

Response to Office Action

MARK: PUPPY
SERIAL NO.: 88201532
APPLICANT: Pawz LLC
FILING DATE: November 20, 2018
INTERNATIONAL 14, 18, 25, 35, 41
CLASS:
TO: Jennifer Button
Examining Attorney
USPTO, Law Office 105

Applicant, Pawz LLC (“Applicant”) respectfully submits this Response to the Office Action issued on March 1, 2019 against Application Serial No. 88201532 for the PUPPY mark in Classes 14, 18, 25, 35, and 41 (the “Mark”).

The Examining Attorney has refused registration on the ground that the Applicant’s Mark is merely descriptive of Applicant’s goods, under 15 U.S.C. § 1052(e)(1). Applicant maintains that the Mark is not merely descriptive because it is suggestive. Further, the Mark should be registered because similar marks exist for analogous goods on the Principal Register with no confusion. Consequently, Applicant respectfully requests that this refusal be withdrawn.

Descriptiveness Standard

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 is Not Merely Descriptive Because it is Suggestive

Applicant’s goods are *Jewelry; Jewelry, namely, dog tags for wear by humans for decorative purposes; Pet jewelry for dogs; Pet collar accessories, namely, pendants* in Class 14;

Dog collars and leads; Dog coats; Dog bellybands; Dog shoes; Dog parkas; Dog apparel; Dog clothing; Neckwear for dogs; Dog leashes in Class 18;

[as amended] *Clothing, namely, shirts, T-shirts, under shirts, night shirts, rugby shirts, polo shirts, cardigans, jerseys, uniforms, smocks, pants, trousers, slacks, jeans, cargo pants, stretch pants, denim jeans, overalls, jumpers, jump suits, shorts, boxer shorts, tops, stretch tops, tube tops, crop tops, tank tops, tankinis, halter tops, sweat shirts, hooded sweat shirts, sweat shorts, sweat pants, wraps, warm-up suits, jogging suits, track suits, play suits, blouses, skirts, dresses, sweaters, vests, fleece vests, pullovers, snow suits, parkas, capes, ponchos, cloaks, shrugs, jackets, coats, turtlenecks, ski bibs, swimwear, beachwear, tennis wear, surf wear, ski wear, layettes, infantwear, infants sleepers, booties, baby bibs not of paper, caps, beanies, hats, visors, headbands, wrist bands, sweat bands, headwear, ear muffs, aprons, scarves,*

bandanas, belts, suspenders, neckwear, ties, neckerchiefs, pocket squares, ascots, underwear, briefs, swim and bathing trunks, bras, thong underwear, singlets, socks, loungewear, robes, underclothes, pajamas, sleepwear, night gowns, nighties, lingerie, leg warmers, hosiery, pantyhose, body stockings, knee highs, leggings, tights, gloves, mittens, rain slickers, rainwear, boots, galoshes, sandals, flip-flops, and slippers in Class 25;

On-line retail store services featuring clothing; On-line retail store services featuring jewelry and accessories; On-line retail store services featuring pet apparel and accessories; Promoting the charitable services of others, namely, providing individuals with information about various charities for the purpose of making donations to charities in Class 35; and

Entertainment services, namely, providing images and text featuring animal stories and pictures on-line and in mobile wireless form in Class 41.

The Office has found the PUPPY trademark to be merely descriptive for the goods in Classes 14, 18, 35, and 41.

The trademark PUPPY is not merely descriptive of these goods because it is suggestive of them.

First, PUPPY is obviously descriptive of the pet-related goods in the above-referenced four International Classes; it is not *merely* descriptive, though. As the Office notes in its letter of March 1, “puppy” is not a pure synonym with “dog”, but a particular type of dog, namely, a young dog. The concept of young dogs – puppies – has an entire unique set of connotations distinct from those consumers associate with dogs in general, not to mention pets in general. Specifically, puppies are commonly associated with young children, or young families, and themes of optimism and commitment to responsibility.

Given the pet-related goods in question, the trademark PUPPY does convey a distinct, suggestive commercial impression. The Class 14 goods are jewelry with no qualifier, which presumably means jewelry for humans, dog tags for humans, and pet jewelry and pendants. The word PUPPY encountered as a trademark for jewelry is not descriptive at all. There is nothing pet-related about jewelry, per se. There is also nothing pet related about dog tags, despite the name. Indeed, if the Office is worried that the dog tags may be used as some version of a locket, with a beloved dog’s photo displayed, this is not likely, since dog tags by their very nature do not contain photos, only text. Alternately, since consumers, upon encountering a dog tags jewelry product, are likely to mentally pronounce the phrase “dog tags”, any dog-related matter (customizable text on the dog tags of one’s dog’s name, for example) is suggestive in the sense that it *suggests* the unspoken pun on dog tags-dogs as puppies.

Second, PUPPY is suggestive in the way the Board has defined the term in the past based on the practical reality that puppies are very cute. This dictates that when the average consumer, or anyone, uses “puppy” in a descriptive sense, i.e. when they call a dog a puppy, they are never *merely* describing the dog as a puppy. Nearly all average consumers would see how cute the puppy is and add some kind of baby-talk inflection on the word, and most likely add some other matter to the word “puppy”, i.e. “oohh a wiiddle puppy puppers” etc etc.

When a single familiar common word is used as a unitary brand name, especially for a range of goods as broad as pet-related products across 5 Classes, it is naturally interpreted by consumers for its more thematic meanings. For example, Staples or Greyhound. In this sense, consumers will encounter the word PUPPY as such a unitary trademark and naturally start to examine the word for deeper thematic or associative meanings. In this case, however, this is an absurd idea because aesthetically the word “puppy” is overpoweringly cute. It makes no sense to think about it seriously. Yet the Applicant’s Mark employs it very dryly as such a muted unitary brand name.

The goods in Class 18 are dog collars and leads, dog coats, bellybands, shoes, parkas, apparel, clothing, neckwear and leashes. PUPPY is suggestive of these goods for the latter reason set forth above, namely, because presenting this inherently cute word with a straight face is counterintuitive to most consumers since their experience of the word is usually less restrained (“who’s the puppy wuppy??”).

It should also be noted that PUPPY as related to dog goods in general is far more than merely descriptive. It takes on different significance based on the specific context, for example, when encountered with an old dog, PUPPY is somewhat ironic, like a bald man named Curly.

Finally, the PUPPY trademark does not merely describe the Class 35 and 41 services. The Class 35 services are online retail services featuring clothing and pet-related accessories. The PUPPY Mark suggests a particular set of connotations which are more than the mere descriptive value the word conveys, requiring the consumer to exercise a moment of reflection to reach a conclusion as to the nature of the services. It is therefore suggestive by the Board’s definition. The Class 41 services involve online entertainment services in the nature of providing images and text related to pet stories. Since the word PUPPY is only tangentially related, and since competitors would have plenty of other options for trademarks should they desire to compete with the Applicant in the market for these services, the Mark is suggestive for these Class 41 services.

Consequently, Applicant respectfully maintains that the mark is not merely descriptive because it is suggestive.

Similar Marks Exist on the Principal Register Without Confusion

Third-party registrations are not conclusive on the question of descriptiveness. Each case must stand on its own merits, and a mark that is merely descriptive must not be registered on the Principal Register simply because other such marks appear on the register. *In re theDot Commc’ns Network LLC*, 101 USPQ2d 1062, 1067 (TTAB 2011) (holding .music merely descriptive for, inter alia, on-line social networking services, domain registration services, interactive hosting services, electronic publishing, recording, and production services, online retail store and promotional services, and downloadable files and recordings despite the presence of third-party registrations for marks consisting of "dot ____" or ". ____"); *In re Scholastic Testing Serv., Inc.*, 196 USPQ 517, 519 (TTAB 1977) (holding SCHOLASTIC merely descriptive of devising, scoring, and validating tests for others despite the presence of other marks on the Register using the word "Scholastic"). The question of whether a mark is merely descriptive must be determined based on the evidence of record at the time registration is sought. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001) (holding ULTIMATE BIKE RACK merely descriptive of "bicycle racks" despite the presence of "ultimate" without a disclaimer in other marks on the Principal Register); *In re Sun Microsystems Inc.*, 59 USPQ2d 1084 (TTAB 2001) (holding AGENTBEANS merely descriptive of computer software for use in software development and deployment where the Board found that changes in the vocabulary of the field reduced the relevance of third-party registrations).

Applicant acknowledges that third-party registrations are not conclusive on the question of descriptiveness, but respectfully offers the following trademarks as evidence that similarly descriptive marks for analogous goods may exist on the Principal Register without the type of confusion the Trademark Act seeks to prevent:

PUP	Reg. No. 4581226	Carpet, namely, carpet that contains fibers or has been treated with chemicals designed to limit the absorbency and effects of exposure to pet urine
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		<p>and other liquids; carpet padding, namely, carpet padding that contains an impermeable or semipermeable top layer designed to resist the absorbency of pet urine or other liquids in Class 27; and</p> <p>Retail services by direct solicitation of sales agents in the field of carpeting and padding that are designed to limit the absorbency and effects of exposure to pet urine and other liquids; retail store services in the field of carpeting and padding that are designed to limit the absorbency and effects of exposure to pet urine and other liquids; online retail store services in the field of carpeting and padding that are designed to limit the absorbency and effects of exposure to pet urine and other liquids; mobile retail store services in the field of carpeting and padding that are designed to limit the absorbency and effects of exposure to pet urine and other liquids in Class 35</p>
DOVE	Reg. No. 4419926	Beauty wash, namely, liquid soaps in Class 03
AXE	Reg. No. 5008427	Body cleaning washes, deodorant and antiperspirant; hair care products, namely, shampoo, styling cream; facial cleansers in Class 03
BLUE RIBBON	Reg. No. 3253193	Processed meat, namely, poultry and poultry parts in Class 29

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 ...”).

Therefore, respectfully, the Mark is not merely descriptive of the applied-for goods because it is suggestive. Applicant asks that the 2(e)(1) be withdrawn.

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,

By: Abraham Lichy
The Lichy Law Firm, P.C.
Attorney for Applicant
222 East 68th Street
New York, NY 10065
917-933-3895
alichy@lichylaw.com