

Mark: COLGATE ESSENTIALS
Ser. No.: 87812049

REMARKS

Disclaimer of ESSENTIALS

The Office Action issued on April 7, 2018 required a disclaimer of the term “ESSENTIALS” on the ground that the term is merely descriptive. For the reasons set forth below, Applicant respectfully disagrees that “ESSENTIALS” is merely descriptive as applied to Applicant’s goods and requests that the disclaimer requirement be withdrawn.

It is well settled that a mark is suggestive, and not merely descriptive, if imagination, thought, or perception is required to reach a conclusion as to the nature of the goods or services. In re TMS Corp. of the Americas, 200 U.S.P.Q. 57, 58 (TTAB 1978); Stix Products, Inc. v. United Merchants and Manufacturers, Inc., 160 U.S.P.Q. 777, 785 (S.D.N.Y. 1968). As TMEP § 1209.01(a) states regarding the registrability of suggestive marks on the Principal Register, “a designation does not have to be devoid of all meaning in relation to the goods and services to be registrable.” Even a mark that is highly suggestive is registrable. Minnesota Mining and Manufacturing Co. v. Johnson and Johnson, 454 F.2d 1179 (C.C.P.A. 1972).

Moreover, a term is only *merely* descriptive and unregistrable “if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, function, or feature of the product in connection with which it is used.” In re Bright Crest, Ltd. 204 U.S.P.Q. 591, 593 (TTAB 1979). In this regard “merely” means “only”, *i.e.*, to be “merely” descriptive, the mark must do no more than describe. In re Quik-Print Copy Shop Inc., 205 U.S.P.Q. 505 (CCPA 1980). Given this, where a mental leap (*i.e.*, imagination, thought or perception) is required to connect the mark to the product, the mark is not “merely” descriptive, but is suggestive, inherently distinctive and

registrable. Brookfield Communications v. West Coast Entertainment Corp., 50 U.S.P.Q. 2d 1545, 1561 (9th Cir. 1999) (MOVIEBUFF not descriptive because it does not describe either the purpose or product of movie information database software).

The Federal Circuit recently reaffirmed that the suggestiveness bar is a low one when it reversed a descriptiveness refusal for DOTBLOG for “providing specific information as requested by customers via the Internet.” In re Driven Innovations, Inc., No. 16-1094 (Fed. Cir. Jan. 4, 2017) (not precedential). In reversing the TTAB, the Federal Circuit noted that the descriptive meaning of the mark must be “immediate” and “instantaneous” in order for a mark to be considered merely descriptive and unregistrable. Id. at Pp.7-8. “Mere relation,” the Court stated, “does not mean that a mark is descriptive.” Id.


The term ESSENTIALS, when used in connection with toothpaste, requires a mental leap to discern its meaning and impression. The term is therefore suggestive rather than *merely* descriptive. Indeed, the word “ESSENTIALS” has multiple possible interpretations, all of which are vague and do not clearly identify something specific about Applicant’s toothpaste. ESSENTIAL could mean “of, relating to, or constituting essence,” “of the utmost importance,” or “being a substance that is not synthesized by the body in a quantity sufficient for normal health and growth and that must be obtained from the diet.” See Exhibit A (<https://www.merriam-webster.com/dictionary/essentials>). It could also be a noun, meaning something basic or indispensable. Id. None of these definitions are immediately applicable to toothpaste. At a minimum, a consumer would need to pause and consider the definitions of the terms before concluding what the intended meaning of the word is in relation to the goods. Conveying indefinite and indirect meanings and requiring consumers to pause and contemplate meaning is the hallmark of a suggestive and inherently registrable term.

Past Trademark Office practice suggests that the term “ESSENTIALS” is not merely descriptive. For instance, there are many marks that contain the word ESSENTIAL or ESSENTIALS for oral care products that are registered on the Principal Register, or have been published, without a showing of secondary meaning under 2(f) or a disclaimer of “ESSENTIALS.” Several of the registrations and applications include disclaimers of other elements, but not “ESSENTIALS.” In some cases, ESSENTIALS is the only element *not* deemed descriptive. The application for IRONKIDS ESSENTIALS goes so far as to disclaim ESSENTIALS for Class 5 (vitamins) but not the goods in Class 3, which include toothpaste. Some examples of comparable marks are below:

TM/AN/RN/Disclaimer	Status/Key Dates	Full Goods/Services	Owner Information
<u>ESSENTIALS PLUS</u> SN: 87416782	Allowed - Intent to Use Notice of Allowance Issued September 19, 2017 Filed: April 19, 2017	(Int'l Class: 03) toothpaste	Cabot Hill Naturals, Inc. (NEW HAMPSHIRE CORP.) 62 Bridge Street Lancaster, New Hampshire 03584 United States of America
<u>CLINIC ESSENTIALS</u> SN: 86421608 Disclaimer: "CLINIC"	Allowed - Intent to Use 3rd Extension of Time Granted December 7, 2017 Filed: October 13, 2014	(Int'l Class: 03) non-medicated mouthwash (Int'l Class: 05) medicated mouthwash; medicated fluoride mouthwash (Int'l Class: 21) toothbrushes and dental floss	Johnson & Johnson (NEW JERSEY CORP.) One Johnson & Johnson Plaza New Brunswick, New Jersey 08933 United States of America
<u>IRONKIDS ESSENTIALS</u> SN: 87498909 Disclaimer: "ESSENTIALS" IN	Allowed - Intent to Use Notice of Allowance Issued January 9, 2018 Filed: June 21, 2017	(Int'l Class: 03) hair shampoo; hair conditioner; body washes; bubble bath; tooth paste (Int'l Class: 05) vitamins; gummy vitamins; adhesive	World Triathlon Corporation (FLORIDA CORP.) 3407 W. Dr. Martin Luther King Jr. Blvd

TM/AN/RN/Disclaimer	Status/Key Dates	Full Goods/Services	Owner Information
INTERNATIONAL CLASS 5		bandages for skin wounds (Int'l Class: 21) tooth brushes	Suite 100 Tampa, Florida 33607 United States of America
HILL COUNTRY ESSENTIALS RN: 4242188 SN: 77490690	Registered November 13, 2012 Int'l Class: 03 First Use: July 19, 2008 Filed: June 4, 2008 Registered: November 13, 2012	(Int'l Class: 03) hair shampoo, hair conditioner, facial cleansers, skin moisturizers, hand lotion, body lotion, breath fresheners, mouthwash, pre-shave cream, shower gel, body washes, eye cream, eye lotion, beauty serums	Heb Grocery Company, LP, Hebco GP, L.L.C., a Texas Limited Liability Company, Its Sole General Partner. (Tx LTD Partnership) (TEXAS LTD. PARTNERSHIP) Corporate Law Department 646 S. Main San Antonio, Texas 78204 United States of America
AGE ESSENTIAL RN: 4305637 SN: 85135657	Registered March 19, 2013 Int'l Class: 05 First Use: August 1, 2010 Filed: September 22, 2010 Registered: March 19, 2013	(Int'l Class: 05) medicated mouth and oral care products, namely, medicated toothpaste, dissolvable strips to stop bleeding in the mouth from minor cuts, oral spray for boosting energy, oral spray for the cessation of smoking, medicinal preparations for the mouth and as sprays; meal replacement powders for making drinks, medicated chewing gum; mouth and oral lozenges, namely, cough lozenges, medicated lozenges, throat lozenges, zinc supplement lozenges; medicated mouth washes; medicated mouth and oral sanitizer, namely, mouth cavity cleansers; medicated candy; medicated mouth care products, namely, mouth and	Oasis Consumer Healthcare LLC (OHIO LIMITED LIABILITY COMPANY) 812 Huron Road Cleveland, Ohio 44115 United States of America

TM/AN/RN/Disclaimer	Status/Key Dates	Full Goods/Services	Owner Information
		oral antiseptics; medicated mouth care products, namely, orally ingested gel for boosting energy, and, medicated brush-on oral care gels; medicated preparations and moisturizing mouth washes for relief of dry mouth and associated symptoms and conditions	
OFFICE ESSENTIALS RN: 4365094 SN: 85156641	Registered July 9, 2013 Int'l Class: 03,05,21 First Use: January 31, 2012 Int'l Class: 44 First Use: October 31, 2012 Filed: October 20, 2010 Registered: July 9, 2013	(Int'l Class: 03) non-medicated mouthwash (Int'l Class: 05) medicated mouthwash; fluoride mouthwash (Int'l Class: 21) toothbrushes and dental floss (Int'l Class: 44) providing information in the field of oral care	Johnson & Johnson (NEW JERSEY CORP.) One Johnson & Johnson Plaza New Brunswick, New Jersey 089337001 United States of America
ZEN ESSENTIALS RN: 4529152 SN: 86073882	Registered May 13, 2014 Int'l Class: 03 First Use: May 12, 2012 Filed: September 25, 2013 Registered: May 13, 2014	(Int'l Class: 03) cosmetic preparations for skin care; skin cleansers; skin conditioners; skin creams; skin lotions; skin soaps; skin toners; hair care preparations; hair care lotions; hair conditioners; hair creams; hair lotions; beauty soap; cosmetic soaps; perfumery; essential oils; cosmetics and cosmetic preparations; cosmetics and make-up; body lotions; hand lotions; lip balms; facial scrubs; body scrub; dentifrices	Martin, Launa (UNITED STATES CITIZEN) 884 Emeralds Bay Rd South Lake Tahoe, California 96150 United States of America
LISTERINE ESSENTIAL CARE	Registered 8 & 15 June 5, 2014 Int'l Class: 03 First Use: October 20, 2000	(Int'l Class: 03) toothpaste	Johnson & Johnson (NEW JERSEY CORP.) One Johnson & Johnson Plaza New Brunswick,

TM/AN/RN/Disclaimer	Status/Key Dates	Full Goods/Services	Owner Information
RN: 3606056 SN: 77591101	Filed: October 13, 2008 Registered: April 14, 2009		New Jersey 089337001 United States of America
<p data-bbox="201 510 422 604"> LAVISH ESSENTIALS and Design </p>  <p data-bbox="201 863 357 926"> RN: 5392901 SN: 87330336 </p>	Registered January 30, 2018 Int'l Class: 03 First Use: March 3, 2017 Filed: February 9, 2017 Registered: January 30, 2018	(Int'l Class: 03) tooth whitening pastes	Lavish Essentials (CANADA CORP.) 2600 Don Mills Road Unit#212 North York, M2j 3B4 Canada
<p data-bbox="201 1039 407 1150"> ULTIMATE ESSENTIAL MOUTHCARE </p> <p data-bbox="201 1157 431 1310"> RN: 2159720 SN: 75220708 Disclaimer: "MOUTHCARE" </p>	Renewed May 19, 2008 Int'l Class: 03,05 First Use: May 14, 1997 Filed: January 2, 1997 Registered: May 19, 1998 Last Renewal: May 19, 2008	(Int'l Class: 03) dentifrice and non-medicated mouthwash (Int'l Class: 05) medicated mouthwash	Lotus Brands, Inc. (WISCONSIN CORP.) Po Box 325 Twin Lakes, Wisconsin 53181 United States of America
<p data-bbox="201 1497 391 1570"> SHAKLEE ESSENTIALS </p> <p data-bbox="201 1577 391 1650"> RN: 1527668 SN: 73735038 </p>	Renewed March 7, 2009 Int'l Class: 03 First Use: April 8, 1988 Filed: June 16, 1988 Registered: March 7, 1989 Last Renewal: March 7, 2009	(Int'l Class: 03) solid and liquid skin cleansers, [preparation for grooming hair, hair shampoo, hair conditioner,] skin moisturizer, dentifrice [, personal deodorant]	Shaklee Corporation (DELAWARE CORP.) 4747 Willow Road Pleasanton, California 94588 United States of America

TM/AN/RN/Disclaimer	Status/Key Dates	Full Goods/Services	Owner Information
<p><u>ORGANIC ESSENTIALS</u> RN: 2439570 SN: 75980118 Disclaimer: "ORGANIC"</p>	<p>Renewed March 27, 2011 Int'l Class: 03 First Use: August 14, 1997 Filed: June 24, 1997 Registered: March 27, 2001 Last Renewal: March 27, 2011</p>	<p>(Int'l Class: 03) skin and facial creams, skin and facial cleansers, hand creams, hand cleansers, skin and facial night creams, skin and facial wrinkle creams, skin and facial moisturizers, skin and hair conditioners, shaving creams, hair shampoos, liquid and bar hand and body soaps, [sun blocks,] body deodorants, toothpastes, mouthwashes, mouth sprays, [perfumes, colognes, facial and body powders,] and personal care products, namely, facial scrub, skin cleansing pads, [hair styling gels, hair sprays, hair mousse,] cleansing body washes, eye creams, sunscreens, [skin self tanners,] skin toners, facial masques, hand and body lotions, and foot lotions, for topical use and not for ingestion</p>	<p>Freelife International Holdings, LLC (CONNECTICUT LIMITED LIABILITY COMPANY) 4950 S. 48th Street Phoenix, Arizona 85040 United States of America</p>
<p><u>ESSENTIALLY LAVENDER</u> RN: 2876950 SN: 76555408 Disclaimer: "LAVENDER"</p>	<p>Renewed August 24, 2014 Int'l Class: 03 First Use: October 1, 2002 Filed: October 30, 2003 Registered: August 24, 2004 Last Renewal: August 24, 2014</p>	<p>(Int'l Class: 03) body lotion, massage oil, hair shampoo, hair conditioner, facial wash, body polish, mouthwash, lip balm, facial and skin toner, facial moisturizing cream, hand lotion, aloe gel, anti-aging cream, bath oil, body moisturizers, body oil, body mists, and personal deodorants</p>	<p>Monroe, Cary (UNITED STATES CITIZEN) 13471 Grain Lane San Diego, California 92129 United States of America</p>

Applicant also owns two registrations for ESSENTIALS-formative marks (covering dishwashing detergent) in which ESSENTIALS is not disclaimed:

TM/AN/RN/Disclaimer	Status/Key Dates	Full Goods/Services	Owner Information
PALMOLIVE SCENT ESSENTIALS RN: 5032151 SN: 85817681 Disclaimer: "SCENT"	Registered August 30, 2016 Int'l Class: 03 First Use: February, 2013 Filed: January 8, 2013 Registered: August 30, 2016	(Int'l Class: 03) dishwashing liquid	Colgate-Palmolive Company (DELAWARE CORP.) 300 Park Avenue New York, New York 10022 United States of America
PALMOLIVE ESSENTIAL CLEAN RN: 5330586 SN: 87003080 Disclaimer: "CLEAN"	Registered November 7, 2017 Int'l Class: 03 First Use: March, 2017 Filed: April 15, 2016 Registered: November 7, 2017	(Int'l Class: 03) dishwashing detergent	Colgate-Palmolive Company (DELAWARE CORP.) 300 Park Avenue New York, New York 10022 United States of America

Printouts of the TESS database records for these marks are attached as Exhibit B.

This evidence of past Trademark Office practice favors finding that “ESSENTIALS” is suggestive and not merely descriptive for oral care products.

Finally, not only does the evidence above support the conclusion that a disclaimer of ESSENTIALS is not appropriate, but the Office Action includes no evidence to support the disclaimer requirement. Therefore, the USPTO has not met its burden to establish that the term is merely descriptive. See In re Bayer Aktiengesellschaft, 488 F.3d 960, 963064, U.S.P.Q.2d 1828, 1831 (Fed. Cir. 2007) (the Examining Attorney must support his conclusion with appropriate evidence and has the burden of establishing that a term is merely descriptive).

Finally, it is well settled that any doubt as to mere descriptiveness should be resolved in Applicant's favor. As the Board stated in In re Bed-Check Corp., 226 U.S.P.Q. 946 (TTAB 1985)

(holding that SENSORMAT was not merely descriptive of, *inter alia*, an electrical sensing pad placed under a patient):

We recognize that there is often a thin line separating merely descriptive from suggestive terms and that judgments in these cases are frequently subjective. However, where there is doubt in the matter, the doubt should be resolved in Applicant's favor.

The fact that so many ESSENTIALS-formative marks are on the Register without disclaimers or 2(f) claims casts doubt on the conclusion that the term is merely descriptive. For the foregoing reasons, Applicant respectfully submits that the term “ESSENTIALS” is not merely descriptive and requests that the disclaimer requirement be withdrawn.