

The examining attorney has refused registration of Applicant's Mark SOOTHE based upon a finding that the mark is merely descriptive of the Applicant's essential oils for medicinal use. Insofar as Applicant's proposed mark is not merely descriptive of the goods identified in its application, Applicant respectfully submits that there is no basis to maintain the instant refusal and that registration of Applicant's Mark is appropriate.

Matter that "merely describes" the goods or services on or in connection with which it is used is not registrable on the Principal Register. TMEP §1209. As noted in *In re Abcor Development Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (C.C.P.A. 1978):

The major reasons for not protecting such marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.

In the present case, there is no evidence in the record that SOOTHE is ever used to describe essential oils for medicinal use. Thus, registration of this mark by Applicant cannot possibly inhibit competition. Moreover, there is no evidence that this is a term that anyone needs to be able to describe essential oils for medicinal use.

To be characterized as "descriptive," a mark must immediately convey knowledge of the ingredients, qualities or characteristics of the goods or services. *In re Quik-Print Copy Shops Inc.*, 616 F.2d 523, 205 U.S.P.Q. 505, 507 (C.C.P.A. 1980)

(emphasis added). In the context of the Lanham Act, "merely" descriptive means "only" descriptive. *Id.* at n. 7. Moreover, the mark must give some reasonably accurate or tolerably distinct knowledge of the essence of the goods or services. If the information conveyed by the mark is indirect or vague, the mark is being used in a suggestive rather than a descriptive manner. See J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 11:19 (Ed. 2000); *The Money Store v. Harris Corp. Finance, Inc.* 216 USPQ 11, 18 (Fed. Cir. 1982) ("'THE MONEY STORE' conveys the idea of a commercial establishment whose service involves supplying money. The term does not, however, necessarily convey 'the essence of the business, money lending.... Some imagination and perception are therefore required to identify the precise nature of the services'"); *In re Ralston Purina Company*, 191 U.S.P.Q. 237, 238 (T.T.A.B. 1976) (The term SUPER is not used to describe any real or specific item or characteristic or quality, but merely to connote a vague desirable characteristic or quality and therefore it need not be disclaimed from RALSTON SUPER SLUSH).

SOOTHE, being such a vague terms with many possible connotations, does not immediately describe with specificity that which the essential oils might soothe. This is the hallmark of a suggestive mark.

In *Ex Parte Club Aluminum Products Co.* 105 USPQ 44 (Commissioner 1955), the mark COOK-N-LOOK was held registrable for transparent glass covers for cooking utensils. The mark was somewhat suggestive of a property the goods might have, but like Applicant's Mark, did not describe the goods per se:

The mark is a compound word mark that describes what one who uses the covers can do, i.e. look into the utensil to see the cooking process, but this does not

make the mark descriptive of the covers. The necessity for analysis removes it from the category of mere descriptiveness.

Id.

In determining whether a particular mark is merely descriptive of a product, a reviewing court must consider the mark in its entirety, with a view toward "what the purchasing public would think when confronted with the mark as a whole." *In re Hutchinson Technology Inc.* 852 F.2d 552, 552-54 (Fed. Cir. 1988). To the extent that there may be doubt as to whether applicant's mark is merely descriptive or suggestive of its goods, it is commonly accepted practice to resolve any doubt in the applicant's favor and publish the mark for opposition. *In re Morton-Norwich Products, Inc.* 209 USPQ 791 (TTAB 1981); *In re Gourmet Bakers Inc.*, 173 USPQ 565 (TTAB 1972).

Applicant respectfully submits that the instant mark is suggestive of the Applicant's goods and not merely descriptive as contended by the examining attorney. If a consumer has to exercise "mature thought or follow a multi-stage reasoning process" to determine the characteristics of a product or service, then the mark is suggestive, not descriptive. *Douglas Laboratories Corp. v. Copper Tan, Inc.* 210 F.2d 453, 100 U.S.P.Q. 237 (2d Cir. 1954), *cert. denied* 347 U.S. 968, 101 U.S.P.Q. 505 (1954) (finding COPPERTONE for sun tan oil suggestive, not descriptive); *In re Realistic Co.* 440 F.2d 1393, 169 U.S.P.Q. 610 (C.C.P.A. 1971) (finding CURV for permanent wave solution suggestive, not descriptive); and, *Colgate-Palmolive Co. v. House for Men, Inc.* 143 U.S.P.Q. 159 (TTAB 1964) (finding RAPID-SHAVE for shaving cream suggestive, not descriptive).

In *Equine Technologies Inc. v. Equitechnology Inc.* 68 F.3d 542 (1st Cir. 1995), the court was required to determine whether the mark EQUINE TECHNOLOGIES was descriptive or suggestive when used in connection with high-tech hoof pads for horses. The court cited authorities indicating that the hallmark of the descriptive term is a specific identification of the marked good. *Id.* at 544. In holding the mark EQUINE TECHNOLOGIES suggestive rather than descriptive, the court noted that while there is no dispute that the term "equine" is descriptive of horses, the question is whether the mark, in its entirety, is merely descriptive of the plaintiff's product -hoof pads for horses. *Id.* at 545. In this case, the court found that the mark itself does not convey information about the plaintiff's products or its intended consumers. Rather, it requires imagination to connect the term "Equine Technologies" to hoof care products in general, and to the plaintiff's product in particular.

In *Independent Nail & Packing Co. v. Stronghold Screw Products, Inc.* 205 F.2d 921, 925 (Cir. 1953), *cert. denied* 346 U.S. 491 (1953), the court held that STRONGHOLD as applied to ribbed nails was not descriptive, and stated that:

Although the word 'stronghold' is suggestive of one of the attributes of plaintiff's nail with the annular thread, it is not descriptive of a nail, let alone that type of nail. A person unaware of the particular product of the manufacturer, upon seeing or hearing the name 'stronghold' would find it virtually impossible to identify the product to which it might have been applied.

Id.

A brief review of other suggestive marks helps clarify this dichotomy:

SUGAR & SPICE for use on bakery products held suggestive not descriptive. *In re Colonial Stores, Inc.* 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968).

100 YEAR NITE-LITE for light with life expectancy of 500 years held suggestive not descriptive. *Donslry v. Bandwagon, Inc.* 193 USPQ 336 (D. Mass. 1976).

TENNIS IN THE ROUND held not descriptive of tennis facilities. *In re Tennis in the Round, Inc.* 199 USPQ 496 (TTAB 1978).

RAILROAD SALVAGE for sale of goods from bankruptcy liquidations and discontinued goods held suggestive. *Railroad Salvage of Conn., Inc. v. Railroad Salvage, Inc.* 561 F.Supp. 1014 (D.R.I. 1983).

CITIBANK for urban banking services held suggestive in *Citibank, N A. v. Citibanc Group, Inc.* 724 F.2d 1540 (11th Cir. 1984).

CHARRED KEG for bourbon whiskey held suggestive, even though bourbon is an American-type whiskey that is made in part by aging carried out in new charred oaken containers. *In re Majestic Distilling Co., Inc.* 164 USPQ 386 (CCPA 1970).

LONGTONG for barbecue tongs held suggestive in *Ex parte Nixdoll J Krein Mfg Co.*, 115 USPQ 362 (Comm. Pat. 1957).

DRI-FOOT was held only suggestive of foot deodorant in *In re Pennwalt Corp.* 173 USPQ 317 (TTAB 1972).

CHEW 'N CLEAN was held not to be descriptive for a dentrifice in *In re Colgate-Palmolive Company* 160 USPQ 733 (CCPA 1969).

In the present case, the "mental link" between the mark "PrivateRFP" and Applicant's surety services is neither immediate nor instantaneous.

The Trademark Trial and Appeal Board has adopted a three-part test to help determine whether a mark is descriptive or suggestive: (1) the degree of imagination necessary to understand the product; (2) a competitor's need to use the same terms; and (3) competitors' current use of the same or similar terms. *See No Nonsense Fashions, Inc. v. Consolidated Food Corp.*, 226 U.S.P.Q. 502 (TTAB 1985).

Under the degree of imagination test, the more imagination that is required by a consumer to get some direct description of the product or service from the mark, the more likely the term is suggestive and not merely descriptive. *See Railroad Salvage of Connecticut, Inc. v. Railroad Salvage, Inc.*, 561 Fed. 1014 (D.C.R.I. 1983). Since there is no instantaneous connection as to the nature of the goods provided by the Applicant, it is far more likely that the mark is suggestive than descriptive. *See Stix Products, Inc. v. United Merchants and Manufacturers, Inc.*, 295 Fed. Supp. 479 (S.D.N.Y. 1968).

The second test in the descriptiveness analysis is the competitor's need to use the same or similar terms. This test inquires as to the probability that a competitor may need the mark to fairly describe the competitor's goods or services. If a competitor is likely to need the mark to describe its goods or services, it is thus more likely that the mark is descriptive. *See Educational Development Corp. v. Economy Company*, 562 Fed.2d 26 (10th Cir. 1977). Correspondingly, if a

competitor is not likely to need the mark's terms to describe its product, it is less likely that the mark is actually descriptive. *Id.*

Applying the second test to the mark at issue, there is no evidence that SOOTHE is the only word that describes Applicant's essential oils. Accordingly, it is highly unlikely that any competitor would have need of this exact word.

The third test is the competitor's use test. Under this test, if competitors are *not* already using a term from the mark at issue to describe their goods or services, this is evidence that the term is neither a natural nor obvious way to describe the goods or services. *See Firestone Tire and Rubber Company, 186 USPQ 557 (TTAB 1975)*. In the instant matter, there is no evidence of record of a competitor's use of Applicant 's Mark.

In view of the above arguments, Applicant believes that the proposed mark is entitled to registration on the Principal Register. However, if the Examining Attorney remains unsure, he is respectfully reminded that because of the thin line between suggestive and descriptive marks, it is the practice of the USPTO to resolve doubt in Applicant 's favor and publish the mark for opposition. *See In re Morton-Norwich Products, Inc. 209 U.S.P.Q. 791 (TTAB 1981)*; and *In re Grand Metropolitan Foodservice Inc. 30 U.S.P.Q.2d 1974, 1976 (TTAB 1994)*.