

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Koppers Performance Chemicals Inc.

Mark: SUNWOOD

Serial No. 87/903,808

Examining
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Commissioner for Trademarks
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RESPONSE TO OFFICE ACTION OF AUGUST 29, 2018

The applicant, Koppers Performance Chemicals Inc. (“Applicant”), by its attorneys, responds to the Office Action of August 29, 2018 as follows:

I.
INTRODUCTION

Applicant filed to register the mark SUNWOOD for, as amended herein, treated wood in the nature of wood treated with a copper-based wood preservative for protection against fungal decay and termites and lumber in the nature of lumber treated with a copper-based wood preservative for protection against fungal decay and termites in Class 19.

Applicant previously owned a registration for SUNWOOD (Registration No. 1,175,696) and Applicant’s predecessor, Osmose Holdings (formerly known as Osmose Wood Preserving Co. of America, Inc.), previously owned a registration for OSMOSE SUNWOOD & Design (Registration No. 1,239,892), both covering color additive compositions for use with wood preservatives of the chromated copper arsenate (CCA) type in Class 2 on the Principal Register (collectively, the “SUNWOOD Registrations”).¹

¹ The SUNWOOD Registrations were cancelled in 2016 when the marks were not renewed.

In an Office Action dated August 29, 2018, the Trademark Office refused registration of Applicant's SUNWOOD mark pursuant to 15 U.S.C. § 1052(e) on the grounds that the mark is allegedly merely descriptive of Applicant's goods. Applicant respectfully disagrees with the conclusion that its SUNWOOD mark is descriptive. In support of its argument, Applicant respectfully submits that: (A) the mark does not immediately convey any characteristic of Applicant's goods; (B) the SUNWOOD Registrations that previously existed on the Principal Register support a finding that Applicant's SUNWOOD application is also distinctive and registrable; and (C) if there is doubt as to whether a term is descriptive, such doubt must be resolved in favor of Applicant.

Applicant has also amended its classification of goods, as noted above, in light of the Office Action's requirement for clarification of the identified goods.

II.
**THE MARK SUNWOOD IS NOT MERELY
DESCRIPTIVE OF APPLICANT'S GOODS**

**A. The Mark SUNWOOD Does Not Immediately
Convey Any Characteristic of Applicant's Goods**

Applicant's mark is not merely descriptive as it does not immediately convey any characteristic of Applicant's goods. A mark need not "be devoid of all meaning in relation to the goods and services to be registrable on the Principal Register." Trademark Manual of Examining Procedure ("TMEP") § 1209.01(a). Suggestive marks, for example, consist of commonly used words but "require imagination, thought or perception to reach a conclusion as to the nature of the goods or services." *Id.* On the other hand, descriptive marks immediately tell the consumer "something about the goods or services." In re Bed & Breakfast Registry, 791 F.2d 157, 229 U.S.P.Q. 818 (Fed. Cir. 1986).

The determination of whether a mark is merely descriptive must be made in relation to Applicant's goods, not in the abstract. See e.g. In re Polo Int'l Inc., 51 U.S.P.Q.2d 1061, 1062-63 (T.T.A.B. 1999) (finding DOC in DOC-CONTROL would refer to the "documents" managed by applicant's software rather than the term "doctor" shown in a dictionary definition). The question is whether someone who knows what the goods and services are understands the mark to convey information about them. See In re TBG, Inc., 229 U.S.P.Q. 759, 760 (T.T.A.B. 1986) (finding SHOWROOM ONLINE not to be descriptive of computer databases of interior furnishings). The test then for descriptiveness is whether a mark immediately conveys an idea of "the intended purpose, function or use of the goods; . . . the class of users of the goods, of a desirable characteristic of the goods, or of the end effect upon the user." McCarthy, supra, § 11:16 at 11-21 – 11-22. Applying this very test, courts and the Trademark Trial and Appeal Board have found marks such as SUNWOOD to be distinctive and registrable.

For example, in In re Vaughn Furniture Co., the Trademark Trial and Appeal Board found the mark PINE CRAFTS for furniture was not descriptive. The Board noted that simply because the word "craft" may be used to describe furniture does not make the term merely descriptive for furniture. See 24 U.S.P.Q.2d 1068, 1069 (T.T.A.B. 1992). Similarly, in Stix Products, Inc. v. United Merchants & Manufacturers, the District Court for the Southern District of New York analyzed whether the mark CON-TACT for self-adhesive decorative plastics was descriptive. 295 F. Supp. 479 (S.D.N.Y. 1968). The court examined whether the mark conveyed any of the characteristics, functions, or qualities of the goods to anyone who was unfamiliar with the mark and determined that the mark CON-TACT was not merely descriptive even though self-adhesive paper can be referred to as "contact paper." Id. at 493.

Similarly, in In re Shutts, the Trademark Trial and Appeal Board decided that the mark SNO-RAKE for “a snow removal hand tool” was not descriptive. 217 U.S.P.Q. 363, 365 (T.T.A.B. 1983). The Board noted that the term “rake” did not “readily and immediately evoke an impression and understanding” of Applicant’s snow removal device. Id. at 364. Specifically, the Board stated, “[t]he concept of mere descriptiveness . . . must relate to general and readily recognizable word formulations and meanings . . . and should not penalize coinage of hitherto unused and somewhat incongruous word combinations whose import would not be grasped without some measure of imagination and mental pause.” Id. at 364-65.

The SUNWOOD mark creates a distinctive, registrable impression, and the term SUN does not immediately convey any information about Applicant’s treated wood and lumber. For example, the term SUN does not describe treatment for protection against the sun. Instead, Applicant’s goods are simply wood and lumber for use outdoors; therefore, the term SUN in SUNWOOD is at the very most only suggestive of Applicant’s goods and by no means descriptive of Applicant’s goods. When viewed in its entirety, the mark requires some imagination, thought, or perception to reach a conclusion as to the nature of Applicant’s treated wood and lumber goods.


Lastly, the references cited by the Trademark Office in the Office Action are in fact third parties’ references to the SUNWOOD mark owned by Applicant and its predecessor. Applicant sells its products to wood suppliers and retailers. Incidentally, the third party company references cited by the Trademark Office are referring to the products covered by the SUNWOOD Registrations. Although Applicant had allowed the SUNWOOD Registrations to lapse, some of its SUNWOOD products are still in the market. Thus, the cited third party

references do not indicate that Applicant's mark is merely descriptive, but in fact demonstrate that Applicant's mark functions as a trademark in the minds of Applicant's consumers.

B. The Prior SUNWOOD Registrations Are Evidence That Applicant's SUNWOOD Mark is Distinctive and Registrable

The Trademark Office had previously determined on at least two occasions that "SUNWOOD" was registrable for wood and related goods on the Principal Register without a § 2(f) claim and without a disclaimer. Applicant and its predecessor owned the SUNWOOD Registrations in connection with color treatment for wood, with use of the mark since July 1980. No office actions were rendered for either registration, and the marks were registered on the Principal Register from 1981 and 1983, respectively, to 2016.

Furthermore, the Trademark Office also allowed the following third-party mark to register on the Principal Register without a disclaimer of SUNWOOD: SUNWOOD FLOORS &

Design  (Registration No. 3561394)² for building materials, not of metal, namely, building timber; worked timber; floors, not of metal in Class 19 (disclaiming FLOORS).

² The SUNWOOD FLOORS & Design registration was cancelled in 2017 when the owner did not file for renewal of the international registration, upon which the U.S. registration was based.

Copies of the TSDR reports for the above-listed registrations are attached hereto as Exhibit A. Applicant's SUNWOOD mark is at least as distinctive as the SUNWOOD Registrations and the third-party SUNWOOD FLOORS mark listed above. The fact that the Trademark Office approved the above-mentioned marks for registration on the Principal Register without a disclaimer of "SUNWOOD" suggests that Applicant's SUNWOOD mark should also be considered distinctive.

**C. Any Doubts Regarding A Mark's Descriptiveness
Should Be Resolved In Favor Of Applicant**

Any doubt as to whether a mark is descriptive should be resolved in favor of the Applicant. As stated in McCarthy on Trademarks and Unfair Competition,

Because the line between merely descriptive and only suggestive terms is 'so nebulous,' the Trademark Board takes the position that doubt is resolved in favor of the applicant on the assumption that competitors have the opportunity to oppose the registration once published and to present evidence that is usually not present in ex parte examination.

McCarthy § 11.51 at 11-100 - 11-101.

Even when doubts exist as to whether a term is descriptive as applied to the goods or services for which registration is sought, it is the practice of the Trademark Trial and Appeal Board to resolve those doubts in favor of the Applicant, and allow the mark to register. In re Grand Metropolitan Foodservice, Inc., 30 USPQ2d 1974 (T.T.A.B. 1994). Additionally, in In re Penwalt Corp., 173 U.S.P.Q. 317, 319 (T.T.A.B. 1972), the Trademark Trial and Appeal Board, in finding that the mark DRI-FOOT for foot deodorant was not descriptive, noted that although the conclusion that DRI-FOOT was not descriptive was not "free from doubt . . . the doubt should be resolved in favor of the applicant." Id. See also In re Women's Publishing Co., 23 U.S.P.Q.2d 1876, 1877 (T.T.A.B. 1992) (finding that the mark DECORATING DIGEST for a magazine featuring articles on decorating was not descriptive and noting that "in accordance

with precedent, we must resolve any reasonable doubt in favor of applicant”); In re Merrill Lynch, Pierce, Fenner and Smith, 4 U.S.P.Q.2d 1141, 1144 (Fed. Cir. 1987) (“It is incumbent on the Board . . . to resolve reasonable doubt in favor of the applicant, in accordance with practice and precedent.”). Thus, Applicant respectfully submits that it has raised doubts regarding the descriptiveness of its SUNWOOD mark, and those doubts should be resolved in favor of Applicant.

Therefore, Applicant respectfully requests that its SUNWOOD application be approved for publication.