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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Merrell Pharmaceuticals Inc.

Serial Nos. 78404542 and 78404543

Susan Upton Douglass of Fross Zelnick Lehrman & Zissu, P.C. for Merrill Pharmaceuticals Inc.

Michael G. Lewis, Trademark Examining Attorney, Law Office 111 (Craig D. Taylor, Managing Attorney).[1]

Before Seeherman, Hairston and Cataldo, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

On April 20, 2004, Merrell Pharmaceuticals applied to register the marks CITRUCEL FIBERSHAKE (Application Serial No. 78404542) and FIBERSHAKE (Application Serial No. 78404543) for goods which were ultimately identified as "laxatives and fiber dietary supplements." Both

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[1] The current Examining Attorney took over responsibility for the applications with the preparation and filing of the appeal briefs.

applications were initially filed pursuant to Section 1(b) of the Trademark Act, asserting a bona fide intention to use the marks in commerce; applicant subsequently filed Allegations of Use for both marks, alleging first use and first use in commerce as of April 21, 2005.

The Examining Attorney issued a final refusal of registration with respect to the application for CITRUCEL FIBERSHAKE pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), requiring a disclaimer of FIBERSHAKE on the ground that it is merely descriptive of applicant's goods, and is therefore an unregistrable component of the mark. With respect to the application for FIBERSHAKE, the Examining Attorney issued a final refusal of registration 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.

Applicant and the Examining Attorney have filed appeal briefs. An oral hearing was not requested.

Because both appeals involve the same issue, namely, whether FIBERSHAKE is merely descriptive of laxatives and fiber dietary supplements, and because the records in each application are essentially the same, we are deciding both appeals in a single opinion.

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered to be merely descriptive; rather, it is enough that the term describe one significant attribute, function or property of the goods or services. In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982); In re MBAssociates, 180 USPQ 338 (TTAB 1973). 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 on or in connection with the 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 its use; that a term may have other meanings in different contexts is not controlling. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

In support of his position that FIBERSHAKE is merely descriptive, the Examining Attorney has made of record excerpts from a number of various websites showing use of the term "fiber shake," including the following:

> Pumpkin Fiber Shake
> Great Starter Shake in the Morning.
> Fast and Easy to Make
> www.recipezaar.com
>
> Figure 8 weight loss program
> ...
> 4 products make it simple
> 1 Go Easy! Protein Shake with INNER G-Pex, chocolate & vanilla
> 2 Just Go! Orange Fiber Shake
> www.arbonne.com
>
> INTESTINAL CLEANSE 5 to 7 Days
> ...
> 8:30 to 10:30 AM: First Herb Bulk shake (at least 1+1/2 hour after breakfast). Mix 1 scoop in 8 oz of H2O or apple juice. Remember to drink 8 oz. of water immediately after your fiber shake.
> ...
> 1:00 to 3:00 PM: Early Afternoon Second Fiber Shake (At least 1-1/2 hour after lunch.)
> *Remember: Drink 8 oz. of water immediately after your fiber shake.*
> www.camdenclay.com
>
> Soluble Products
> Nutritional Beverage Mix Checklist
> ...
> Healthy Lifestyle
> ...
> High Fiber Shake Mix
> Mix with Cold Water or Milk
> (lists flavors Chocolate, Strawberry, Vanilla, Plain)
> www.solubleproducts.com

> GoLEAN Essentials: High Protein & High Fiber
> Fule [sic] your weight and fitness goals with Kashi GoLEAN Natural High Protein High Fiber Shakes, Delicious and Nutritious, GoLEAN shakes provide 30 grams (when mixed with 1 cup of fat free milk) of high quality protein and 7 grams of satisfying fiber….
> www.mothernature.com
>
> **Nutrition Shakes Products**
> Diet Shakes
> Energy Shakes
> High-Fiber Shakes
> www.health-checker.com

The Examining Attorney has also made of record dictionary definitions for "fiber" and "shake,"[2] the most pertinent of which are:

> Fiber: Coarse, indigestible plant matter, consisting primarily of polysaccharides such as cellulose, that when eaten stimulates intestinal peristalsis. In this sense, also called *bulk, roughage.*
>
> Shake: a. See milk shake b. A beverage in which the ingredients are mixed by shaking.

In addition to the foregoing evidence, we note that applicant has identified its goods as laxatives and <u>fiber</u> dietary supplements (emphasis added), and that applicant's

[2] <u>The American Heritage Dictionary of the English Language</u>, 3d ed. © 1992.

specimen of use describes its goods as "methylcellulose fiber therapy for regularity."

We have no doubt that the individual words "fiber" and "shake" in applicant's marks describe significant characteristics or features of the goods. Fiber is clearly a major ingredient of applicant's fiber dietary supplement. In fact, applicant has acknowledged the descriptiveness of FIBER: "the term FIBER is descriptive as being an ingredient of the laxative and nutritional supplement," and "The term FIBER describes an ingredient of the nutritional supplements." Brief, p. 4. The word SHAKE, too, is descriptive, in that applicant's product is consumed in the form of a shake. Applicant states that its goods are a powdered laxative, rather than a shake, such that the product "is not literally a 'fiber shake,' but rather, a laxative containing fiber, that can be combined with other ingredients and so processed to become a shake." Brief, p. 5. While this argument might have some applicability if the refusal were that FIBERSHAKE is a generic term for applicant's powder, the question before us in this appeal is whether the term is merely descriptive. When FIBERSHAKE is viewed in connection with the goods, a FIBERSHAKE powder or a FIBERSHAKE mix, the descriptive nature of FIBERSHAKE, or SHAKE per se, is readily apparent; consumers would

immediately understand that FIBERSHAKE describes a powder or mix for making a fiber shake. Moreover, the evidence of record shows that third parties use "fiber shake" or "shake" to describe goods that are powders that are combined with liquid to make a shake. See, for example, "High Fiber Shake Mix" on the www.solubleproducts.com website. Thus, "shake" is understood by consumers, in the context of these goods, to describe that the goods are a powder or mix that makes a "shake."

When these two descriptive words, FIBER and SHAKE, are combined, the resulting term FIBERSHAKE continues to have a merely descriptive meaning, i.e., it immediately tells consumers that applicant's goods make a shake that has fiber as a primary ingredient. No imagination or thought is required to reach this conclusion; the evidence shows that "fiber shake" is a recognized term for such shakes.[3]

Applicant argues that, although the term "fiber shake" may be used by third parties, applicant's mark FIBERSHAKE is a unitary term that applicant has coined. We assume that when applicant asserts that its mark is coined, it is

[3] Applicant has pointed out that some of the Internet evidence submitted by the Examining Attorney uses the term "fiber shakes" (plural) rather than "fiber shake." While there is sufficient evidence of "fiber shake" per se to support our conclusion that FIBERSHAKE is merely descriptive, we consider the evidence of "fiber shakes" relevant to show how the public would perceive applicant's mark.

referring to the fact that applicant spells FIBERSHAKE without a space between "fiber" and "shake." We are not persuaded by this argument. The absence of a space between "fiber" and "shake" does not create a different meaning or perception of FIBERSHAKE. Although in applicant's mark the two words, "fiber shake," are run together so that there is no space between them, consumers would still readily recognize that FIBERSHAKE consists of these two words. The commercial impression that FIBERSHAKE is simply the words FIBER SHAKE is emphasized by the specimen showing applicant's use of the mark, which depicts FIBERSHAKE with a capitalized "F" and "S" and with the other letters in lower case, such that consumers would view the mark as being the separate words FIBER SHAKE. Moreover, in a Google search summary submitted by applicant, most of the listings that refer to applicant's product depict the mark as "FiberShake," with the "F" and "S" capitalized and the remaining letters in lower case, indicating that various websites view the mark as consisting of the two words. Thus, consumers would understand FIBERSHAKE, when used in connection with a laxative and dietary fiber supplement sold in powder form, to have the same meaning as FIBER SHAKE, namely, a powder that makes a fiber shake. See In re Planalytics Inc., 70 USPQ2d 1453 (TTAB 2004).

Applicant argues that the USPTO has registered other SHAKE marks that include descriptive words because they were found to be unitary terms. We do not consider the third-party marks that applicant has made of record to be analogous to the present situation. In any event, a similar argument to that of applicant herein was made by the applicant in In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). What the Court said in that decision, at 57 USPQ2d 1566, is equally applicable here:

> The Board must decide each case on its own merits. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1127, 227 USPQ 417, 424(Fed. Cir. 1985). Even if some prior registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court.
>
> Needless to say, this court encourages the PTO to achieve a uniform standard for assessing registrability of marks. Nonetheless, the Board (and this court in its limited review) must assess each mark on the record of public perception submitted with the application. Accordingly, this court finds little persuasive value in the registrations that Nett Designs submitted to the examiner or in the list of registered marks Nett Designs attempted to submit to the Board.

Finally, applicant points out that the search the Examining Attorney conducted was for "fiber shake" as two words, not the single word FIBERSHAKE. Applicant also

asserts that, on the other hand, the Google search that it conducted for the single term FIBERSHAKE retrieved "dozens of listings for the applicant and its FIBERSHAKE product, and *no* third-party references." Brief, p. 8. As a result, applicant claims that "the public can, and does, differentiate between the words 'fiber shake' or 'fiber shakes' and the mark that applicant uses and seeks to register, FIBERSHAKE." Brief, p. 8.

As a general rule, a party cannot take a merely descriptive term and obtain exclusive rights to it by misspelling it, or depicting it as a compound word, i.e., without a space. See, in particular, the following cases, in which the deletion of a space between words did not prevent the combined term from being found merely descriptive (or generic): In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (SCREENWIPE generic for a wipe for cleaning television and computer screens); In re Abcor Development, supra, (GASBADGE at least descriptive for gas monitoring badges; three judges concurred in finding that term was the name of the goods); In re Orleans Wines, Ltd., 196 USPQ 516 (TTAB 1977) (BREADSPRED descriptive for jams and jellies that would be a spread for bread); In re Perkin-Elmer Corp., 174 USPQ 57 (TTAB 1972) (LASERGAGE merely descriptive for

interferometers utilizing lasers). As noted previously, the commercial impression conveyed by applicant's mark is of the two words, FIBER SHAKE, which have merely been combined. Thus, even without a space in the mark, the public will still view FIBERSHAKE as a descriptive term.[4]

In view of the foregoing, we find that FIBERSHAKE is merely descriptive of laxatives and fiber dietary supplements.

Decision: The refusal to register FIBERSHAKE—Serial No. 78404543—is affirmed. The refusal to register CITRUCEL FIBERSHAKE—Serial No. 78404542--in the absence of a disclaimer is also affirmed. However, if within thirty days of the mailing of this decision applicant submits the required disclaimer of FIBERSHAKE, our decision in Serial No. 78404542 will be set aside.

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[4] It is not clear to us whether applicant is also asserting that the public has come to recognize FIBERSHAKE, when shown as a single word, as applicant's trademark. To the extent that applicant is contending that FIBERSHAKE is not merely descriptive because it has acquired distinctiveness as a trademark, we note that applicant has not claimed that its marks are entitled to registration pursuant to the provisions of Section 2(f) of the Trademark Act, and therefore this question is not before us.