

**STATEMENT IN RESPONSE TO OFFICE ACTION**  
**U.S. TRADEMARK APPLICATION NO. 88288262 – WRIGHT’S APOTHECARY**  
**ISSUE/MAILING DATE: 4/18/2019**

**EXAMINING ATTORNEY’S REASON FOR REFUSAL**

Registration is refused because the applied-for mark is primarily merely a surname. Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4); see TMEP §1211.

The applied-for mark is “WRIGHT’S APOTHECARY” in standard characters for “ Massage apparatus for massaging the face” in International Class 10.

An applicant’s mark is primarily merely a surname if the surname, when viewed in connection with the applicant’s recited goods, “is the primary significance of the mark as a whole to the purchasing public.” *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374, 1377, 123 USPQ2d 1411, 1413 (Fed. Cir. 2017) (quoting *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 554, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988)); TMEP §1211.01.

The following five inquiries are often used to determine the public’s perception of a term’s primary significance:

- (1) Whether the surname is rare;
- (2) Whether anyone connected with applicant uses the term as a surname;
- (3) Whether the term has any recognized meaning other than as a surname;
- (4) Whether the term has the structure and pronunciation of a surname; and
- (5) Whether the term is sufficiently stylized to remove its primary significance from that of a surname.

*In re Eximius Coffee, LLC*, 120 USPQ2d 1276, 1278 & n.2, 1282-83 (TTAB 2016); TMEP §1211.01.

These inquiries are not exclusive, and any of these circumstances – singly or in combination – and any other relevant circumstances may be considered when making this determination. *In re Eximius Coffee, LLC*, 120 USPQ2d at 1277-78; TMEP §1211.01. For example, when the applied-for mark is not stylized, it is unnecessary to consider the fifth inquiry. *In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007); TMEP §1211.01.

**REPLY TO REFUSAL**

**I. APPLICANT SHOULD BE PERMITTED TO REGISTER THE MARK AS APPLIED FOR BECAUSE THE MARK IS NOT PRIMARILY MERELY A SURNAME AND HAS ACQUIRED SECONDARY MEANING.**

**A. Facts**

Applicant owns the following registrations of the same mark:

<b>Word Mark</b>	<b>WRIGHT’S APOTHECARY</b>
<b>Goods and Services</b>	IC 003. US 001 004 006 050 051 052. G & S: Bath gel; Bath salts; Bath soaps; Body cream; Body lotion; Body oil; Body powder; Body scrub; Body sprays; Bubble bath; Lip balm; Lip gloss; Liquid soap; Shampoos. <b>FIRST USE: 20060401. FIRST USE IN COMMERCE: 20060401</b>

**Standard Characters Claimed**

**Mark Drawing Code** (4) STANDARD CHARACTER MARK  
**Serial Number** 86265874  
**Filing Date** April 29, 2014  
**Current Basis** 1A  
**Original Filing Basis** 1B  
**Published for Opposition** July 22, 2014  
**Registration Number** 4661142  
**International Registration Number** 1240346  
**Registration Date** December 23, 2014

**Word Mark**

**WRIGHT'S APOTHECARY**

**Goods and Services**

IC 003. US 001 004 006 050 051 052. G & S: Gel eye masks; Hand lotions; Hand soaps; Non-medicated foot cream; Pre-moistened cosmetic wipes. FIRST USE: 20160205. FIRST USE IN COMMERCE: 20160205

**Standard Characters Claimed**

**Mark Drawing Code** (4) STANDARD CHARACTER MARK  
**Serial Number** 87012644  
**Filing Date** April 25, 2016  
**Current Basis** 1A  
**Original Filing Basis** 1A  
**Published for Opposition** October 4, 2016  
**Registration Number** 5104216  
**Registration Date** December 20, 2016

**Word Mark**

**WRIGHT'S APOTHECARY**

**Goods and Services**

IC 025. US 022 039. G & S: Gloves; Socks. FIRST USE: 20160205. FIRST USE IN COMMERCE: 20160205

**Standard Characters Claimed**

**Mark Drawing Code** (4) STANDARD CHARACTER MARK  
**Serial Number** 87012774  
**Filing Date** April 25, 2016  
**Current Basis** 1A  
**Original Filing Basis** 1A  
**Published for Opposition** October 4, 2016  
**Registration Number** 5104222  
**Registration Date** December 20, 2016

**Word Mark**

**WRIGHT'S APOTHECARY**

**Goods and Services**

IC 010. US 026 039 044. G & S: Therapeutic hot and cold therapy packs. FIRST USE: 20160205. FIRST USE IN COMMERCE: 20160205

**Standard Characters Claimed**

**Mark Drawing Code** (4) STANDARD CHARACTER MARK  
**Serial Number** 87013157  
**Filing Date** April 25, 2016  
**Current Basis** 1A  
**Original Filing Basis** 1A  
**Published for Opposition** October 4, 2016  
**Registration Number** 5104234  
**Registration Date** December 20, 2016

**Word Mark**

**WRIGHT'S APOTHECARY**

**Goods and Services**

IC 005. US 006 018 044 046 051 052. G & S: Sinus pillows containing aromatic substances for relief from headaches, insomnia and sinus discomfort. FIRST USE: 20160205. FIRST USE IN COMMERCE: 20160205

**Standard Characters Claimed**

**Mark Drawing Code** (4) STANDARD CHARACTER MARK  
**Serial Number** 87014050  
**Filing Date** April 26, 2016  
**Current Basis** 1A  
**Original Filing Basis** 1A  
**Published for Opposition** October 4, 2016  
**Registration Number** 5104266  
**Registration Date** December 20, 2016

**Word Mark**

**WRIGHT'S APOTHECARY**

**Goods and Services**

IC 008. US 023 028 044. G & S: Nail files. FIRST USE: 20160205. FIRST USE IN COMMERCE: 20160205

**Standard Characters Claimed**

**Mark Drawing Code** (4) STANDARD CHARACTER MARK  
**Serial Number** 87014032  
**Filing Date** April 26, 2016  
**Current Basis** 1A  
**Original Filing Basis** 1A  
**Published for Opposition** April 11, 2017  
**Registration Number** 5230704  
**Registration Date** June 27, 2017

**Word Mark**

**WRIGHT'S APOTHECARY**

**Goods and Services**

IC 004. US 001 006 015. G & S: Candles. FIRST USE: 20160205. FIRST USE IN COMMERCE: 20160205

**Standard Characters Claimed**

**Mark Drawing Code** (4) STANDARD CHARACTER MARK

**Serial Number** 87012847  
**Filing Date** April 25, 2016  
**Current Basis** 1A  
**Original Filing Basis** 1A  
**Published for Opposition** October 4, 2016  
**Registration Number** 5104225  
**International Registration Number** 1472612  
**Registration Date** December 20, 2016

Applicant has been issued Notices of Allowance for the same mark:

**Word Mark** **WRIGHT'S APOTHECARY**  
**Goods and Services** IC 026. US 037 039 040 042 050. G & S: Hair accessories, namely, hair ties, hair scrunchies, hair clips, hair pins, hair coils  
**Standard Characters Claimed**  
**Mark Drawing Code** (4) STANDARD CHARACTER MARK  
**Serial Number** 88105595  
**Filing Date** September 5, 2018  
**Current Basis** 1B  
**Original Filing Basis** 1B  
**Published for Opposition** February 12, 2019

**Word Mark** **WRIGHT'S APOTHECARY**  
**Goods and Services** IC 025. US 022 039. G & S: Head scarves; Headbands  
**Standard Characters Claimed**  
**Mark Drawing Code** (4) STANDARD CHARACTER MARK  
**Serial Number** 88107481  
**Filing Date** September 6, 2018  
**Current Basis** 1B  
**Original Filing Basis** 1B  
**Published for Opposition** February 12, 2019

**Word Mark** **WRIGHT'S APOTHECARY**  
**Goods and Services** IC 003. US 001 004 006 050 051 052. G & S: Facial beauty masks. FIRST USE: 20170901. FIRST USE IN COMMERCE: 20170901  
**Standard Characters Claimed**  
**Mark Drawing Code** (4) STANDARD CHARACTER MARK  
**Serial Number** 88112120  
**Filing Date** September 11, 2018  
**Current Basis** 1A  
**Original Filing Basis** 1B

**Published for  
Opposition**

February 12, 2019

Applicant's present application is for the following:

<b>Word Mark</b>	<b>WRIGHT'S APOTHECARY</b>
<b>Goods and Services</b>	IC 010. US 026 039 044. G & S: Massage apparatus for massaging the face
<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
<b>Serial Number</b>	88288262
<b>Filing Date</b>	February 4, 2019
<b>Current Basis</b>	1B
<b>Original Filing Basis</b>	1B
<b>International Registration Number</b>	1454949

Facial massagers are often sold together with cosmetics/bath & body products (see attached **Exhibits**).

## **B. Argument**

Marks which are "primarily merely a surname" may not be registered on the Principal Register unless they have acquired distinctiveness. 15 U.S.C. §§ 1052(e) and (f); *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). "A term is primarily merely a surname if, when viewed in relation to the goods or services for which registration is sought, its primary significance to the purchasing public is that of a surname." *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1480 (TTAB 2017). This is a question of fact, on which the Office bears the burden of proof. It can be resolved only on a case-by-case basis. *Darty*, 225 USPQ at 653; *In re Eximus Coffee, LLC*, 120 USPQ2d 1276, 1278 (TTAB 2016). See *In Re C. Josef Lamy GmbH*, No. 79201309, 2019 WL 1918952, at \*4 (Apr. 9, 2019)

To satisfy the first element, the applicant must establish acquired distinctiveness as to the other goods or services by appropriate evidence, such as ownership of an active prior registration for the same mark for *sufficiently similar or related* goods or services (see TMEP § §1212.04-1212.04(e)), a *prima facie* showing of acquired distinctiveness based on five years' use of the same mark with *related* goods or services (see TMEP §§1212.05-1212.05(d))<sup>1</sup>, or actual evidence of

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<sup>1</sup> Nothing in the statute suggests that a trademark may not become distinctive for purposes of the Lanham Act in less than five years. To the contrary, to provide that five years creates a rebuttable presumption of distinctiveness implies that distinctiveness can be proved, instead of presumed, before that time. Indeed, due to the "mass exposure achievable with today's communications media," public demand for a particular product and concomitant secondary meaning can be "rapidly achieved." *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1130 (Fed. Cir. 1993). If a product with a particular trade dress becomes popular in a short period of time, the trade dress may become distinctive through secondary meaning in a matter of months. See *Id.* (finding that popular shoe design had acquired secondary meaning in five months)." In *L.A. Gear*, at 1130, the district court found that L.A. Gear's Hot Shots design had acquired secondary meaning during the period from its introduction in December 1987 to the time infringement began in May 1988 or within approximately five months.

acquired distinctiveness for the same mark with respect to the other goods or services (see TMEP §§1212.06-1212.06(e)(iv)). See *In Re Olin Corp.*, 124 U.S.P.Q.2d 1327 (T.T.A.B. 2017). *Steelbuilding.com*, 75 USPQ2d at 1424 (“In determining whether secondary meaning has been acquired, the Board may examine copying, advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage, and consumer studies (linking the name to a source).”); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 422 (Fed. Cir. 1985) (“An evidentiary showing of secondary meaning, adequate to show that a mark has acquired distinctiveness indicating the origin of the goods, includes evidence of the trademark owner’s method of using the mark, *supplemented by* evidence of the effectiveness of such use to cause the purchasing public to identify the mark with the source of the product.”); Trademark Rule 2.41(a)(3) (providing in part that an applicant may submit evidence showing “advertising expenditures in connection [with use in commerce] (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both”).

Finally, it is noteworthy that “in appropriate cases, ownership of one or more active prior registrations on the Principal Register or under the Trademark Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness if the goods or services are sufficiently similar to the goods or services in the application ...”. See *Schlafly v. Saint Louis Brewery, LLC*, 909 F.3d 420, 424 (Fed. Cir. 2018).

Here, Applicant owns seven related registrations for the same mark on the Principal Register (plus three Notices of Allowance) with dates of first use as far back as 2006 (see Reg. No. 4661142), i.e., more than thirteen years ago. Applicant’s sales of products throughout the United States using this mark have been continuous and exceed millions of dollars and hundreds of thousands of units. The mark WRIGHT’S APOTHECARY does not identify a living individual.