


**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

<p>In re Application of Edgewell Personal Care Brands, LLC</p> <p>Serial No.: 88/373,204</p> <p>Filed: April 5, 2019</p> <p>Mark: </p>	<p>Examining Attorney Elle Marino Law Office 121</p>
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**RESPONSE TO NON-FINAL OFFICE ACTION**

This responds to the non-final Office Action issued on May 15, 2019 (“Office Action”), in which the Examining Attorney refused registration on the ground that the applied-for mark merely describes Applicant’s goods, which are razors and razor blades. The Examining Attorney also required that Applicant amend the description of the mark.

Applicant hereby amends the description of the mark to the following: “The mark consists of a stylized design of a razor with stylized soap bubbles shown on the top left portion and bottom right portion of the razor head. A design of two overlapping circles appears on the razor handle, which the lower circle being larger than the upper circle and the upper circle cutting through the top right portion of the lower circle.”

Applicant further submits the following disclaimer statement: “No claim is made to exclusive right to use the pictorial representation of an outline of a razor apart from the mark as shown.”

As for the refusal under Trademark Act Section 2(e)(1), Applicant strongly disagrees with the Examining Attorney's refusal and requests that the refusal be withdrawn and that the applied-for mark be approved for registration on the Principal Register.

Under TMEP §1209.01(b), a mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's goods. Suggestive marks, on the other hand, 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. Thus, a suggestive term differs from a descriptive term, which immediately tells something about the goods or services. *See In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985) (SPEEDI BAKE for frozen dough found to fall within the category of suggestive marks because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread); *In re The Noble Co.*, 225 USPQ 749 (TTAB 1985) (NOBURST for liquid antifreeze and rust inhibitor for hot-water-heating systems found to suggest a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function, or attribute); *In re Pennwalt Corp.*, 173 USPQ 317 (TTAB 1972) (DRI-FOOT 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 the case at hand, the applied-for mark is a design of a razor that contains stylized soap bubbles on the top and bottom of the head of the razor and a design on the razor handle that contains a design element consisting of two overlapping circles, with the lower circle being larger than the upper circle, which appears to the top right of the lower circle. Applicant has submitted a disclaimer of the pictorial representation of the outline of a razor apart from the mark

as shown. As such, while the outline of the razor design shown in the mark may be descriptive of the identified goods, Applicant argues that the stylized soap bubbles that appear on the head of the razor and the design of the overlapping circles that appear on the handle of the razor are distinctive and, as such, are sufficient to carry this mark for registration on the Principal Register with the disclaimer provided by Applicant.

A visual representation that consists merely of an illustration of the goods, or of an article that is an important feature or characteristic of the goods or services, is merely descriptive under §2(e)(1) of the Trademark Act, just as a merely descriptive word would be. However, if the design is considered to not be merely an illustration of the goods or of an article that is an important feature or characteristic of the goods, the pictorial representation is not merely descriptive of the identified goods. *See In re LRC Prods., Ltd.*, 223 USPQ 1250 (TTAB 1984) (stylized hand design found not merely an illustration of the goods, i.e., gloves; thus not merely descriptive). Here, the stylized soap bubbles on the head of the razor and the overlapping circles design on the handle of the razor are not pictorial representations of the goods or articles that are important features or characteristics of the goods. Moreover, these design elements are distinctive and, as such, the applied-for mark should be registrable on the Principal Register.

With respect to the stylized soap bubbles, while such bubbles may form on a razor while the razor is in use by a user, the soap bubbles are not descriptive of the razor as these soap bubbles, which are stylized, can only be present on the razor once the razor is in use by the consumer. These soap bubbles are not part of the razor nor do they appear on the razor when the consumer purchases the razor. As such, these stylized soap bubbles suggest to the consumer the desired or end result of using the identified goods, which is that soap bubbles will form around the razor head. As such, these stylized soap bubbles are suggestive of the identified goods. This

is analogous to the *In re The Noble Co.* case noted above where the Board found that NOBURST for liquid antifreeze and rust inhibitor for hot-water-heating systems suggested a desired result of using the product rather than immediately informing the purchasing public of a characteristic, feature, function, or attribute. As the stylized soap bubbles that appear on the razor head do not immediately describe a characteristic or feature of the razor, this design is suggestive of the identified goods and, therefore, not descriptive of the goods under Trademark Act Section 2(e)(1).

Further, the overlapping circles design that appear on the handle of the razor is a fanciful design that does not immediately inform the consumer about a characteristic, feature, function, or attribute of the identified goods. The overlapping circles design is merely a fanciful design element on the handle that identifies Applicant as the source of the goods as Applicant uses this design element across its line of Intuition razors. Thus, it is clear that the overlapping circles design on the handle is not merely descriptive of the identified goods.

Finally, the Examining Attorney has failed to provide sufficient evidence to show that the applied-for mark is descriptive of the identified goods, particularly with respect to the stylized soap bubbles on the razor head and the overlapping circles design on the handle of the razor. The Examining Attorney failed to provide any evidence to support the refusal under Trademark Act Section 2(e)(1) and, as such, the Examining Attorney has not established a *prima facie* case that the applied-for design mark as a whole, which includes all of the elements of the design, is merely descriptive of the identified goods.

In conclusion, a mental step is required on the part of the consumer to understand the nature of the identified goods as the stylized soap bubble are suggestive of the desired result of using the identified goods and the overlapping circles design on the razor handle is fanciful and,

therefore, inherently distinctive. Therefore, in light of Applicant's disclaimer of the pictorial representation of the outline of a razor, Applicant respectfully requests that the refusal under Trademark Act Section 2(e)(1) be withdrawn and that the mark be approved for publication immediately on the Principal Register.

Respectfully submitted,

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