

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Rolf C. Hagen Inc.  
Serial No. : 88/220,688  
Date Filed : December 7, 2018  
Mark : SMOOTH AND SAVORY  
Class No. : 31  
Examiner : Mark Peisecki  
Law Office : 105

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**RESPONSE**

Applicant submits the following remarks in response to the January 18, 2019 Office Action and requests that the Examining Attorney reconsider and withdraw the outstanding refusal to register.

**REMARKS**

**Section 2(e)(1) Refusal – Merely Descriptive**

The Examining Attorney has initially refused registration of Applicant's SMOOTH AND SAVORY mark, contending that the mark is merely descriptive of Applicant's "pet food" under Section 2(e)(1) of the Trademark Act. Notably, the Examining Attorney has the burden of proving that Applicant's mark is merely descriptive of the goods in its identification. *See* T.M.E.P. § 1209.02. Applicant respectfully submits that this § 2(e)(1) refusal is improper in light of (a) the at-most suggestive nature of the mark in the context of Applicant's goods and (b) the unique and alliterative juxtaposition of the terms in Applicant's mark.

**A. Applicant's Mark is At-Most Suggestive in the Context of the Goods in Its Identification.**

Applicant's mark, SMOOTH AND SAVORY, is at-most, merely suggestive of the underlying goods, namely, pet food. Suggestive marks are those which require imagination, thought, or perception to reach a conclusion as to the nature of the goods or services. Thus, a suggestive term differs from a descriptive term, which immediately conveys something about the underlying goods or services. T.M.E.P. § 1209.01(a) (citing *In re Shutts*, 217 U.S.P.Q. 363, 365 (T.T.A.B. 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool)).

Moreover, Applicant submits that a designation does not have to be devoid of all meaning in relation to the goods or services to be registrable. It is well established that to be

characterized as “descriptive,” a mark must directly give some reasonably accurate or distinct knowledge of the characteristics of the product or service. If information about the product or service given by the mark is indirect or vague, then this indicates that the mark is being used in a “suggestive,” not descriptive, manner. Here, when used in connection with the applied-for goods, the mark SMOOTH AND SAVORY does not *immediately* convey a quality, characteristic, feature, or purpose of Applicant’s goods. The mental leap between the mark and the goods’ attributes is not instantaneous, because consumers do not primarily associate “smooth and savory” with pet food.

“Smooth and savory” is typically used to refer to human food. Specifically, food writers, restaurant critics, and food manufacturers frequently use the phrase to describe soups, sauces, spreads, salad dressing, and beverages such as coffee and wine. “Smooth and savory” implies that food or a beverage is a superior quality and may convey that the product is gourmet, rich, or a luxury food item or beverage. For example, people often use “smooth and savory” in relation to pâté and goat cheese. *See, e.g.,* Molly Wizenberg and Misha Gravenor, *A Taste of Pâté Past*, BON APPÉTIT (Nov. 15, 2008), <https://www.bonappetit.com/test-kitchen/cooking-tips/article/a-taste-of-p-t-past>; *Delamere Goat Cheddar*, iGOURMET (last accessed July 15, 2019), [https://www.igourmet.com/shoppe/prodview\\_prod.aspx?prod=8190&orderid=&](https://www.igourmet.com/shoppe/prodview_prod.aspx?prod=8190&orderid=&). Thus, consumers perceive “smooth and savory” as conveying an attribute of high-end or well-prepared human food. As a result, the notion of “smooth and savory” pet food is intended to be comical or playful, and the mark would not immediately inform consumers about the underlying goods.

**B. The Unique and Alliterative Juxtaposition of Terms in Applicant’s Mark Precludes a § 2(e)(1) Refusal.**

The ultimate determination of descriptiveness is made on the basis of the mark in its entirety. *See In re Hester Indus., Inc.*, 230 U.S.P.Q. 797, 798 n.5 (T.T.A.B. 1986). Even if the mark can be divided into descriptive components, the combination can be registered if the juxtaposition of the words is inventive or evokes a unique commercial impression, or if the term has a bizarre or incongruous meaning as applied to the goods. T.M.E.P. § 1209.03(d) (citing *In re Colonial Stores Inc.*, 394 F.2d 549, 552-53 (C.C.P.A. 1968) (SUGAR & SPICE held not merely descriptive of bakery products)). In the present case, Applicant has combined SMOOTH and SAVORY to create a unique and memorable mark in the context of pet food.

In support of the refusal, the Examining Attorney has attached internet evidence demonstrating that the words “smooth” and “savory” have separately been used to describe pet

food. However, aside from one website that describes the subject cat food as “savory and smooth,” each website displays “smooth” or “savory” alone without the precise combination of the applied-for mark. None of the referenced websites feature Applicant’s exact word order. The Examining Attorney has not provided any evidence showing that SMOOTH AND SAVORY, considered as a whole, has any descriptive significance as applied to pet food. Thus, within the pet food industry, the unusual juxtaposition of terms in Applicant’s mark gives the phrase source-identifying power, which in turns cuts against a finding that the mark is merely descriptive.

Furthermore, Applicant’s double use of the letter “S” as the first consonant in the two main components of Applicant’s mark, SMOOTH AND SAVORY, provides an element of alliteration. *See In re Jeffrey Butscher*, Serial No. 87/572,095, at \*7 (T.T.A.B. Jan. 29, 2019) [not precedential]. While not dispositive, alliteration “adds character to the mark,” which weighs against a finding that the mark is merely descriptive. *See id.* (citing *In re Star Metal Corp.*, 150 U.S.P.Q. 133, 134 (T.T.A.B. 1966) (“VITTLE VENDOR for food displaying and dispensing equipment is not merely descriptive, in part, because the alliteration adds character”); *In re David Crystal, Inc.*, 145 U.S.P.Q. 95, 95 (T.T.A.B. 1965) (“SPORTSWEAR FOR EVERYWEAR for dresses and suits is not merely descriptive, in part, because it has some alliteration”); *cf. In re Joseph Bancroft & Sons Co.*, 129 U.S.P.Q. 329, 331 (T.T.A.B. 1961) (“THE TEST IS IN THE TOUCH for knitted underwear, outerwear and hosiery is an alliterative slogan that possesses a certain degree of originality that serves as a trademark”)). Hence, the alliterative combination SMOOTH AND SAVORY creates a distinctive mark that evokes a unique commercial impression and obviates the § 2(e)(1) refusal.

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Finally, in support of registrability of the trademark, Applicant notes that in light of the lack of evidence of consumer understanding of any special meaning of the applied-for trademark, it must be assumed registrable. *In re American Fertility Society*, 51 U.S.P.Q.2d 1832, 1837 (Fed. Cir. 1999) (“[T]here was no evidence produced that the term is used by the relevant public to refer to a similar class.”). Consequently and for the reasons stated above, Applicant asks the Examining Attorney to withdraw the § 2(e)(1) refusal and permit Applicant’s mark to proceed to allowance.

## **CONCLUSION**

In view of the foregoing, the Applicant believes the application is in condition for allowance. Such action is solicited.