

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark: SMILE DIRECT CLUB
Serial No.: 88/268,881
Filing Date: January 20, 2019
Int. Classes: 21
Applicant: SmileDirectClub, LLC
Attention: Eric Sable
Examining Attorney
Law Office 117

RESPONSE TO OFFICE ACTION DATED APRIL 3, 2019

This responds to the Office Action dated April 3, 2019 concerning the application for SMILE DIRECT CLUB (the “**Mark**”), Serial No. 88/268,881 (the “**Application**”) by SMILEDIRECTCLUB, LLC (the “**Applicant**”). First, the Examining Attorney rejected the mark as merely ornamental based on the specimen submitted. Second, the Examining Attorney requested an amendment to the specified goods. Third, the Examining Attorney requested a disclaimer of the wording “DIRECT CLUB” used in the Mark. Each objection is addressed in turn below.

REMARKS

Merely Ornamental

The Examiner, based on the submitted specimen, rejected Applicant’s mark as merely ornamental. In response to the Examiner’s refusal, Applicant is submitting an alternate specimen online through TEAS, and respectfully requests that the merely ornamental refusal be withdrawn.

Amendment

Applicant has amended the identification of goods to read as indicated herein, in conformity with the Examining Attorney's helpful suggestions. Specifically, Applicant has amended its application to specify that its water bottles are "sold empty." Applicant believes this amendment is sufficiently specific and that it clarifies the identification without expanding or adding to the goods identified in the original application. *See* 37 C.F.R. § 2.71(a). Thus, Applicant respectfully requests that the amended identification of goods be accepted. The requested changes will be submitted online through TEAS.

Disclaimer

Applicant seeks to register the mark SMILE DIRECT CLUB in Class 21 for "Insulated containers for food or beverage for domestic use; coffee mugs; water bottles sold empty." The Examiner has requested that Applicant disclaim the wording "DIRECT CLUB" as descriptive of "an ingredient, quality, characteristic, function, feature, purpose, or use of applicant's goods and/or services." In response, Applicant respectfully submits that the phrase "DIRECT CLUB" is suggestive, rather than merely descriptive, when used to describe Applicant's insulated containers, coffee mugs, and water bottles. Applicant explains its position more fully below.

a. The Phrase "DIRECT CLUB" Does Not *Directly* and *Immediately* Describe the Purpose or Function of Applicant's Goods.

A mark is deemed to be merely descriptive only if it conveys a direct and immediate idea of an ingredient, quality, characteristic, feature, function, purpose, or use of the goods or services. *See, e.g., In re Abcor Development Corp.*, 588 F.2d 811, 814 (C.C.P.A. 1978). If, on the other hand, one must "follow a *multi-stage* reasoning process in order to determine what product or service characteristics the term indicates, the term is *suggestive* rather than merely descriptive." *In re Tennis in the Round Inc.*, 199 U.S.P.Q. 496, 498 (T.T.A.B. 1978) (holding

TENNIS IN THE ROUND not descriptive of tennis facilities) (emphasis added). Applicant respectfully submits that the phrase DIRECT CLUB does not directly and immediately describe the purpose or function of Applicant's goods.

The critical element in this standard is "directly and immediately." It is axiomatic that one may be informed by suggestion as well as description. *See, e.g., In re George Weston Ltd.*, 228 U.S.P.Q. 57, 58 (T.T.A.B. 1985) (SPEEDI BAKE is suggestive, not merely descriptive, of desirable characteristic of dough that quickly bakes into bread); *Jeno's Inc. v. Commissioner of Patents and Trademarks*, 227 U.S.P.Q. 227, 228 (D.Minn. 1985) (PIZZA ROLLS suggestive of snack rolls); *In re Shutts*, 217 U.S.P.Q. 363, 365 (T.T.A.B. 1983) (SNO RAKE suggestive of snow removal hand tool); *In re Pennwalt Corp.*, 173 U.S.P.Q. 317, 319 (T.T.A.B. 1972) (DRI-FOOT suggestive of applicant's goods). If, however, some operation of imagination, thought, or perception is necessary to reach a conclusion as to the nature or quality of the goods or services, the mark (or portion thereof) is suggestive, not merely descriptive. *In re George Weston Ltd.*, 228 U.S.P.Q. at 58.

Here, the phrase DIRECT CLUB is not merely descriptive because some operation of imagination or thought is required for consumers to discern the nature or qualities of Applicant's goods. The phrase "DIRECT CLUB" when used as part of the mark as a whole does not directly or immediately inform consumers that Applicant offers food containers and water bottles. It would not be clear to the average purchaser what the Mark suggests with respect to the applied-for goods. Instead, consumers viewing the Mark must engage in a "multi-stage reasoning process" to make a connection between the literal meaning of the entire Mark and Applicant's insulated containers, coffee mugs, and water bottles.

As an initial matter, Applicant respectfully notes that the nature of the goods Applicant intends to offer under the Mark have not been accurately described in the Office Action. The Office Action indicates that the Mark is used on products sold by “an organization that one joins in order to buy something.” That is incorrect, however. Applicant does *not* require individuals to join any sort of club or mailing list – or even to sign up to receive Applicant’s clear aligners – before they can order Applicant’s insulated containers, coffee mugs, and water bottles. Instead, any visitors to Applicant’s website may purchase the goods specified in the Application, because there is no actual “club” involved with the provision of the applied-for goods. Applicant’s Mark is intended to suggest to its consumers that associating with Applicant will allow them to show they are part of the proverbial “in crowd,” who are (or who plan to) increase their confidence and appearance with straighter teeth. Applicant’s urging of consumers to “join the club” is a conceit, employing the bandwagon propaganda advertising technique. The Mark suggests that by purchasing Applicant’s insulated containers, coffee mugs, and water bottles, consumers can join the cool crowd of others who wish to – or are – straightening their teeth.

To support the idea that the Mark is descriptive, the Examiner relies on the American Heritage Dictionary and the Macmillan Dictionary (for the definitions of “direct” and “club” respectively). Instead of proving that “DIRECT CLUB” is descriptive of the applied-for goods, however, the identified definitions underscore the suggestive nature of the phrase “direct club” when used on the applied-for goods. The dictionaries show that both of the terms “direct” and “club” can have a variety of different meanings in business, mathematics, science, sports, and astronomy (among others) – none that directly describe Applicant’s proposed goods. Furthermore, neither dictionary provides a definition for the combination of terms, “DIRECT

CLUB,” let alone one that relates to Applicant’s insulated containers, coffee mugs, and water bottles.

The Examiner does not state which basis he relies upon when claiming that the “DIRECT CLUB” portion of the mark is descriptive of Applicant’s goods, but to jump from the immediate impressions created by those definitions to Applicant’s insulated containers, coffee mugs, and water bottles requires multiple cognitive steps. Simply because the goods are shipped to consumers from Applicant’s website does not mean that its goods are any more “direct” than those of any other on-line retailer, or, indeed, any store that one enters to purchase similar items directly from the manufacturer.

Further, because Applicant does not actually run or maintain a club, or offer club membership services (or goods), the use of “club” in the mark is vague. The jump from an “organization that one joins in order to buy something” to a company that provides insulated containers, coffee mugs, and water bottles requires multiple cognitive steps. Consumers frequently purchase containers for their food and beverages, but the fact that a group of consumers may all go to a particular business for the same or similar goods does not render the business a “club.” Consumers may have any number of reasons for purchasing Applicant’s goods, and have no common interest in the goods Applicant makes available to others.¹

Beyond this, the list of meanings submitted in support of the Office Action underscores the myriad of meanings for the word “club,” none of which point directly to Applicant’s insulated containers, coffee mugs, and water bottles. For example, “club” can refer to an

¹ Applicant respectfully notes that in other instances, the Office has allowed registration of CLUB-formative marks **without a disclaimer of “club.”** where the applied-for goods and services were not in the nature of club services. These prior (recent) registrations are instructive here. *See, e.g.*, Reg. No. 5,703,169 (DIGITAL FIGHT CLUB for entertainment services); Reg. No. 5,697,067 (EAU CLUB for robes); Reg. No. 5,696,700 (RANG CLUB for hats and t-shirts); Reg. No. 5,689,794 (EASY SUNDAY CLUB & design for blankets and bedding); Reg. No. 5,679,467 (BITTERS CLUB & design for alcoholic bitters); Reg. No. 5,439,493 (THE A.V. CLUB for entertainment services); Reg. No. 5,704,895 (PATRIOTS CLUB for on-line retail and wholesale services); all included at Composite **Exhibit A**.

entertainment venue, a sports team, a weapon, or a suit of playing cards. Meanwhile, the list of definitions for “direct” indicates that it can mean “to show or indicate the way for” as well as “straightforward and candid.” These alternative definitions could have just as much, if not more, relation to Applicant’s brand and applied-for goods (*e.g.*, Applicant’s goods allow customers to tell their friends “directly” about how they can straighten their teeth, or “direct” them towards the goal of perfect teeth). The sheer number of possible meanings that *could* be attributed to Applicant’s use of “direct” means that a multi-step process will be required for consumers to determine how the Mark relates to Applicant’s goods. Consumers will have to stop, think and take notice of the Mark when used on the applied-for goods.

The bottom line is that none of the identified definitions for “club” or “direct,” on their own, or when seen in the context of the full SMILE DIRECT CLUB mark, describe Applicant’s goods in *any* way. Instead, consumers will have to make the rather sizeable leap from “direct club” to coffee mugs, insulated containers, or water bottles.

b. Competitors Do Not Need to Use the Phrase “DIRECT CLUB” to Describe Similar Goods.

The Board has held that if a competitor does not need to make use of a particular turn of phrase to describe competitive goods or services, then the phrase is generally deemed suggestive, rather than descriptive, for trademark purposes. *See, In re Minnesota Mining & Manufacturing Co. v. Johnson & Johnson*, 172 U.S.P.Q. 491 (T.T.A.B. 1972) (the term SKINVISIBLE for transparent medical adhesive tape not needed by competitors); *In re Reynolds Metal Co.*, 178 U.S.P.Q. 296 (C.C.P.A. 1972) (BROWN N’ BAG is suggestive for plastic bags and would not prevent competitors from informing buyers that goods may be browned in bags). Moreover, the fact that others in the industry do not use a particular phrase to describe their own goods or services is evidence (albeit by omission) that the term is suggestive rather than descriptive. *See,*

e.g., In re T.B.G., Inc., 229 U.S.P.Q. 759 (T.T.A.B. 1996); *Firestone Tire & Rubber Co. v. Goodyear Tire & Rubber Seal*, 186 U.S.P.Q. 557 (T.T.A.B. 1975); *In re Sweet Victory, Inc.*, 228 U.S.P.Q. 959, 961 (T.T.A.B. 1986). Here, the record is devoid of any evidence that competitors in the business of providing insulated containers, coffee mugs, and water bottles use the phrase DIRECT CLUB to describe, or inform consumers about, their own goods.

c. Doubts Should Be Resolved in Applicant's Favor

The line between marks that are suggestive and those that are merely descriptive is often a fine one. *In re conductive Systems, Inc.*, 220 U.S.P.Q. 84, 86 (T.T.A.B. 1983). For this reason, the Board takes the position that the “suggestive” threshold is relatively low. *In re Southern Nat'l Bank of North Carolina*, 219 U.S.P.Q. 1231 (1983) (test requires only “some degree of imagination”; MONEY 24 suggestive for “automated teller services”; refusal of registration reversed). Furthermore, the Board has noted that if there is any doubt as to whether a mark is merely descriptive, “it is clear that such doubts are to be resolved in favor of applicants.” *In re Shutts*, 217 U.S.P.Q. 363, 365 (T.T.A.B. 1983). To the extent that there are any doubts as to the inherent distinctiveness of any portion of the Mark, those doubts should be resolved in favor of Applicant.

CONCLUSION

For the foregoing reasons, Applicant believes it has addressed all of the issues raised in the Office Action, and respectfully requests that this Application be placed in the publication queue.

Signature page follows

May 8, 2019

FOLEY & LARDNER LLP

/Lisa Valenti-Jordan/

Jami A. Gekas
Lisa Valenti-Jordan
321 North Clark Street
Suite 2800
Chicago, IL 60610
Phone: 312-832-4500