

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

MARCH 23, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Signal Investment & Management Co.**

Serial No. 75/113,558

Douglas T. Johnson of Miller & Martin for Signal Investment & Management Co.

Charles L. Jenkins, Jr., Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Seeherman, Hohein and Chapman, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Signal Investment & Management Co. has applied to register ICY TO DULL THE PAIN AND HOT TO RELAX IT AWAY as a trademark for "topical analgesics."¹ A final refusal of registration was issued by the Trademark Examining Attorney pursuant to 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 identified goods.

¹ Application No. 75/113,558, filed June 4, 1996, based on an asserted bona fide intention to use the mark in commerce.

Applicant filed the instant appeal. The case has been fully briefed, but an oral hearing was not requested.

Before turning to the issue before us, we must discuss a procedural matter. For the first time in its brief, applicant asserted, in the last paragraph, an alternative basis for registration. Specifically, applicant stated that "the mark is registrable on the ground of acquired distinctiveness under Section 2(f) of the Trademark Act, and Applicant prays that the registration be granted on that ground or that the application be remanded to the Examining Attorney for further consideration on the basis of Section 2(f)." Brief, p. 12. The Examining Attorney objected to the consideration of this issue on appeal.

We agree that applicant's assertion of a Section 2(f) claim in its brief was untimely.² Trademark Rule 2.142(d) provides that the record in the application should be complete prior to the filing of an appeal. Although applicant argues that the evidence (the declaration of Robert Bosworth) upon which it bases its Section 2(f) claim was made of record in response to the first Office action, and therefore prior to the filing of the appeal, the Section 2(f) claim itself is an addition to the record. Nor will we grant applicant's request for remand at this point. After the filing of an appeal, a request for remand will be granted by the Board upon a showing of good cause or upon

² In any event, a request for remand should be identified in a separate paper where it will be immediately noticed so that it can be acted on by the Board immediately. Because applicant placed the reference to a remand in the text of a closing paragraph of a 12-page brief, it was not read by the Board until the time the final decision was to be rendered.

consent. See TBMP § 1207.02. In view of the Examining Attorney's position, it is obvious that he does not consent to a remand. Nor has applicant shown good cause why the claim of acquired distinctiveness could not have been made, in the alternative, prior to the filing of the appeal.

This brings us to the question of whether applicant's slogan, ICY TO DULL THE PAIN AND HOT TO RELAX IT AWAY, is merely descriptive of topical analgesics. Whether a given mark is suggestive or merely descriptive depends on whether the mark immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods with which it is used, or whether imagination, thought, or perception is required to reach a conclusion on the nature of the goods. **In re Gyulay**, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). It has been recognized that there is but a thin line of distinction between a suggestive and a merely descriptive term, and it is often difficult to determine when a term moves from the realm of suggestiveness into the sphere of impermissible descriptiveness. **In re Recovery, Inc.**, 196 USPQ 830 (TTAB 1977).

Applicant has acknowledged that the topical analgesic on which it intends to use the mark contains ingredients that "cause the user to experience sensations which are suggestive of the feelings of ice and heat." Brief, p. 5. Further, the Examining Attorney has submitted evidence that ice has been reported as having an analgesic effect. For example, an article from the May 15, 1996 issue of "American Family Physician" includes the statement, "Ice is a very effective anti-

inflammatory and analgesic agent." Another article, in the March 1994 issue of "Playboy," states, "Hippocrates sang the praises of ice as an analgesic back in the fourth century."

However, applicant's mark is not just the words ICY TO DULL THE PAIN. It also includes the phrase AND HOT TO RELAX IT AWAY. The Examining Attorney contends that heat "helps alleviate muscle pain by relaxing the muscle" and that "analgesics typically work as a muscle relaxant." Office action, May 13, 1997. In our view, though, the fact that one must interpret HOT TO RELAX [the pain] AWAY as heat relaxing the muscle and therefore alleviating pain indicates that the consumer must engage in a multi-stage reasoning process. And because such thought is required we must conclude that this phrase is only suggestive.

The evidence submitted by the Examining Attorney does show that heat can be used to treat sports injuries. For example, an article in the September 1996 issue of "Community Pharmacy" advises that for injuries, ice and heat should be applied alternatively--"heat to increase blood flow, decrease joint stiffness and make the collagen fibres (connective tissue) more elastic and capable of rehabilitation exercises." The December 1993 issue of "Current Health 2" says that "an external analgesic, such as an ice pack or a deep-heating rub, is applied directly to the pain." And the article from "The Tampa Tribune," August 8, 1996, states that muscle-pain relieving rubs actually cause a self-inflicted, mild sunburn" which creates "temporary skin pain to mask the muscle pain."

None of the articles indicates that heat, or a topical analgesic which creates a sensation of heat, relaxes pain away. HOT TO RELAX IT AWAY, therefore, will not immediately and directly convey to consumers information about a characteristic of applicant's product.

The only evidence which refers to relaxing pain is an article which reports another pain reliever product produced by applicant, the ICY HOT CHILL STICK pain reliever. The packaging for this product includes the following language:

Works on contact to relieve everyday arthritis and muscle pain. At home or on the go, the Chill Stick goes on icy to dull pain. Activates to hot for a penetrating warmth to relax pain away.

We regard this text, some of which applicant also uses on the packaging for its ICY HOT analgesic, as suggesting the benefits of the product, rather than as describing the product as literally providing a penetrating warmth that actually relaxes pain away.³

Applicant's mark, thus, is not merely descriptive because the phrase AND HOT TO RELAX IT AWAY is only suggestive. Moreover, when the mark is viewed in its entirety, there is an inherent incongruity caused by the juxtaposition of the two phrases ICY TO DULL THE PAIN and HOT TO RELAX IT AWAY. At first blush, it would appear that a product could not be both ICY and

³ The dissent points out that the packaging for applicant's ICY HOT analgesic displays the phrases ICY TO DULL THE PAIN and HOT TO RELAX IT AWAY. To the extent that the dissent refers to this as an indication of descriptive use, we note that the declaration of applicant's president states that this packaging shows the current use

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HOT. The mental pause that is required to resolve this apparent contradiction again brings this mark into the realm of suggestive, rather than descriptive phrases.

Finally, as has often been stated, there is a gray area in determining whether a mark is descriptive, and where reasonable people may differ, it is our practice to resolve doubt in applicant's favor. See **In re The Gracious Lady Service, Inc.**, 175 USPQ 380 (TTAB 1972).

Decision: The refusal of registration is reversed.

E. J. Seeherman

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board

of the applied-for trademark; we also note that the phrases are used with a "TM" symbol.

Hohein, Administrative Trademark Judge, concurring in part and dissenting in part:

While I agree with the majority that applicant's assertion in its initial brief of a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), is untimely and that a remand at this stage is inappropriate, I would affirm the refusal of mere descriptiveness under Section 2(e)(1) of the statute, 15 U.S.C. §1052(e)(1). The majority appears to find that the words "ICY TO DULL THE PAIN" in applicant's slogan "ICY TO DULL THE PAIN AND HOT TO RELAX IT AWAY" are merely descriptive of applicant's topical analgesics, correctly noting that applicant has acknowledged in its initial brief that such a product "contains ingredients that 'cause the user to experience sensations which are suggestive of the feelings of ice and heat'" and that "the Examining Attorney has submitted evidence that ice has been reported as having an analgesic effect."¹ However, because applicant's slogan also includes the phrase "AND HOT TO RELAX IT AWAY," the majority finds the slogan as a whole to be suggestive inasmuch as "the

¹ In addition to the examples set forth by the majority, the record contains such excerpts as (**emphasis added**):

"Aspirin may no longer be used in **topical analgesic** products (such as the "hot" and "cold" **ice** creams to relieve pain (Ben-Gay @, etc.), although it is still considered effective for external pain relief." -- Nutrition Health Review, June 22, 1991; and

"Analgesics are available for both internal and external use. Both types of these pain relievers reduce pain signals sent to the brain. In contrast, an external **analgesic**, such as an **ice** pack or a deep-heating rub, is applied directly to the pain." -- Current Health 2, December 1993.

fact that one must interpret HOT TO RELAX [the pain] AWAY as heat relaxing the muscle and therefore alleviating pain indicates that the consumer must engage in a multi-stage reasoning process."

Specifically, while conceding that "[t]he evidence submitted by the Examining Attorney does show that heat can be used to treat sports injuries," the majority maintains that "[n]one of the articles indicates that heat, or a topical analgesic which creates a sensation of heat, relaxes pain away"² and that the phrase "HOT TO RELAX IT AWAY, therefore, will not immediately and directly convey to consumers information about a characteristic of applicant's product." As the majority acknowledges, however, an article from the October 28, 1996 edition of Product Alert clearly refers to applicant's "ICY HOT CHILL STICK" pain reliever (a type of topical analgesic) as one which, according to the packaging therefor, not only "goes on **icy to dull the pain,**" but also "[a]ctivates to **hot** for a penetrating warmth **to relax pain away**" (**emphasis added**). Notably, the front panel of the packaging for applicant's "ICY HOT" analgesic balm

² While, indeed, none of the articles quoted by the majority uses the word "relax" to indicate the effect of hot or other heat sensations on muscle pain, it seems clear enough from the Community Pharmacy article that using "heat to ... make the collagen fibres (connectivetissue) more elastic and capable of rehabilitation exercises" is indicative of relaxation and, as further set forth in the article, is thus one of "[t]he recommended steps to reduce pain" Furthermore, as confirmed by the following excerpt of record, analgesics assist muscle relaxation, irrespective of whether they create an icy and/or hot sensation (**emphasis added**):

"Sedative and **analgesic** medications assist muscle **relaxation** during a [shoulder dislocation] reduction maneuver, but many physicians advocate performing reductions without medication." -- American Journal of Sports Medicine, January 1995.

(also a kind of topical analgesic) prominently displays the phrases "ICY TO DULL THE PAIN" and "HOT TO RELAX IT AWAY" in conjunction with a description of such product as a "Pain Relieving Cream".³

Although the majority regards such evidence as only "suggesting the benefits of the product, rather than as describing the product as literally providing a penetrating warmth that actually relaxes pain away," I agree with the Examining Attorney's statement in his brief that applicant's slogan merely "describes how the applicant's topical analgesics function once they are applied to the skin." In particular, as further stated in such brief:

The proposed mark ICY TO DULL THE PAIN AND HOT TO RELAX IT AWAY for "topical analgesics" is merely descriptive. The phrases "icy to dull the pain" and "hot to relax it away" describe a feature, function and characteristic of the applicant's topical analgesics. The wording "icy to dull the pain" merely describes one aspect of the applicant's topical analgesics. Typically, topical analgesics generate an icy feeling when applied to human skin. The icy sensation generated by a topical analgesic penetrates the skin to dull muscle pain. The wording "hot to relax it away" [merely] describes the second characteristic of applicant's topical analgesics. The warm or hot feeling generated by the topical analgesic, on the surface of the skin, relaxes the pain away.

³ While the packaging shows use of the "TM" symbol in connection with the latter phrase, it is settled that use of such symbol in connection with a phrase or term cannot make a merely descriptive or otherwise unregistrable phrase or term a trademark. See, e.g., In re Pennzoil Products Co., 20 USPQ2d 1753, 1760 (TTAB 1991) at n. 15; In re General Foods Corp., 177 USPQ 403, 404 (TTAB 1973) at n. 1; and In re Nosler Bullets, Inc., 169 USPQ 62, 64 (TTAB 1971).

Rather than constituting a multi-stage reasoning process or syllogistic approach, I find the Examining Attorney's explanation to be one which immediately and directly sets forth, without resort to any speculation or conjecture, why the slogan "ICY TO DULL THE PAIN AND HOT TO RELAX IT AWAY" merely describes a significant feature, function or characteristic of applicant's goods. It should be noted, in this regard, that nowhere in the record does applicant deny that topical analgesics may feel icy in order to dull muscle pain and yet also feel hot to relax such pain away. In fact, the packaging for two types of applicant's topical analgesics succinctly indicates in each instance that the products create an icy sensation to dull the pain and a hot sensation to relax it away. I find such evidence, along with the fact that it is common knowledge that heat, whether warm or hot, physiologically causes cramped or otherwise tight and painful muscles to relax, to be sufficient to establish the mere descriptiveness of applicant's slogan as applied to topical analgesics.

Applicant argues in its initial brief, however, that its slogan "is not merely descriptive of Applicant's topical analgesics, but is rather a suggestive reference to the sensations generated by Applicant's topical analgesic and includes an ingenious double entendre reference to Applicant's famous ICY-HOT trademark." I do not see any "ingenious double entendre" and believe that the ordinary consumer for applicant's products would not so perceive applicant's slogan. Moreover, while the majority finds that, when viewed in its entirety,

applicant's slogan possesses "an inherent incongruity caused by the juxtaposition of the two phrases ICY TO DULL THE PAIN and HOT TO RELAX IT AWAY" inasmuch as "a product could not be both ICY and HOT," I concur with the Examining Attorney that purchasers and prospective customers would not reasonably expect applicant's topical analgesics to provide icy and hot sensations at the same time. Instead, as the Examining Attorney points out, "[t]he words 'icy' and 'hot' are not used in the applicant's slogan in a contradictory manner, [but] rather both of these words are used in separate phrases to convey ... descriptive characteristic[s] of applicant's product." Applicant, in fact, admits in its initial brief that "the Examining Attorney's evidence shows that ... one other topical analgesic, Warming Ice™, claims to provide the sensations of both ice and heat working in concert." The record also shows that another brand of topical analgesic, "BEN-GAY," is likewise in the product category of "'hot' and 'cold' ice creams to relieve pain".

In view thereof, I agree with the Examining Attorney that consumers of topical analgesics would readily regard applicant's slogan "ICY TO DULL THE PAIN AND HOT TO RELAX IT AWAY" as merely describing "two ways in which the applicant's topical analgesic functions." I would therefore affirm the refusal to register.

G. D. Hohein
Administrative Trademark Judge,
Trademark Trial and Appeal Board