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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JULY 11, 2000

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Indena S.p.A.

Serial No. 74/603,891

Ralph E. Bucknam and Joseph J. Orlando
of Bucknam and Archer for Indena S.p.A.

Curtis W. French, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

Before Simms, Cissel and Wendel, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Indena S.p.A. filed an application to register the mark PHYTOSOME on the Principal Register for "complexes of vegetable substances with phospholipids for use in the manufacture of cosmetics, pharmaceuticals and health foods."[1]

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[1] Serial No. 74/603,891, filed November 28, 1994, setting forth first use dates of July 1988.

Registration was initially refused, and the refusal made final, on the ground that the mark was merely descriptive under Section 2(e)(1) of the Trademark Act. Applicant subsequently amended the application to one seeking registration on the Supplemental Register. Registration has now been finally refused under Section 23 of the Trademark Act on the ground that the proposed mark is generic and thus incapable of distinguishing applicant's goods from those of others.

Both applicant and the Examining Attorney filed briefs in the case. The Board issued a decision in the case on March 28, 2000. Applicant then filed a request for reconsideration, pointing out that an oral hearing had been requested but the Board had issued its decision without scheduling or holding a hearing. Upon reviewing the file, the Board determined that an oral hearing had been timely requested. Accordingly, the Board granted the request for reconsideration, vacated its decision of March 28, 2000 and scheduled an oral hearing. This opinion is being issued after an oral hearing was held in which both applicant and the Examining Attorney participated.

Generic terms are by definition incapable of indicating source and thus can never attain trademark status. In re Merrill, Lynch, Pierce, Fenner, and Smith

Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). The critical issue in determining genericness is whether members of the relevant public primarily use or understand the term sought to be registered to refer to the genus or category of services in question. See H. Marvin Ginn Corp. v. International Association of Fire Chiefs Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986); In re Recorded Books, Inc., 42 USPQ2d 1275 (TTAB 1997). Evidence of the relevant public's understanding of the term may be obtained from any competent source, including dictionaries, trade journals, newspapers, and other publications. See In re Northland Aluminum Products, Inc., 777 F.2d 1566, 227 USPQ 961 (Fed. Cir. 1985).

Here the Examining Attorney maintains that PHYTOSOME is a term of art used by the relevant public, namely, those in the cosmetic and pharmaceutical manufacturing industries, to describe a combination of liposomes and plant extracts and thus identifies goods of the class covered by applicant's identification of goods. The Examining Attorney supports this position with excerpts from twenty-some articles obtained from the Nexis database, printouts from three Web sites and a dictionary definition of the term "phytosome" from the *Consumer's Dictionary of Cosmetic Ingredients* (4th Ed. 1994). As representative

examples of the uses of the term by others in the cosmetic and pharmaceutical fields, we note the following:

> Its eye color has licorice phytosome to provide softening. And so it goes in the treatment-protection ingredient race... *Drug & Cosmetic Industry* (Oct. 1991);
>
> ...Duo Tanning Powder. All are formulated with natural proteins and active ingredients such as hyaluronic acid and oligo elements (for hydration); phytosome acid glycyhiza and potassium (to reduce swelling and puffiness); natural sun filters ... *Cosmetics International* (Apr. 13, 1993);
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> ...anti-acne effect of a formulation containing standardized extract from Krameria triandra Ruiz (0.5%), escrin-[Beta]-sitosterol phytosome (1%) and lauric acid... *Manufacturing Chemist* (Dec. 1996);
>
> ...supplements thought to be cancer fighters: the mineral selenium, vitamins A and E, flaxseed oil, organic germanium, grape-seed phytosome, maitake..... *Washingtonian* (Oct. 1997).

The dictionary definition reads:

> A new term cosmetologists are using for the combination of liposomes (*see*)[2] and plant extracts. They claim that the desirable substances then pass more easily through the skin. In the works are phytosomes to carry catechin, quercitron, escin, and glycyrrhetinic acid... .

Applicant argues that it coined the term PHYTOSOME to identify certain complexes obtained by combining vegetal active principles and purified natural phospholipids which it had developed; that these developments have been

[2] We take judicial notice of the corresponding definition for "liposomes" as "microscopic sacs, or spheres, manufactured from a variety of fatty substances, including phospholipids."

patented and the term PHYTOSOME has been treated as a trademark by applicant and registered in Italy; and that the usages which the Examining Attorney has produced only show that the mark has been appropriated and misused by others in the cosmetic and pharmaceutical industry. Applicant maintains that this is a less than substantial showing of generic use and that the Examining Attorney has failed to meet the burden of proof necessary to show that the consuming public considers the term generic. Applicant relies upon four articles written by employees of applicant describing applicant's work with respect to these complexes as evidence that applicant was responsible for coining the term PHYTOSOME for the products, which is used throughout the articles in the manner of a trademark. Applicant argues that it is not clear from the abbreviated Nexis excerpts introduced by the Examining Attorney if the term "phytosome" was in some other portion attributed to applicant. Even if there has been no recognition that applicant coined the term, applicant argues that it should not be penalized for the "uncontrollable actions" of others in using the term to describe "the same or similar" products. (Applicant's Reply Brief, p.3).

From the articles introduced by applicant, we have no doubt that applicant coined the term PHYTOSOME for the

complexes of vegetal principles and phosopholipids which it has developed and patented, and which have useful cosmetic and pharmaceutical properties. Applicant's fatal error lies in using this coined term as the sole designation for these new complexes. As a result of this failure to indicate a name per se for the products, the term has been subsequently adopted by others in the relevant fields as the generic name for the complexes, as shown by the Examining Attorney's evidence. See J. T. McCarthy, 2 McCarthy on Trademarks and Unfair Competition, § 12:25 (1991) for a general discussion of names for new products becoming generic. Even though a term may start out nongeneric as applied to a product, if the term over a period of time comes to identify the product itself, rather than the source thereof, it becomes generic and cannot be exclusively appropriated by any one party. See In re Randall and Hustedt, 226 USPQ 1031 (TTAB 1985); In re Texas Meat Brokerage, Inc., 199 USPQ 40 (TTAB 1978).

Here, similar to the *Randall and Hustedt* case, although applicant dismisses subsequent third-party uses of the term as "misappropriation" of its coined mark, applicant has failed to introduce any evidence that it has attempted to police its alleged trademark rights. In fact, at the oral hearing, applicant's counsel admitted that

applicant had not made any efforts to police its mark in the United States. The evidence of the use by others in the cosmetic and pharmaceutical fields of the term "phytosome" in a generic sense to describe ingredients consisting of complexes of plant extracts (vegetable substances) and liposomes (phospholipids) is sufficient to establish that the term has come to be perceived and has been adopted as a generic reference to goods of this class by the relevant public, which in this case consists of those involved in the production of cosmetic and pharmaceutical products. See Continental Airlines, Inc. v. United Air Lines Inc., 53 USPQ2d 1385 (TTAB 1999)[term "E-ticket" has been adopted by many airlines as common descriptive term for electronic ticketing and reservation services].

Accordingly, we find that the term PHYTOSOME is primarily used and understood by the relevant public as a generic name for the class of goods within which applicant's complexes fall and thus is incapable of functioning as a mark indicating applicant as the source of goods of this type.

Decision: The refusal to register under Section 23 is affirmed.

R. L. Simms

R. F. Cissel

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board