IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE EXAMINER OF TRADEMARKS

Trademark / Servicemark Application United States Principal Register **In re Application of:** HinesLabs, Inc. 1540 Wabasso Way Glendale, CA 91208	Mark: KIDSAFE Serial Number: 88279836 International Class(es): 020

OFFICE ACTION RESPONSE

In the Office Action, mailed on April 15, 2019 ("Office Action"), the Examining Attorney refused registration on the Principal Register under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1) on the grounds that the "applied-for-mark merely describes a function or purpose of applicant's goods."

Specifically, the Office Action alleged that the word KID refers to "a child" or "a young person," and that the word SAFE means "affording protection." The Office Action concludes that the wording "kid safe" would refer to something affording protection to a child or young person.

Applicant has carefully reviewed the Office Action, but respectfully disagrees that the mark KIDSAFE is merely descriptive of the function or purpose identified in the application for the following reasons.

I. SECTION 2(E)(1) REFUSAL – MERELY DESCRIPTIVE

Applicant, ("Applicant") has applied to register **"KIDSAFE"** for services in 020 relating to baseboards to prevent furniture from tipping over, namely, for dressers, chests, cribs, and bookshelves.

A. THE MARK IS INHERENTLY DISTINCTIVE

Applicant contends that the composite mark KIDSAFE neither describes the goods recited in the application nor are any of its separate terms descriptive in anyway whatsoever as they pertain to Applicant's identified goods. In fact, Applicant's mark is inherently distinctive. A term is merely descriptive and unregistrable only if it immediately conveys knowledge of a significant quality, characteristic, function, feature, or purpose of the services it identifies. *In re Chamber of Commerce*, 102 U.S.P. Q 2d 1217, 1219 (Fed. Cir 2012). The determination of whether a mark is merely descriptive must be made in relation to the products for which registration is sought, not in the abstract. *Id*. At 1219. This requires consideration of the context in which the mark is intended to be used in connection with those products, and the possible significance that the mark would have to the average purchaser of the products in the marketplace. *Id*.

Conversely, a suggestive mark (which is registrable without evidence of acquired distinctiveness), is one for which imagination, thought, or perception is required to reach a conclusion as to the nature of the products. *In re Gyulay*, 3 U.S.P.Q. 2d 1009 (Fed. Cir. 1987). If one must exercise mature thought or follow a multi-stage reasoning process in order to determine what product characteristic the term indicates, the term is suggestive rather than merely descriptive. *In re Tennis in the Round, Inc.*, 199 U.S.P.Q. 496, 497 (TTAB 1978).

KIDSAFE does not describe an ingredient, quality, characteristic, function, feature, or purpose of the goods with which it is associated. At the very least, Applicant's mark is suggestive and not descriptive. The “imagination test,” which is widely used to distinguish a suggestive mark from a descriptive one, when applied to the instant case, supports Applicant’s position that its mark is at least suggestive. See 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §§ 11.05 and 11.22 (3d ed. 1995). A prospective consumer must use a certain amount of imagination to associate the mark KIDSAFE with a furniture baseboard that provide more stability to prevent it from tipping over. According to *Merriam Webster* online dictionary, the term “kid" means “a young person:”

According to *Merriam Webster* online dictionary, the term “safe” means “1: free from harm or risk : UNHURT, 2 a: secure from threat of danger, harm, or loss, b: successful at getting to a base in baseball without being put out, and 3: affording safety or security from danger, risk, or difficulty:”

The term “SAFE” would tend to invoke in the buyer’s mind many different types of goods and services, including an object that provides safety. The Office Action has not provided any evidence showing that Applicant’s baseboard refers to affording protection to a young person. In the minds of the ordinary consumer, the commercial impression of the term SAFE, alone, would NOT be a pane of wood located at the bottom of furniture to prevent it from tipping over.

In view of the foregoing, it would take a substantial amount of imagination on the part of the purchaser to associate the composite term KIDSAFE with the goods identified in the instant trademark application; therefore, KIDSAFE is a suggestive mark at the very least.

In addition, the "need test" (See 1 McCarthy, supra, at § 11.22.), supports

Applicant's contention that its mark is suggestive, at the least, rather than descriptive. The need test helps distinguish a descriptive mark from a suggestive mark by determining the likelihood that competitors will need to use the term to describe their products. In the present case, there is little likelihood, if any, that Applicant's competitors would need to use the term KIDSAFE to describe their furniture baseboard.

In view of the foregoing. Applicant's mark is ripe for registration because it is inherently distinctive and not descriptive.

Further, it is also well-established that "[T]he validity and distinctiveness of a composite trademark is determined by viewing the trademark as a whole, as it appears in the marketplace." *Official Airline Guides Inc. v. Goss*, 6 F.3d 1385, 1392 (9th Cir. 1993). The Office Action should not review the registrability of a composite term (or unitary) trademark by "dissecting" the term and reviewing the validity of its component parts individually. See also 2 James T. McCarthy, *McCarthy on Trademarks and Unfair Competition,* § 23.15[1][a], at 23-82 to 23-83. Further, a composite trademark may become a distinguishing mark, although its components individually cannot. Lanham Trademark Act, §§ 1, et seq., 15 U.S.C.A. §§ 1051, et seq.

In the present case, it is improper to dissect and pull apart Applicant's mark. KIDSAFE into two separate component terms, “KID” and “SAFE.” Applicant's mark must be viewed as a whole, and when this is done, it is apparent that Applicant’s KIDSAFE mark is at the very least suggestive, if not arbitrary and fanciful. Regarding the Applicant's mark KIDSAFE, there is neither a word dictionary definition of this term nor is there any such word that is currently in the vocabulary of the public.

Moreover, by combining the terms KID and SAFE into one composite mark, Applicant's mark clearly creates a new and different commercial impression, and this term also imparts a bizarre or incongruous meaning as used in connection with Applicant's services. *In re Associated Theatre Clubs Co.*, 9 U.S.P.Q.2d 1660 (TTAB 1988). Applicant's position is supported by the following decisions: *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694 (2 Cir.1961) (where the court held that plaintiff had a valid common-law trademark in the term "Poly Pitcher"); *Application of Colonial Stores, Inc.*, 157 U.S.P.Q. 382 (CCPA 1968) (The CCPA held that the mark "SUGAR & SPICE" is registrable because the combination of the words "SUGAR" and "SPICE" resulted in a composite mark which could not be said to be merely descriptive); *National Trailways Bus System v. Trailways Van Lines, Inc.,* 222 F.Supp. 143, 145 (E.D.N.Y. 1963) (holding "Trailways" a valid mark.) See also, *Coca-Cola Co. v. Seven-Up Co.,* 497 F.2d 1351 (C.C.P.A. 1974) ("Uncola" valid mark for soft drink); *Maremont Corp. v. Air Lift Co.,* 463 F.2d 111459 C.C.P.A. 1152 (1972) ("Load-Carrier" valid mark for shock absorbers); and *Tigrett Industries, Inc. v. Top Value Enterprises, Inc.*, 217 F.Supp. 313 (W.D.Tenn. 1963).

In the present case, the terms KID and SAFE result in an inherently distinctive composite mark. Further, as stated above, Applicant's mark would require a lot of imagination to understand that the goods with which the mark is used are related to a baseboard. Moreover, Applicant's position that its mark is inherently distinctive is further supported by the fact that the Office Action failed to provide evidence showing the terms KID and SAFE being used together, side by side with one another, in the context of describing goods that include a baseboard for furniture to prevent it from tipping over.

B. THE NATURE AND NUMBER OF SIMILAR REGISTERED MARKS DEMONSTRATE THAT APPLICANT'S MARK IS NOT MERELY DESCRIPTIVE

The KIDSAFE mark is not descriptive but suggestive. Although it is acknowledged that the existence of third-party registrations does not, by itself, justify registration of the Mark, the third-party registrations are indicators that other more descriptive marks were allowed. A brief search of the USPTO's records reveal a number of existing registrations for marks that 1) incorporate the term KIDSAFE (or similar variation), 2) are registered on the Principal Register without a §2(f) acquired distinctiveness claim, and 3) are for the products/services that seemingly protect children or are not dangerous to children. These marks include:

Mark	Registration No.	Date of Registration	Goods/Services
KIDSAFE HOME SAFETY PRODUCTS design mark	3,964,773	May 24, 2011	metal safety gates for babies, children, and pets
KID SAFE MAIL	3,543,639	December 9, 2008	computer services, namely, filtering emails and attachments and filtering language in such emails and attachments that is undesirable for children, including parental control of emails
KID SAFE CONNECTION design mark	3,986,371	June 28, 2011	non-metal identification bracelets to be worn by children for use in connection with subscription service provided to

			identify and reunite lost children with their parents or guardians" and "Missing child recovery services, namely, assisting in the identifying and reuniting of lost children with their parents or guardians using a telephone
KIDSAFE	3,418,969	April 29, 2008	electrical circuitry for use in vehicles with power panel closures, namely, power windows, power sun roofs, and power doors, for reversing power panel closure motor upon sensing presence of an object in the path of the power panel closure
KIDSAFE	2,591,561	July 9, 2002	window for a building
KIDSAFE	1,912,314	August 15, 1995	lenses for children's eyeglasses

Applicant's Mark should not be treated any differently than the Registrations noted above. Applicant sells products (baseboard) that are not dangerous to children and are safely used on or around children. Similarly, the registrants of the above marks offer a variety of products/services that are safe for children to use or protect children from particular dangers. Although Applicant understands that the Trademark Examining

attorney is not bound by the actions of other examining attorneys; however, as a matter of fairness and consistency, Applicant respectfully requests that its mark should be allowed for registration on the Principal Register.

As stated earlier, for a mark to be merely descriptive it must immediately convey a *significant* quality, characteristic, function, feature, or purpose of the products it identifies. In Applicant's opinion, the fact that its baseboards do not pose a health risk to children does not by itself meet that threshold. Applicant's products are marketed specifically to parents of young children. These parents would already universally assume Applicant's products are safe for use with children and likely would not even think twice about the characteristic when making their purchasing decision. Applicant's KIDSAFE mark does not describe any *particular* feature, function, characteristic, quality, or purpose of its baseboard, such as the steady, solid, firm, rock-hard, and/or stabilizing properties for which parents would specifically buy Applicant's baseboard. As such, Applicant's mark is entitled to registration on the Principal Register.

The burden is initially on the Trademark Office to make a *prima facie* showing that the mark in question is merely descriptive form the vantage point of the purchasers of Applicant's products. *In re Box Solutions Corp.*, 79 U.S.P.Q. 2d 1953, 1955 (TTAB 2006). To the extent that doubt exists as to whether a mark is merely descriptive, such doubt should be resolved in favor of the applicant. *Id.* In this case, the evidence demonstrates that Applicant's KIDSAFE mark is not merely descriptive of its products, but even if there remains some doubt as to the descriptive nature of KIDSAFE, such doubt should be resolved in Applicant's favor and its KIDSAFE mark should be published for opposition.

II. CONCLUSION

For the reasons stated herein, Applicant respectfully requests that the Trademark Examining Attorney to Withdraw his refusal to register the mark KIDSAFE and promptly pass this application for publication, and favorable action is also respectfully requested. Thank you.

Respectfully submitted,

COTMAN IP LAW GROUP, PLC

/Griffin Lee/

Griffin Lee
Cotman IP Law Group, PLC
Tel. (626) 405-1413
Fax (626) 316-7577