agency. If the applicant includes this statement, and the specimens submitted report this claim, then no question as to compliance may be raised.

A related problem arises when the name of the applicant and the name appearing on the specimens is not the same (manufacturer–distributor situation). A brief explanation of the applicant’s relationship to the named party and a statement that he controls the nature and quality of the goods may be sufficient.⁴⁵

IV. STATUTORY REFUSALS TO REGISTER

A. Refusal to Register on the Grounds That the Mark Is Descriptive

Section 2(e)(1) of the Lanham Act⁴⁶ prohibits the registration of a mark which, when applied to goods or services, is merely descriptive, or deceptively misdescriptive, of them. The key word to be remembered here is that the mark must be *merely* descriptive. If the term is suggestive, then registration will not be refused. Descriptive involves the relationship of the mark to the goods it is applied to. A classic example would be “wild turkey” which is descriptive of turkeys, but not descriptive of a whiskey. A term is merely descriptive if it communicates information to the average consumer of an ingredient, quality, characteristic, or function of the product.⁴⁷ The term does not have to describe all the ingredients, qualities, or purposes of the item—it is sufficient that the mark be descriptive of one of these.

⁴³ T.M.E.P. § 901.03(a) (1981).

⁴⁴ T.M.E.P. § 901.04 (1981).

⁴⁵ T.M.E.P. § 1201.04 (1981).

⁴⁶ 15 U.S.C. § 1052(e) (1976).

⁴⁷ *Bright-Crest, Inc.*, 204 U.S.P.Q. 591 (T.T.A.B. 1979).

If the entire mark of an applicant is not descriptive, but a portion thereof is, the applicant may be requested to disclaim the descriptive portion of the mark.⁴⁸ A disclaimer does not detract from the registrability of a mark. It merely says that a particular portion of the applicant's mark should be available for use by anyone. For example, suppose a component of the applicant's mark is the word "apple," and the applicant is selling apples. It certainly would not be fair to grant the applicant in that situation the exclusive right to use the word "apple" as applied to apples.

If a mark is determined to be descriptive and the applicant agrees, there are several alternatives available to the applicant: (1) abandon the application, (2) seek registration on the Supplemental Register, or (3) seek registration under the provisions of section 2(f) of the Lanham Act.⁴⁹

Section 2(f) provides for the registration of a descriptive term on the Principal Register where the mark has become distinctive (achieved a secondary meaning) of the applicant's goods or services in commerce. The section is divided into two areas: the *prima facie* showing and the evidentiary showing.

Prima facie evidence is a statement, in affidavit or declaration form, that the mark has been used in interstate commerce substantially and continuously for the five years following registration on the Supplemental Register. This showing is reserved, in general, for those marks which are only slightly descriptive.

The evidentiary showing does not require the applicant to wait five years; rather it recognizes that if one has highly promoted and publicized the mark it is possible for the mark to acquire a secondary meaning within a short time. The showing, of course, will have to be supported by the type of evidence which proves that the mark has become distinctive, including but not limited to sales figures, announced advertising, examples of media advertisements, promotional materials, consumer affidavits and letters, and consumer surveys. The quantum of evidence needed to prove that the mark has become distinctive of the applicant's goods depends on the mark itself. A highly descriptive mark needs a great deal of evidence while a mark which is merely descriptive needs a lesser quantum of evidence.

B. Refusal to Register Based on a Likelihood of Confusion

One of the refusals most often cited by the PTO is that an applicant's mark is likely to be confused with a registered mark. Section 2(d) of the Lanham Act⁵⁰ prohibits the PTO from registering a mark which consists of or comprises a mark which so resembles an already registered mark as to be likely, when applied to the goods of the applicant, to cause confusion, mistake, or deception. Simply stated: the mark of an applicant must be different enough so that prospective consumers will not be confused as to the source or origin of the goods or services.

⁴⁸ 15 U.S.C. § 1056 (1976).

⁴⁹ 15 U.S.C. § 1052(f) (1976).

⁵⁰ 15 U.S.C. § 1052(d) (1976).

The tests for determining likelihood of confusion are: is there a similarity in sound, appearance, or meaning? Are the goods of such a nature that prospective purchasers would expect the goods to originate from the same source? Only when all of the above factors have been taken into account can the determination be made as to whether an applicant's mark is confusingly similar to that of a registered mark.

For many years there has been a growing trend in the case law reflecting the view that food and drug products, irrespective of their nature, are closely related and the use of the same or similar mark on such products will be likely to cause confusion in the trade. The court in *Sweet Sue Kitchens, Inc. v. C-B Drug Company*,⁵¹ held that a synthetic fruit sweetener and chicken products were related goods, while in *B.F. Trappey's Sons, Inc. v. Mama Cookie Bakery*,⁵² it held that cookies and canned sweet potatoes, hot sauce, and pickled peppers were related food items. Still another case held that liquor-filled chocolates and wheat flour were similar products.⁵³ The trend was apparently narrowed in 1978 when the Court of Customs and Patent Appeals (CCPA) held that the mark "Red Zinger" for herbal tea was not likely to cause confusion with "Zingers" for cakes.⁵⁴ Some recent decisions though have limited the Zinger case to its particular facts, and have held that, for example, fresh strawberries, fresh avocados, and fresh vegetables are similar to cookies and crackers.⁵⁵ There was also a finding in *King Shrimp Company, Inc.*,⁵⁶ that a frozen shrimp dinner consisting of shrimp stuffed with crabmeat was similar to dried raisins.

Cosmetics may also be refused registration based on the likelihood of confusion. Despite the wide variance in cosmetic products, which includes not only the traditional makeups and fragrances but also soaps, the only question will be: how close are the marks and how close are the goods? It has been held that where toothpaste and antiperspirant are sold under the same mark, a likelihood of confusion would exist,⁵⁷ the rationale being that one could purchase both items during the same visit to a drugstore. In *Charles Pfizer and Company, Inc. v. The Luzier Inc.*,⁵⁸ the court held that the name "Natte Magic" for cosmetics and toilet preparations would be likely to cause confusion with the name "Mani Magic," a cream cuticle remover, because there was a similarity in both sound and appearance of the goods, even though it was argued "discerning" consumers would be aware that "Natte" and "Mani" were not similar. On the other hand, it was held that "Captain Clean" and the design of a ship and captain for cleaning services was not so similar to "Mr. Clean" for liquid detergent as to cause confusion.⁵⁹

⁵¹ *Sweet Sue Kitchens, Inc. v. C-B Drug Co.*, 159 U.S.P.Q. 242 (T.T.A.B. 1968).

⁵² *B.F. Trappey's Sons, Inc. v. Mama Cookie Bakeries, Inc.*, 168 U.S.P.Q. 440 (T.T.A.B. 1970).

⁵³ *P. Ferrero and C.S.A.*, 177 U.S.P.Q. 605 (T.T.A.B. 1973).

⁵⁴ *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 198 U.S.P.Q. 151 (C.C.P.A. 1978).

⁵⁵ *Midwest Biscuit v. John Livacich Produce, Inc.*, 203 U.S.P.Q. 628 (T.T.A.B. 1979).

⁵⁶ *King Shrimp Co., Inc.*, 210 U.S.P.Q. 853 (T.T.A.B. 1980).

⁵⁷ *La Meur, Inc. v. Int'l Pharmaceutical Corp.*, 199 U.S.P.Q. 612 (T.T.A.B. 1978).

⁵⁸ *Charles Pfizer & Co. v. Luzier, Inc.*, 149 U.S.P.Q. 850 (T.T.A.B. 1966).

⁵⁹ *Proctor & Gamble Co. v. C.C.I., Inc.*, 176 U.S.P.Q. 425 (T.T.A.B.), *affirmed*, 181 U.S.P.Q. 169 (C.C.P.A. 1972).

The present state of the law appears to be that although there is no per se rule that all foods, drugs, cosmetics, and similar products are related, the Board and courts are more inclined to find a likelihood of confusion among these products than not.

The same principles also apply to pharmaceuticals. If the PTO finds that the goods are related and the marks are similar, registration will be refused. It has been held that the word "OCTIAN" for an antispasmodic to treat spasmodic conditions of the digestive tract and "OCTINE" for an eyewash are related.⁶⁰ It has also been held that "NOXPAIN," a preparation for temporary relief of minor aches and pains of simple neuralgia, rheumatism, arthritis, headache, and minor menstrual cramps, is similar to "NOZAIN," a medicated skin cream for treatment of cuts, sunburn, itching, irritations, and burns.⁶¹

In a number of pharmaceutical cases, a doctrine generally referred to as "the doctrine of greater care," has been applied. This doctrine states that because drugs are potentially harmful to the prospective purchaser, a higher standard should be applied to medical products, thus lowering the threshold of finding a likelihood of confusion. However, there appears to be a difference of opinion as to whether this higher standard should be applied in ex parte actions arising in the PTO (an ex parte being an action wherein the examiner-attorney refuses registration and the applicant appeals from that decision). One line of thinking would hold the doctrine applicable only to situations where two parties are involved in litigation.

The doctrine of greater care was applied to find a likelihood of confusion between "MYOCHOLINE," a medical preparation for treatment of dysphagia, abdominal distention, gastric retention, and urinary retention, and "MYSO-LINE," an anticonvulsant drug.⁶² However, where it was held that "POLARAMINE," an antihistamine for use in the treatment of a variety of allergic conditions, was similar to "PROLAMINE," an appetite suppressant, the court refused to apply the doctrine of greater care.⁶³ Instead, the court based its decision in part upon the fact that one of the items involved was a prescription item while the other was not, thus indicating that a means of challenging a refusal to register based on the doctrine of greater care is to show that the channels of trade are distinct and different.

C. Refusal to Register on the Ground That the Mark Is a Surname

A mark is not registerable on the Principal Register if it is primarily merely a surname. However, the mere fact that a mark includes a surname does not mean that the mark is "primarily" a surname. Moreover, a surname may be entitled to registration on the Supplemental Register after lawful use for one year if it is capable of becoming distinctive, and may be entitled to protection and registration in the Principal Register if it has acquired a secondary meaning.⁶⁴ A full name,

⁶⁰ *Walgreen Co. v. Knoll Pharmaceutical Co.*, 162 U.S.P.Q. 609 (T.T.A.B. 1969).

⁶¹ *Noxema Chemical Co. v. Wina Corp.*, 143 U.S.P.Q. 122 (T.T.A.B. 1964).

⁶² *Glenwood Laboratories, Inc. v. American Home Prod. Corp.*, 173 U.S.P.Q. 19 (1971).

⁶³ *Schering Corp. v. Thompson Medical Co., Inc.*, 209 U.S.P.Q. 72 (S.D.N.Y. 1979).

⁶⁴ *I. Lewis Cigar Co.*, 205 F.2d 204 (1953).

that is, first and last name, is registerable, if used in a trademark sense, without a showing of secondary meaning.⁶⁵

Refusal to register a mark because it is primarily merely a surname differs from a refusal to register because a mark is merely descriptive. The case law, as it applies to surnames, states that registration shall be refused only when the sole meaning of the mark is a surname. The test generally laid down is the primary significance of the term to the purchasing consumer.⁶⁶ If the term has significance other than as a surname, it will not be held to be merely a surname. For example, "Douglas" for buttermilk and feeds for poultry and livestock was held not primarily merely a surname, because it was the name of a Scottish clan, and a species of fir tree.⁶⁷ Therefore, if any evidence is presented to the examining attorney showing that the mark is not primarily merely a surname, then the refusal to register can be withdrawn. It is important to note that the burden of proof is on the PTO to prove that a mark is primarily merely a surname.⁶⁸

A section 2(e) refusal cannot be avoided by the fact that the word may be a rare surname.⁶⁹ Nor will the addition of the generic name of the goods to a surname defeat a refusal. The Board has held that a surname coupled with the generic term for the goods is primarily merely a surname.⁷⁰

When surnames are coupled with given names, one must consider 2(c) and 2(e).⁷¹ In *Sears, Roebuck & Co.*,⁷² "J. C. Higgins" was held to be primarily a surname despite the addition of initials to the surname. In that case, "J. C. Higgins" was a fanciful name and did not identify a particular living individual. Along this line, while the titles Mr., Mrs., Miss, or Ms. may serve to enhance the surname significance of a mark, the addition of titles such as "Lady" as in "Lady Pen" and "Lady Hilton" have been held to take it out of the surname category since it suggests a particular living individual.⁷³

Marks primarily merely a surname are registerable on the Supplemental Register or on the Principal Register under section 2(f) if there is proof that the mark has become distinctive.⁷⁴ Five years of substantially exclusive and continuous use in interstate commerce is generally accepted as an adequate showing of distinctiveness for a mark held to be a surname.

The primary significance must be that of a surname, and a mark is primarily merely a surname if the impact upon the purchasing consumer seeing the mark

⁶⁵ Dallioux, 37 T.M.R. 965 (1949).

⁶⁶ Rivera Watch Corp., 106 U.S.P.Q. 145 (1955).

⁶⁷ Omaha Cold Storage Co., 47 T.M.R. 124 (1965).

⁶⁸ Kahan & Weisz Jewelry Mfg. Corp., 184 U.S.P.Q. 421 (1974).

⁶⁹ Ciclo Tecnica Indus., S.A., 194 U.S.P.Q. 547 (1977), Rivera Watch Corp., 106 U.S.P.Q. 145 (1955).

⁷⁰ See E. Martinoni Co., 189 U.S.P.Q. 589 (1975), which involved an attempt to register the mark "Liquore Martinoni" for a liquor.

⁷¹ 15 U.S.C. §§ 1052(c),(e) (1976). See Dallioux, 83 U.S.P.Q. 262 (1949), wherein "Andre Dallioux" was held not primarily merely a surname because it was an individual's full name.

⁷² Sears, Roebuck & Co., 87 U.S.P.Q. 400 (1950).

⁷³ Penderi's, Inc., 137 U.S.P.Q. 168 (1964), and Hilton Hotels Corp., 166 U.S.P.Q. 216 (1971).

⁷⁴ 15 U.S.C. § 1052(f) (1976).

used on the goods is that of a surname.⁷⁵ The Board held that a baptismal name or one which has a geographical or historical significance is not primarily merely a surname. "Primarily" has been equated with "only."⁷⁶ For example, where an applicant applied for the mark "Kingsland" for machinery, and no listings for that name were found in the Washington, D.C. metropolitan area telephone directories, the Board held that while "Kingsland" possessed surname significance to some extent, it projects other and more significant meanings and associations, and therefore the primary significance to the purchasing public is not that of a surname.⁷⁷ In 1977, the Board held that the primary significance of "Fairbanks" for weighing machines would not be that of a surname, when its geographical significance as the name of a well-known city in Alaska was just as dominant in character as the surname significance.⁷⁸ In that case, the applicant supplied the Board with copies of the Northern Virginia and District of Columbia telephone directories, wherein Fairbanks was listed thirteen times.

D. Refusal to Register on the Grounds That the Mark Is Deceptively Misdescriptive

Does the mark describe a characteristic, a quality, or a function of the goods or services that they do not possess? If the answer is in the affirmative, the mark may be deceptively misdescriptive. Note the distinction between marks which are intentionally deceptive under section 2(a) and deceptively misdescriptive under section 2(e).⁷⁹ The distinction is crucial because marks held deceptive under section 2(a) are unregistrable on either the Principal or Supplemental Register.⁸⁰ Deceptively misdescriptive marks under section 2(e) involve a degree of untruth, but the deception is innocent, harmless, or negligible.⁸¹

In *Gold Seal Company v. Weeks*,⁸² use of the term "glass" with the word "wax" was held not deceptive under section 2(a) when applied to a glass and metal cleaner which contained no wax. The court found a significant deception, but it did not involve an essential and material element relied upon by consumers. Since some cleaners of this type do contain wax, the mark was held deceptively misdescriptive under section 2(e).

In determining descriptiveness, the reasonable man rule is applied. For example, "George Washington ate here" was held not deceptive or deceptively misdescriptive as applied to a restaurant in Indiana⁸³ and "ice cream" for chewing

⁷⁵ *Allied Mills, Inc.*, 150 U.S.P.Q. 757 (1967), wherein "Wayne" was held to be both a given name and a surname and therefore registrable.

⁷⁶ *Omaha Cold Storage Co.*, 111 U.S.P.Q. 189 (1957).

⁷⁷ *Barcorp Indus., Inc.*, 187 U.S.P.Q. 61 (1975).

⁷⁸ *Colt Indus. Operating Corp.*, 195 U.S.P.Q. 75 (1977).

⁷⁹ 15 U.S.C. § 1052(a),(e) (1976).

⁸⁰ 15 U.S.C. § 1052(a) (1976).

⁸¹ 15 U.S.C. § 1052(e) (1976).

⁸² *Gold Seal Co. v. Weeks*, 105 U.S.P.Q. 407 (T.T.A.B. 1954).

⁸³ *George Washington Ate Here, Inc.*, 167 U.S.P.Q. 702 (1970).

gum was held registerable.⁸⁴ While misdescriptive, it was not deceptively misdescriptive because it would be ludicrous to consider it anything but arbitrary or fanciful as applied to the goods.

The alternatives for deceptively misdescriptive marks are similar to those for merely descriptive marks. The applicant may use section 2(f) or the Supplemental Register.⁸⁵

E. Refusal to Register on the Grounds That the Mark Is Primarily Geographically Descriptive or Geographically Deceptively Misdescriptive

Previously, the leading case on this issue was *Charles S. Loeb Pipes, Inc.*,⁸⁶ where an application was filed to register the mark "Old Dominion" for a pipe tobacco grown in Virginia. The Board held the mark geographically descriptive and clarified the criteria for making the determination. The reason for the prohibition against registration of geographically descriptive marks is much the same as that for descriptive terms. If all manufacturers have the right to use descriptive words to describe their products, they should also have the right to inform the customer of the place where the goods are made. The burden is on the PTO to put forth evidence that other businesses have or are likely to have legitimate interests in the use of the geographic name claimed by an applicant. The tests, however, for determining whether a mark is primarily geographically descriptive or geographically deceptively misdescriptive have, in the past several months, taken a complete turnaround and appear at this point still to be in a state of flux.

There must be a reasonable basis for believing that consumers are likely to be deceived when a "deceptively misdescriptive" mark is judged on the basis of its role in the marketplace. The CCPA stated in *Nantucket, Inc.*:⁸⁷

Geographically deceptive misdescriptiveness cannot be determined without considering whether the public associates goods with the place which the mark names. If the goods do not come from the place named, and the public makes no goods-place association, the public is not deceived and the mark is accordingly not geographically deceptively misdescriptive.⁸⁸

The questions to ask are: what is the impact or the commercial impression of the mark on the consumer? What was the motive for its adoption? Again "primarily" has been construed to mean "only." If the term conveys a geographic significance to the average consumer, and the goods come from the place so named, then the term is primarily geographically descriptive of the goods,⁸⁹ and is registerable on the Supplemental Register or the Principal Register only upon a section 2(f) showing. If the term, however, conveys a geographic significance

⁸⁴ *Borden, Inc. v. Topps Chewing Gum, Inc.*, 173 U.S.P.Q. 447 (T.T.A.B. 1971).

⁸⁵ 15 U.S.C. § 1052(f) (1976).

⁸⁶ *Charles S. Loeb Pipes, Inc.*, 190 U.S.P.Q. 238 (T.T.A.B. 1975).

⁸⁷ *Nantucket, Inc.*, 213 U.S.P.Q. 889 (C.C.P.A. 1982).

⁸⁸ *Id.* at 893.

⁸⁹ *Charles S. Loeb Pipes, Inc.*, 190 U.S.P.Q. 238 (T.T.A.B. 1975); *Nantucket, Inc.*, 209 U.S.P.Q. 868 (T.T.A.B. 1981), *reversed*, 213 U.S.P.Q. 889 (C.C.P.A. 1982).

to the average consumer and the goods do not come from the geographic area named, then the term is geographically deceptively misdescriptive of the goods.⁹⁰ Again, it is registerable on the Supplemental Register or the Principal Register only upon a section 2(f) showing.

The Board reversed the decisional trend on geographic terms when it held that the mark "Nantucket" for men's shirts not originating from Nantucket was not deceptively misdescriptive.⁹¹ In the case of the use of "Denver Westerns" for shirts coming from Denver,⁹² the Board appears not to have applied the *Nantucket* case, reasoning that if the term appears to have a genuine geographic significance that is not remote or obscure, and the goods come from that area, the name is geographically descriptive. But the Board has applied the *Nantucket* decision to a case concerning the use of the mark "California Mix" for a mix of fruit and nuts not originating from California. The Board found the term "California Mix" for mixtures of dried fruits and nutmeats primarily geographically deceptively misdescriptive.⁹³ Here the Board felt that the examining attorney submitted ample evidence to show that California was "noted for" fruits and nuts.

In looking at composite geographic marks, the Board held that a composite mark which included the words "Italian Maid" and a representation of a girl was not deceptive under section 2(a) as applied to canned vegetables, including tomato paste and spaghetti sauce, since consumers were not likely to assume that the products are of Italian origin.⁹⁴ In discussing section 2(a) deception, the Board described situations in which a party applies a geographical designation to a product, knowing that it will bestow upon the product an appearance of greater quality or salability not actually possessed by it, with the intention thereby of inducing or misleading a particular class of consumers into purchasing the product. While such intent is often difficult to prove, especially in *ex parte* proceedings, it can be inferred when the geographical area is well known for the particular product. Deception is not present within the meaning of section 2(a) where a geographical trademark may involve a degree of untruth, and the deception may be perfectly innocent, harmless, or negligible.

CONCLUSION

As is evident from this paper, the adoption, use, and registration of trademarks for food, drugs, cosmetics, and related products is not a simple matter. The Lanham Act contains several specific proscriptions which must be heeded or federal registration will not be obtained. Companies should consider this primer as the starting point for careful evaluation of trademark adoption and use, realizing that proper trademark counseling as well as selection is not only one of the first steps in marketing a product, but also one of the most important.

⁹⁰ *Id.*

⁹¹ *Nantucket, Inc.*, 213 U.S.P.Q. 889 (C.C.P.A. 1982).

⁹² *Handler Fenton Westerns, Inc.*, Ser. Nos. 186, 977 (T.T.A.B. 1982).

⁹³ *Midwest Nut & Seed Co., Inc.*, Ser. Nos. 144, 971 (T.T.A.B. 1982).

⁹⁴ *Amerise*, 160 U.S.P.Q. 687 (1969).

APPENDIX: REQUIREMENTS FOR THE DRAWING

Paper and ink: The drawing must be made upon pure white durable paper, the surface of which must be calendered and smooth. A good grade of bond paper is suitable. India ink alone must be used for pen drawings to secure perfectly black solid lines. The use of white pigment to cover lines is not acceptable.

Size of sheets and margins: The size of the sheet on which a drawing is made must be 8 inches wide and 11 inches long. One of the shorter sides of the sheet should be regarded as its top. When the figure is longer than the width of the sheet, the sheet should be turned on its side with the top at the right. The size of the mark must be such as to leave a margin of at least 1 inch on the sides and bottom of the paper and at least 1 inch between it and the heading.

Heading: Across the top of the drawing, beginning 1 inch from the top edge and not exceeding one-fourth of the sheet, there should be placed a heading, listing, in separate lines, applicant's name, applicant's post office address, the dates of first use, and the goods or services recited in the application (or typical items of the goods or services if a number are recited in the application). This heading may be written.

Character lines: All drawings, except as otherwise provided, must be made with a pen or by a process which will give them satisfactory reproduction characteristics. Every line and letter, names included, must be black. This direction applies to all lines, however fine, and to shading. All lines must be clean, sharp, and solid, and they must not be too fine or crowded. Surface shading, when used, should be open. A photolithographic reproduction or printer's proof copy may be used if otherwise suitable.

Extraneous matter: Extraneous matter must not appear upon the face of the drawing.

Linings for color: Where color is a feature of a mark, the color or colors employed may be designated in the drawing by means of conventional linings.