

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

U.S. APPLICATION SERIAL NO. 88245645)
)
MARK:)
THE CERAMIC ALLIANCE)
)
APPLICANT:)
Tile Council of North America, Inc.)
)

**RESPONSE TO
OFFICE ACTION**

Applicant respectfully responds to the Office Action dated March 20, 2019. The Office Action contained two primary issues for Applicant to address. First, the Office Action initially determines that the mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1). Second, the Office Action initially determines that the identification of services is indefinite. As set forth below, Applicant proposes to amend its description of services to one of the descriptions proposed in the Office Action. With this proposed amendment, Applicant respectfully submits that the mark is not merely descriptive and is entitled to registration on the Principal Register.

In noting that the current identification included several potential classes, the Office Action proposed that Applicant could adopt the following identification, if accurate:

Trade association services, namely, promoting the interests of members of the tile, brick, mortar, and masonry industries, in **International Class 35**.

Promoting the interests of members of the tile, brick, mortar, and masonry industries by means of public advocacy, in **International Class 35**.

Consulting services in the field of environmental assessment and planning in the tile, brick, mortar, and masonry industries, in **International Class 42**.

Expert witness services in legal matters in the field of safety in the tile, brick, mortar, and masonry industries, in **International Class 45**.

Consulting in the field of workplace safety in the tile, brick, mortar, and masonry industries, in **International Class 45**.

Having reviewed these proffered descriptions, Applicant desires to amend its description of services to cover only those listed in Class 42, namely:

Consulting services in the field of environmental assessment and planning in the tile, brick, mortar, and masonry industries, in **International Class 42**.

With this amendment, Applicant respectfully submits that the term THE CERAMIC ALLIANCE, when used for these services, is not merely descriptive.¹

Whether a mark is merely descriptive, and thus not initially entitled to registration on the Principal Register (without some other proof of acquired distinctiveness), or is inherently distinctive because it is fanciful, arbitrary, or suggestive, depends on the circumstances and where the mark falls on the “continuum” of trademark significance. *See* TMEP §1209.01. A suggestive mark is one that, when applied to the goods and services at issue, requires imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. *See* TMEP §1209.01(a). A merely descriptive mark, however, is one that only describes an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services. *See* TMEP §1209.01(b).

The TTAB has explained that “the suggestive/descriptive dichotomy can require the drawing of fine lines and often involves a good measure of subjective judgment.” *In re Shutts*, 217 U.S.P.Q. (BNA) 363, 365, 1983 TTAB LEXIS 150, *7-8 (TTAB February 25, 1983). Therefore, where there are doubts about whether a mark is suggestive or merely descriptive, “such doubts are to be resolved in favor of applicants.” *Id.* (emphasis added). For example, the TTAB resolved any doubts in favor of the applicant to conclude that “SNO-RAKE” was suggestive, not merely descriptive, for “a snow removal hand tool having a handle with a snow-removing head at

¹ Applicant focuses its discussion on the now-amended description, without necessarily conceding that the mark is descriptive of the services as originally proposed.

one end, the head being of solid uninterrupted construction without prongs.” *See id.* Similarly, the mark “DRI-FOOT” has been found suggestive and not descriptive for anti-perspirant foot deodorant. *See id.* (citing *In re Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972)).

While “CERAMIC” may be used as a term to describe tile, brick and masonry products, the use of this term in connection with “ALLIANCE” does not merely describe “an ingredient, quality, characteristic, function, feature, purpose, or use” of the (now-amended) services of “consulting services in the field of environmental assessment and planning in the tile, brick, mortar, and masonry industries.” *See* TMEP §1209.01(b). The term may *suggest* a relationship to the tile, brick, mortar, and masonry industries, but it still requires “imagination, thought, or perception” to reach a conclusion that Applicant would specifically be providing consulting services in the field of environmental assessment and planning. *See* TMEP §1209.01(a).

For example, the USPTO has registered on the Principal Register, without proof of acquired distinctiveness, the mark FORESTWATER ALLIANCE for use in connection with:

Charitable services, namely, promoting public awareness of and interest in protecting and restoring forests and watersheds; association services, namely, promoting public awareness by advocating for expanded conservation and restoration of forested watersheds; providing an internet website featuring news and information in the fields of forest and water resource management policy and natural resource management relating to the environment; business and natural resource management consulting services in the field of conservation, preservation and protection of forests, water, land, and other natural resources. [Class 35]

Providing an internet website featuring news and information in the fields of forest and water resource financial policy and management; financial consulting services in the field of conservation, preservation and protection of forests, water, land, and other natural resources. [Class 36]

See Reg. No. 5,752,985 (submitted herewith).

The use of these terms – FORESTWATER and ALLIANCE – together may suggest a group working to promote interests of protecting forests, but some “imagination, thought, or perception” is still required to determine that the specific services (such as “business and natural resource management consulting services in the field of conservation, preservation and protection of forests, water, land, and other natural resources”) would be offered.

Similarly, the mark HEALTHY BUSINESS ALLIANCE is registered on the Principal Register, without proof of acquired distinctiveness, for use in connection with:

Promoting the goods and services of others by means of a preferred customer program to participating members of chambers of commerce featuring insurance plans, employee health and wellness tools, payroll services, business consulting and assistance resources, and employee benefit programs; administration of a discount program to participating members of chambers of commerce for enabling participants to obtain discounts on the costs of services or receiving improved services; providing payroll processing services and business administration assistance resources to companies through chamber of commerce programs; providing health insurance exchanges in the nature of a marketplace that offers purchasers of health insurance a variety of plans from different insurance providers; Promoting employee benefit insurance plans of others for members of chambers of commerce and association participants; promoting a variety of insurance and health-related plans and programs of others via local chambers of commerce; promoting various types of insurance plans of others, namely, health insurance, dental insurance, vision insurance, and life insurance, to participating chamber of commerce member. [Class 35]

Consulting services in the field of insurance; insurance agency and brokerage services. [Class 36]

See U.S. Reg. 4359986 (submitted herewith).

Again, the use of “HEALTHY” in combination with “BUSINESS ALLIANCE”, while perhaps suggestive of health-related matters in the business community, still requires some “imagination, thought, or perception” to know that the services would include those listed above,

such as “consulting services in the field of insurance” or “insurance agency and brokerage services.”

In the present application, use of “CERAMIC” in conjunction with “ALLIANCE” requires similar imagination, thought, and perception to know that the Applicant is offering consulting services in the field of environmental assessment and planning in Class 42 as set forth above in the now-amended description. To the extent there are any doubts as to the distinctiveness of the mark, such doubts should be resolved in favor of the Applicant and the application allowed to proceed. *See In re Shutts*, 217 U.S.P.Q. (BNA) at 365.

Respectfully submitted,

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