

THIS DISPOSITION IS  
NOT CITABLE AS PRECEDENT  
OF THE TTAB

Mailed: March 9, 2004  
Paper No. 12  
BAC

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**Trademark Trial and Appeal Board**

---

In re Primal Elements, Inc.

---

Serial No. 76339766

---

Kit M. Stetina of Stetina Brunda Garred & Brucker for  
Primal Elements, Inc.

John E. Michos, Trademark Examining Attorney, Law Office  
105 (Thomas G. Howell, Managing Attorney).

---

Before Seeherman, Quinn and Chapman, Administrative  
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On November 15, 2001, Primal Elements, Inc. (a  
California corporation) filed an application to register  
the mark BOTANICALLY BASED on the Principal Register for  
goods identified as "candles, candle wax and candle  
components, such as wicks" in International Class 4. The  
application is based on applicant's assertion of a bona  
fide intention to use the mark in commerce on the goods.

In the first Office action, the Examining Attorney refused registration on the ground that applicant's mark, BOTANICALLY BASED, is merely descriptive of applicant's goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). The Examining Attorney also required (i) informational materials regarding applicant's goods; and (ii) a more definite identification of goods, suggesting, if appropriate, "candles, and candle wax and wicks, sold as components of candles, all containing botanical ingredients." He explained that if the goods do not contain botanical (plant based) ingredients, then the mark would be deceptive or deceptively misdescriptive.

Applicant responded by stating that informational materials about its recited goods "cannot be found at this time"; proposing an amendment to the identification of goods to "candles, and candle wax and wicks, sold as components of candles"; and arguing that its mark is not merely descriptive of the goods.

The Examining Attorney then made final both the refusal to register the mark as merely descriptive, and the requirement for an acceptable identification of goods, stating that the phrase "all containing botanical ingredients" must be included.

Applicant filed a timely notice of appeal and it also requested reconsideration as to the identification of goods issue. The Examining Attorney denied the request for reconsideration.

Both applicant and the Examining Attorney have filed briefs;<sup>1</sup> an oral hearing was not requested.

We consider first the Examining Attorney's requirement for a further amendment to the identification of goods. The Examining Attorney contends that the identification of goods is unacceptable because it does not indicate that the goods contain botanical ingredients as stated in applicant's mark. Applicant argues that its proposed identification of goods is acceptable under the rules and policies of the USPTO.

---

<sup>1</sup> Applicant submitted three exhibits with its appeal brief. (Exhibit A consists of printouts of pages from the mainstonline.com web site, which was one of the sites listed in a Google search list previously made of record by the Examining Attorney; Exhibit B consists of printouts of pages from applicant's web site (also one of the web sites listed in a Google search list submitted by the Examining Attorney); and Exhibit C consists of printouts of pages from three different web sites which refer to candle holders and candle bases.) The Examining Attorney did not object to the new evidence, and in fact specifically addressed some of the information in his brief on appeal. Although normally new evidence may not be filed after an appeal is filed, see Trademark Rule 2.142(d), in this case, the Examining Attorney did not object thereto and, instead, treated it as being of record. With respect to the web pages from sites which were in the Google listing previously submitted by the Examining Attorney, these have been allowed because applicant is allowed to place such fragments in context. See *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 820 (Fed. Cir. 1986).

We agree with applicant. According to the "Trademark ID Manual," the word "candles" alone is an acceptable identification of goods. Thus, although the limiting phrase "all containing botanical ingredients" provides additional information about applicant's products, the inclusion of the phrase is clearly not necessary for an acceptable identification of these goods. The amended identification of goods presented by applicant is acceptable. See TMEP §§1402.04 and 1402.05 (3d ed. 2002).

Accordingly, the Examining Attorney's requirement for a further amendment to the identification of goods is reversed.

We turn then to the refusal to register the mark as merely descriptive in relation to the identified goods. The Examining Attorney contends that the proposed mark merely describes characteristics and properties of applicant's goods, namely, that the candles, candle wax and candle wicks contain botanical materials (i.e., components or extracts made from plants). He specifically argues that the words BOTANICALLY BASED are used to describe any product which contains ingredients derived from plants (e.g., skin care products, hair care products, cosmetics, aromatherapy products and candles); that applicant's own web site refers to "botanically based candles" and to

"Herbaceous" candles with "fresh anise and sweet powdery vanilla" or "evergreens"; and that a variety of products based on natural ingredients is highly desirable to consumers.

Applicant argues that the mark BOTANICALLY BASED is not merely descriptive of the goods. Specifically, applicant argues that the mark does not directly convey information about applicant's goods, but rather is suggestive, requiring thought or perception to reach a conclusion about the goods; that the words "botanically based" could refer to the ingredients used in manufacturing the candles, but the words could also refer to the candle base, or to the appearance or fragrance of the candle (brief, pp. 7-8); that the dictionary definition of the word "base" includes multiple definitions; that the Examining Attorney has not met the burden of proof to establish that the mark is merely descriptive; and that doubt must be resolved in applicant's favor.

The test for determining whether a mark is merely descriptive is whether the term or phrase 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 is intended to be used. See *In re Nett Designs*

Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978); In re Eden Foods Inc. 24 USPQ2d 1757 (TTAB 1992); and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979).

Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used or is intended to be used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995); and In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991). Consequently, "[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). Rather, the question is whether someone who knows what the goods or services are will understand the term or phrase to convey information about them. See In re Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990).

The Examining Attorney has made of record the following definition from The American Heritage Dictionary of the English Language (Third Edition 1992):

**botanical** adjective 1. of or relating to plants or plant life... .

Applicant referred to the fact that there are several definitions of the word "base" in Webster's Ninth New Collegiate Dictionary, such as "foundation," "low in place or position," and "that part of a bodily organ by which it is attached to another more central structure of the organism." However, applicant did not include a copy thereof. (Applicant's April 12, 2002 response, pp. 3-4.)

The Board hereby takes judicial notice of The American Heritage Dictionary of the English Language (1976) definition of "base." As applicant contends, there are several separate definitions of the word "base," one of which is "3. the fundamental ingredient from which a mixture is prepared; ... a paint with an oil base..."

Applicant's assertion about the multiple meanings of the word "base" is unpersuasive because those other meanings are irrelevant in the context of applicant's goods. It is the significance of the mark as used in connection with applicant's goods that we must consider. Moreover, applicant's mark uses the word "based," not

"base," and this term follows the word "botanically." In this context, the dictionary meaning we have set forth above would be the one consumers would attribute to the mark.

As mentioned earlier, the Examining Attorney submitted printouts from a list retrieved by a Google search for "botanically based and candles," which provided limited excerpts from the various web sites listed therein. This search indicated that 356 references were found. He also submitted printouts of a few pages listing brief excerpts from web sites retrieved by a Google search for "primal elements botanically based." These excerpts included a short segment from applicant's web site stating the following: "... we believe our botanically based candles will be ...." Normally such a Google search listing is not particularly persuasive because it does not include printouts of the pages from the listed web site, and it is often difficult to understand the context in which the retrieved phrase is used. However, in this case, the short excerpt from applicant's web site shows applicant's use of the applied-for term in a descriptive manner, and applicant has not denied this, or given any other explanation of its use. We also note that the web pages submitted by applicant of its web site, while not showing the use of

"botanically based" indicated above, do tout applicant's candles as including such botanical ingredients or scents as "anise," "vanilla" or "evergreen."

The Examining Attorney also made of record several excerpted stories retrieved from the Nexis database, examples of which are reproduced below, to show that "botanically based" has a descriptive significance in relation to a wide variety of products, particularly those for health and beauty, lifestyle, aromatherapy, and the like:

Headline: GF Tested  
...Product claims: Botanical Kinetics formulas are botanically based daily care for all skin types. They soothe with plant-derived emollients, protect with natural anti-oxidants and nourish with ...  
"Palm Beach Post," November 22, 2002;

Headline: Dry Hair? Try One of These Conditioners  
...loves Phytologie's Phytocitrus Essential Nutrition Hair Mask for dry and brittle hair. Phytologie is a botanically based line. This mask is packed with things such as shea butter and grapefruit extracts and is specially ... "The Dallas Morning News," August 15, 2002; and

Headline: Organic Growth; Organic Cosmetics and Toiletries  
...Integrity is the key to our work. All our products are botanically based and driven and all ingredients are grown on local farms. "Soap Perfumery & Cosmetics," October 1, 2001.

We agree with the Examining Attorney that the phrase "botanically based is a commonly used marketing phrase which describes the source of ingredients for a variety of goods." (Brief, p. 8.) The evidence shows that people are conditioned to seeing the term "botanically based," and that people will understand the term as meaning that skin care products, cosmetics, soaps and aromatherapy products are made of plant ingredients. Candles, too, are general consumer products, which are akin to aromatherapy products. Thus, when purchasers see the words "botanically based" used in connection with candles, the same meaning will be understood, particularly in view of applicant's own use of the term.

Accordingly, we find that applicant's mark, BOTANICALLY BASED, when used in connection with applicant's identified goods, immediately describes, without need of conjecture or speculation, the primary characteristics of applicant's goods. No exercise of imagination or mental processing or gathering of further information is required in order for purchasers of and prospective customers for applicant's goods to readily perceive the merely descriptive significance of the phrase BOTANICALLY BASED. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Omaha National Corporation*, 819 F.2d 1117, 2

**Ser. No. 76339766**

USPQ2d 1859 (Fed. Cir. 1987); In re Intelligent Instrumentation Inc., 40 USPQ2d 1792 (TTAB 1996); and In re Time Solutions, Inc., 33 USPQ2d 1156 (TTAB 1994).

**Decision:** The requirement for a further amendment to the identification of goods is reversed, and the refusal to register on the ground that the mark is merely descriptive under Section 2(e)(1) of the Trademark Act is affirmed.