

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

August 9, 2019

Amy Kean  
Trademark Examining Attorney  
Law Office 112  
United States Patent and Trademark Office

RE: Serial No: 88412173  
Mark: ONDISPLAY  
Applicant: Vandue Corporation  
Office Action Of: June 20, 2019

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**APPLICANT'S RESPONSE TO OFFICE ACTION**

The following is the response of Applicant, Vandue Corporation, by Counsel, to the Office Action sent via email on June 20, 2019 by Examining Attorney Amy Kean.

**I. APPLICATION VOLUNTARY AMENDMENT TO DATES OF USE**

Pursuant to T.M.E.P. § 903.04, 37 C.F.R. § 2.20 and 37 C.F.R. §2.71(c), Applicant hereby amends the dates of “first use anywhere” and “first use in commerce”<sup>1</sup> of the mark ONDISPLAY for all goods and/or services identified in International Class 021 as follows:

- Date of First Use Anywhere: April 8, 2014 (04/08/2014)
- Date of First Use in Commerce: April 8, 2014 (04/08/2014)

The dates listed in the original application dated May 2, 2019 (May 5, 2015) were erroneous. These changes to the dates of use are supported by the affidavit or declaration associated with the filing of this Response to Office Action.

**II. DESCRIPTIVENESS REFUSAL**

The Examining Attorney has refused registration of the proposed mark pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), on the ground that the mark merely

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<sup>1</sup> Per the USPTO guidance, if an applicant/attorney finds an error after the examining attorney has issued an office action, proper procedure is to submit both the amendment and response to the office action at the same time using the form Response to Examining Attorney Office Action. See <https://www.uspto.gov/trademarks-application-process/filing-online/after-you-file>

describes Applicant's goods. For the following reasons, Applicant respectfully disagrees with the Office's finding and requests that the Examining Attorney reconsider the statutory refusal and allow registration of Applicant's mark.

**A. Factual Background**

Applicant seeks to register the mark ONDISPLAY for “[c]ontainers for household or kitchen use; cups; bowls; [m]ake-up brush holders” in International Class 021. The Examining Attorney refused registration on the following basis:

(1) the mark is a commonly used phrase ON DISPLAY compounded into one term – ONDISPLAY;

(2) both the individual components and the composite result are descriptive of applicant's goods and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods;

(3) dictionaries define the wording ON DISPLAY “to be a commonly used idiom that means an eye-catching arrangement by which something is exhibited and a collection of things being shown in a manner for all to easily see”; and

(4) all of Applicant's products are materially constructed of clear acrylic – enabling consumers to store their cosmetic products and household items in a manner that makes them easily seen (*i.e.*, store items while keeping them on display).

**III. Argument**

The Examining Attorney, respectfully, has not carried her burden of proof that Applicant's mark is merely descriptive. Specifically, registrability must be determined solely based on the goods or services specified in the application, not Applicant's merchandise. Here, the Examining attorney erred by basing the Trademark Act Section 2(e)(1) rejection on Applicant's clear acrylic products rather than the goods specified in the application – containers for household or kitchen use; cups; bowls; make-up brush holders.

Further, the applied-for mark is not descriptive of the goods identified in the application. Thought and imagination are required to understand the nature of Applicant's goods. Therefore, the mark is, at worst, suggestive and the Examining Attorney should withdraw the refusal under Section 2(e)(1).

Finally, in the alternative, Applicant's mark has acquired distinctiveness due to *inter alia* more than five years' substantially exclusive and continuous use in connection with the claimed goods.

**A. Applicable Law**

“Pursuant to the general rule that registrability is determined solely on the basis of the goods or services specified in the registration, the descriptiveness of the designation sought for registration is determined on the basis of the goods or services listed in the application, not the goods or services actually used or intended to be used.” J. McCarthy, *McCarthy on Trademarks and Unfair Competition* §11.51 (4th ed. 2017) (citing *In re Vehicle Information Network Inc.*, 32 U.S.P.Q.2d 1542 (T.T.A.B. 1994) (descriptiveness of an application is determined solely on the basis of the goods listed.))

A mark is merely descriptive only if it immediately describes an ingredient, quality, characteristic, function, feature, purpose or use of the identified goods or services. *See In re Gyulay*, 820 F.2d 1216 (Fed. Cir. 1987). Such information must describe the goods or services with a “degree of particularity.” *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199, 1204-1205 (T.T.A.B.1981). Further, to be deemed merely descriptive, a mark must directly provide the consumer with reasonably accurate knowledge of the characteristics of the product or service in connection with which it is used.

By contrast, a suggestive mark is one that, when applied to the goods or services at issue, requires imagination, thought, or perception as to the nature of the goods or services. *See In re Shutts*, 217 U.S.P.Q. 363 (T.T.A.B. 1983). If information about the product or service is indirect or vague, then the mark is considered suggestive, not descriptive. *See J. McCarthy, McCarthy on Trademarks and Unfair Competition* §11.16 (4th ed. 2017) (“[a] ‘descriptive’ term is one that directly and immediately conveys some knowledge of the characteristics of a product or service”); *see also* T.M.E.P. §1209.01(a) (“Suggestive marks 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.”)

Whether a term is merely descriptive or suggestive is determined not in the abstract, but in relation to the goods and/or services identified in the application for which registration is sought and the possible significance that the term would have to the average purchaser of the identified goods and/or services. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (T.T.A.B. 1979).

**B. The Examining Attorney Erred by Determining Descriptiveness on the Basis of Applicant's Products**

The descriptiveness analysis set forth in the Office Action misapplies the law by impermissibly analyzing Applicant's mark in connection with the products from Applicant's website rather than the goods listed in the application. "[T]he descriptiveness of the designation sought for registration is determined on the basis of the goods or services listed in the application, not the goods or services actually used or intended to be used." J. McCarthy, *McCarthy on Trademarks and Unfair Competition* §11.51 (4th ed. 2017) (emphasis added). "[T]he question of registrability must be determined ... on the basis of the goods or services as set forth in the application, rather than in reference to the precise nature of the goods or services on or in connection with which the mark is actually used or intended to be used." *In re Vehicle Information Network Inc.*, 32 U.S.P.Q.2d 1542 (T.T.A.B. 1994) (emphasis added) (citing *Octocom Systems Inc. v. Houston Computers Svcs. Inc.*, 918 F.2d 937 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods"); *In re Allen Electric and Equipment Co.*, 458 F.2d 1404 (C.C.P.A. 1972) ("[T]rademark cases must be decided on the basis of the identification of the goods as set forth in the application", not the specimen.); *In re Dataline Corp.*, 203 U.S.P.Q. 878 (T.T.A.B.1979) ("[I]t is well settled that it is the goods as set forth in the application papers that are determinative of the issue rather than what the evidence discloses such goods to be."). Thus, a proper descriptiveness inquiry only considers whether Applicant's mark "would provide information about a feature or characteristic of the [goods] as they are specified in the application." *In re Vehicle Information Network Inc.*, 32 U.S.P.Q.2d (emphasis added).

Notwithstanding the above guidance, the Examining Attorney's analysis in the Office Action are improperly based on Applicant's products and specimen rather than the goods identified in the application. First, the Examining Attorney defined "ON DISPLAY" to be "a commonly used idiom that means an eye-catching arrangement by which something is exhibited and a collection of things being shown in a manner for all to easily see." Second, the Examining Attorney stated that the "pictured products" on Applicant's website are "constructed of clear acrylic – enabling consumers to collect and store cosmetic products and other household items in a manner that makes them easily seen." (Emphasis added.) Finally, the Examining Attorney incorrectly concludes that

“applicant’s products by design, enable consumers to store items while keeping them *on display*.”  
(Emphasis added.)

Thus, the Office’s descriptiveness rejection is based solely on an improper analysis of Applicant’s products and should be withdrawn.

**C. ONDISPLAY is not Descriptive of the Goods Listed in Applicant’s Application**

ONDISPLAY (or “on display”) is not descriptive of the goods listed in Applicant’s application – *e.g.*, containers for household or kitchen use; cups; bowls; make-up brush holders. “A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services.” T.M.E.P. § 1209.01(b). ONDISPLAY (or “on display”) does not describe Applicant’s goods.

Here, ONDISPLAY (or “on display”) is not an ingredient, quality, characteristic, function, feature, purpose, or use of containers for household or kitchen use; cups; bowls; make-up brush holders.<sup>2</sup> Using the Examiner’s own definition (ONDISPLAY is an idiom that means an eye-catching arrangement by which something is exhibited) Applicant’s mark does not immediately describe Applicant’s claimed goods or convey an immediate knowledge of a characteristic of the identified goods.

If anything, ONDISPLAY (or “on display”) is the anthesis of Applicant’s goods because the goods are, *e.g.*, storage containers or other receptacles in which consumers put things away. It is counterintuitive (and in no way descriptive) that items, once put in a storage container, cup, bowl or make-up brush holder, would continue to be “on display” using the Examiner’s own definition of the term.

Similarly, Applicant’s mark does not immediately convey to one encountering it the nature of Applicant’s goods. *See* T.M.E.P. § 1209.01(b)<sup>3</sup> (“a mark is considered merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of an applicant’s goods or services.”) ONDISPLAY is neither a natural nor obvious way to describe Applicant’s storage containers, cups, bowls or make-up brush holders. It is therefore evident that relevant consumers would not immediately reach the conclusion that Applicant’s mark (ONDISPLAY)

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<sup>2</sup> In fact, the Examining Attorney does not present any evidence or argument that Applicant’s mark is descriptive of the goods identified in Applicant’s application.

<sup>3</sup> Citing *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, (Fed. Cir. 2012); *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64 (Fed. Cir. 2007).

describes household or kitchen containers, cups, bowls, and/or make-up brush holders. As a result, Applicant's mark is not merely descriptive, but at worst, suggestive.

**D. At Worst, Applicant's Mark is Suggestive**

Applicant's mark is not merely descriptive of its goods because the mark has an ambiguous and nebulous meaning that requires consumers to use imagination, thought and perception to understand the mark's relationship to the goods, and because the mark creates a distinct commercial impression. Therefore, Applicant's mark, at worst, has a suggestive connotation and is not merely descriptive.

To be deemed merely descriptive, a mark must directly provide the consumer *with reasonably accurate knowledge of the characteristics of the product or service in connection with which it is used*. If information about the product or service is *indirect or vague*, then the mark is considered suggestive, not descriptive. *See J. McCarthy, McCarthy on Trademarks and Unfair Competition* §11.19 (4th ed. 1998); Trademark Manual of Examining Procedure §1209.01(a) (“a suggestive term differs from a descriptive term, which *immediately* tells something about the goods or services”).

Here, Applicant's mark does not provide consumers with reasonably accurate knowledge of the characteristics of the claimed goods. As is stated in the Office Action, the Examiner defined “on display” as “an eye-catching arrangement by which *something* is exhibited and a collection of *things* being shown in a manner for all to easily see.” (Emphasis added.) Using this definition and its inherently vague terms (“something” and “things”), it is plain that the mark ONDISPLAY (or “on display”) does not describe household or kitchen containers, cups, bowls, and/or make-up brush holders – let alone describe these goods in a manner which provides consumers with reasonably accurate knowledge of the characteristics of the identified goods.

Rather, ONDISPLAY (or “on display”) is an ambiguous moniker that cannot provide real information about the functions, features or characteristics of Applicant's claimed goods. “[A] mark is suggestive if imagination, thought, or perception is required to reach a conclusion on the nature of the goods or services.” *Application of Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 525 (C.C.P.A. 1980). Applying the Examiner's definition to Applicant's claimed goods, it is unclear what exactly is being placed “on display” – the household/kitchen containers themselves? the various household/kitchen items stored in the containers? cups and/or bowls? the contents of the cups/bowls? make-up brush holders? make-up brushes? something else? It is precisely this

ambiguity which requires consumers encountering the mark to exercise imagination, thought and perception to reach a conclusion on the nature of Applicant's goods.

If Applicant's mark provides any information about the identified goods, such information is indirect and/or vague. For the foregoing reasons, the mark is suggestive, and therefore the Examining Attorney should withdraw the refusal under Section 2(e)(1).

**E. All Doubts as to Whether a Mark is Descriptive or Suggestive Must be Resolved in Applicant's Favor**

To the extent the Examining Attorney finds Applicant's ONDISPLAY mark to fall within the "gray area" between obviously descriptive marks, on the one hand, and suggestive marks on the other, all doubts must be resolved in Applicant's favor. *In re Conductive Systems, Inc.*, 220 U.S.P.Q. 84, 86 (T.T.A.B.1983) (where mark might be either descriptive or suggestive, doubts are to be resolved in favor of applicants; refusal reversed); *In re Pennwalt Corp.*, 173 U.S.P.Q. 317, 319 (T.T.A.B.1972) (DRI-FOOT not merely descriptive for antiperspirant foot deodorant; doubts to be resolved in favor of publication; refusal reversed). Accordingly, the Examining Attorney should withdraw the refusal under Section 2(e)(1).

**F. Acquired Distinctiveness**

In the alternative (should the Examiner continue to assert that the mark is descriptive), Applicant alleges that the ONDISPLAY mark, as a whole, has become distinctive as applied to Applicant's goods. Because Applicant has used its mark in commerce for more than 5 years, Applicant is entitled to registration of its mark under Trademark Act §2(f), 15 U.S.C. §1052(f), based on acquired distinctiveness.

To establish that a mark is registrable under section 2(f), Applicant may rely on any appropriate evidence tending to show that the mark distinguishes the Applicant's goods. 37 C.F.R. §2.41(a); T.M.E.P. §1212.03. It is well-established that Applicant need present only a *prima facie* case of acquired distinctiveness, rather than conclusive evidence, to be entitled to registration. T.M.E.P. §1212.01. Five years' use in commerce may be accepted as *prima facie* evidence that the mark has acquired distinctiveness. T.M.E.P. §1212.05.

Here, Applicant began using the ONDISPLAY mark in connection with all the goods identified in the application beginning April 8, 2014 – more than five (5) years prior to the Application and the date on which the current claim of distinctiveness is made. Applicant's use of the mark has been substantially exclusive and continuous since April 8, 2014.

The five years of use do not have to be exclusive, but may be substantially exclusive. This makes allowance for use by others that may be inconsequential or infringing, which does not necessarily invalidate the applicant's claim. *L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349 (Fed. Cir. 1999). Applicant's use of the ONDISPLAY mark since April 8, 2014 has been substantially exclusive.

Further, Applicant's use of the ONDISPLAY mark since April 8, 2014 was continuous, with no periods of "nonuse" or suspension of trade in the goods in connection with which the mark is used. To the contrary, use of the mark in connection with the identified goods generally expanded during this period.

Documentation and sworn statements supporting the claim that the ONDISPLAY mark has become distinctive of Applicant's goods through Applicant's continuous use of the mark in commerce for at least the five years preceding the date on which this claim is made are not currently provided, but may be submitted to the Office upon request.<sup>4</sup>

#### **IV. POTENTIAL SUSPENSION ADVISORY**

Applicant specifically reserves all rights to present arguments in support of registration in light of U.S. Application Serial No. 87648877 identified in the Office Action. Applicant notes that a Suspension Letter was issued to the owner of Application Serial No. 87648877 on June 7, 2019, and no response has yet been provided to the USPTO.

#### **V. CONCLUSION**

For the foregoing reasons, Applicant's mark is not merely descriptive and the refusal under Section 2(e)(1) should be withdrawn. If any further information or response is required, please contact Applicant's attorney. The attorney may be reached at (619) 343-3984 or [adam.garson@garsongutierrez.com](mailto:adam.garson@garsongutierrez.com).

Sincerely,  
GARSON & GUTIERREZ, PC



Adam S. Garson

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<sup>4</sup> This argument and evidence is submitted without prejudice to Applicant's right to submit further and additional argument and evidence should the Examining Attorney continue to refuse to allow Applicant's mark to proceed to publication.