

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Strong Current Enterprises Limited

Trademark: **HEALTH AND SOLE**

Serial No.: 88251276

Filed: January 6, 2019

Examining Attorney: DAWE III, WILLIAM H

Date: May 29, 2019

RESPONSE TO OFFICE ACTION

The Examining Attorney has refused registration of our proposed trademark "HEALTH AND SOLE" ("The "Applicant's Mark") on the basis of section 2(e)(1) of the Trademark Act. The Examining Attorney takes the position that the Applicant's applied-for mark is merely descriptive of a feature or purpose of applicant's goods and that the individual components and the composite result do not create a unique, incongruous, or non-descriptive meaning in relation to the goods.

In response to the refusal, Applicant respectfully submits that the proposed mark is not descriptive, that the applied for mark is unique, incongruous, or non-descriptive meaning in relation to the goods and the burden of establishing a prima facie case of mere descriptiveness has not been met in this case. In view of the following comments, the Examining Attorney is respectfully requested to withdraw the refusal.

Applicant's mark is not descriptive

Descriptive marks define a particular characteristic of the product or services in a way that **does not require any exercise of the imagination**; *George & Co. LLC v. Imagination Entertainment Ltd.*, 575 F. 3d 383, 394, 91 U.S.P.Q. 2d 1786 (4th Cir. 2009). As indicated at TMEP §1209.01(a), a descriptive term immediately tells something about the goods or services. On the other hand, suggestive marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. If one must exercise mature thought or 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. 196, 197 (T.T.A.B. 1978). For example, DRI-FOOT was held suggestive of anti-perspirant deodorant for feet in part because, in the singular, it is not the usual or normal manner in which the purpose of an anti-perspirant and deodorant for the feet would be described; *In re Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972).

As stated at TMEP §1209.01(a):

Incongruity is a strong indication that a mark is suggestive rather than merely descriptive. *In re Tennis in the Round Inc.*, 199 USPQ 496,498 (TTAB 1978) (TENNIS

IN THE ROUND held not merely descriptive for providing tennis facilities, the Board finding that the association of applicant's marks with the phrase "theater-in-the-round" created an incongruity because applicant's tennis facilities are not at all analogous to those used in a "theater-in-the-round"). The Board has described incongruity in a mark as "one of the accepted guideposts in the evolved set of legal principles for discriminating the suggestive from the descriptive mark," and has noted that the concept of mere descriptiveness "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.'" (emphasis added)

The words "HEALTH", and "SOLE" when combined to form HEALTH AND SOLE are grammatically incongruent. They are not words that are commonly or even logically combined together in this combination. The word SOLE has multiple meanings, it may be used as a noun or adjective. The word SOLE is also the homophone of the word SOUL which means a person's spirit and non-physical aspect. The word HEALTH is a noun which does not logically modify the noun or adjective SOLE. The addition of the noun or adjective SOLE does not give meaning to the noun HEALTH (i.e. the phrase HEALTH AND SOLE has no meaning). Upon first seeing or hearing the combination of HEALTH AND SOLE, thought is required to reach any understanding of how such words could fit together since, in fact, they do not fit together in a grammatical sense. It therefore follows that it would require imagination, thought, or perception to reach a conclusion as to the nature of the goods and services associated with the trademark HEALTH AND SOUL. The Applicant therefore submits that the trademark HEALTH AND SOLE is at least somewhat incongruous, and the import of the trademark HEALTH AND SOLE would not be grasped without some measure of imagination and 'mental pause.' Given that incongruity is a strong indication that a mark is suggestive rather than merely descriptive, the Applicant therefore submits that the Applicant's Mark is **suggestive rather than merely descriptive**.

Applicant's mark is suggestive

Courts primarily use the "imagination test" to determine whether a trademark is considered descriptive or suggestive and therefore deserving of registration. A mark is therefore only merely descriptive when it conjures an "**immediate and direct**" connection to the particular product. Thus, even **where the mark might "readily conjure up the image" of such product**, it is merely suggestive when a **variety of other connotations might also follow**. E.g. AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 349 (9th Cir. 1979)

The applied for mark HEALTH AND SOLE did not rise to the level of descriptiveness because nothing about "Health and Sole" conjures an "**immediate and direct**" connection to the applicant's goods: Foot massage apparatus; Orthopaedic soles; Orthopaedic inner soles incorporating arch supports; Orthopedic soles and Soles for Footwear. **HEALTH AND SOLE has several connotations**. HEALTH AND SOLE, when heard phonetically, can also connote HEALTH AND SOUL. Since SOLE also means solo, HEALTH and SOLE can also connote HEALTH and ONE. Insoles are not the only products that are connected with the soles of the feet. There are a variety of products, i.e. socks, shoes, slippers, foot lotion, foot bandage, etc.

A suggestive mark also employs terms that relate to the product's characteristics or intended use. The difference, at least in theory, is that a consumer must make a mental leap to

understand the relationship between a suggestive mark and the product. See *Xtreme Lashes, LLC*, 576 F.3d at 233 (“A suggestive term suggests, but does not describe, an attribute of the good; it requires the consumer to exercise his imagination to apply the trademark to the good.”). A suggestive mark thus “requires the observer or listener to use imagination and perception to determine the nature of the goods.” *Leelanau Wine Cellars*, 502 F.3d at 513 n.3 (emphasis added).

A suggestive term suggests, but does not describe, an attribute of the good; it requires the consumer to exercise his imagination to apply the trademark to the good.

Thus, the proposed mark, HEALTH AND SOLE *is merely suggestive and is not descriptive* of “Foot massage apparatus; Orthopaedic soles; Orthopaedic inner soles incorporating arch supports; Orthopedic soles and Soles for Footwear” as pointed out by the examiner, but instead requires the general public to use thought, imagination and perception to reach the conclusion as to the nature of the goods.

In refusals to register marks under Section 2(e)(1) of the Trademark Act, the Board has reversed decisions of the examining attorneys in the absence of actual evidence linking the recognized meaning of the mark sought to be registered to the goods of the Applicant. See *In re Bel Paese Sales Co.*, 1 U.S.P.Q.2d 1233 (T.T.A.B. 1986) (reversing examiner’s refusal to register “DOLCELATTE” where examiner failed to introduce evidence establishing that the public would perceive the mark as identifying a type of cheese).

Even if the Examiner continues to doubt the Applicant’s assertions, doubts about the “merely descriptive” character of a mark are to be resolved in favor of applicants. *In re Shutts*, 217 U.S.P.Q. 365 (TTAB 1983); See Also *In re Gracious Lady Services, Inc.*, 175 U.S.P.Q. 380 (TTAB 1972).

The Examining Attorney has the burden of establishing a prima facie case of mere descriptiveness. *In re Gyulay*, 3 U.S.P.Q.2d 1009 (Fed. Cir. 1987).

For at these reasons, Applicant respectfully submits that HEALTH AND SOLE is not merely descriptive of the specified goods.

REQUEST FOR INFORMATION

Due to the descriptive nature of the applied-for mark the Examining Attorney requested for information and documentation regarding the goods and wording appearing in the mark.

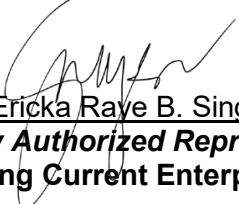
Fact sheets, instruction manuals, brochures, advertisements and pertinent screenshots of website related to the goods are not available as our filing basis is 1(b) which is intent-to-use.

Health and Sole will be a comprehensive eComm store featuring a variety of health, beauty and wellness products. The existing products we currently have include:

1. Acupressure Slippers;
2. Compression Socks;
3. Reflexology Bracelets & Rings;
4. Reflexology Insole;
5. All Clear Facial Cleansing Brush; and
6. Nature Spa Shower Head.

Having addressed and resolved the objections/requests raised by the Examining Attorney, the Applicant respectfully submits that this application is in condition for publication and respectfully requests that it be approved for publication at an early date.

Respectfully submitted,


By: Ericka Raye B. Singson
Duly Authorized Representative
Strong Current Enterprises Limited