



TTAB Refuses Mucinex 'Mini Melts' TMs

By **Bill Donahue**

Law360, New York (May 2, 2016, 6:14 PM ET) -- The Trademark Trial and Appeal Board has weighed in on a decadelong battle between [Reckitt Benckiser](#) and an ice cream company over dueling “Mini Melts” brands, ruling that consumers would not confuse the two but nonetheless still refusing the giant drugmaker’s bid to register the name as a trademark.

Reckitt Benckiser and Mini Melts Inc. have been fighting at the TTAB and in federal court for more than nine years over the name. Mini Melts used it first, and the ice cream company filed cases in both venues when the drugmaker started using it as subbrand of its Mucinex cold medication.

Following court rulings that Reckitt Benckiser wasn’t infringing Mini Melts trademarks, the case shifted back to the TTAB and to the question of whether the drugmaker could secure its own trademark registrations for “Mini Melts” and “Mini-Melts.”

In a precedential ruling issued Wednesday, the board said it could not.

Consumers are not going to confuse the two brands, the panel wrote, but Reckitt Benckiser had also failed to show that the descriptive name had acquired the kind of distinctiveness required to be registered.

“The ultimate test in determining whether a designation has acquired distinctiveness is applicant’s success, rather than its efforts, in educating the public to associate the proposed mark with a single source,” Judge T. Jeffrey Quinn wrote for the three-judge panel.

“More evidence, especially in the form of direct evidence from the relevant purchasing public, than what applicant has submitted would be necessary to show that its proposed marks have become distinctive for its goods,” Quinn wrote.

When it came to consumer confusion, however, the board echoed the courts that had ruled in Reckitt Benckiser’s favor on Mini Melts’ infringement claims.

“To state the obvious, opposer’s ‘ice cream’ and these pharmaceutical preparations are very different,” Quinn wrote. “Although both products are ingestible and intended for consumption by children, the similarities end there.”

“Not surprisingly, the record is devoid of any evidence that a single entity produces both ice cream and a pharmaceutical, let alone under the same mark,” Quinn added.

Attorneys for both sides did not immediately return requests for comment on Monday.

Mini Melts launched the fight in 2006 with an opposition to applications filed by Reckitt Benckiser for the two iterations of the name. It sued in federal court the following year, and the TTAB case was suspended for years in favor of the civil action.

In 2009, following a jury trial, a federal judge entered judgment in favor of the drugmaker. The Fifth Circuit affirmed the ruling 2011, and the [U.S. Supreme Court](#) refused to hear the case later that year, sending the case back to TTAB.

Oral hearings were held in September, setting the stage for Wednesday’s ruling.

Reckitt Benckiser is represented by Debra Deardourff Faulk of [GrayRobinson PA](#).

Mini Melts is represented by Robert G. Oake, Jr. of [Oake Law Office](#).

The case is Mini Melts, Inc. v. Reckitt Benckiser LLC, opposition number 91173963, in the [U.S. Patent and Trademark Office's](#) Trademark Trial and Appeal Board.

--Editing by Rebecca Flanagan.