

Response to Office Action

MARK: PALEO PUDDING
SERIAL NO.: 88083555
APPLICANT: Eric Wagner
FILING DATE: August 17, 2018
INTERNATIONAL CLASSES: 030
TO: Susan Stiglitz
Examining Attorney
USPTO, Law Office 109

Applicant, Eric Wagner (“Applicant”) respectfully submits this Response to the Office Action issued on December 6, 2018 against Application Serial No. 88083555 for the PALEO PUDDING mark (the “Mark”).

The Examining Attorney has refused registration on the ground that the Mark is merely descriptive of Applicant’s goods, under 15 U.S.C. § 1052(e)(1). Applicant respectfully requests that the refusal be withdrawn as the Mark is not merely descriptive because the Mark is suggestive of the goods.

The Mark is Not Merely Descriptive Because it is Suggestive

A trademark is not merely descriptive if it does not immediately tell an average potential purchaser what the goods or services are. *In re Energy Resources Corporation*, 173 USPQ 510 (TTAB 1972) (holding ENERGY RESOURCES not merely descriptive of the services of exploration for and production of oil and gas for others). If a trademark does not without interpretation and imagination describe the goods or services, then the trademark is not merely descriptive. *In re The Gracious Lady Service, Inc.*, 174 USPQ 340 (TTAB 1972). If the mental leap between the mark and the applicant’s goods and services is not almost instantaneous, this strongly indicates suggestiveness, not mere descriptiveness. See *McCarthy On Trademarks* (4th ed.), § 11.67 at 118. Further, a trademark is not merely descriptive if it is not needed by others to describe the goods or services. See *McCarthy On Trademarks* (4th ed.), § 11.68.

Applicant’s mark does not merely describe its goods. The phrase “PALEO PUDDING” calls to mind an image that is altogether greater, and much richer in meaning than the functional scope of what the words actually describe. The Examiner cites many instances of the phrase “PALEO” used in relation to online pudding recipes. A significant portion of these, however, show the author using “PALEO” in the generically descriptive cultural shorthand to a set of dietary restrictions as “Atkins-friendly”, “South Beach-approved”, “gluten-free” or a spectrum of analogous dietary restrictions. For example, the recipe for “paleo and vegan pudding” reads as a descriptive title designed to be read by users searching primarily for those things in particular. See, e.g. Office Action of December 6, 2018, p. 2-25. Encountered as part of “PALEO PUDDING”, the “PALEO” is likely to strongly emphasize the instantly apparent brand name qualities of the phrase in the snack foods context. “Paleo” is not just a standard-issue dietary restriction, it sounds on a very particular and distinct wavelength culturally—the kind of pre-packaged extreme Silicon Valley lifestyle trend that inevitably filters down to general-audience Whole Foods-type fare (“organic,” “whole grain”).

Moreover, since many such holistic-living-focused snack/lifestyle brands style their goods as being understated, simple, and completely up front (Honest-Tea), sometimes playfully (Life Is Good). The simple “PALEO PUDDING”, with the light stylization in the form of alliteration of the solid “P”

sounds, the warm consonant sounds, the somewhat clashing connotations of “paleo” and “pudding”, and the potential to use the phrase figuratively that the average consumer is very likely to perceive the phrase PALEO PUDDING as a brand-identifier to begin with. With even the most minimal context clue that the phrase is used in a trademark context, average consumers will have no problem recognizing the mark as a brand signifier.

Moreover, Applicant’s goods—the ones consumers see in the marketplace associated with the phrase PALEO PUDDING—are comprised of a distinct and pre-recognized subset of the things that would technically fit the description of “paleo pudding” (is all pudding paleo?). Perhaps because the bounds of what would actually be “paleo pudding” are so seemingly broad and open-ended, the deliberate invocation of those two things together seems to have some greater meaning than the simple functional value of filtering possible results by things that are pudding and things that are paleo.

Finally, the phrase PALEO PUDDING has those pleasing holistic qualities that would lead a great deal of consumers to perceive it as a stylized phrase being used figuratively as the name of a chocolate flavor or a craft beer or a kind of trail mix or any other suggestive product. Without the proper context clues, it is very likely that this huge amount of average consumers would simply assume the phrase would fit the referred-to good with the required degree of distinctiveness, and by implication source-identifying capacity. As a result, when those consumers discover that PALEO PUDDING refers to Applicant’s goods, it will seem natural that those goods become associated with PALEO PUDDING as a brand name, since the phrase struck them as a brand name in the first place.

If the mental leap between the mark and the Applicant’s services is not almost instantaneous, this strongly indicates suggestiveness, not mere descriptiveness. *See McCarthy on Trademarks*, § 1.67 (4th ed.) at 118. There is no instantaneous recognition of the nature of Applicant’s goods from its mark, since the mark, on its surface, conveys information requisite for all goods of its kind. The conclusion consumers draw from the mark, rather, is as to the nature of the Applicant’s brand values and identity, which only secondarily redounds to the nature of the goods themselves. This “requires imagination, thought and perception to reach a conclusion as to the nature of goods and services.” *Stix Products*.

Based on the above, it is clear that Applicant’s mark PALEO PUDDING is not merely descriptive of Applicant’s goods. Further, there has been no showing that the mark is needed by others to describe their goods. Therefore, Applicant respectfully requests that the Examining Attorney reconsider and withdraw the refusal to register.

Doubts as to Registrability are Resolved in Favor of Applicant and Publication

Applicant respectfully notes that the Office bears the burden of demonstrating mere descriptiveness by a preponderance of evidence. At a minimum, Applicant has raised a doubt about the propriety of the classification of Applicant’s Mark as merely descriptive. Any doubts concerning the descriptive significance of a mark are to be resolved in favor of Applicant and of passing the mark to publication. *See In re Grand Forest Holdings Inc.*, 78 U.S.P.Q.2d 1152, 2006 WL 337549 (T.T.A.B. 2006).

As the Federal Circuit stated in the case *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 1571, 4 U.S.P.Q.2d 1141 (Fed. Cir. 1987), “It is incumbent on the Board to balance the evidence of public understanding of the mark against the degree of descriptiveness encumbering the mark, and to resolve reasonable doubt in favor of the applicant, in accordance with practice and precedent.” *See also In re the Gracious Lady Service, Inc.*, 175 U.S.P.Q. 380, 382, 1972 WL 17804 (T.T.A.B. 1972) (“It is recognized that there is a large gray area in determining the descriptiveness of a mark, and where reasonable men may differ, it has been the practice to resolve such doubt in an

applicant's behalf and publish the mark for opposition purposes ...”).

CONCLUSION

Applicant respectfully requests that the Examining Attorney withdraw the refusal to register Applicant's Mark and approve the Application for publication. If a telephone call will assist in the prosecution of this Application, the Examining Attorney is invited to call 917-933-3895.

Respectfully submitted,

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