

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Wayfair LLC

Serial No.: 88/173,412

Filed: Oct. 29, 2018

Mark: SOL 72 OUTDOOR

Examining Attorney
Caitlin Watts-FitzGerald
Law Office 111

RESPONSE TO FIRST OFFICE ACTION

Applicant, Wayfair LLC (“Applicant”), acknowledges receipt of the Office Action dated January 21, 2019 (“Office Action”). Please consider the following response to the Office Action.

RESPONSE

The Examining Attorney (“EA”) has requested clarification of the identification of goods and disclaimer of the wording OUTDOOR and SOL on the grounds that OUTDOOR and SOL are “merely descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of the applicant’s goods and/or services.” The EA has also requested a submission of an English translation for the foreign wording of SOL.

Applicant hereby amends the identification of goods in Class 20, submits a disclaimer of OUTDOOR, and submits a translation of “SOL” as requested by the Examiner. However, Applicant respectfully submits that SOL does not merely describe an ingredient, quality, characteristic, function, purpose, or use of the goods it seeks to register in connection with the mark, and that therefore a disclaimer of SOL should not be required.

AMENDMENTS

I. Identification of Goods

The EA requested the following amendment to the identification of goods in the application:

Class 20: Furniture; outdoor furniture; outdoor décor, namely, **{identify goods in Class 20 that would be considered a form of outdoor décor, e.g., outdoor blinds of textile}**; accent pillows; outdoor accent pillows

Applicant respectfully requests that the below amendment be made to the identification of goods in the Application:

Class 20: Furniture; outdoor furniture; ~~outdoor décor~~; accent pillows; outdoor accent pillows.

As the Examiner has advised that all other classes are acceptable as written, no additional amendments to the goods and services in this Application are being made.

II. Disclaimer of OUTDOOR

The EA asserts that OUTDOOR must be disclaimed because it merely describes an ingredient, quality, characteristic, function, purpose, or use of Applicant's goods. Applicant agrees to this disclaimer, and as such, Applicant respectfully requests that the EA accept Applicant's disclaimer that:

No claim is made to the exclusive right to use "OUTDOOR" as to all classes, apart from the mark as shown.

III. Translation

The EA requested that Applicant submit an English translation of "SOL." Applicant respectfully submits the following translation:

The English translation of "SOL" in the mark is "SUN."

ARGUMENTS AGAINST DISCLAIMER

The EA requests that Applicant disclaim the word SOL. Specifically, the EA contends that in class 18, “the goods are outdoor umbrellas to keep the sun off. SOL is translated to SUN in English, and identifies the use of the goods: to keep the user from the sun (a physical sun screen).” The Applicant respectfully submits that disclaimer of SOL should not be required because SOL is not merely descriptive of Applicant’s goods, including “patio umbrellas.” Applicant further notes that the USPTO has frequently allowed registration of “SOL” formative marks in class 18 without requiring a disclaimer of SOL, including for marks claiming umbrellas in the identification.

The EA may require a disclaimer of “an unregistrable component of a mark otherwise registrable.” 15 USC § 1056(a). A component of the mark is unregistrable if “when used on or in connection with the goods of the applicant is merely descriptive . . . of them.” 15 USC § 1052(e). “A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.” *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976). In contrast, “[a] term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of goods.” *Id.* Here, SOL is suggestive but not descriptive because it does not immediately convey the use of Applicant’s goods such as patio umbrellas.

The term SOL stands as an abstract term that requires a consumer to engage in thought and imagination to understand how SOL 72 OUTDOOR relates to patio and table umbrellas. *See, e.g., In re the Prudential Ins. Co. of Am.*, 2006 WL 236405, at *4 (TTAB Jan. 19, 2006) (disclaimer of DISCIPLINE in the mark EXPERIENCE RESEARCH DISCIPLINE for use with investment management services was not required because “the word DISCIPLINE alone and as it appears in the mark is more of an abstract term and is suggestive.”). The TTAB’s decision in *JPI ColorWorkshop, Inc.*, is instructive. There, the TTAB held that STRIPE WRITER for use in

connection with “coloring pens, writing pens, drawing pens and felt tip markers” was suggestive, rather than descriptive, because STRIPE WRITER would immediately convey a person who writes stripes rather than an instrument for writing. 2005 WL 1822541, at *4-5 (TTAB July 26, 2005). “SOL” is recognized as meaning sun. Similarly, SOL is not descriptive because Applicant’s goods do not create sun rather it is suggestive of an *instrument* that can be used when the sun is out (or when it is raining, or when a user needs some shade).

The Applicant’s goods, patio and table umbrellas, are not best – or even frequently – described using the term SUN/SOL. Therefore, Applicant’s mark is distinguishable from the case cited by the EA where the marks SNAP! and SNAP SIMPLY SAFER were merely descriptive of injection syringes that easily snap off to avoid accidental sticks. *DuoPro SS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1249 (Fed. Cir. 2012). There, the terms immediately and clearly described the product: a syringe that is *snapped* and sealed into a barrel for *safe* disposal. SOL/SUN on the other hand, does not immediately describe patio and table umbrellas and therefore is suggestive. Because SOL, used in connection with Applicant’s goods, is suggestive, not descriptive, Applicant respectfully submits that disclaimer of SOL should not be required.

The array of “SOL” formative marks that have been allowed to register in class 18 further confirm that SOL is not descriptive of table and patio umbrellas. *See In re Broadway Chicken Inc.*, 38 U.S.P.Q.2d 1559, *6 (TTAB 1996) (“Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field.”). These marks often include umbrellas in the goods description and

the USPTO did not require disclaimers. A small sample of these co-existing registrations are listed below.

Mark	Selected Goods
SOL MAR (U.S. Reg. 3779001)	Patio umbrellas
SOLEX (U.S. Reg. 4516746)	Leather and imitations of leather, and goods made of these materials and not included in other classes; trunks; suitcases; umbrellas; parasols; walking sticks; wallets; change purses; bags (envelopes, pouches) of leather, for packaging; travelling bags; key wallets
SOLARTECK (U.S. Reg. 3694892)	Umbrellas
SOLINCO (U.S. Reg. 3600953)	Backpacks [; boston bags; leather bags for climbers; all purpose bags for climbers; traveling bags; and bags for sports umbrellas]
SOLAS (U.S. Reg. 2988833)	purses, handbags, knapsacks, tote bags
SOL ANGELES (U.S. Reg. 5192262)	Backpacks, book bags, sports bags, bum bags, wallets and handbags; Messenger bags

Given the numerous other marks containing the term SOL used in connection with umbrellas without a disclaimer, the PTO has clearly concluded that SOL is not “merely descriptive” when used with these goods, and thus Applicant’s mark, SOL 72 OUTDOOR, should likewise be able to co-exist on the register without a disclaimer of SOL.

CONCLUSION

Through the foregoing Response, Applicant believes that it has addressed the issues raised by the Examining Attorney in the Office Action dated January 21, 2019. Applicant respectfully requests that the Examining Attorney withdraw the provisional refusal and approve

Applicant's Mark for publication.

Date: June 12, 2019

Respectfully submitted,

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