UNITED STATES: TTAB Finds HOLISTIC Merely Descriptive of Cat Food

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The Trademark Trial and Appeal Board (TTAB or Board) found that the mark HOLISTIC was merely descriptive under Section 2(e)(1) of the Trademark Act, affirming the examining attorney’s refusal to register HOLISTIC for “cat food” in Class 31. In re Midwestern Pet Foods, Inc., Serial No. 85128946 (T.T.A.B. Nov. 13, 2013) (not precedential). The TTAB based its decision on evidence demonstrating that the word HOLISTIC described an important feature of the applicant’s cat food, namely, it “nourish[es] the whole cat.”

Applicant Midwestern Pet Foods, Inc. (Midwestern) asserted that HOLISTIC was not descriptive but rather suggestive because the term had varied definitions such that it did not immediately describe a certain characteristic of cat food. Instead, it “convey[ed] [Midwestern’s] ability to provide healthy, healthful foods that aim to keep your whole cat in good shape” and “connot[ed] a sophisticated level of pet food formulation.” Highlighting Midwestern’s website, the examining attorney contended that HOLISTIC described a significant characteristic of the applicant’s cat food. Specifically, the website described Midwestern’s “holistic approach to nutrition” by providing ingredients that “nourish the whole cat.” Third-party registrations also illustrated that HOLISTIC was a commonly used term in the cat food industry.

According to the TTAB, HOLISTIC “immediately inform[ed] the customer” that Midwestern’s cat food “nourish[ed] the whole cat.” The examples of third-party registrations presented by the examining attorney demonstrated sufficient use in the cat food industry for the Board to find that the mark was descriptive for cat food.

After refusing to disclaim HOLISTIC, Midwestern also argued that EARTHBORN HOLISTIC, which it had registered over five years previously as a trademark for dog food, constituted a unitary expression, while reasoning that the terms had opposite meanings and were “suggestive of a new age lifestyle.” The TTAB, however, held that “if the elements are so merged together that they cannot be regarded as separable elements, the mark is a single unitary mark and not a composite mark and no disclaimer is necessary.” In re EBS Data Processing, Inc., 212 U.S.P.Q. 964, 966 (T.T.A.B. 1981). Both words, HOLISTIC and EARTHBORN, retained their separate meanings and were not “so merged together” that they “cancel[ed] one another out.” Therefore, the descriptive meaning of HOLISTIC was not replaced by a new and combined meaning.

Midwestern further contended that the unitary aspects of EARTHBORN HOLISTIC had been recognized and that consistent treatment should be applied for cat food without disclaiming HOLISTIC. The TTAB found that “ownership of an incontestable registration does not give [an] applicant a right to register the same or similar mark for different goods or services, even if they are closely related to the goods or services set forth in the incontestable registration.” In re Best Software Inc., 63 U.S.P.Q.2d 1109, 1113 (T.T.A.B. 2002). While dog food and cat food are in the same category as pet foods, the TTAB found them to be different products.

This case highlights a common misconception among brand owners in expanding a company’s product line. There is no statutory right to register an incontestable trademark for additional and/or different goods and services. A registered mark is incontestable only in the form registered and for the goods and services claimed. Here, the Board recognized that although dog food and cat food are similar, they are distinct products; therefore, it could treat the contested mark as separate from and unrelated to the registered mark.

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