

**RESPONSE TO OFFICE ACTION – SERIAL NO. 85/116,502 - TRAVELER**

**SECTION 2(e)(1) REFUSAL - MERELY DESCRIPTIVE**

The Examining Attorney has refused registration of the mark TRAVELER on the Principal Register because it is believed that the proposed mark “merely describes a feature of the applicant’s goods” under Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1). Applicant respectfully traverses this refusal and asserts that its mark is suggestive.

It is well established that a mark is suggestive if a multi-stage reasoning process or the utilization of imagination, thought or perception is required in order to determine the attributes of the goods used in connection with the mark. In re Abcor Development Corp., 200 USPQ 215 (CCPA 1978); No Nonsense Fashions, Inc. v. Consolidated Foods Corp., 226 USPQ 502 (TTAB 1995). Specifically, as the law establishes, a mark is suggestive “if the mental leap between the word and the products is not almost instantaneous.” Stix Products, Inc. v. United Merchants and Mfg., Inc., 160 USPQ 777, 785 (S.D.N.Y. 1968); *See also* In re Stroh Brewery Co., 34 USPQ 2d 1796 (TTAB 1994) (VIRGIN held not descriptive of a non-alcoholic malt beverage); In re McDonald’s Corp., 199 USPQ 490 (TTAB 1978) (TWO ALL BEEF PATTIES held not merely descriptive of a hamburger sandwich). As courts have repeatedly stated, a suggestive term differs from a descriptive term because it does not immediately tell something about the goods or services. *See* In re Shutts, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool). In the present case, Applicant’s prospective consumers, upon viewing Applicant’s TRAVELER mark, will not instantaneously understand the purpose or features of Applicant’s goods. Rather, they will be required to use some imagination to recognize the meaning of Applicant’s mark as applied to its blood glucose meters.

First and foremost, Applicant's goods are not known as "travelers." In fact, Applicant is not aware of any specific meaning related to "traveler" in the medical or diabetic field. It has been argued that the term "traveler" means "that applicant's goods are portable, or capable of being transported." This does not describe a function, feature or purpose of Applicant's goods. Applicant's goods are blood glucose meters that are utilized by customers to ascertain constituent parts of blood. Applicant's blood glucose meters do not undertake anything relating to traveling.

Applicant's consumers will be required to use some imagination and mental leaps to understand the meaning of TRAVELER as it applies to Applicant's goods. Again, Applicant's goods are blood glucose meters that are utilized by customers to ascertain constituent parts of blood. Applicant's goods are not used to travel. The purpose and function of Applicant's goods are different from the definition of "traveler." Applicant's goods are also not identifying a group of users to whom Applicant directs its goods, and for this reason the example given in the Office Action is, respectfully, misplaced. Consequently, there is not an immediate connection between Applicant's goods and the meaning of "TRAVELER." Consumers would be forced to use some imagination or "mental leaps" to understand the relationship between Applicant's goods, the functions of those goods and the term TRAVELER. Thus, Applicant's TRAVELER mark is suggestive.

Furthermore, assuming, arguendo, that "TRAVELER" is applicable to Applicant's goods to some degree, the meaning of "traveler" is too vague to give consumers a clear and immediate idea of the function, quality or features of Applicant's goods. In re Hutchinson Technology, 582 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988); *See also*, Concurrent Technologies, Inc. v. Concurrent Technologies Corp., 12 USPQ2d 1054 (TTAB 1989). In Hutchinson, the court

found that the term “TECHNOLOGY” was “a very broad term which includes many categories of goods,” even as used with computer goods and other equipment, and, thus, was not merely descriptive of the applicant’s goods. In re Hutchinson Technology, supra, 554. Specifically, the court found that “the fact that the term ‘technology’ is used in connection with computer products does not mean that the term is descriptive of them. Many other goods possibly may be included within the broad term ‘technology,’ but that does not make the term descriptive of all those goods.” *Id.*

Similarly, the definition of “traveler,” and what it could refer to, is too vague and general and could include any number of products. In fact, the definition states “commercial traveler” and “fellow traveler,” which refer to people. The alternative definition is “one that travels,” further confirming that the word “traveler” refers to people, not things such as Applicant’s blood glucose meters. Applicant’s goods are not people; therefore, it would require much thought and imagination for Applicant’s customers to understand the meaning of TRAVELER in connection with Applicant’s goods, which are not people. Specifically, customers would see Applicant’s mark as referring to people, not goods. Even if they knew about the meaning of “traveler,” as defined by the USPTO, the definition is so general and vague that it could relate to anything. They would still need to use much thought and imagination to figure out how “traveler” relates, if at all, to the fact that Applicant’s goods are meters used for ascertaining constituent parts of blood. Therefore, Applicant’s mark cannot be merely descriptive since TRAVELER requires its consumers to use imagination, thought and perception to begin to understand, if at all, the purpose and function of Applicant’s goods. Stix Prods. Inc. v. United Merchants and Mfrs. Inc., 295 F. Supp. 479, 160 USPQ 777 (SDNY 1968); *See Also*, Abercrombie and Fitch Co. v. Hunting World Inc., 537 F.2d 4, 189 USPQ 759, 189 USPQ 719 (2d Cir. 1976). It is clear that

Applicant's TRAVELER mark does not immediately or clearly convey the function or feature of Applicant's goods. Accordingly, Applicant's mark is not merely descriptive but suggestive of its goods.

Respectfully, the Examining Attorney's own explanation and argument for why Applicant's mark is merely descriptive utilizes a multi-step process. Specifically, the Examining Attorney has provided two definitions for the word "traveler." It has been argued that "traveler" means "portable" and "capable of being transported," and at the same time "one who travels." The latter definition refers to people, not goods. (See Office Action p. 3) Assuming that those meanings are accurate and readily recognizable by Applicant's consumers, the very fact that this word has two meanings makes this mark suggestive. The Board has clearly recognized that when a mark has a dual meaning, the mark is suggestive and not merely descriptive. In re Computer Business Systems Group, 229 USPQ 859 (TTAB 1985) (citations omitted). Specifically, the Board has stated that "when a term or phrase, as applied to the goods or services in question, possesses double meaning; suggests something more than a characteristic of the goods; and functions as more than a mere description of the goods; it is not merely descriptive of the goods and may be registered under the Trademark Act *Id.* (emphasis added).; *See also In re Ocusoft, Inc.*, 2005 TTAB LEXIS 238 (Case not citable as precedent but attached for reference.) If these are accurate meanings that are commonly recognized by the consuming public, then Applicant's mark has two meanings, which makes the word "TRAVELER" suggestive not merely descriptive.

Evidence was attached to the Office Action to try to show that TRAVELER is a term used with goods. However, Applicant notes that these exhibits show use of the word "TRAVELER" in relation to electronic products, purses, and luggage. Applicant's goods do not

relate to such products. Therefore, these articles do not relate to Applicant's goods. Therefore, Applicant respectfully submits that this evidence is irrelevant and does not support a finding that TRAVELER is merely descriptive of Applicant's specific goods.

Below, Applicant presents several examples where the USPTO has accepted the mark TRAVELER, or close variants thereof, for goods that are portable, or capable of being transported. Each of these marks has been approved, and Applicant submits its use of TRAVELER is no different.

<b>MARK</b>	<b>REG. #</b>	<b>GOODS</b>
TRAVELER	3390440	Portable Water Filters
TRAVELER	2979232	Hand Held Electronic Devices, Namely, Computer Hardware And Software Used As An Aid To The Playing Of Bingo. Games, Namely, Bingo Game Playing Equipment.
TRAVELLER	3048857	Electronic Sensoring And Reporting Devices, Namely, Radar And Laser Speed Detectors.
TRAVELER	3016232	Canopies And Tents With Canvas Coverings
TRAVELER	3048857	Electronic Sensoring And Reporting Devices, Namely, Radar And Laser Speed Detectors
TRAVELLER	2880447	Electronic Device For Guiding Blind Persons In Unassisted Walking.
TRAVELER	3763224	Portable Communications System Comprised Of Radio Receivers And Transmitters For The Purpose Of Local Area Data And Voice Communications, Amplifiers, Antennas, Telecommunication Switches, Telecommunication Network Routers, Communication And Application Servers, And Communication And Interface Software Used To Receive, Process, Aggregate, Distribute, And Transmit Voice, Video, And Data Communications, Used For Disaster Recovery, Emergency Management, And Continuity Of Operations.
TRAVELER	3746471	Medicated Sun Care Preparations.
TRAVELER	3677782	Portable And Handheld Digital Electronic Devices For Organizing, Transmitting, Manipulating, And Reviewing Text, Data, And Audio Files, Relating To Bibles And/Or Religious Texts.
TRAVELER	3618078	Mobile Refuelling Tanks For The Transportation Of Petroleum Fuels
TRAVELER	3476019	Fitted Motorcycle Covers.
TRAVELER	2635930	Shirts, T-Shirts, Tops. Stuffed Toy Animals, Plush Toys.
TRAVELER	2310739	Power Inverters
TRAVELER	1492280	Non-Insulated, Disposable, Plastic Lids For Closing Paper And Plastic Cups For Commercial Use.
TRAVELER	1387440	Toilets, And Component Parts, For Use In Recreational Vehicles And Boats.
TRAVELER	1369911	Computer Systems, Namely Keyboards, Display Screens, Storage Disks [ And Tapes, ] Disk And Tape Drives And Printers, And On Computer Programs, For Use In The Field Of Health Care.

Accordingly, for at least the reasons stated above, Applicant respectfully asserts that its mark is not merely descriptive of its goods, as defined under Section 2(e)(1) of the Trademark Act. 15 U.S.C. Section 1052(e)(1). Under the established standards, Applicant's mark is suggestive.

Applicant respectfully reminds the Examining Attorney that in matters of Section 2(e) refusals, doubt must be resolved in favor of the applicant. In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972), *Accord*, In re Morton-Norwich Products, Inc., 209 USPQ 791 (TTAB 1981); In re Conductive Systems, Inc., 220 USPQ 84 (TTAB 1983); In re Aid Laboratories, Inc., 221 USPQ 1215 (TTAB 1983); In re Bel Paese Sales Co., 1 USPQ2d 1233 (TTAB 1986). Applicant respectfully asks that the Examining Attorney reconsider this refusal in light of the established standard.

The Applicant believes that it has responded to all the outstanding issues raised in the Office Action, and the application is now in position for approval. It is, therefore, respectfully requested that the refusal to register be reconsidered and withdrawn. If the Examining Attorney has any questions regarding the above application, she is encouraged to contact the undersigned attorney.