

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
APPLICANT’S RESPONSE TO OFFICE ACTION**

**Application Serial No.:** 88216610

**Applicant:** Society of Corporate Compliance  
And Ethics and Health Care Compliance  
Association, DBA SCCE

**Correspondent:** Katheryn A. Andresen  
Nilan Johnson Lewis PA  
120 South Sixth Street, Suite 400  
Minneapolis, Minnesota 55402

**Mark:** REPORT ON SUPPLY CHAIN COMPLIANCE

**Examiner:** Fong Hsu

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In the Office Action issued March 7, 2019, the registration of the mark REPORT ON SUPPLY CHAIN COMPLIANCE, Application No. 88216610, applied for by Society of Corporate Compliance and Ethics and Health Care Compliance Association, DBA SCCE (“Applicant”), was refused under 15 U.S.C. § 1052(e) due to a *merely descriptive* argument. Based on the information presented below, Applicant respectfully requests that the examining attorney reconsider the refusal and grant the application for Applicant’s mark.

**APPLICANT’S MARK IS NOT MERELY DESCRIPTIVE**

**A. General Information.**

The registration of Applicant’s mark was refused on a *merely descriptive* basis. This refusal was based on the applied-for mark merely describing a feature/ingredient/characteristic/purpose/function/intended audience/etc. of Applicant’s good and/or services. 15 U.S.C. § 1052(e)(1).

A mark is merely descriptive if it descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant’s goods and/or services. *See, e.g. In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (*quoting In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm’r of Patents*, 252 U.S. 538, 543 (1920)).

## **B. Applicant's Services Are Not Merely Descriptive.**

The examiner found that the applied for mark "REPORT ON SUPPLY CHAIN COMPLIANCE" is merely descriptive of Applicant's identified goods and/or services, because it merely describes that the goods/services feature "reports" which are detailed accounts or statements presumably in the field of supply chain compliance. Thus, the examiner concluded that the mark is properly refused under 15 U.S.C. § 1025(e)(1).

Applicant's mark "REPORT ON SUPPLY CHAIN COMPLIANCE" was filed in the following classes:

International Class 009:

Downloadable electronic publications in the nature of newsletters and magazines in the field of regulatory compliance.

International Class 016:

Printed newsletters and magazines in the field of regulatory compliance.

International Class 038:

Providing on-line electronic bulletin boards for transmission of messages among users concerning regulatory compliance.

International Class 041:

On-line journals, namely, blogs featuring content in the field of regulatory compliance; providing online newsletters in the field of regulatory compliance via e-mail.

When analyzing whether or not a mark is merely descriptive, the courts look both to the mark as a whole as well as the context of the goods and/or services. *See In re Bright-Crest, Ltd.*, 204 U.S.P.Q. 591, \*3 (TTAB 1979) ("the question of whether or not a particular designation is merely descriptive must be determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which the designation is being used on or in connection with said goods or services, and the possible significance that it would have, because of such manner of use, to the average purchaser of the goods or services.") (citations omitted).

While the examining attorney found that each word of the mark was descriptive on its own, the mark must be considered as a whole. *Id.* ("Finally, it does not follow as a matter of law that, because the component words of a mark may be merely descriptive and therefore unregistrable, the combination thereof is equally descriptive and incapable of functioning as a trademark; the question is whether the mark considered in its entirety possesses a merely descriptive significance

as applied to the goods in question, i.e., whether it conveys a readily understood meaning to the average purchaser of such goods.”).

Applicant respectfully submits that the mark as a whole, REPORT ON SUPPLY CHAIN COMPLIANCE, is ***not*** merely descriptive of Applicant’s goods and services. Combinations of words or word parts in a mark, which might themselves be descriptive if taken separately, are not necessarily descriptive if used as a mark. *See, e.g., Equine Techs., Inc. v. Equitech., Inc.*, 68 F.3d 542, 545 (1st Cir.1995) (holding that “EQUINE TECHNOLOGIES” in its entirety is not descriptive of hoof pads for horses, notwithstanding that “equine” describes horses). The examining attorney states “because it merely describes that the goods/services feature “reports” which are detailed accounts or statements....” It is relevant to note that Applicant does not use the word “report” and that the goods and services are electronic publications, printed publications, electronic bulletin boards, and online journals/blogs.

Additionally, when taken as a whole REPORT ON SUPPLY CHAIN COMPLIANCE is actually only suggestive of the electronic publications, printed publications, electronic bulletin boards, and online journals/blogs. Contrary to the examples provided in *Finance Exp. LLC v. Nowcom Corp.*, 564 F.Supp.2d 1160, 1169 (C.D. Cal. 2008) where “Honey Baked Ham” was deemed a descriptive term for a ham that has been baked with honey and “Honey Roast” was deemed a descriptive term for nuts that have been roasted with honey, Applicant’s mark is more suggestive than descriptive considering the nature of the goods and services because consumers would have to use their imagination to associate such electronic access (e.g. an online journal or blog) from a word such as “report.”

## **CONCLUSION.**

Applicant respectfully asserts that the mark REPORT ON SUPPLY CHAIN COMPLIANCE when taken as a whole is suggestive and not merely descriptive of Applicant’s goods and services. Applicant requests that the examining attorney reconsider his refusal.